Ref No. 21307.034

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 86/154,616 and Supplemental Registration No. 4,549,532
Filed: December 30, 2013 and Supplemental Registration Issued: June 10, 2014
For Marks: TULSA ATHLETICS EST. 2003 and Design and TULSA ATHLETICS
Published in the Official Gazette: May 20, 2014

ATHLETICS INVESTMENT GROUP LLC D/B/A THE OAKLAND ATHLETICS BASEBALL COMPANY, Opposer/Petitioner, v. TULSA ATHLETICS, LLC, Applicant/Registrant.	Opposition No. Cancellation No. **COMBINED NOTICE OF OPPOSITION AND PETITION FOR CANCELLATION**

11/20/2014 SWILSON1 00000002 86154616
01 FC:6402 300.00 OP

Commissioner for Trademarks
Attn: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

11/20/2014 SWILSON1 00000003 4549532
01 FC:6401 300.00 OP

Opposer/Petitioner Athletics Investment Group LLC d/b/a The Oakland Athletics Baseball Company ("Opposer/Petitioner"), a California limited liability company with offices at 7000 Coliseum Way, Second Floor, Oakland, California 94621, believes that it will be damaged by (1) registration of the mark TULSA ATHLETICS EST. 2003 and Design ("Applicant/Registrant's Design Mark") by Tulsa Athletics, LLC ("Applicant/Registrant") for "Entertainment in the nature of soccer games" in International Class 41, as shown in Application Serial No. 86/154,616 (the "Application"), and (2) continued registration of the standard character word mark TULSA ATHLETICS ("Applicant/Registrant's TULSA ATHLETICS

11-17-2014
U.S. Patent and Trademark Office #72

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I hereby certify that this paper or fee is being deposited with the United States Postal Service "**Express Mail** Post office to Addressee" service under 37 C.F.R. 1.10 on the date indicated below and is addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on
11-17-14 COLLEEN REGAN
(Date of Deposit) (Print name)
Colleen Regan
(Signature)

21307/034/1552566.2

Mark") (together with Applicant/Registrant's Design Mark, "Applicant/Registrant's Marks") on the Supplemental Register for "Entertainment in the nature of soccer games" in International Class 41 as shown in Registration No. 4,549,532 (the "Supplemental Registration"), and having been granted extensions of time to oppose the Application up to and including November 16, 2014, Opposer/Petitioner hereby opposes the Application and hereby petitions to cancel the Supplemental Registration.

As grounds for opposition, it is alleged that:

1. Opposer/Petitioner is the owner of the renowned OAKLAND ATHLETICS MAJOR LEAGUE BASEBALL club (the "Club").

2. Since long prior to April 4, 2013, Applicant/Registrant's claimed first use date, Opposer/Petitioner and its predecessors, and their affiliated and related entities, licensees and/or sponsors have used marks and names comprising or containing the word "ATHLETICS," a stylized letter "A" and/or the term "A's" in an Old-English stylization, alone or with other word, letter and/or design elements, including, without limitation, the geographic designations "OAKLAND," "PHILADELPHIA," and/or "KANSAS CITY," and including, without limitation, in the following distinctive stylizations: Athletics, Athletics, A's, A's, OAKLAND A's ATHLETICS, and ("Opposer/Petitioner's ATHLETICS Marks"), in connection with baseball games and exhibition services and a wide variety of goods and services, including, but not limited to, organizing community sporting events, fan clubs, organizing and

conducting fantasy sports, sports contests and sweepstakes, information services, namely, providing information in the field of sports, entertainment and related topics, and providing for informational messages relating thereto, educational services in the nature of baseball skills programs, baseball camps, and clinics offered live; apparel, including, without limitation, hats, shirts, shorts, jackets, jerseys, sweatshirts, and footwear; sporting goods and toys; paper goods and printed matter; jewelry; and novelty items, and Opposer/Petitioner's principal has an ownership interest in a soccer team that has played at the Club's home stadium.

3. Since long prior to April 4, 2013, Applicant/Registrant's claimed first use date, Opposer/Petitioner and its predecessors, and their affiliated and related entities, licensees and/or sponsors have used the combined colors green and gold in connection with Opposer/Petitioner's ATHLETICS Marks, and the combined colors green and gold have long been strongly associated with Opposer/Petitioner (the "ATHLETICS Trade Dress Colors").

4. Opposer/Petitioner owns U.S. federal registrations for Opposer/Petitioner's ATHLETICS Marks in International Classes 6, 9, 11, 14, 16, 18, 20, 21, 24, 25, 28 and 41; namely, Registration Nos. 1,234,697, 1,257,146, 1,263,825; 1,267,687; 1,267,861, 1,523,854, 1,530,675; 1,530,851; 1,560,962; 1,570,831, 2,573,396; 2,630,348; 2,759,932; 3,349,787, 3,349,788, 3,349,789; 3,538,727; 3,633,242 and 3,633,243. Registration Nos. 1,234,697, 1,257,146, 1,263,825; 1,267,687; 1,267,861, 1,523,854, 1,530,675; 1,530,851, 1,560,962, 1,570,831, 2,573,396, 2,630,348, 2,759,932, 3,349,787, 3,349,788 and 3,349,789 are incontestable. Registration No. 3,538,727 is partially incontestable.

5. Since long prior to April 4, 2013, Applicant/Registrant's claimed first use date, Opposer/Petitioner and its predecessors, and their affiliated and related entities, licensees and/or sponsors have promoted and advertised the sale and distribution of goods and services bearing or

offered in connection with Opposer/Petitioner's ATHLETICS Marks, including, but not limited to, baseball games and exhibition services and a wide variety of goods and services, including, but not limited to, organizing community sporting events, fan clubs, organizing and conducting fantasy sports, sports contests and sweepstakes, information services, namely, providing information in the field of sports, entertainment and related topics, and providing for informational messages relating thereto, educational services in the nature of baseball skills programs, baseball camps, and clinics offered live; apparel, including, without limitation, hats, shirts, shorts, jackets, jerseys, sweatshirts, and footwear; sporting goods and toys; paper goods and printed matter; jewelry; and novelty items, and have offered such goods and rendered such services in commerce.

6. As a result of the sales and promotion of its goods and services bearing or offered in connection with Opposer/Petitioner's ATHLETICS Marks, Opposer/Petitioner has built up highly valuable goodwill in Opposer/Petitioner's ATHLETICS Marks, and said goodwill has become closely and uniquely identified and associated with Opposer/Petitioner.

7. On December 30, 2013, Applicant/Registrant filed an application to register Applicant/Registrant's TULSA ATHLETICS Mark for "Entertainment in the nature of soccer games" in International Class 41, claiming a first use date of April 4, 2013. The Examining Attorney found that Applicant/Registrant's TULSA ATHLETICS Mark was primarily merely descriptive of Applicant/Registrant's services and primarily merely geographically descriptive of the origin of Applicant/Registrant's services, and the application was later amended to the Supplemental Register and matured to Supplemental Registration No. 4,549,532 on June 10, 2014.

8. Upon information and belief, Applicant/Registrant did not use Applicant/Registrant's TULSA ATHLETICS Mark in commerce in connection with the services

covered by the Supplemental Registration prior to April 4, 2013, Applicant/Registrant's claimed first use date.

9. As Applicant/Registrant has claimed Applicant/Registrant's TULSA ATHLETICS Mark as a standard character mark, continued registration of such mark effectively could give Applicant/Registrant rights to use Applicant/Registrant's TULSA ATHLETICS Mark in any stylization, including the stylizations of Opposer/Petitioner's ATHLETICS Marks, which have been duly registered and/or have priority over Applicant/Registrant's TULSA ATHLETICS Mark, or in stylizations confusingly similar thereto. Additionally, continued registration of such mark effectively could prevent Opposer/Petitioner from developing additional ATHLETICS marks in the future and/or registering Opposer/Petitioner's ATHLETICS Marks for services in International Class 41 or related classes.

10. On December 30, 2013, Applicant/Registrant filed the Application for Applicant/Registrant's Design Mark for "Entertainment in the nature of soccer games" in International Class 41, claiming a first use date of April 4, 2013.

11. Upon information and belief, Applicant/Registrant did not use Applicant/Registrant's Design Mark for the services covered in the Application in United States commerce prior to its earliest claimed first use date of April 4, 2013.

12. Upon information and belief, Applicant/Registrant promotes its Class 41 services using Applicant/Registrant's Marks and advertises and offers for sale apparel and other merchandise bearing Applicant/Registrant's Marks on Applicant/Registrant's website, accessible at *http://www.tulsaathletics.com* ("Applicant/Registrant's Website").

13. The services covered by the Application and Supplemental Registration are closely related to the goods offered and services rendered in connection with Opposer/Petitioner's ATHLETICS Marks.

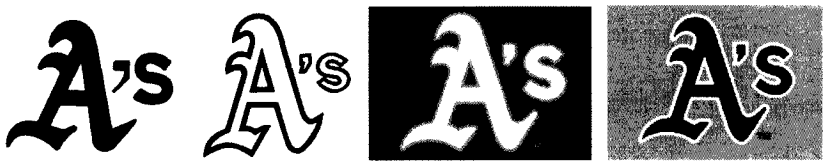
14. The word ATHLETICS in Applicant/Registrant's Marks is identical to certain of Opposer/Petitioner's ATHLETICS Marks as well as the name of the ATHLETICS club.

15. Opposer/Petitioner is well known as simply the "ATHLETICS" or the "A's."

16. Upon information and belief, Applicant/Registrant is using the names the "ATHLETICS" and the "A's" to refer to Applicant/Registrant.

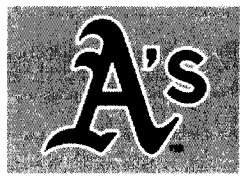
17. Certain of Opposer/Petitioner's ATHLETICS Marks appear in an Old-English stylization, and the words TULSA ATHLETICS appear in Applicant/Registrant's Design Mark in an Old-English stylization as shown here: [redacted], which closely resembles the Old-English stylizations used by Opposer/Petitioner, including, without limitation, in the distinctive stylization shown here: Athletics.

18. Certain of Opposer/Petitioner's ATHLETICS Marks comprise or contain the term A's in an Old-English font as shown below:

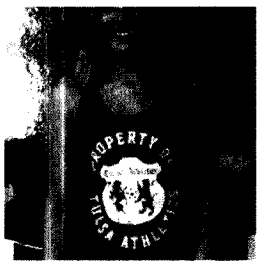


19. Upon information and belief, Applicant/Registrant is using the term "A's" in an Old-English font on Applicant/Registrant's Website as shown below:

20. Opposer/Petitioner's ATHLETICS Marks are used in the ATHLETICS Trade Dress Colors of green and gold as shown below:



21. Upon information and belief, Applicant/Registrant's team colors are green and yellow, and Applicant/Registrant is using Applicant/Registrant's Marks, the word "ATHLETICS" and the term "A's" in the colors green and yellow and/or in a combination of green and yellow in connection with Applicant/Registrant's Class 41 services and related apparel and merchandise currently offered for sale on Applicant/Registrant's Website as shown below:



22. Upon information and belief, Applicant/Registrant adopted Applicant/Registrant's Marks with an intent to trade on the valuable goodwill of Opposer/Petitioner as demonstrated by

Applicant/Registrant's use of the names the "ATHLETICS" and the "A's" to refer to Applicant/Registrant, Applicant/Registrant's use of Applicant/Registrant's Marks in the ATHLETICS Trade Dress Colors, and Applicant/Registrant's use of Applicant/Registrant's TULSA ATHLETICS Mark and the term "A's" in an Old-English stylization that closely resembles the Old-English stylizations used by the ATHLETICS club.

23. Applicant/Registrant's Design Mark, which contains the identical term ATHLETICS in an Old-English font and preceded by the geographic term TULSA, so resembles Opposer/Petitioner's ATHLETICS Marks, which are often displayed in an Old-English font and are well-known as consisting of the term ATHLETICS preceded by a geographic term, as to be likely when used in connection with Applicant/Registrant's services, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Applicant/Registrant's services have their origin with Opposer/Petitioner and/or that such services are approved, endorsed or sponsored by Opposer/Petitioner or associated in some way with Opposer/Petitioner.

24. Applicant/Registrant's TULSA ATHLETICS Mark, which as a standard character mark would encompass any stylization, including, without limitation, the Old-English stylization shown in Applicant/Registrant's Design Mark, which closely resembles the Old-English stylization used in certain of Opposer/Petitioner's ATHLETICS Marks, and as used in the ATHLETICS Trade Dress Colors, so resembles Opposer/Petitioner's ATHLETICS Marks as to be likely, when used in connection with Applicant/Registrant's services, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Applicant/Registrant's services have their origin with Opposer/Petitioner and/or that such services are approved, endorsed or sponsored by Opposer/Petitioner or associated in some way

with Opposer/Petitioner. Opposer/Petitioner would thereby be injured by allowing the continued registration of the Supplemental Registration for Applicant/Registrant's TULSA ATHLETICS Mark.

WHEREFORE, Opposer/Petitioner believes that it is being damaged by registration of the Supplemental Registration for Applicant/Registrant's TULSA ATHLETICS Mark and requests that the cancellation be sustained and the Supplemental Registration be cancelled.

WHEREFORE, Opposer/Petitioner believes that it will be damaged by registration of Applicant/Registrant's Design Mark and requests that the opposition be sustained and said registration be denied.

Please recognize as attorneys for Opposer/Petitioner in this proceeding Mary L. Kevlin, Richard S. Mandel and Erika S. Krystian (members of the bar of the State of New York) and the firm Cowan, Liebowitz & Latman, P.C., 1133 Avenue of the Americas, New York, New York 10036.

Please address all communications to Mary L. Kevlin, Esq. at the address listed below.

Dated: New York, New York
November 17, 2014

Respectfully submitted,

COWAN LIEBOWITZ & LATMAN, P.C.
Attorneys for Opposer/Petitioner

By: _____

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(212)790-9200

Ref No. 21307.034

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on November 17, 2014, I caused a true and correct copy of the foregoing Combined Notice of Opposition and Petition for Cancellation to be sent via First Class Mail, postage prepaid, to Applicant/Registrant and Correspondent of Record, Tulsa Athletics, LLC, at 4802 East 15th Street, Tulsa, Oklahoma 74012, and Tulsa Athletics, LLC, 4802 East 15th Street, Tulsa, Oklahoma 74112.

Erika S. Krystian

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November 17, 2014

By Express Mail
Commissioner for Trademarks
Attn: TTAB
P.O. Box 1451
Alexandria, VA 22313-1451

Re: Athletics Investment Group LLC d/b/a The Oakland Athletics Baseball Company
Combined Notice of Opposition and Petition for Cancellation
Against
Tulsa Athletics, LLC
Application to register TULSA ATHLETICS EST. 2003 and Design and
Supplemental Registration for TULSA ATHLETICS
Ref. No. 21307.034

Dear Commissioner:

We enclose a Combined Notice of Opposition and Petition for Cancellation against Application Serial Number 86/154,616, published in the Official Gazette on May 20, 2014, and Supplemental Registration No. 4,549,532, issued June 10, 2014. Enclosed is a check in the amount of $600 to cover the filing fee.

If the amount received is insufficient and additional fees are required, please charge our Deposit Account No. 03-3415.

Please address all future correspondence to the attention of Mary L. Kevlin of Cowan, Liebowitz & Latman, P.C.

Respectfully submitted,

Erika S. Krystian

Enclosures

cc: Ms. Diane Kovach (w/encs.)
Mary L. Kevlin, Esq. (w/encs.)