

ESTTA Tracking number: **ESTTA645044**

Filing date: **12/17/2014**

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

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	D1 Sports Holdings, LLC
Granted to Date of previous extension	12/17/2014
Address	7115 SOUTH SPRINGS DRIVE FRANKLIN, TN 37067 UNITED STATES
Attorney information	Shauna M. Wertheim The Marbury Law Group, PLLC 11800 Sunrise Valley Drive 15th Floor Reston, VA 20191 UNITED STATES swertheim@marburylaw.com, tm-docketing@marburylaw.com Phone:7033912900

### Applicant Information

Application No	85915737	Publication date	08/19/2014
Opposition Filing Date	12/17/2014	Opposition Period Ends	12/17/2014
Applicant	D1X LACROSSE, LLC P.O. Box 341 Farmington, MI 483320341 UNITED STATES		

### Goods/Services Affected by Opposition

Class 041. First Use: 2012/09/01 First Use In Commerce: 2012/09/01 All goods and services in the class are opposed, namely: PROVIDING LACROSSE CAMP AND LACROSSE CLINIC SERVICES TO PREPARE STUDENT ATHLETES WITH THE SKILLS TO TRY OUT FOR DIVISION 1 LACROSSE PROGRAMS; ARRANGING AND CONDUCTING ATHLETIC COMPETITIONS TO MEASURE LACROSSE PLAYERS FOR SPEED, SKILL AND STRENGTH IN THE FIELD OF LACROSSE TO ASSESS SKILLS FOR POTENTIAL ACCEPTANCE INTO DIVISION 1 LACROSSE PROGRAMS; SPORTS INSTRUCTION SERVICES IN THE FIELD OF LACROSSE TO PREPARE STUDENT ATHLETES WITH THE SKILLS TO TRY OUT FOR DIVISION 1 LACROSSE PROGRAMS
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Marks Cited by Opposer as Basis for Opposition


U.S. Registration	2877559	Application Date	08/18/2003
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No.			
Registration Date	08/24/2004	Foreign Priority Date	NONE
Word Mark	D1		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2003/03/01 First Use In Commerce: 2003/03/01 Sports training in the fields of football, baseball, hockey, basketball and soccer		


U.S. Registration No.	4051176	Application Date	12/19/2006
Registration Date	11/08/2011	Foreign Priority Date	NONE
Word Mark	D1		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2002/02/01 First Use In Commerce: 2003/03/01 Management of wellness centers for others Class 044. First use: First Use: 2002/02/01 First Use In Commerce: 2003/03/01 Physical therapy		


U.S. Registration No.	4051175	Application Date	12/19/2006
Registration Date	11/08/2011	Foreign Priority Date	NONE
Word Mark	D1		

Design Mark			
Description of Mark	The mark consists of a red square with rounded edges and a grey border. The square contains the letter "D" and an underlined number "1" in white.		
Goods/Services	Class 035. First use: First Use: 2002/02/01 First Use In Commerce: 2003/03/01 Management of wellness centers for others Class 041. First use: First Use: 2002/02/01 First Use In Commerce: 2002/02/01 Sports training Class 044. First use: First Use: 2002/02/01 First Use In Commerce: 2003/03/01 Physical therapy		
U.S. Application No.	86267641	Application Date	04/30/2014
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	D1		

Design Mark			
Description of Mark	The mark consists of a square with rounded edges. The square contains the letter "D" and an underlined number "1".		
Goods/Services	Class 041. First use: First Use: 2003/03/01 First Use In Commerce: 2003/03/01 Sports training services; providing facilities for sports and physical fitness training; Providing fitness and exercisefacilities; gymnasiums; athletic and physical fitness training services; conducting fitness classes; Personal fitness training services and consultancy; Healthclub services, namely, providing instruction and equipment in the field of physical exercise; Personal trainer services; Physical fitness studio services, namely, providing group exercise instruction, equipment, and facilities; Physical fitness instruction		

U.S. Application No.	86267601	Application Date	04/30/2014
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	D1		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2003/03/01 First Use In Commerce: 2003/03/01 Sports training services; providing facilities for sports and physical fitness training; Providing fitness and exercisefacilities; gymnasiums; athletic and physical fitness training services; conducting fitness classes; Personal fitness training		

	services and consultancy; Healthclub services, namely, providing instruction and equipment in the field of physical exercise; Personal trainer services; Physical fitness studio services, namely, providing group exercise instruction, equipment, and facilities; Physical fitness instruction		
U.S. Application No.	86213500	Application Date	03/06/2014
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	D1		
Design Mark			
Description of Mark	The mark consists of a square with rounded edges. The square contains the letter "D" and an underlined number "1".		
Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 Clothing, namely, shirts, shorts, pants, head bands, socks, polo shirts, tee shirts, long sleeve tee shirts, sweatshirts and hoodies; headwear; footwear		

Attachments	77067773#TMSN.png( bytes ) 77067168#TMSN.png( bytes ) 86267641#TMSN.png( bytes ) 86267601#TMSN.png( bytes ) 86213500#TMSN.png( bytes ) Notice of Opposition_17 DEC 2014.pdf(976298 bytes ) Notice of Opposition Ex 1.pdf(263462 bytes ) Notice of Opposition Ex 2.pdf(419752 bytes ) Notice of Opposition Ex 3.pdf(342376 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Shauna M. Wertheim/
Name	Shauna M. Wertheim
Date	12/17/2014

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

In The Matter of Application Serial No. 85/915,737  
For the Trademark: **D1X LACROSSE & Design**  
Published in the Official Gazette on August 19, 2014

D1 Sports Holdings, LLC	)	
	)	
	)	
<i>Opposer,</i>	)	Opposition No. _____
	)	
v.	)	
	)	
D1X Lacrosse, LLC.	)	
	)	
<i>Applicant.</i>	)	

**NOTICE OF OPPOSITION**

Opposer D1 Sports Holdings, LLC., a Tennessee limited liability company with its principal place of business at 7115 South Spring Drive, Franklin, Tennessee 37067, believes it will be damaged by registration of the mark "D1X LACROSSE & Design ("Applicant's Mark") as applied for in Serial No. 85/915,737 filed on April 26, 2013 by Applicant D1X Lacrosse, LLC ("Applicant").

As grounds for opposition, Opposer alleges as follows:

1. On information and belief, Applicant is a Michigan limited liability company with a mailing address at P.O. Box 341, Farmington, Michigan 48332-0341.
2. Applicant filed Application Serial No. 85/915,737 on April 26, 2013, seeking registration of Applicant's Mark for "providing lacrosse camp and lacrosse clinic services; arranging and conducting athletic competitions to measure lacrosse players for speed, skill and

strength in the field lacrosse; sports instructions services in the field of lacrosse” in International Class 41.

3. On August 20, 2013, the Examining Attorney for Applicant's Mark issued an Office Action refusing to register Applicant's Mark based on a likelihood of confusion with Opposer's marks **D1** in U.S. Registration No. 2,877,559 and **D1 & Design** in U.S. Registration No. 4,051,175 (the "Cited Marks"). True and correct copies of U.S. Reg. Nos. 2,877,559 and 4,051,175 are attached as Exhibits 1 and 2, respectively.

4. Opposer is the owner of incontestable U.S. Registration No. 2,877,559 for the mark **D1** for “sports training in the fields of football, baseball, hockey, basketball and soccer” in Class 41. The second registration cited by the Examining Attorney for Applicant's Mark, U.S. Registration No. 4,051,175, for the mark **D1 & Design**, cover “management of wellness centers for others” in Class 35.

4. On February 28, 2014, in its response to the Office Action, Applicant, among other things, amended its application to modify the identification of services to read as follows:

providing lacrosse camp and lacrosse clinic services to prepare student athletes with the skills to try out for Division 1 lacrosse programs; arranging and conducting athletic competitions to measure lacrosse players for speed, skill and strength in the field of lacrosse to assess skills for potential acceptance into Division 1 lacrosse programs; sports instructions—services in the field of lacrosse to prepare student athletes with the skills to try out for Division 1 lacrosse programs.

(Additions and deletion to the amended identification of services are underlined above). The amendments to the identification of services were accepted on March 4, 2014.

5. Applicant's Mark was published in the *Official Gazette* on August 19, 2014.

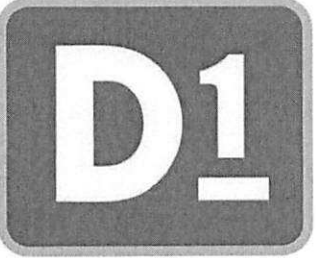



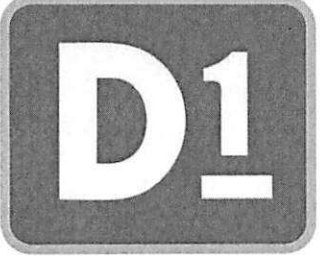
6. In addition to the Cited Marks, Opposer is the owner of U.S. Registration No. 4,051,176 for the mark **D1** for “management of wellness centers for others” in Class 35 and “physical therapy” in Class 44; (This registration, together with the Cited Marks, are referred collectively herein as “Opposer’s Registered Marks.”) A true and correct copy of Opposer's Reg. no. 4,051,176 is attached as Exhibit 3. The date of first use in commerce for all of Opposer's Registered Marks is March 1, 2003.

7. Opposer’s Registered Marks are valid, subsisting, uncanceled and conclusive evidence of Opposer’s exclusive right to use the mark **D1** in commerce and/or in connection with the services specified in the registrations for Opposer’s Registered Marks. True and correct copies of the registrations for Opposer's Marks are attached hereto as Exhibits A-1, A-2 and A-3, and incorporated by reference as though fully set forth herein.

8. Opposer is also the owner of the following marks (collectively, “Opposer’s Pending Marks”) which are the subject of pending applications, and all but one of which to date were already approved for publication.

Mark and Serial No.	Classes	Goods/Services
D1  86/173,607	5, 9, 28 and 41	<b>5:</b> Nutritional supplements <b>9:</b> Downloadable instructional videos in the field of athletic training <b>28:</b> Equipment for sports training, namely, weight lifting plates and exercising bands <b>41:</b> Non-downloadable instructional videos in the field of athletic training

 86/267,641	41	Sports training services; providing facilities for sports and physical fitness training; Providing fitness and exercise facilities; gymnasiums; athletic and physical fitness training services; conducting fitness classes; Personal fitness training services and consultancy; Health club services, namely, providing instruction and equipment in the field of physical exercise; Personal
		trainer services; Physical fitness studio services, namely, providing group exercise instruction, equipment, and facilities; Physical fitness instruction.
D1 86/267,601	41	Sports training services; providing facilities for sports and physical fitness training; Providing fitness and exercise facilities; gymnasiums; athletic and physical fitness training services; conducting fitness classes; Personal fitness training services and consultancy; Health club services, namely, providing instruction and equipment in the field of physical exercise; Personal trainer services; Physical fitness studio services, namely, providing group exercise instruction, equipment, and facilities; Physical fitness instruction.
 86/213,500	25	Clothing, namely, shirts, shorts, pants, head bands, socks, polo shirts, tee shirts, long sleeve tee shirts, sweatshirts and hoodies; footwear; headwear

 86/173,431	5, 9, 28 and 41	<b>5:</b> Nutritional supplements <b>9:</b> Downloadable instructional videos in the field of athletic training <b>28:</b> Equipment for sports training, namely, weight lifting plates and exercising bands <b>41:</b> Non-downloadable instructional videos in the field of athletic training
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9. Since at least as early as March 1, 2003, Opposer adopted and has continuously used its D1 word and design marks in connection with sports training and other related goods and services. Opposer has used its D1 word and design marks since at least 9 ½ years prior to Applicant's alleged first use in commerce and for at least 10 years prior to Applicant's filing of the subject Application.

10. Opposer has invested substantial amounts of time, effort and money in developing, marketing, promoting and protecting its D1 marks in the field of sports training and related goods and services. As a result, Opposer's D1 Marks are widely recognized in the sports training industry and by other relevant consumers. As such, in addition to the protection afforded Opposer by its federal trademark registrations for D1, it has non-registered statutory and common law rights in and to the mark D1.

11. Applicant has no license, consent or permission from Opposer to use or register the mark D1.

12. Applicant's Mark so resembles Opposer's Registered Marks and Opposer's Pending Marks and covers related services that it is likely to cause confusion, or to cause mistake or to deceive within the meaning of Section 2(d) of the Trademark (Lanham) Act of 1946, 15 U.S.C. § 1052(d); and more particularly, Applicant's Mark and use thereof are likely to cause

confusion in, or to cause mistake by, or to deceive the trade and purchasing public into believing that the services in Serial No. 85/915,737 originate with or are affiliated with Opposer, or otherwise are authorized, licensed or sponsored by Opposer.

13. Previously, on or about July 27, 2012, Applicant filed an application for the mark "D1X," Serial. No. 85/685,298 for "sports training services, namely, lacrosse training services." Applicant abandoned that application on June 21, 2013, after failing to respond to the Examining Attorney's Office Action, which refused registration based on a likelihood of confusion with two marks, including U.S. Registration 4,051,175 owned by Opposer.

14. By reason of the foregoing, Opposer will be gravely damaged by the registration of Applicant's Mark for the services in Serial No. 85/915,737, because registration of that mark would be in violation of Opposer's trademark rights.

WHEREFORE, Opposer prays that this Notice of Opposition be sustained in favor of Opposer and that Serial No. 85/915,737 be denied registration.

Dated: December 17, 2014

Respectfully submitted,

D1 SPORTS HOLDINGS, LLC

By:



Shauna M. Wertheim

Timothy J. Murphy

THE MARBURY LAW GROUP PLLC

11800 Sunrise Valley Drive

15<sup>th</sup> Floor

Reston, Virginia 20191

(703) 391-2900

(703) 391-2901 (fax)

*Attorney for Opposer D1 Sports Holdings, LLC*

**CERTIFICATE OF SERVICE**

I hereby certify that on this 17th day of December, 2014, I caused a true and correct copy of the foregoing Notice of Opposition, together with Exhibits 1-3 thereto, to be served by first-class mail, postage prepaid upon:

Anna Heint  
Brooks Kushman P.C.  
1000 Town Center, Floor 22  
Southfield, MI 48075-1183

*Attorney for Applicant*

  
\_\_\_\_\_  
Shauna M. Wertheim

Int. Cl.: 41

Prior U.S. Cls.: 100, 101 and 107

**United States Patent and Trademark Office**

**Reg. No. 2,877,559**

Registered Aug. 24, 2004

**SERVICE MARK  
PRINCIPAL REGISTER**

**D1**

D-1 SPORTS TRAINING OF NASHVILLE, LLC  
(TENNESSEE LTD LIAB CO)  
SUITE 200  
210 GOTHIC COURT  
FRANKLIN, TN 37067

AND SOCCER, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 3-1-2003; IN COMMERCE 3-1-2003.

SER. NO. 78-288,572, FILED 8-18-2003.

FOR: SPORTS TRAINING IN THE FIELDS OF  
FOOTBALL, BASEBALL, HOCKEY, BASKETBALL

MARTHA FROMM, EXAMINING ATTORNEY





# United States of America

United States Patent and Trademark Office



**Reg. No. 4,051,175**

**Registered Nov. 8, 2011**

**Int. Cls.: 35, 41 and 44**

**SERVICE MARK**

**PRINCIPAL REGISTER**

EXPLOSION SPORTS TRAINING, LLC (TENNESSEE LIMITED LIABILITY COMPANY)  
7115 SOUTH SPRINGS DRIVE  
FRANKLIN, TN 37067

FOR: MANAGEMENT OF WELLNESS CENTERS FOR OTHERS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 2-1-2002; IN COMMERCE 3-1-2003.

FOR: SPORTS TRAINING, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 2-1-2002; IN COMMERCE 2-1-2002.

FOR: PHYSICAL THERAPY, IN CLASS 44 (U.S. CLS. 100 AND 101).

FIRST USE 2-1-2002; IN COMMERCE 3-1-2003.

OWNER OF U.S. REG. NO. 2,877,559.

THE COLOR(S) GREY, RED, AND WHITE IS/ARE CLAIMED AS A FEATURE OF THE MARK.

THE MARK CONSISTS OF A RED SQUARE WITH ROUNDED EDGES AND A GREY BORDER. THE SQUARE CONTAINS THE LETTER "D" AND AN UNDERLINED NUMBER "1" IN WHITE.

SER. NO. 77-067,168, FILED 12-19-2006.

ROBIN MITTLER, EXAMINING ATTORNEY



*David J. Kyffers*

Director of the United States Patent and Trademark Office

EXHIBIT

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# United States of America

United States Patent and Trademark Office

## D1

**Reg. No. 4,051,176**

**Registered Nov. 8, 2011**

**Int. Cls.: 35 and 44**

**SERVICE MARK**

**PRINCIPAL REGISTER**

EXPLOSION SPORTS TRAINING, LLC (TENNESSEE LIMITED LIABILITY COMPANY)  
7115 SOUTH SPRINGS DRIVE  
FRANKLIN, TN 37067

FOR: MANAGEMENT OF WELLNESS CENTERS FOR OTHERS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 2-1-2002; IN COMMERCE 3-1-2003.

FOR: PHYSICAL THERAPY, IN CLASS 44 (U.S. CLS. 100 AND 101).

FIRST USE 2-1-2002; IN COMMERCE 3-1-2003.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 2,877,559.

SER. NO. 77-067,773, FILED 12-19-2006.

ROBIN MITTLER, EXAMINING ATTORNEY



*David J. Kappas*

Director of the United States Patent and Trademark Office

