

ESTTA Tracking number: **ESTTA897604**

Filing date: **05/18/2018**

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

Proceeding	91236715
Party	Plaintiff Robot Wars, LLC
Correspondence Address	ROBERT B GOLDEN LACKENBACH SIEGEL LLP ONE CHASE ROADLACKENBACH SIEGEL BLDG, PENTHOUSE FL SCARSDALE, NY 10583 UNITED STATES Email: HAronson@LSLLP.com, RGolden@LSLLP.com, EMenist@LSLLP.com, TMEFS@LSLLP.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Robert B. Golden
Filer's email	RGolden@LSLLP.com, EMenist@LSLLP.com, TMEFS@LSLLP.com
Signature	/Robert B. Golden/
Date	05/18/2018
Attachments	First Amended Notice of Opp. to WARBOT 5.18.2018 (with Exhibit).pdf(138919 bytes)

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

Application Serial No.: 87/371,308
Mark: WAR BOT
International Classes: 16 & 28
Applicant: Theatricality LLC
Published in *Official Gazette*: July 18, 2017

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ROBOT WARS, LLC	:
	:
Opposer,	:
	:
v.	:
	:
THEATRICALITY LLC,	: Opposition No. 91236715
	:
Applicant.	:
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FIRST AMENDED NOTICE OF OPPOSITION

Robot Wars, LLC, a New York Limited Liability Company, having its principal place of business at 740 Broadway, New York, New York 10003 (“Opposer”), believes that it will be damaged by the registration of the trademark WAR BOT as applied for by Theatricality LLC (“Applicant”), in Application Serial Number 87/371,308 for use in connection with goods in International Classes 16 & 28.

As grounds for opposition, it is alleged that:

1. Opposer is a New York Limited Liability Company having its principal place of business at 740 Broadway, New York, New York 10003.
2. Opposer engages, and has engaged, in an entertainment enterprise that produces television programming, live events, and consumer merchandise. One such form of entertainment Opposer provides is a premier robot fighting competition, in which competitors build robot machines to compete and battle against each other (“Matches”). Such Matches are

televised worldwide and followed by millions of fans. In connection with these Matches, Opposer has adopted and uses the mark ROBOT WARS (“Opposer’s Trademark”).

3. Opposer’s Trademark is the house mark, trade name, and identity of Opposer.

4. Opposer is the owner of United States Trademark Registration No. 1,858,931 for Opposer’s trademark ROBOT WARS (the “Registration”) (the Registration, together with its corresponding Trademark Status and Document Retrieval (TSDR) Report is attached as Exhibit 1 hereto).

5. The services identified in the Trademark Registrations are “entertainment services in the nature of competitions involving radio-controlled model vehicles,” and Opposer currently uses Opposer’s Trademark on and in connection with such services (“Opposer’s Services”).

6. Opposer has also adopted and uses Opposer’s Trademark on and in connection with merchandise related to the Matches, such as, without limitation, clothing and drinking mugs (“Opposer’s Goods”) (Opposer’s Goods and Opposer’s Services are now collectively defined herein as “Opposer’s Goods and Services”).

7. Opposer has used Opposer’s Trademark since at least as early as 1993 (“Opposer’s First Use Date”).

8. Opposer’s Goods and Services bearing Opposer’s Trademark have been continuously advertised and offered to the public through various channels of trade throughout the United States, and the World, since Opposer’s First Use Date.

9. Through use of Opposer’s Trademark for Opposer’s Goods and Services, the public has come to recognize Opposer’s Trademark as signifying Opposer and its products and services, and Opposer has built up extensive and valuable goodwill in connection with the sale of such products and services under Opposer’s Trademark.

10. Since Opposer's First Use Date, Opposer has expended substantial amounts of money, time and effort in advertising, promoting and popularizing Opposer's Trademark, and thus the trade, industry, and public have come to associate and attribute usage of Opposer's Trademark to Opposer and Opposer alone, and that goods and services bearing Opposer's Trademark originate from or belong to Opposer.

11. Opposer has used Opposer's Trademark in interstate commerce openly and notoriously since Opposer's First Use Date.

12. Opposer's Trademark is strong and well-known throughout the United States and has developed goodwill and a good reputation that is exclusive to Opposer, and has acquired a secondary meaning.

13. Due to the strength, goodwill, and notoriety of Opposer's Trademark, Opposer's Trademark is famous throughout the United States and the World.

14. Opposer's Trademark became famous prior to any claim of priority that Applicant may have.

15. The Registration has become incontestable.

16. Upon information and belief, and according to the Patent and Trademark Office's ("PTO") records, Applicant is a limited liability company organized under the laws of the State of California, with a mailing address of PO Box 49788, Los Angeles, California 90049, and has a principal place of business in California.

17. Upon information and belief, and according to the PTO's records, on March 14, 2017, Applicant filed a trademark application to register the mark WAR BOT ("Applicant's Purported Mark") for "Comic books" in International Class 16 and "Toy robots" in International

Class 28 (collectively “Applicant’s Goods”); which was subsequently assigned Application Serial No. 87/371,308 (“Applicant’s Application”).

18. Upon information and belief and according to the PTO’s records, Applicant’s Application was filed in part, on a use basis for the goods listed in International Class 28, and in part, on an intent-to-use basis for the goods listed in International Class 16.

19. Upon information and belief, Applicant had not used Applicant’s Purported Mark, in the applied for format, on Applicant’s Goods, in the United States prior to March 2, 2008.

CLAIM I
PRIORITY AND LIKELIHOOD OF CONFUSION (Section 2(d))

20. Opposer repeats and realleges each of the allegations made in the preceding paragraphs as if set forth fully herein.

21. There is no issue of priority of use.

22. Opposer has superior, paramount, and prior rights as compared to Applicant. Opposer has used Opposer’s Trademarks since at least as early as Opposer’s First Use Date, a date significantly earlier than any other date claimed by or available to Applicant.

23. Applicant’s Goods intended to be sold under Applicant’s Purported Mark are closely related to Opposer’s Goods and Services sold under Opposer’s Trademark.

24. Applicant’s Goods and Opposer’s Goods and Services are of a type sold through similar channels of trade and to the same class(es) of customers, and such goods would reasonably be expected by the trade and purchasing public to emanate from, or be sponsored by, the same source.

25. Applicant’s Purported Mark and Opposer’s Trademark are similar in sight, sound, and connotation.

26. Applicant's Purported Mark creates an overall commercial impression and connotation that is confusingly similar to that created by Opposer's Trademark.

27. Because of the close similarity of Applicant's Purported Mark to Opposer's Trademark, use and registration of Applicant's Purported Mark by Applicant on Applicant's closely related goods is likely to cause confusion, deception, and mistake as to the origin of Applicant's Goods, and to confuse, mislead and deceive members of the public into believing that Applicant's Goods originate from and/or are sponsored, approved, or licensed by Opposer, or are in some other way connected with Opposer.

28. If Applicant were granted registration for Applicant's Purported Mark, Applicant would thereby obtain at least *a prima facie* exclusive right to use Applicant's Purported Mark, and such right would be a source of damage and injury to Opposer.

29. For the foregoing reasons, Applicant is not entitled to adopt, use, or seek registration of Applicant's Purported Mark in connection with Applicant's Goods, and Applicant's Purported Mark should be denied registration under Section 2(d) of the Lanham Act (15 U.S.C. § 1052(d)).

CLAIM II
FALSE SUGGESTION OF CONNECTION (Section 2(a))

30. Opposer repeats and realleges each of the allegations made in the preceding paragraphs as if set forth fully herein.

31. Opposer's Trademark is Opposer's house mark, trade name, and the identity of Opposer.

32. Opposer's Trademark is famous throughout the United States and the world due to mass unsolicited media coverage, large scale television and internet programming, and is the greatest identifier of Opposer.

33. Applicant's Purported Mark is a close approximation of Opposer's Trademark in that both marks utilize the terms "WAR" and "BOT," and "BOT" is the abbreviation for, and/or the shortened version of, the term ROBOT, which is a term utilized in Opposer's Trademark.

34. Due to the close approximation of Applicant's Purported Mark to Opposer's Trademark and the fame of Opposer's Trademark, Applicant's Purported Mark would be recognized by consumers as uniquely and unmistakably pointing to and/or identifying, and/or having a connection, with Opposer and Opposer's Trademark.

35. The appearance of a connection between Applicant's Purported Mark and Opposer and Opposer's Trademark would be damaging to Opposer because there is no such connection between Applicant, Applicant's Purported Mark, and/or Applicant's Goods on the one hand and Opposer, Opposer's Trademark, and/or Opposer's Goods and Services on the other hand.

36. If Applicant were granted registration for Applicant's Purported Mark, Applicant would thereby obtain at least *a prima facie* exclusive right to use Applicant's Purported Mark, and such right would be a source of damage and injury to Opposer.

37. For the foregoing reasons, Applicant is not entitled to adopt, use, or seek registration of Applicant's Purported Mark in connection with Applicant's Goods, and Applicant's Purported Mark should be denied registration under Section 2(a) of the Lanham Act (15 U.S.C. §§ 1052(a)).

CLAIM III
TRADEMARK DILUTION (Section 43(c))

38. Opposer repeats and realleges each of the allegations made in the preceding paragraphs as if set forth fully herein.

39. Opposer's Trademark is famous throughout the United States and the world due to mass unsolicited media coverage, large scale television and internet programming, and a large and emphatic fan base.

40. Opposer's Trademark became famous prior to the filing date of Applicant's Application, Applicant's claimed first use date, and any other priority date that Applicant may claim.

41. Applicant's Purported Mark and Opposer's Trademark are similar in sight, sound and connotation, in that Applicant's Purported Mark and Opposer's Trademark both utilize the terms "WAR" and "BOT," and "BOT" is the abbreviation for, and/or the shortened version of, the term ROBOT, which is a term utilized in Opposer's Trademark.

42. Due to the similarity of the parties' respective marks and the fame of Opposer's Trademark, the consuming public would believe that there is an association between Applicant's Purported Mark and Opposer's Trademark, when in fact, no such association exists.

43. If Applicant is allowed to register and use Applicant's Purported Mark, the simultaneous registration of Applicant's Purported Mark will dilute Opposer's rights, and will eventually result in a lack of designation or indication of origin and a loss of distinctiveness and exclusivity in Opposer's Trademark.

44. If Applicant is allowed to register Applicant's Purported Mark, dilution by blurring will be likely and will occur as the connection in the trade and consumers' minds

between Opposer, Opposer's Trademark, and Opposer's Goods and Services will be weakened, resulting in damage to Opposer.

45. If Applicant is allowed to register Applicant's Purported Mark, dilution by blurring will be likely and will occur as Applicant's registration and use of Applicant's Purported Mark will create an association arising from the similarity between Opposer's Trademark and Applicant's Purported Mark that impairs the distinctiveness of Opposer's Trademark.

46. Because of the strength and fame of Opposer's Trademark, and the fact that it is owned by Opposer alone, and because Applicant's Purported Mark is similar thereto, any faults or imperfections in Applicant's Goods will reflect adversely on Opposer and Opposer's Trademark, and their established goodwill and reputation, all to the detriment of Opposer, unless this opposition is sustained.

47. If Applicant is allowed to register Applicant's Purported Mark, dilution by tarnishment will be likely and will occur as Applicant's registration of Applicant's Purported Mark will create an association arising from the similarity between Opposer's Trademark and Applicant's Purported Mark that will harm the reputation and goodwill of Opposer's Trademark.

48. If Applicant were granted registration for Applicant's Purported Mark, Applicant would thereby obtain at least *a prima facie* exclusive right to use Applicant's Purported Mark, and such right would be a source of damage and injury to Opposer.

49. For the foregoing reasons, Applicant is not entitled to adopt, use, or seek registration of Applicant's Purported Mark in connection with Applicant's Goods, and Applicant's Purported Mark should be denied registration under Section 43(c) of the Lanham Act (15 U.S.C. § 1125(c)).

WHEREFORE, Opposer respectfully requests that this Opposition be sustained and that registration of Applicant's Purported Mark WAR BOT be refused.

Respectfully submitted,

LACKENBACH SIEGEL, LLP

Dated: Scarsdale, New York
May 18, 2018

By: /s/ Robert B. Golden
Robert B. Golden
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RGolden@LSLLP.com
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Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of the foregoing documents was served on Applicant via email, addressed to Applicant's counsel of record, as follows:

Kathryn A. Tyler
LAW OFFICES OF KATHRYN A. TYLER
931 Alta Vista Drive
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Ktyler931@gmail.com

Dated: Scarsdale, New York
May 18, 2018

 /s/ Eric A. Menist
Eric A. Menist

Exhibit 1

Int. Cl.: 41

Prior U.S. Cl.: 107

United States Patent and Trademark Office

Reg. No. 1,858,931

Registered Oct. 18, 1994

**SERVICE MARK
PRINCIPAL REGISTER**

ROBOT WARS

THORPE, MARC (UNITED STATES CITIZEN)
59 HILLSIDE DRIVE
FAIRFAX, CA 94930

FIRST USE 2-4-1993; IN COMMERCE
2-4-1993.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "ROBOT", APART FROM THE
MARK AS SHOWN.

FOR: ENTERTAINMENT SERVICES IN THE
NATURE OF COMPETITIONS INVOLVING
RADIO-CONTROLLED MODEL VEHICLES, IN
CLASS 41 (U.S. CL. 107).

SER. NO. 74-415,465, FILED 7-21-1993.

PAUL F. GAST, EXAMINING ATTORNEY

Generated on: This page was generated by TSDR on 2018-05-17 14:50:42 EDT

Mark: ROBOT WARS

US Serial Number: 74415465

Application Filing Date: Jul. 21, 1993

US Registration Number: 1858931

Registration Date: Oct. 18, 1994

Register: Principal

Mark Type: Service Mark

Status: The registration has been renewed.

Status Date: Nov. 01, 2014

Publication Date: Feb. 08, 1994

Mark Information

Mark Literal Elements: ROBOT WARS

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Disclaimer: "ROBOT"

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: entertainment services in the nature of competitions involving radio-controlled model vehicles

International Class(es): 041 - Primary Class

U.S Class(es): 107

Class Status: ACTIVE

Basis: 1(a)

First Use: Feb. 04, 1993

Use in Commerce: Feb. 04, 1993

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: ROBOT WARS, LLC

Owner Address: 740 BROADWAY
NEW YORK, NEW YORK 10003
UNITED STATES

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country NEW YORK
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Howard N. Aronson
Attorney Primary Email Address: TMEFS@LSLLP.COM
Docket Number: 7787
Attorney Email Authorized: Yes

Correspondent

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Correspondent e-mail Authorized: Yes

Domestic Representative

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Fax: 914-723-4301
Domestic Representative e-mail Authorized: Yes

Prosecution History

Date	Description	Proceeding Number
Nov. 01, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Nov. 01, 2014	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	67603
Nov. 01, 2014	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	67603
Nov. 01, 2014	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	67603
Oct. 17, 2014	TEAS SECTION 8 & 9 RECEIVED	
Jul. 20, 2007	CASE FILE IN TICRS	
Jun. 29, 2006	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Nov. 29, 2004	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Nov. 29, 2004	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Oct. 08, 2004	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Oct. 08, 2004	TEAS SECTION 8 & 9 RECEIVED	
May 08, 2003	PAPER RECEIVED	
Mar. 08, 2001	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Oct. 23, 2000	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Oct. 18, 1994	REGISTERED-PRINCIPAL REGISTER	
Mar. 10, 1994	EXTENSION OF TIME TO OPPOSE RECEIVED	
Feb. 08, 1994	PUBLISHED FOR OPPOSITION	
Jan. 07, 1994	NOTICE OF PUBLICATION	
Nov. 24, 1993	APPROVED FOR PUB - PRINCIPAL REGISTER	
Nov. 17, 1993	EXAMINER'S AMENDMENT MAILED	
Nov. 15, 1993	ASSIGNED TO EXAMINER	59959

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Oct. 18, 2014

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Nov. 01, 2014

Assignment Abstract Of Title Information

Summary

Total Assignments: 2

Registrant: Thorpe, Marc

Assignment 1 of 2

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [1739/0875](#)

Pages: 10

Date Recorded: Jun. 08, 1998

Supporting Documents: [assignment-tm-1739-0875.pdf](#)

Assignor

Name: [THORPE, MARC](#)

Execution Date: Jul. 22, 1994

Legal Entity Type: UNKNOWN

State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [ROBOT WARS, INC.](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: NEW YORK

Address: 740 BROADWAY
NEW YORK, NEW YORK 10003

Correspondent

Correspondent Name: ROGERS & WELLS

Correspondent Address: RANDI S. MILLER ESQ.
200 PARK AVENUE
NEW YORK, NY 10166

Domestic Representative - Not Found

Assignment 2 of 2

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [1990/0735](#)

Pages: 5

Date Recorded: Nov. 15, 1999

Supporting Documents: [assignment-tm-1990-0735.pdf](#)

Assignor

Name: [ROBOT WARS, INC.](#)

Execution Date: Sep. 09, 1999

Legal Entity Type: CORPORATION

State or Country Where Organized: NEW YORK

Assignee

Name: [ROBOT WARS, LLC](#)

Legal Entity Type: NEW YORK LIMITED LIABILITY COMPANY

State or Country Where Organized: No Place Where Organized Found

Address: 740 BROADWAY
NEW YORK, NEW YORK 10003

Correspondent

Correspondent: ROGERS & WELLS LLP

Name:

Correspondent CINDY D. CAREY
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 200 PARK AVENUE
 NEW YORK, NY 10166

Domestic Representative - Not Found

Proceedings

Summary

Number of 1
 Proceedings:

Type of Proceeding: Opposition

Proceeding Number: [91236715](#) **Filing Date:** Sep 18, 2017
Status: Pending **Status Date:** Sep 18, 2017
Interlocutory Attorney: MIKE WEBSTER

Defendant

Name: THEATRICALITY LLC
Correspondent Address: KATHRYN A TYLER
 LAW OFFICES OF KATHRYN A TYLER
 2062 Roaring Camp Drive
 Rancho Cordova CA , 95670
 UNITED STATES
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Associated marks

Mark	Application Status	Serial Number	Registration Number
WAR BOT	Opposition Pending	87371308	

Plaintiff(s)

Name: Robot Wars, LLC
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 SCARSDALE NY , 10583
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Associated marks

Mark	Application Status	Serial Number	Registration Number
ROBOT WARS	Renewed	74415465	1858931

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Sep 18, 2017	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Sep 18, 2017	Oct 28, 2017
3	PENDING, INSTITUTED	Sep 18, 2017	
4	STIP FOR EXT	Oct 29, 2017	
5	EXTENSION OF TIME GRANTED	Oct 29, 2017	
6	ANSWER	Dec 06, 2017	
7	P MOT TO STRIKE	Dec 21, 2017	
8	D OPP/RESP TO MOTION	Jan 07, 2018	
9	SUSP PEND DISP OF OUTSTNDNG MOT	Jan 16, 2018	
10	D CHANGE OF CORRESP ADDRESS	Mar 23, 2018	
11	TRIAL DATES RESET	Apr 11, 2018	