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

Proceeding	91236715
Party	Plaintiff Robot Wars, LLC
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Date	12/09/2019
Attachments	Motion to Amend with Exhibits.pdf(669129 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	:
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Opposer,	:
	:
v.	:
	:
THEATRICALITY LLC,	: Opposition No. 91236715
	:
	:
Applicant.	:
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**OPPOSER’S MOTION TO AMEND ITS FIRST AMENDED NOTICE OF OPPOSITION
TO ADD CLAIM BASED UPON NEWLY DISCOVERED EVIDENCE**

Robot Wars, LLC (“Opposer”), by and through its undersigned counsel of record, hereby moves (this “Motion”) pursuant T.B.M.P. § 507 and Fed. R. Civ. P. 15(a)(2) to amend its First Amended Notice of Opposition to add a claim for invalidity of Applicant Theatricality LLC’s Application Serial No. 87/371,308 (the “Application”), on the grounds that Applicant’s failure to use its mark WAR BOT in commerce renders the subject Application void *ab initio* under Lanham Act §§ 1(a) and 45, 15 U.S.C. §§ 1051, 1127. This Opposition Motion is based upon the points and authorities and arguments set forth below. A redlined copy of Opposer’s proposed Second Amended Notice of Opposition is attached hereto as Exhibit A; a clean copy of Opposer’s proposed Second Amended Notice of Opposition is attached as Exhibit B.

I. BACKGROUND AND RELEVANT FACTS

This Motion to amend is brought by Opposer concurrently with its Opposition to Applicant's Motion for Summary Judgment (the "SJ Opposition"). Opposer must do so because this Motion is based solely upon evidence only discovered by Opposer through its initial Motion for Discovery Under FRCP 56(d) in Opposition to Applicant's Motion for Summary Judgment filed on May 24, 2019 (the "Rule 56(d) Motion") (TTABVue No. 25), and the Board's subsequent October 8, 2019 order partially granting the Rule 56(d) Motion and ordering Applicant to amend its discovery responses and produce documents (the "10/8 Order") (TTABVue No. 27). Specifically, documents only produced by Applicant in response to the Board's 10/8 Order clearly indicate that the Application, which Applicant filed as a use-based application under Lanham Act 1(a) on March 14, 2017, must be declared void *ab initio* by reason of Applicant's failure to make use of the applied-for mark, WAR BOT, in commerce prior to the filing date.

The Board is familiar with the procedural and background facts of this matter, as they have been briefed thoroughly by Opposer in connection with Applicant's currently pending motion for summary judgment. Opposer briefed and authenticated the relevant facts in connection with its previous Rule 56(d) motion, including the Declaration of Jeffrey M. Rollings filed in support thereof (the "56(d) Decl."). Opposer has further briefed and authenticated the relevant facts in connection with its concurrently filed SJ Opposition, including the Declaration of Jeffrey M. Rollings submitted in support thereof (the "SJ Decl."). The factual presentations set forth in these motions and declarations are incorporated herein by this reference. For the sake of brevity and consistency, Opposer will briefly summarize the facts relevant to this instant motion here, and cite to the previously filed Declarations where appropriate.

Applicant filed its Application for the mark WAR BOT (“Applicant’s Mark”) on March 14, 2017 as a use-based application for “toy robots” in International Class 28. The Application states that Applicant’s first use date of Applicant’s Mark is March 1, 2008, and first use date in commerce was July 1, 2009.

Opposer timely filed its Notice of Opposition against Applicant on September 18, 2017, on the grounds that Applicant’s Mark is confusingly similar to Opposer’s trademark ROBOT WARS (“Opposer’s Mark”) and if registered, Applicant’s Mark will cause a likelihood of confusion with Opposer’s Mark and dilute Opposer’s Mark by tarnishment. Opposer filed its First Amended Notice of Opposition on May 18, 2018, and Applicant filed its Answer on June 18, 2018. On October 24, 2018, the Board reset the remaining dates for this matter, including the close of the Discovery Period which the Board set for May 11, 2019.

On January 31, 2019, Opposer served its first sets of document requests (“Opposer’s RFPs”) and interrogatories (“Opposer’s Interrogatories”) (collectively “Opposer’s Discovery Requests”) on Applicant. On April 3, 2019, Applicant served its responses and objections to each (“Applicant’s RFP Responses” and “Applicant’s Interrogatory Responses,” respectively). See Exhs. 1-2 to SJ Decl. Applicant agreed in its RFP Responses to produce documents responsive to Opposer’s RFP Nos. 5, 8 - 18, 30. Exh. 1 to SJ Decl. Applicant served no discovery requests on Opposer.

Applicant’s Interrogatory Responses were deficient, consisting of misleading, incomplete, and/or unresponsive answers. Applicant also failed to produce documents despite agreeing to do so. Instead, Applicant filed its Motion for Summary Judgment (the “SJ Motion”) (TTABVue No. 22) on April 23, 2019. Opposer initially opposed the SJ Motion by filing the Rule 56(d) Motion in order to address the deficiencies in Applicant’s Interrogatory Responses

and its failure to produce documents. The Board's 10/8 Order granted Opposer's Rule 56(d) Motion in part, ordering Applicant (i) to respond more fully to Opposer's Interrogatory Nos. 11-13, 17, 26-28, and (ii) to produce documents in response to Opposer's RFP Nos. 1, 10-13, 17, 18. On October 28, 2019, Applicant served amended responses to Opposer's RFPs (Exh. 3 to SJ Decl.), and Opposer's Interrogatories (Exh. 4 to SJ Decl.), and served 16 pages of allegedly responsive documents (Exh. 5 to SJ Decl.).

Opposer's RFP No. 13 sought *all* documents from Applicant that evidence where and when Applicant has sold goods in connection with Applicant's Mark. Exh. 1 to SJ Decl. at p. 6. The 10/8 Order obligated Applicant to produce documents responsive to RFP No. 13. TTABVue No. 27 at 4. In response, Applicant produced just 16 pages of documents – the only documents produced by Applicant in this case. The only documents contained in the set responsive to RFP No. 13 are pages 15 and 16, which document one *purely intrastate* sale of toy robots allegedly made by Applicant in September, 2017, several months after the Application filing date.

Page 15 of these documents consists of a copy of a personal check written to "Chris Bird" for \$103.99 for "WAR-BOTS" and a copy of an envelope addressed to "War Bot Toys." The check is redacted but shows that the person or business writing and sending the check resided in Santa Monica, California, and that the check was mailed from within Los Angeles on September 11, 2017, several months after. Exh. 5 to SJ Decl., p. 15. Page 16 is a copy of an invoice issued by "Warbot Robots" of Los Angeles, California, for the purchase of one "Robo Soldier" for \$99.00, and one "Mini Bot" for \$4.99." The invoice is redacted but was billed to a business or individual in Santa Monica, California on September 21, 2017. *Id.* at 16.

Given this newly discovered evidence and information, justice now clearly requires that Opposer be permitted to amend its First Amended Notice of Opposition to add a claim for the

invalidity of Applicant's Application. Since Applicant cannot document a single transaction of its goods in commerce prior to the filing date of the Application despite the Board's order to produce documents in response to RFP 13, a strong possibility exists that the Board must declare the Application to be invalid under Lanham Act §§ 1(a) and 45.

III. ARGUMENT

A. Motion To Amend Standard

Pleadings in *inter partes* proceedings “may be amended in the same manner and to the same extent as in a civil action in a United States district court.” T.B.M.P. § 507.01 (citing 37 C.F.R. § 2.115). “Amendments to pleadings in *inter partes* proceedings before the Board are governed by Fed. R. Civ. P. 15.” T.B.M.P. § 507.01. Rule 15 states that “a party may amend its pleading only with the opposing party’s written consent or the court’s leave” and that “the court should freely give leave when justice so requires.” Fed. R. Civ. P. 15(a)(2). “[T]he Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party....” T.B.M.P. § 507.02.

Specifically, “[i]n deciding whether to grant leave to amend, the Board may consider undue delay, prejudice to the opposing party, bad faith or dilatory motive, futility of the amendment, and whether the party has previously amended its pleadings.” *Embarcadero Techs., Inc. v. Delphix Corp.*, 117 U.S.P.Q.2d 1518, 1523 (T.T.A.B. 2016). However, “whether or not the moving party can actually prove the allegation(s) sought to be added to a pleading is a matter to be determined after the introduction of evidence at trial or in connection with a proper motion for summary judgment, and the nonmoving party should not argue against granting the moving party leave to amend merely because the nonmoving party believes the moving party will not be

able to prove the additional claim or allegations at trial.” T.B.M.P. § 507.01.

A. There Has Been No Undue Delay

Despite the fact that discovery has closed in this matter, Opposer’s Motion is not unduly delayed. Opposer brings this Motion within five (5) weeks of first discovering the facts underlying Opposer’s proposed new claim, and during the pendency of the summary judgment motion which gave rise to Opposer’s discovery of these new facts. While a long or unexplained delay in filing a motion to amend can render the amendment untimely, this does not apply where the filing is occasioned by newly discovered evidence. T.B.M.P. § 507.02(a); *see, Boral Ltd. v. FMC Corp.*, 59 U.S.P.Q.2d 1701, 1703-04 (TTAB 2000) (no undue delay where motion to add claim was promptly filed after facts underlying claim became known, over two years after commencement of proceeding); *Karsten Manufacturing Corp. v. Editoy AG*, 79 U.S.P.Q.2d 1783, 1786 (TTAB 2006) (motion for leave to amend pleading granted because grounds for new claim was learned during discovery). Here, Applicant had refused entirely to produce documents, including the documents which give rise to this Motion, until the Board’s 10/8 Order commanded Applicant to comply with discovery. See, TTABVue No. 28 at 4. In reality, there has been no delay at all regarding this Motion, let alone undue delay.

The fact that the discovery period has closed in this matter does not change this fact. Neither party’s testimony period has opened. The Board clearly has the discretion to grant leave to amend after the close of discovery, and even during the parties’ testimony periods. *See, e.g., Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 U.S.P.Q.2d 1316, 1318 (TTAB 1992) (motion to amend filed prior to opening of petitioner’s testimony period permitted); *Space Base Inc. v. Stadis Corp.*, 17 U.S.P.Q.2d 1216, 1217 n.1 (TTAB 1990) (Opposer’s motion to amend its pleading during its testimony period granted in the interests of

justice and judicial economy); *Focus 21 Int'l Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 U.S.P.Q.2d 1316, 1318 (T.T.A.B. 1992) (motion to amend filed prior to opening of petitioner's testimony period permitted).¹

Indeed, the timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) plays a large role in the Board's determination of whether the adverse party would be prejudiced by allowance of the proposed amendment. T.B.M.P. § 507.02(a); *see, Marshall Field & Co. v. Mrs. Field's Cookies*, 11 U.S.P.Q.2d 1355, 1359 (TTAB 1989) ("concept of 'undue delay' is inextricably linked with the concept of prejudice to the nonmoving party"). Here, the timing has been dictated by Applicant's dilatory tactics. Applicant cannot claim any prejudice due to timing, as any delay in filing this Motion was occasioned solely by Applicant's refusal to produce documents which gave rise to Opposer's Rule 56(d) Motion and the Board's 10/8 Order.

In short, Opposer has not unduly delayed filing this Motion. This weighs heavily in support of granting Opposer's Motion.

B. There is no Prejudice to Applicant

As noted above, the "...concept of 'undue delay' is inextricably linked with the concept of prejudice to the nonmoving party." *Marshall Field & Co. v. Mrs. Field's Cookies*, 11 U.S.P.Q.2d at 1359; *see, also, Nike, Inc. v. United States Naval Acad. Found.*, 2015 TTAB LEXIS 86, at *3-4 (T.T.A.B. Mar. 09, 2015) (granting motion to amend to assert lack of bona fide intent because there was no prejudice from undue delay). Applicant cannot claim it is

¹ Some cases have held that the Board can alleviate possible prejudice to the non-moving party by re-opening discovery. *See, e.g., Space Base Inc. v. Stadis Corp.*, 17 U.S.P.Q.2d at 1217 n.1. In the present case, however, Applicant had every opportunity to conduct and participate in discovery but chose not to do so. Applicant took no discovery whatsoever prior to the expiration of the discovery period. *See*, 56(d) Decl. ¶ 20. Moreover, Applicant was ordered by the Board in its 10/8 Order to produce all documents evidencing where and when Applicant sold goods in connection with Applicant's Mark, responsive to Opposer's RFP No. 13. Exh. 1 to SJ Decl. at p. 6; TTABVue No. 27 at 4. Applicant must be precluded from responding any further to RFP 13, as such further production would trivialize the Board's previous order and prejudice Opposer who has expended considerable resources in bringing this matter before the Board.

prejudiced, because Applicant's refusal to participate in discovery is what occasioned Opposer's Rule 56 Motion and ultimately resulted in Opposer's discovery of the evidence of Applicant's lack of sales in commerce that compels this Motion.

Prejudice may also result from a party's inability to secure evidence or testimony relevant to its defense of a newly added claim. *See, Action Prods. v. Serta Inc.*, 2014 TTAB LEXIS 562, at *18 (T.T.A.B. Sept. 4, 2014). Applicant in the instant case is not so prejudiced, however, because the parties' testimony periods have not opened. *See, Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 U.S.P.Q.2d at 1318 (motion to amend filed prior to opening of petitioner's testimony period permitted). Moreover, Applicant had ample opportunity to provide documentation showing sales of Applicant's robot toys in commerce made prior to the filing date of the Application, either in response to the Board's 10/8 Order requiring documents responsive to RFP No. 13, or during the discovery period in response to RFP No. 13 in the ordinary course without the Board's involvement. *See, Exh. 1 to SJ Decl. at p. 6; TTABVue No. 27 at 4.* Applicant should now be precluded from attempting, in response to this Motion, from producing any further sales documentation, and Applicant cannot claim that it is now prejudiced by its own failure to produce any such evidence in response to the Board's 10/8 Order.

Since Applicant cannot claim prejudice, this factor weighs strongly in favor of granting the Motion.

C. The Motion Is Not Made in Bad Faith Or For a Dilatory Motive

Opposer's sole motivation for bringing this Motion and seeking to amend its First Amended Notice of Opposition is its discovery of new facts regarding Applicant's claimed use of Applicant's Mark in commerce, which facts compel a claim for the invalidity of Applicant's Application. Given that these facts are newly discovered, and had been withheld by Applicant

through its refusal to produce documents, Opposer's motivation cannot be considered dilatory or in bad faith. To the extent that any bad faith is even suggested by the current circumstances, it is Applicant's initial refusal to produce documents in favor of a premature summary judgment motion, not Opposer's Motion, that suggests questionable intent.

Indeed, Opposer's desire to add a claim for the invalidity of Applicant's Application is the antithesis of bad faith. It is long held and canon that the trademark laws are designed to protect the consuming public from deception and fraud. *See, e.g., James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266 (7th Cir. 1976). "The law is not made for the protection of experts, but for the public – that vast multitude which includes the ignorant, the unthinking, and the credulous, who, in making purchases, do not stop to analyze, but are governed by appearances and general impressions." *Florence Mfg. Co. v. J.C. Dowd & Co.*, 178 F. 73, 74 (C.C.A. 2d Cir. 1910). Opposer's new claim seeks to expose the real possibility that Applicant's use-based Application is actually void *ab initio* because Applicant did not make use of Applicant's Mark in commerce prior to filing the Application. *See*, 15 U.S.C. §§1051(a) (Lanham Act requires that a mark be used in commerce before it may be registered, unless the application to register the mark is based on a foreign registration). Should Applicant's Mark be registered based upon the false pretense that Applicant made such use, Applicant's registration for WAR BOT would essentially perpetrate a fraud on the public.

In light of the foregoing, Opposer's Motion is made in good faith, which weighs in favor of granting Opposer leave to amend.

D. The Amendments are not Futile

Finally, Opposer's proposed amendment would not be futile because Opposer's proposed new claim against Applicant is well founded in the law and the record, and properly plead (see

Exhs. A and B to this Motion, setting forth redlined and clean versions of Opposer’s proposed Second Amended Notice of Opposition, at ¶¶ 20, 51-54). “Use in commerce” on goods occurs when a mark is affixed to the goods and such goods are sold or transported in commerce. 15 U.S.C. § 1127. Thus, a sale of goods supporting a valid trademark registration for a mark used for goods must be made “in commerce.” See, T.M.E.P. § 901.04 (Mar. 2017 Ed.). Applicant’s Application for WAR BOT in connection with robot toys in International Class 28 was made under Lanham Act § 1(a) – a “use based” application – and thus Applicant had to have sold or transported its goods in commerce as of the date of the Application. *Id.* If not, the Application was, and is void *ab initio*. See, 15 U.S.C. §§ 1051(a), 1053 (Lanham Act requires that a trademark be used in commerce before it can be registered, unless an application is based on a foreign registration).

As stated above, the Board’s 10/8 Order compelled Applicant to produce *all* documents that evidence where and when Applicant has sold goods in connection with Applicant’s Mark. Exh. 1 to SJ Decl. at p. 6. In response, Applicant produced two pages evidencing a single sale of War Bot robot toys, made wholly within the Los Angeles, California metropolitan area, that occurred more than four months after Applicant filed its Application. Exh. 5 to SJ Decl. at pp. 15-16. There is no further evidence in the record that Applicant has ever made use of Applicant’s mark *in commerce*.² Thus, for purposes of this Motion and based upon the current record, this one sale is the only sale of War Bot robots made by Applicant.

As stated above, “use in commerce” on goods occurs only when a mark is affixed to the goods and such goods are sold or transported in commerce. 15 U.S.C. § 1127. “In commerce”

² Applicant’s specimen of use submitted in connection with its Application, which consists of pages from Applicant’s website, www.warbotrobots.com, that display pictures Applicant’s toys and instructs visitors how to purchase the toys (by mailing money to Applicant – the website is not an ecommerce site), does not constitute use in commerce because it does not evidence the sale or transportation of Applicant’s toys in commerce. See, 15 U.S.C. § 1127.

for purposes of the Lanham Act, can only arise in the context of an *intrastate* sale of goods – use of a mark that occurs solely within one U.S. state – if that use is of a type that would, in the aggregate, have a direct effect on interstate commerce. *See, Christian Faith Fellowship Church v. Adidas AG*, 841 F.3d 986, 993 (Fed. Cir. 2016). There, the sale occurred at a retail store in a border town in Illinois, made to a Wisconsin resident who had traveled across the border to purchase hats. *Id.* An intrastate sale was also deemed to affect interstate commerce where imported wines were shipped from outside the U.S. and then sold intrastate at retail. *See, In re Silenus Wines, Inc.*, 557 F.2d 806 (C.C.P.A. 1977).

There is no evidence that Applicant’s robot toys, or parts therefor, were assembled, or acquired from outside of California or the United States; to the contrary, Applicant stated in response to Interrogatory No. 30 that Applicant itself is the only entity involved in the manufacture of Applicant’s toys. Exh. 2 to Rollings Decl. at p. 9. Moreover, it is difficult to argue that this single sale transaction made by Applicant, taken in the aggregate, directly affected interstate commerce, as Applicant and its lone purchaser were not only residents of California but resided or were based in the same metropolitan area of California. *See, Christian Faith Fellowship Church*, 841 F.3d at 993.

Based upon the foregoing, it is clear that evidence in the record now exists, based upon the documents just recently produced by Applicant in response to the Board’s 10/8 Order, supporting a claim against Applicant for invalidity of its Application. This claim is clearly not futile. Justice, therefore, requires granting Opposer leave to amend its First Amended Notice of Opposition to add such a claim.

IV. CONCLUSION

Based upon all of the foregoing, and upon all of the matters cited in the SJ Declaration, including all cited Exhibits, which are referenced herein above and are currently before the Board, Opposer respectfully requests that the Board enter an order granting Opposer leave to amend its First Amended Notice of Opposition to include a claim against Applicant invalidating its Application as void *ab initio* on the grounds that Applicant had not made use of Applicant's Mark in commerce in connection with the goods described in the Application as of the filing date of the Application.

Dated: Scarsdale, New York
December 9, 2019

Respectfully submitted,

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CERTIFICATE OF SERVICE

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

Willmore F. Holbrow III
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Dated: Scarsdale, New York
December 9, 2019

/s/ Marlana Del Colle
Marlana Del Colle

EXHIBIT A

**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

ROBOT WARS, LLC	X	
	:	
Opposer,	:	
	:	
v.	:	
	:	Opposition No. 91236715
THEATRICALITY LLC,	:	
	:	
Applicant.	:	
	X	

FIRST-SECOND 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.

~~19.20.~~ Upon further information and belief, Applicant did not use Applicant’s Purported Mark in commerce in connection with the goods in International Class 28 listed in Applicant’s Application, “toy robots,” prior to filing Applicant’s Application on March 14, 2017.

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

~~20.21.~~ Opposer repeats and realleges each of the allegations made in the preceding paragraphs as if set forth fully herein.

~~21.22.~~ There is no issue of priority of use.

~~22.23.~~ 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.

~~23.24.~~ 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.

~~24.25.~~ 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.

~~25.26.~~ Applicant's Purported Mark and Opposer's Trademark are similar in sight, sound, and connotation.

~~26.27.~~ Applicant's Purported Mark creates an overall commercial impression and connotation that is confusingly similar to that created by Opposer's Trademark.

~~27.28.~~ 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.

~~28.29.~~ 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.

~~29.30.~~ 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))

~~30.31.~~ Opposer repeats and realleges each of the allegations made in the preceding paragraphs as if set forth fully herein.

~~31.~~32. Opposer's Trademark is Opposer's house mark, trade name, and the identity of Opposer.

~~32.~~33. 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.~~34. 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.~~35. 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.~~36. 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.~~37. 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.~~38. 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.~~39. Opposer repeats and realleges each of the allegations made in the preceding paragraphs as if set forth fully herein.

~~39.~~40. 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.~~41. 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.~~42. 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.~~43. 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.~~44. 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.

44.45. 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.

45.46. 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.

46.47. 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.

47.48. 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.

48.49. 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.

50. 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)).

CLAIM IV
INVALIDITY OF APPLICANT'S APPLICATION (Sections 1, 45)

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

52. Applicant filed Applicant's Application on March 14, 2017, in part on a use-basis under Lanham Act § 1(a) for "Toy robots" in International Class 28.

53. Upon information and belief, Applicant had not used Applicant's Purported Mark in commerce in connection with toy robots prior to filing Applicant's Application on March 14, 2017.

49-54. By reason of Applicant's failure to use Applicant's Purported Mark in commerce in connection with toy robots prior to March 14, 2017, Applicant's Application was, and is void *ab initio* in so far as it seeks to register Applicant's Purported Mark in connection with goods in International Class 28, and thus Applicant should be denied registration therefor under Sections 1 and 45 of the Lanham Act, 15 U.S.C. §§ 1051(a), 1127.

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
December 9, 2019

By: /s/ Robert B. Golden
Robert B. Golden
Jeffrey M. Rollings
One Chase Road
Lackebach Siegel Building,
Penthouse Floor
Scarsdale, New York 10583
Phone: (914)723-4300
Fax: (914)723-4301
RGolden@LSLLP.com
JRollings@LSLLP.com
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 and overnight mail, addressed to Applicant's counsel of record, as follows:

Willmore F. Holbrow III
Buchalter
1000 Wilshire Blvd. Suite 1500
Los Angeles, CA 90017
wholbrow@buchalter.com

Dated: Scarsdale, New York
December 9, 2019

 /s/ Marlana Del Colle
Marlana Del Colle

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 2019-12-09 11:00:31 EST

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

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

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

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: ROBOT WARS, LLC

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

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: NEW YORK

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Howard N. Aronson

Docket Number: 7787

Attorney Primary Email Address: TMEFS@LSLLP.COM

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Howard N. Aronson
LACKENBACH SIEGEL LLP
One Chase Road
Lackebach Siegel Building
SCARSDALE, NEW YORK UNITED STATES 10583

Phone: 914-723-4300

Fax: 914-723-4301

Correspondent e-mail: tmefs@LSLLP.com

Correspondent e-mail Authorized: Yes

Domestic Representative

Domestic Representative Name: Howard N. Aronson

Phone: 914-723-4300

Fax: 914-723-4301

Domestic Representative e-mail: TMEFS@LSLLP.COM

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

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 Name: ROGERS & WELLS LLP

Correspondent Address: CINDY D. CAREY
TRADEMARK LEGAL ASSISTANT
200 PARK AVENUE

Proceedings

Summary

Number of
Proceedings: 1

Type of Proceeding: Opposition

Proceeding
Number: [91236715](#)

Filing Date: Sep 18, 2017

Status: Suspended

Status Date: Apr 23, 2019

Interlocutory
Attorney: MIKE WEBSTER

Defendant

Name: Theatricality LLC

Correspondent
Address: WILLMORE F HOLBROW III
BUCHALTER
1000 WILSHIRE BLVD, SUITE 1500
LOS ANGELES CA UNITED STATES , 90017

Correspondent e-mail: wholbrow@buchalter.com , jgass@buchalter.com , ipdocket@buchalter.com

Associated marks

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

Plaintiff(s)

Name: Robot Wars, LLC

Correspondent
Address: ROBERT B GOLDEN
LACKENBACH SIEGEL LLP
ONE CHASE ROAD PENTHOUSE FLOOR LACKENBACH SIEGEL BUILDING
SCARSDALE NY UNITED STATES , 10583

Correspondent e-mail: HAronson@LSLLP.com , RGolden@LSLLP.com , TMEFS@LSLLP.com , MDeiColle@LSLLP.com , JRollings@LSLLP.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
ROBOT WARS	REGISTERED AND 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	
12	P MOT TO AMEND PLEADING/AMENDED PLEADING	May 18, 2018	
13	TRIAL DATES REMAIN AS SET	Jun 05, 2018	
14	ANSWER	Jun 18, 2018	
15	P MOT TO STRIKE	Jun 29, 2018	
16	D OPP/RESP TO MOTION	Jul 15, 2018	
17	SUSP PEND DISP OF OUTSTNDNG MOT	Jul 17, 2018	

18	P REPLY IN SUPPORT OF MOTION	Aug 03, 2018
19	P REQ FOR RECON DENIED; PROCEEDINGS RESUMED	Oct 24, 2018
20	D APPEARANCE / POWER OF ATTORNEY	Feb 25, 2019
21	P CHANGE OF CORRESP ADDRESS	Apr 17, 2019
22	D MOT FOR SUMMARY JUDGMENT	Apr 23, 2019
23	P CHANGE OF CORRESP ADDRESS	Apr 24, 2019
24	SUSP PEND DISP OF OUTSTNDNG MOT	May 01, 2019
25	MOT FOR DISCOVERY AFTER MSJ - FRCP 56	May 23, 2019
26	D REPLY IN SUPPORT OF MOTION	Jun 13, 2019
27	MOT GRANTED, IN PART; RESPONSE DUE	Oct 08, 2019

EXHIBIT B

**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

-----	X
ROBOT WARS, LLC	:
	:
Opposer,	:
	:
v.	:
	:
THEATRICALITY LLC,	: Opposition No. 91236715
	:
Applicant.	:
-----	X

SECOND 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.

20. Upon further information and belief, Applicant did not use Applicant’s Purported Mark in commerce in connection with the goods in International Class 28 listed in Applicant’s Application, “toy robots,” prior to filing Applicant’s Application on March 14, 2017.

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

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

22. There is no issue of priority of use.

23. 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.

24. 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.

25. 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.

26. Applicant's Purported Mark and Opposer's Trademark are similar in sight, sound, and connotation.

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

28. 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.

29. 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.

30. 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))

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

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

33. 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.

34. 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.

35. 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.

36. 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.

37. 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.

38. 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))

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40. 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.

41. 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.

42. 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.

43. 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.

44. 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.

45. 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.

46. 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.

47. 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.

48. 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.

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Applicant's Purported Mark should be denied registration under Section 43(c) of the Lanham Act (15 U.S.C. § 1125(c)).

CLAIM IV
INVALIDITY OF APPLICANT'S APPLICATION (Sections 1, 45)

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

52. Applicant filed Applicant's Application on March 14, 2017, in part on a use-basis under Lanham Act § 1(a) for "Toy robots" in International Class 28.

53. Upon information and belief, Applicant had not used Applicant's Purported Mark in commerce in connection with toy robots prior to filing Applicant's Application on March 14, 2017.

54. By reason of Applicant's failure to use Applicant's Purported Mark in commerce in connection with toy robots prior to March 14, 2017, Applicant's Application was, and is void *ab initio* in so far as it seeks to register Applicant's Purported Mark in connection with goods in International Class 28, and thus Applicant should be denied registration therefor under Sections 1 and 45 of the Lanham Act, 15 U.S.C. §§ 1051(a), 1127.

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
December 9, 2019

By: /s/ Robert B. Golden
Robert B. Golden
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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 and overnight mail, addressed to Applicant's counsel of record, as follows:

Willmore F. Holbrow III
Buchalter
1000 Wilshire Blvd. Suite 1500
Los Angeles, CA 90017
wholbrow@buchalter.com

Dated: Scarsdale, New York
December 9, 2019

 /s/ Marlana Del Colle
Marlana Del Colle

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 2019-12-09 11:00:31 EST

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

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

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

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: ROBOT WARS, LLC

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

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: NEW YORK

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Howard N. Aronson

Docket Number: 7787

Attorney Primary Email Address: TMEFS@LSLLP.COM

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Howard N. Aronson
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One Chase Road
Lackebach Siegel Building
SCARSDALE, NEW YORK UNITED STATES 10583

Phone: 914-723-4300

Fax: 914-723-4301

Correspondent e-mail: tmefs@LSLLP.com

Correspondent e-mail Authorized: Yes

Domestic Representative

Domestic Representative Name: Howard N. Aronson

Phone: 914-723-4300

Fax: 914-723-4301

Domestic Representative e-mail: TMEFS@LSLLP.COM

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

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 Name: ROGERS & WELLS LLP

Correspondent Address: CINDY D. CAREY
TRADEMARK LEGAL ASSISTANT
200 PARK AVENUE

Proceedings

Summary

Number of
Proceedings: 1

Type of Proceeding: Opposition

Proceeding
Number: [91236715](#)

Filing Date: Sep 18, 2017

Status: Suspended

Status Date: Apr 23, 2019

Interlocutory
Attorney: MIKE WEBSTER

Defendant

Name: Theatricality LLC

Correspondent
Address: WILLMORE F HOLBROW III
BUCHALTER
1000 WILSHIRE BLVD, SUITE 1500
LOS ANGELES CA UNITED STATES , 90017

Correspondent e-mail: wholbrow@buchalter.com , jgass@buchalter.com , ipdocket@buchalter.com

Associated marks

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

Plaintiff(s)

Name: Robot Wars, LLC

Correspondent
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SCARSDALE NY UNITED STATES , 10583

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Associated marks

Mark	Application Status	Serial Number	Registration Number
ROBOT WARS	REGISTERED AND 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	
12	P MOT TO AMEND PLEADING/AMENDED PLEADING	May 18, 2018	
13	TRIAL DATES REMAIN AS SET	Jun 05, 2018	
14	ANSWER	Jun 18, 2018	
15	P MOT TO STRIKE	Jun 29, 2018	
16	D OPP/RESP TO MOTION	Jul 15, 2018	
17	SUSP PEND DISP OF OUTSTNDNG MOT	Jul 17, 2018	

18	P REPLY IN SUPPORT OF MOTION	Aug 03, 2018
19	P REQ FOR RECON DENIED; PROCEEDINGS RESUMED	Oct 24, 2018
20	D APPEARANCE / POWER OF ATTORNEY	Feb 25, 2019
21	P CHANGE OF CORRESP ADDRESS	Apr 17, 2019
22	D MOT FOR SUMMARY JUDGMENT	Apr 23, 2019
23	P CHANGE OF CORRESP ADDRESS	Apr 24, 2019
24	SUSP PEND DISP OF OUTSTNDNG MOT	May 01, 2019
25	MOT FOR DISCOVERY AFTER MSJ - FRCP 56	May 23, 2019
26	D REPLY IN SUPPORT OF MOTION	Jun 13, 2019
27	MOT GRANTED, IN PART; RESPONSE DUE	Oct 08, 2019