

ESTTA Tracking number: **ESTTA956368**

Filing date: **02/25/2019**

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	Athletics Investment Group LLC d/b/a The Oakland Athletics Baseball Company
Granted to Date of previous extension	02/24/2019
Address	7000 Coliseum Way Oakland, CA 94621 UNITED STATES

Attorney information	James D. Weinberger Fross Zelnick Lehrman & Zissu, P.C. 4 Times Square, 17th Floor New York, NY 10036 UNITED STATES jweinberger@fzlz.com, jvosgerchian@fzlz.com (212) 813-5900
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Applicant Information

Application No	87863914	Publication date	08/28/2018
Opposition Filing Date	02/25/2019	Opposition Period Ends	02/24/2019
Applicant	Oaklandish LLC 291 3rd Street Oakland, CA 94607 UNITED STATES		

Goods/Services Affected by Opposition

Class 043. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Restaurant and caf� services

Applicant Information

Application No	87910572	Publication date	08/28/2018
Opposition Filing Date	02/25/2019	Opposition Period Ends	
Applicant	Oaklandish LLC 291 3rd Street Oakland, CA 94607 UNITED STATES		


Goods/Services Affected by Opposition

Class 035. First Use: 2011/07/08 First Use In Commerce: 2011/07/08
 All goods and services in the class are opposed, namely: Wholesale store services featuring clothing and hats; Online wholesale store services featuring clothing and hats

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1267687	Application Date	09/27/1982
Registration Date	02/21/1984	Foreign Priority Date	NONE
Word Mark	OAKLAND A'S ATHLETICS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 006. First use: First Use: 1981/11/20 First Use In Commerce: 1981/11/20 Key Tags and Key Chains</p> <p>Class 014. First use: First Use: 1981/11/20 First Use In Commerce: 1981/11/20 [Rings and] Lapel Pins</p> <p>Class 018. First use: First Use: 1981/11/20 First Use In Commerce: 1981/11/20 Tote Bags and All Purpose Sport Bags</p> <p>Class 020. First use: First Use: 1981/09/04 First Use In Commerce: 1981/09/04 Novelty Items, in the Nature of Pins, Portable Cushions and Chairs</p> <p>Class 021. First use: First Use: 1981/11/23 First Use In Commerce: 1981/11/23 Aluminum Tankards, Wastebaskets and Mugs of Non-Precious Metal</p> <p>Class 025. First use: First Use: 1981/11/20 First Use In Commerce: 1981/11/20 Clothing-Namely, T-Shirts, Sport Shirts, Sweaters, [Warm-Up Suits,] Pajamas and Baseball Uniforms</p> <p>Class 028. First use: First Use: 1981/11/23 First Use In Commerce: 1981/11/23</p>		

	[Toy Ceramic Banks] Class 034. First use: First Use: 1981/11/21 First Use In Commerce: 1981/11/21 [Ceramic Ashtrays]
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U.S. Registration No.	1263825	Application Date	09/27/1982
Registration Date	01/10/1984	Foreign Priority Date	NONE

Word Mark	OAKLAND A'S ATHLETICS
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 041. First use: First Use: 1981/04/09 First Use In Commerce: 1981/04/09 Entertainment Services-Namely, Conducting Professional Baseball Games and Exhibitions Rendered Live and Through the Media of Radio and Television Broadcasts
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U.S. Registration No.	1523854	Application Date	09/24/1987
Registration Date	02/07/1989	Foreign Priority Date	NONE


Word Mark	OAKLAND A'S
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 041. First use: First Use: 1968/00/00 First Use In Commerce: 1968/00/00 ENTERTAINMENT SERVICES IN THE NATURE OF BASEBALL EXHIBITIONS
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U.S. Registration No.	1530675	Application Date	08/08/1988
Registration Date	03/21/1989	Foreign Priority Date	NONE

Word Mark	OAKLAND A'S ATHLETICS
Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 1987/00/00 First Use In Commerce: 1987/00/00 [THERMOMETERS]</p> <p>Class 016. First use: First Use: 1981/00/00 First Use In Commerce: 1981/00/00 PAPER PRODUCTS AND PRINTED MATTER, NAMELY, LITHOGRAPHS, POSTERS, PRINTS, [LENTICULAR BASEBALL CARDS] AND BASEBALL CARDS</p> <p>Class 024. First use: First Use: 1986/00/00 First Use In Commerce: 1986/00/00 FABRICS, NAMELY, POTHOLDERS, BEDSPREADSAND SHEETS</p>

U.S. Registration No.	1571006	Application Date	08/08/1988
Registration Date	12/12/1989	Foreign Priority Date	NONE
Word Mark	OAKLAND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 024. First use: First Use: 1987/00/00 First Use In Commerce: 1987/00/00 [FABRICS, NAMELY, TABLECLOTHS]		

	Class 025. First use: First Use: 1987/04/00 First Use In Commerce: 1987/04/00 CLOTHING, NAMELY, T-SHIRTS		
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U.S. Registration No.	2630348	Application Date	12/05/2000
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Registration Date	10/08/2002	Foreign Priority Date	NONE
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Word Mark	A'S OAKLAND ATHLETICS		
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Design Mark			
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Description of Mark	NONE		
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Goods/Services	Class 025. First use: First Use: 1990/00/00 First Use In Commerce: 1990/00/00 CLOTHING, NAMELY, CAPS, HATS, HEADWEAR, SHIRTS, T-SHIRTS, TANK TOPS, [TURTLENECKS,] SHORTS, BASEBALL UNIFORMS, JERSEYS, SWEATSHIRTS,[BOXER SHORTS,] ROBES, SLEEPWEAR, JACKETS, INFANTWEAR, [CLOTH DIAPER SETS WITH UNDERSHIRT AND DIAPER COVER,] ROMPERS, FOOTWEAR, SOCKS		
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U.S. Registration No.	2573396	Application Date	04/10/2001
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Registration Date	05/28/2002	Foreign Priority Date	NONE
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Word Mark	A'S OAKLAND ATHLETICS		
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Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 028. First use: First Use: 1992/12/00 First Use In Commerce: 1992/12/00 TOYS AND SPORTING GOODS, NAMELY, STUFFED TOYS, PLUSH TOYS, [BEAN BAG TOYS, BEAN BAGS,] CHECKER SETS, BOARD GAMES, DART BOARDS AND DART BOARD ACCESSORIES, TOY[CARS AND] TRUCKS, [INFLATABLE BASEBALL BATS,] TOY BASEBALL BATS, BAL- LOONS,PUZZLES, TOY TATTOOS, DECORATIVE WIND SOCKS, MINI BATS, VIDEO GAME CARTRIDGES, [HAND HELD VIDEO AND ELECTRONIC GAMES,]BASEBALLS AND HOLDERS FOR BASEBALLS, AUTOGRAPHED BASEBALLS, BASKETBALLS, PLAYGROUND BALLS, RUBBER ACTION BALLS, GOLF BALLS, GOLF CLUB COVERS, [GOLF CLUB BAGS,GOLF PUTTERS,] BASEBALL BATS, MITTS, [CATCHER'S MASKS, PARTY FA- VORS IN THE NATURE OF NOISE MAKERS,] AND CHRISTMAS TREE OR- NAMENTS</p>		
U.S. Registration No.	2759932	Application Date	12/18/2001
Registration Date	09/02/2003	Foreign Priority Date	NONE
Word Mark	OAKLAND ATHLETICS A'S		

Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1994/03/00 First Use In Commerce: 1994/03/00 ELECTRICAL AND SCIENTIFIC APPARATUS, NAMELY, [PRE-RECORDED VIDEOTAPES RELATING TO BASEBALL,] PRE-RECORDED VIDEODISCS RELATING TO BASEBALL, PRE-RECORDED COMPACT DISCS RELATING TO BASEBALL, PRE-RECORDED AUDIO DISCS RELATING TO BASEBALL, [BINOCULARS,] SUN GLASSES; MAGNETS; COMPUTER ACCESSORIES, namely, MOUSE PADS [AND COMPUTER SOFTWARE, NAMELY, SCREEN SAVERS; COMPACT DISC CASES,] VIDEO AND COMPUTER GAME CARTRIDGES, VIDEO AND COMPUTER GAME DISCS, VIDEO AND COMPUTER GAME CASSETTES, COMPUTER GAME PROGRAMS</p>		
U.S. Registration No.	3943685	Application Date	08/04/2010
Registration Date	04/12/2011	Foreign Priority Date	NONE
Word Mark	OAKLAND		
Design Mark			
Description of	The mark consists of the word "OAKLAND" in stylized form.		

Mark	
Goods/Services	Class 025. First use: First Use: 1996/00/00 First Use In Commerce: 1996/00/00 Clothing and headwear, namely, jerseys,caps, hats, sweatshirts, shirts, and t-shirts

Related Proceedings	Opp. No. 91242172
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Attachments	73389055#TMSN.png(bytes) 73389056#TMSN.png(bytes) 73744853#TMSN.png(bytes) 73744858#TMSN.png(bytes) 76176172#TMSN.png(bytes) 76238485#TMSN.png(bytes) 76349581#TMSN.png(bytes) 85099858#TMSN.png(bytes) F2947187.pdf(165573 bytes)
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Signature	/s/ James D. Weinberger
Name	James D. Weinberger
Date	02/25/2019

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

ATHLETICS INVESTMENT GROUP LLC
D/B/A THE OAKLAND ATHLETICS
BASEBALL COMPANY,

Opposer,

-against-

OAKLANDISH, LLC,

Applicant.

NOTICE OF OPPOSITION

Opposer, Athletics Investment Group LLC d/b/a The Oakland Athletics Baseball Company (“Opposer”), a limited partnership organized under the laws of California, with offices at 7000 Coliseum Way, Oakland, California 94621, believes that it will be damaged by registration of U.S. Patent and Trademark Office Application Serial Nos. 87863914 and 87910572 and for the standard character word mark OAKLANDISH (“Applicant’s Mark”) in connection with “Restaurant and café services” in International Class 43 and “Wholesale store services featuring clothing and hats; Online wholesale store services featuring clothing and hats” in International Class 35, respectively (the “Applications”), and having been granted extensions of time to oppose up to and including February 25, 2018, hereby oppose the same.

As grounds therefore, Opposer alleges as follows:

1. Opposer is the owner of the OAKLAND ATHLETICS MAJOR LEAGUE BASEBALL club.

2. Since long prior to any date on which Applicant may rely, Opposer and its predecessors, and their affiliated and related entities, licensees and/or sponsors have used various trade and service marks comprising or containing the word OAKLAND, including, without

limitation, in distinctive stylizations shown here:  and 

(“Opposer’s OAKLAND Marks”), on or in connection with baseball games and exhibition services and a wide variety of goods and services, including, without limitation, beverage containers; apparel and accessories, including but not limited to t-shirts, caps, hats, shirts, baseball uniforms, jerseys and jackets; paper goods and printed matter; toys and sporting goods; electrical and scientific apparatus; decorative plates; fabrics; and novelty items.

3. Opposer’s OAKLAND Marks are frequently used in the OAKLAND ATHLETICS MAJOR LEAGUE BASEBALL team trade-dress colors, namely, green and gold.

4. Opposer owns U.S. federal registrations for Opposer’s OAKLAND Marks in International Classes 6, 9, 14, 16, 18, 20, 21, 24, 25, 28 and 41, namely, Registration Nos. 1267687, 1263825, 1523854, 1530675, 1571006, 2630348, 2573396, 2759932 and 3943685. All of the registrations for Opposer’s OAKLAND Marks relied upon herein are valid, subsisting and in full effect and serve as *prima facie* evidence of the validity of the mark and of Opposer’s exclusive right to use the mark in connection with the goods and services identified therein, pursuant to Section 33(a) of the Lanham Act, 15 U.S.C. § 1115(a). Moreover, all of the registrations relied upon herein are incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065, and therefore serve as conclusive proof of Opposer’s exclusive right to use the mark in connection with the goods and services identified therein, as provided by Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(b).

5. Since long prior to July 8, 2011, Applicant's claimed date of first use in interstate commerce for Application Ser. No. 87910572 and the earliest day on which Applicant may rely, Opposer, its predecessors, and their affiliated and related entities, licensees and/or sponsors have promoted and advertised the sale and distribution of goods and services bearing or offered in connection with Opposer's OAKLAND Marks, including, but not limited to, baseball games and exhibition services and a wide variety of goods and services, including, without limitation, beverage containers; apparel and accessories, including but not limited to t-shirts, caps, hats, shirts, baseball uniforms, jerseys and jackets; paper goods and printed matter; toys and sporting goods; electrical and scientific apparatus; decorative plates; fabrics; and novelty items.

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

7. On April 4, 2018, Applicant filed Application Ser. No. 87863914 for Applicant's Mark for "Restaurant and café services" in International Class 43 on an intent to use.

8. On May 7, 2018, Applicant filed Application Ser. No. 87910572 for Applicant's Mark for "Wholesale store services featuring clothing and hats; Online wholesale store services featuring clothing and hats" in International Class 43 on the basis of first use in interstate commerce on July 8, 2011.

9. Upon information and belief, Applicant did not use Applicant's Mark for the services covered in Application Ser. No. 87863914 in United States commerce prior to its constructive priority use date of April 4, 2018 and did not use Applicant's Mark for the services

covered in Application Ser. No. 87910572 in interstate commerce prior to its claimed first use date of July 8, 2011.

10. The services covered by the Applications are closely related to the goods offered and services rendered in connection with Opposer's OAKLAND Marks.

11. Applicant's Mark is nearly identical to Opposer's OAKLAND Marks, differing only by the addition of the common suffix -ISH to Opposer's OAKLAND Marks.

12. Applicant uses Applicant's Mark in a manner intended to mimic the distinctive stylized presentation and trade dress colors of Opposer's OAKLAND Marks:



Given this use, among other reasons, Applicant's Mark is plainly intended to reference and call to mind Opposer's OAKLAND Marks.

11. Applicant's Mark so resembles Opposer's OAKLAND Marks as to be likely, when used in connection with Applicant's services, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Applicant's goods have their origin

with Opposer and/or that such services are approved, endorsed or sponsored by Opposer or associated in some way with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

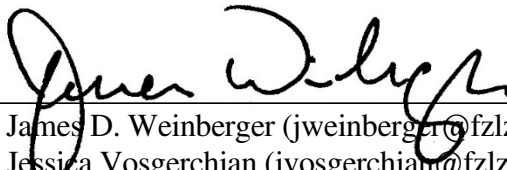
12. Moreover, Opposer's OAKLAND Marks are famous for goods and services relating to baseball games and exhibition services and a wide variety of goods and services including and had become famous long before the earliest priority date upon which Applicant can rely. Because Opposer's OAKLAND Marks have become famous, Applicant's use and registration of Applicant's Mark will damage Opposer by trading on the enormous goodwill associated with Opposer's OAKLAND Marks and diluting their distinctiveness. Thus, Applicant's use and registration of Applicant's Mark in connection with the services identified in the Applications are likely to cause dilution by blurring of the famous Opposer's OAKLAND Marks, in violation of Sections 13(a) and 43(c) of the Lanham Act, 15 U.S.C. §§ 1063(a), 1125(c).

13. By reason of the foregoing, Opposer is likely to be harmed by the registration of the Applications for Applicant's Mark.

THEREFORE, it is respectfully requested that this Opposition be sustained and that registration of the mark shown in the Applications be entirely refused.

Dated: New York, New York
February 25, 2019

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

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