

ESTTA Tracking number: **ESTTA999411**

Filing date: **09/04/2019**

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	Technical Knockout, Inc.
Granted to Date of previous extension	09/04/2019
Address	4660 PINE TIMBERS, SUITE 198 HOUSTON, TX 77041 UNITED STATES

Attorney information	DALE PAUL DIMAGGIO MALIN HALEY DIMAGGIO & BOWEN, P.A. 4901 NW 17TH WAY, SUITE 308 FORT LAUDERDALE, FL 33309 UNITED STATES info@mhdpatents.com 954-763-3303
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Applicant Information

Application No	87925048	Publication date	05/07/2019
Opposition Filing Date	09/04/2019	Opposition Period Ends	09/04/2019
Applicant	MDM Productions, LLC 32 W. 200 S., #250 Salt Lake City, UT 84101 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2017/12/31 First Use In Commerce: 2017/12/31 All goods and services in the class are opposed, namely: Clothing, namely, t-shirts; headwear

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.	3524178	Application Date	12/18/2002
Registration Date	10/28/2008	Foreign Priority Date	NONE

Word Mark	TKO
Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2000/11/00 First Use In Commerce: 2000/11/00 active wear for men and women, namely, [boxer shorts, bicycle shorts,] gym shorts, pants, pullovers, short shirts, sweat pants, sweat shirts, sweat shorts, sweat suits, t-shirts, tank tops, warm-upsuits

U.S. Registration No.	2383541	Application Date	02/10/1997
Registration Date	09/05/2000	Foreign Priority Date	NONE

Word Mark	TKO
Design Mark	TKO
Description of Mark	NONE
Goods/Services	Class 018. First use: First Use: 2000/01/00 First Use In Commerce: 2000/01/00 luggage used in the field of boxing and martial arts, namely, all-purpose sports bags, backpacks and waistpacks Class 025. First use: First Use: 1994/06/00 First Use In Commerce: 1994/06/00 athletic footwear and athletic head wear in the field of boxing and martial arts

Attachments	75239641#TMSN.png(bytes) Opp.TKOR.pdf(808680 bytes)
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Signature	/Dale Paul DiMaggio/
Name	DALE PAUL DIMAGGIO
Date	09/04/2019

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

Technical Knockout, Inc.,)	
a Delaware corporation,)	
)	Opposition No. _____
Opposer,)	Serial No. 87925048
)	Mark: TKOR
v.)	Published: May 7, 2019
)	
MDM Productions, LLC,)	
a Utah limited liability company,)	
)	
Applicant.)	
_____)	

NOTICE OF OPPOSITION

In the matter of Application Serial No. 87925048 for registration of the mark TKOR (hereinafter “Applicant’s Mark”), in connection with “clothing, namely, t-shirts; headwear” in International Class 025, Opposer, Technical Knockout, Inc., a Delaware corporation, having an address at 4660 Pine Timbers, Suite 198, Houston, Texas 77041, (hereinafter “Opposer”) believes that it would be damaged by such registration, and hereby opposes the registration of Applicant’s mark.

As grounds for this Opposition, it is stated that:

1. Opposer has engaged for over two decades in the fitness, boxing, martial arts and sporting goods industry including sales of related merchandise and apparel products and has sold products throughout the United States as well as abroad.

2. Opposer has continuously used the mark TKO since January of 1994 throughout the United States on a variety of fitness, boxing, martial arts and sporting goods items, events and services, as well as on related merchandise and apparel.

3. Opposer is the owner of U.S. Registration Nos. 3524178, 2383541, 2690394, 2902134, 5723808 and 5683232 for the mark TKO for goods listed therein as well as numerous pending applications. Opposer's family of marks are collectively referred to as "TKO marks." See Registrations attached.

4. On May 17, 2018, Applicant filed its application, Serial No. 87925048, to register the mark TKOR in connection with "clothing, namely, t-shirts; headwear," in International Class 025.

5. Opposer's filing dates and dates of first use are prior to Applicant's filing date, May 17, 2018, and Applicant's alleged date of first use in commerce of December 31, 2017.

6. Opposer has sold its goods listed in the aforesaid registrations under the TKO® Marks throughout the United States. Opposer has continued to expand into related goods and services over the years and has developed substantial goodwill with respect to the marks covered by the aforesaid registrations.

7. By virtue of its efforts, the expenditure of considerable sums for promotional activities, and by virtue of the excellence of its products, Opposer has gained a valuable reputation for its above-identified marks.

8. On May 7, 2019, Applicant's Application was published for opposition.

9. On May 30, 2019, Opposer filed its First 30 Day Request for Extension of Time to Oppose, which was granted.

10. On July 2, 2019, Opposer filed its Additional 60 Day Request for Extension of Time to Oppose, which was granted. Accordingly, Opposer timely files this Notice of Opposition.

COUNT I

PRIORITY OF USE AND LIKELIHOOD OF CONFUSION- Section 2(d) of the Lanham Act

11. Opposer realleges and incorporates by reference the allegations contained in paragraphs 1 through 10 above, as if set forth in their entirety herein.

12. Opposer has been using the TKO® Marks since at least as early as 1994, more than two decades prior to Applicant's date of first use of December 31, 2017.

13. Upon information and belief, Applicant was aware of Opposer and Opposer's long standing use of its TKO marks.

14. Opposer has priority over Applicant based on Opposer's long term use of the mark TKO in connection with its registered goods which are similar and substantially related to Applicant's products.

15. Moreover, in addition to Opposer's prior rights in its family of marks and consumer recognition of the TKO® Marks for various goods and services, Opposer has the right to natural expansion.

16. Applicant's mark, TKOR, is confusingly similar to Opposer's TKO mark(s) as it incorporates the identical element of Opposer's marks, "TKO," and is used in connection with goods which are similar and substantially related to the products offered by Opposer.

17. The goods offered under Applicant's Mark are likely directed to the same classes of purchases and marketed and sold to the same consumers, through the same channels of trade as Opposer's goods.

18. Applicant's mark TKOR so resembles Opposer's TKO marks as to be likely, when used in connection with Applicant's products, to cause confusion, to cause mistake, or to deceive. Due to the confusingly similar nature of Applicant's mark to be used with similar and related products, i.e., clothing and accessories, consumers will incorrectly believe that Applicant's products emanate from, or are in some way associated, affiliated, sponsored by or authorized by

Opposer, which confusion, mistake or deception will cause irreparable damage and injury to the goodwill and reputation symbolized by Opposer's TKO marks.

19. Opposer is being and will be injured and damaged by the registration of Applicant's Mark because Applicant's Mark incorporates Opposer's TKO® Marks so as to create confusion, mistake and/or deception. Consumers will likely mistakenly believe that Applicant's products are offered by Opposer or sponsored, authorized, endorsed or otherwise affiliated by Opposer and the registration of Applicant's Mark would be inconsistent with Opposer's TKO® Marks.

COUNT II

DILUTION – Sections 2 and 43(c) of the Lanham Act

20. Opposer realleges and incorporates by reference the allegations contained in paragraphs 1 through 10 and 12-15, as if set forth in their entirety herein.

21. Opposer's mark TKO is inherently distinctive as applied to Opposer's products and has been widely used and advertised in the United States; therefore, the Opposer's mark has become well known and famous before Applicant has made any use of its alleged mark.

22. Registration of Applicant's Mark, which is nearly identical or highly similar to Opposer's TKO mark, in connection with Applicant's products will cause the distinctiveness of Opposer's recognized marks set forth herein to be diluted, and would thereby be a source of damage and injury to Opposer. Registration of Applicant's alleged mark will lessen the capacity of Opposer to identify and distinguish its products and will deny Opposer the ability to protect its reputation and goodwill.

23. Likelihood of damage to Opposer's goodwill is increased by the fact that any objection or fault found with Applicant's products offered and sold under Applicant's Mark would reflect upon and seriously injure the Opposer's reputation and this will dilute Opposer's TKO® marks.

WHEREFORE, in accordance with the Trademark Act 15 U.S.C. §1063, Opposer prays that this Opposition will be sustained and that application Serial No. 87925048 will be refused registration.

The required fee of is enclosed herewith in accordance with 37 C.F.R. §2.6(a)(17).

Respectfully submitted,

Date: September 4, 2019

By: /dale paul dimaggio/
Dale Paul DiMaggio
Kristina M. DiMaggio
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Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify this **NOTICE OF OPPOSITION** is being filed electronically this 4th day of September, 2019, with the U.S. Trademark Trial and Appeal Board which constitutes effective service, and one courtesy copy of the foregoing is being emailed to Applicant's counsel of record:

Adriano Pacifici
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By: /dale paul dimaggio/
Dale Paul DiMaggio
Attorney for Opposer



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Word Mark	TKO
Goods and Services	IC 025. US 022 039. G & S: active wear for men and women, namely, [boxer shorts, bicycle shorts,] gym shorts, pants, pullovers, short shirts, sweat pants, sweat shirts, sweat shorts, sweat suits, t-shirts, tank tops, warm-up suits. FIRST USE: 20001100. FIRST USE IN COMMERCE: 20001100
Mark Drawing Code	(1) TYPED DRAWING
Trademark Search Facility Classification Code	LETTER-3-OR-MORE TKO Combination of three or more letters as part of the mark
Serial Number	78195757
Filing Date	December 18, 2002
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	August 12, 2008
Registration Number	3524178
Registration Date	October 28, 2008
Owner	(REGISTRANT) TECHNICAL KNOCKOUT, INC. CORPORATION DELAWARE 4660 Pine Timbers, Suite 198 HOUSTON TEXAS 77041
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Dale Paul DiMaggio
Prior Registrations	2890665
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20190603.

Renewal 1ST RENEWAL 20190603
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TKO

Word Mark	TKO
Goods and Services	IC 018. US 001 002 003 022 041. G & S: luggage used in the field of boxing and martial arts, namely, all-purpose sports bags, backpacks and waistpacks. FIRST USE: 20000100. FIRST USE IN COMMERCE: 20000100 IC 025. US 022 039. G & S: athletic footwear and athletic head wear in the field of boxing and martial arts. FIRST USE: 19940600. FIRST USE IN COMMERCE: 19940600
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	75239641
Filing Date	February 10, 1997
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	December 29, 1998
Registration Number	2383541
Registration Date	September 5, 2000
Owner	(REGISTRANT) TECHNICAL KNOCKOUT, INC. CORPORATION FLORIDA 10018 SPANISH ISLES BLVD. SUITE A-15 BOCA RATON FLORIDA 33498 (LAST LISTED OWNER) TECHNICAL KNOCKOUT, INC. CORPORATION DELAWARE 7354 DENNY ROAD, SUITE 100 HOUSTON TEXAS 77040
Assignment Recorded	ASSIGNMENT RECORDED DALE PAUL DIMAGGIO

**Attorney of
Record**

Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20100917.
Renewal 1ST RENEWAL 20100917
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Indicator** LIVE

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TKO

Word Mark TKO
Goods and Services IC 009. US 021 023 026 036 038. G & S: protective boxing helmets. FIRST USE: 19940115. FIRST USE IN COMMERCE: 19940115

IC 027. US 019 020 037 042 050. G & S: exercise mats; yoga mats. FIRST USE: 19940115. FIRST USE IN COMMERCE: 19940115

IC 028. US 022 023 038 050. G & S: Boxing and martial art equipment, namely, boxing gloves, training gloves, bag gloves, heavy bags, striking and speed bags, free-standing bags, double-ended bags, body shields, weightlifting wrist supports, knee supports, push up bars, pull up bars, handgrips, jump ropes, mouth guards, head gear, cup protectors, focus mitts, hand wraps, boxing bag swivel mechanisms, speed bag platforms, heavy bag swivel mechanisms, speed bag platforms, heavy bag stands, boxing rings, safety ropes and corner pads, shin guards, foot protectors, rib protectors, medicine balls, trainer's tape, hand and forearm pads and reflex punching bags; toy and juvenile boxing and martial art equipment, namely, boxing gloves, training gloves, heavy bags, striking and speed bags, jump ropes, mouth guards, head gear, cup protectors, focus mitts, hand wraps, boxing bag swivel mechanisms, speed bags, speed bag platforms, heavy bag stands, reflex punching bags, hand wraps, shin guards, foot protectors, rib protectors, hand and forearm pads, inflatable punching bags and bag gloves; sporting goods and related merchandise, namely, weight lifting belts, support belts, practice fitness boxing gloves, and martial art hand and foot protectors; and toy and juvenile sporting goods, namely, weight lifting belts, practice fitness boxing gloves, and martial art hand and foot protectors, weight sets, weight plates, dumbbells, weight bars, ankle and wrist weights. FIRST USE: 19940115. FIRST USE IN COMMERCE: 19940115

Mark Drawing Code (1) TYPED DRAWING

Serial Number 76353353

Filing Date December 28, 2001

Current Basis 1A

Original Filing Basis 1A
Published for Opposition December 3, 2002
Registration Number **2690394**
Registration Date February 25, 2003
Owner (REGISTRANT) Technical Knockout, Inc. CORPORATION DELAWARE 4660 Pine Timbers, Suite 198 Houston TEXAS 77041
Attorney of Record Dale Paul DiMaggio
Prior Registrations 2016016;2029087;2364844;2383541;AND OTHERS
Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20130304.
Renewal 1ST RENEWAL 20130304
Live/Dead Indicator LIVE

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TKO

Word Mark	TKO
Goods and Services	IC 021. US 002 013 023 029 030 033 040 050. G & S: Water bottles sold empty; Reusable stainless steel water bottles sold empty; Thermal insulated containers for food or beverages. FIRST USE: 20190201. FIRST USE IN COMMERCE: 20190201
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	87979018
Filing Date	January 31, 2017
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	June 6, 2017
Registration Number	5723808
Registration Date	April 9, 2019
Owner	(REGISTRANT) Technical Knockout, Inc. CORPORATION DELAWARE 4660 Pine Timbers, Suite 198 Houston TEXAS 77041
Attorney of Record	Dale P. DiMaggio
Type of Mark	TRADEMARK

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TKO

Word Mark TKO

Goods and Services

IC 009. US 021 023 026 036 038. G & S: Head phones, in ear head phones, speakers, protective arm sleeves for music players and phones, protective covers for music players, phones and tablets. FIRST USE: 20131000. FIRST USE IN COMMERCE: 20131000

IC 010. US 026 039 044. G & S: Supports for ankles, knees, thighs, back, elbows, wrists and shoulders for medical use. FIRST USE: 20111100. FIRST USE IN COMMERCE: 20111100

IC 028. US 022 023 038 050. G & S: Fitness machines, exercise equipment and accessories, namely, weights, weight plates, dumbbells, bars, kettle bells and storage racks for the foregoing, exercise equipment in the nature of straps affixed to a wall or door for performance of body resistance, resistance cords, resistance ropes, resistance straps, resistance and stretching bands, jump ropes, yoga straps, stretch bands, waist trimmer exercise belts, aerobic fitness steps, balance boards for improving strength, toning, conditioning, balance and proprioception, foam rollers, push up stands, agility ladders and cones; weight lifting equipment and benches, and hyper extension machine and chains; cardio exercise machines, namely, rowing, stationary bikes and cycles, elliptical exercise machines; strength training exercise machines and equipment, namely, chest press, shoulder press, pectoral fly, bicep curl, seated dip, back extension, abdominal benches, dip/chin assist bars, leg extensions, leg press, seated leg curl, hip abductor, tricep press, calf raise, power squat racks, functional body training apparatus, smith machines; exercise apparatus in the nature of a metal bar and chair system for body weight training; exercise equipment, namely, group functional training rigs and cages. FIRST USE: 19960100. FIRST USE IN COMMERCE: 19960100

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 87661095
Filing Date October 26, 2017
Current Basis 1A
Original Filing Basis 1A
Published for Opposition December 11, 2018
Registration Number 5683232
Registration Date February 26, 2019
Owner (REGISTRANT) **Technical Knockout, Inc.** CORPORATION DELAWARE 4660 Pine Timbers Suite 198 Houston TEXAS 77041
Attorney of Record Dale Paul DiMaggio
Prior Registrations 2383541;2690394;2902134;AND OTHERS
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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TKO

Word Mark	TKO
Goods and Services	IC 016. US 002 005 022 023 029 037 038 050. G & S: exercise manuals, printed instructional, educational, and teaching materials concerning health, fitness and exercise, and product manuals materials concerning health, fitness and exercise. FIRST USE: 20000101. FIRST USE IN COMMERCE: 20000101 IC 028. US 022 023 038 050. G & S: toys namely, inflatable punching bags and hand held electronic games. FIRST USE: 20000110. FIRST USE IN COMMERCE: 20000110
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	76976963
Filing Date	September 14, 2000
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	September 10, 2002
Registration Number	2902134
Registration Date	November 9, 2004
Owner	(REGISTRANT) TECHNICAL KNOCKOUT, INC. CORPORATION DELAWARE 7354 Denny Road, Suite 100 Houston TEXAS 77040
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Dale Paul DiMaggio, Esq.

Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20141128.
Renewal 1ST RENEWAL 20141128
Live/Dead Indicator LIVE

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