

ESTTA Tracking number: **ESTTA1201063**

Filing date: **04/05/2022**

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	Western Power Sports, Inc.
Granted to date of previous extension	04/06/2022
Address	601 E. GOWEN ROAD BOISE, ID 83716 UNITED STATES
Attorney information	DARREN J JONES LOWE GRAHAM JONES PLLC 1325 FOURTH AVENUE, SUITE 1130 SEATTLE, WA 98101 UNITED STATES Primary email: Jones@lowegrahamjones.com Secondary email(s): tmdocketing@lowegrahamjones.com, vladimir@lowegrahamjones.com 2062342490
Docket no.	WPS-6-0030

Applicant information

Application no.	90600226	Publication date	12/07/2021
Opposition filing date	04/05/2022	Opposition period ends	04/06/2022
Applicant	Madrid Pro Designs, Inc. 5271 BUSINESS DR. HUNTINGTON BEACH, CA 92649 UNITED STATES		

Goods/services affected by opposition


Class 025. First Use: None First Use In Commerce: None All goods and services in the class are opposed, namely: shoes for skateboarding
Class 028. First Use: 1984 First Use In Commerce: 1984 All goods and services in the class are opposed, namely: skateboard wheels

Grounds for opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Marks cited by opposer as basis for opposition

U.S. registration no.	2896568	Application date	02/04/2002
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Register	Principal		
Registration date	10/26/2004	Foreign priority date	NONE
Word mark	FLY		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 009. First use: First Use: Feb 21, 1998 First Use In Commerce: Feb 21, 1998 Helmets for driving motorcycles and snowmobiles, protective gloves, and protector body armor for use when driving motorcycles, snowmobiles, BMX bicycles, and watercraft; sunglasses and goggles for use in motorcycle, snowmobile, BMX bicycle and watercraft riding</p> <p>Class 012. First use: First Use: Feb 21, 1998 First Use In Commerce: Feb 21, 1998 Motorcycle, snowmobile, bicycle and watercraft parts, namely, metal handle bars, seats, metal gasoline tank caps, wind shields, metal foot pegs, metal kick stands, metal brake and clutch levers, rubber throttle control grips, metal foot rests, luggage carriers; and snowmobile parts, namely metal handle bars, seats, metal gasoline tank caps, wind shields, metal foot pegs, metal kick stands, metal brake and clutch levers, rubber throttle control grips, metal foot rests, bags, and frames</p> <p>Class 025. First use: First Use: Feb 21, 1998 First Use In Commerce: Feb 21, 1998 Apparel for use in motorcycles, snowmobiles, BMX bicycles, and watercraft, namely gloves, wetsuits, boots, jackets, shoes, coveralls, scarves, cycling shoes, socks, cycling tights</p> <p>Class 028. First use: First Use: Feb 21, 1998 First Use In Commerce: Feb 21, 1998 Body padding and shin guards for sports for use in motorcycle, snowmobile, BMX bicycle, and watercraft riding</p>		

U.S. registration no.	2456611	Application date	07/02/1998
Register	Principal		
Registration date	06/05/2001	Foreign priority date	NONE
Word mark	FLY RACING		
Design mark			
Description of mark	NONE		

Goods/services	<p>Class 009. First use: First Use: Feb 21, 1998 First Use In Commerce: Feb 21, 1998 helmets for driving motorcycles and snowmobiles, protective motorcycle gloves</p> <p>Class 012. First use: First Use: Feb 21, 1998 First Use In Commerce: Feb 21, 1998 motorcycle parts, namely, metal handle bars, seats, metal gasoline tank caps, wind shields,metal foot pegs, metal kick stands, metal brake and clutch levers, rubber throttle control grips, metal footrests, luggage carriers; and snowmobile-parts, namely, metal handle bars, seats, metal gasoline tank caps, wind shields, metal foot pegs, metal kick stands,metal brake and clutch levers, rubber throttle control grips, metal foot rest, luggage carriers</p> <p>Class 025. First use: First Use: Feb 21, 1998 First Use In Commerce: Feb 21, 1998 apparel, namely snowmobile gloves</p>
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U.S. application no.	97181658	Application date	12/20/2021
Registration date	NONE	Foreign priority date	NONE
Word mark	FLY		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 018. First use: First Use: Dec 31, 2002 First Use In Commerce: Dec 31, 2002 Backpacks, travel luggage, roller bags,wheelie bags, tool pack, carry-on bags,helmet bags, goggle bags, laundry bags all for sale at powersports retailers' physical and online stores</p> <p>Class 025. First use: First Use: Dec 31, 2002 First Use In Commerce: Dec 31, 2002 Clothing, namely, jackets, hoodies, dress shirts, t-shirts, shorts, hats, beanies, socks, belts, tank tops all for saleat powersports retailers' physical and online stores</p>		

U.S. application no.	97181408	Application date	12/20/2021
Registration date	NONE	Foreign priority date	NONE
Word mark	FLY RACING		

Design mark	FLY RACING
Description of mark	NONE
Goods/services	<p>Class 018. First use: First Use: Dec 31, 2002 First Use In Commerce: Dec 31, 2002 Backpacks, travel luggage, roller bags,wheelie bags, tool pack, carry-on bags,helmet bags, goggle bags, laundry bags</p> <p>Class 025. First use: First Use: Dec 31, 2002 First Use In Commerce: Dec 31, 2002 Clothing, namely, jackets, hoodies, dress shirts, t-shirts, shorts, hats, beanies, socks, belts, tank tops</p>

Attachments	76365561#TMSN.png(bytes) 97181658#TMSN.png(bytes) 97181408#TMSN.png(bytes) WPS-6-0030 OPP NOT.pdf(120094 bytes)
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Signature	/Darren J Jones/
Name	DARREN J JONES
Date	04/05/2022

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

In the Matter of Application Serial No. 90/600,226 FLY
Published on December 7, 2021 in Classes 025 and 028

WESTERN POWER SPORTS, INC.

Opposer,

v.

MADRID PRO DESIGNS, INC.

Applicant.

Opposition No. _____

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Opposer Western Power Sports, Inc. (“Opposer”), by its attorneys Lowe, Graham, Jones, PLLC for its Notice of Opposition against Applicant Madrid Pro Designs, Inc. (“Applicant”), believes that it would be damaged by registration of the above-identified mark and hereby opposes the same under the provisions of 15 U.S.C. § 1052(d) and alleges as follows:

Parties

1. Opposer is an Idaho state corporation with an address at 601 E Gowen Rd, Boise, Idaho 83716.

2. Applicant is a California corporation with an address at 5271 Business Drive, Huntington Beach, California 92649.

3. Opposer believes that it will be damaged by registration of the mark FLY (“Applicant’s Mark”) on the ground that it is likely to cause confusion with Western Power Sports, Inc.’s earlier rights in a similar mark. Therefore, pursuant to Lanham Act §13(a), 15 U.S.C. § 1063(a), Opposer has standing to oppose Applicant’s Application No. 90/600,226 (the “Application”).

WESTERN POWER SPORTS, INC. and Its FLY and FLY RACING Trademark Rights

4. Opposer was incorporated in the United States in 1960 and distributes over 150,000 products that include off-road and street motorcycle, ATV, snowmobile, and watercraft parts and accessories to thousands of dealers nationwide. Petitioner owns the trademarks: FLY with U.S. Reg. No. 2,896,568 which has been in use since at least as early as 1998 for: Body padding and shin guards for sports for use in motorcycle, snowmobile, BMX bicycle, and watercraft riding in Class 009; Motorcycle, snowmobile, bicycle and watercraft parts, namely, metal handle bars, seats, metal gasoline tank caps, wind shields, metal foot pegs, metal kick stands, metal brake and clutch levers, rubber throttle control grips, metal foot rests, luggage carriers; and snowmobile parts, namely metal handle bars, seats, metal gasoline tank caps, wind shields, metal foot pegs, metal kick stands, metal brake and clutch levers, rubber throttle control grips, metal foot rests, bags, and frames in Class 012; Apparel for use in motorcycles, snowmobiles, BMX

bicycles, and watercraft, namely gloves, wetsuits, boots, jackets, shoes, coveralls, scarves, cycling shoes, socks, cycling tights in Class 025; and body padding and shin guards for sports for use in motorcycle, snowmobile, BMX bicycle, and watercraft riding in Class 028; trademark FLY RACING U.S. Reg. No. 2,456,611 which has been in use since at least as early as 1998 for: helmets for driving motorcycles and snowmobiles, protective motorcycle gloves in Class 009; motorcycle parts, namely, metal handle bars, seats, metal gasoline tank caps, wind shields, metal foot pegs, metal kick stands, metal brake and clutch levers, rubber throttle control grips, metal foot rests, luggage carriers; and snowmobile parts, namely, metal handle bars, seats, metal gasoline tank caps, wind shields, metal foot pegs, metal kick stands, metal brake and clutch levers, rubber throttle control grips, metal foot rest, luggage carriers in Class 012 and, apparel, namely snowmobile gloves in Class 025; trademark application for FLY Serial No. 97/181,658 which has been in use since at least as early as 2002 for: backpacks, travel luggage, roller bags, wheelie bags, tool pack, carry-on bags, helmet bags, goggle bags, laundry bags all for sale at powersports retailers' physical and online stores in Class 018 and, clothing, namely, jackets, hoodies, dress shirts, t-shirts, shorts, hats, beanies, socks, belts, tank tops all for sale at powersports retailers' physical and online stores in Class 025; trademark application for FLY RACING Serial No. 97/181,408 which has been in use since at least as early as 2002 for: backpacks, travel luggage, roller bags, wheelie bags, tool pack, carry-on bags, helmet bags, goggle bags, laundry bag in Class 018 and, clothing, namely, jackets, hoodies, dress shirts, t-shirts, shorts, hats, beanies, socks, belts, tank tops in Class 025.

5. Opposer has expended considerable sums in promoting and advertising its goods in interstate commerce and Opposer has created valuable goodwill among the

consuming public under its FLY and FLY RACING trademarks which have become known as identifying the source of Opposer's goods and has become associated in the minds of consumers with Western Power Sports, Inc.

6. Opposer has built and owns substantial goodwill in the marks FLY and FLY RACING for Opposer's goods and the marks are valuable symbols of the Opposer associated with its distribution business.

7. As a result of extensive use, advertising, promotion, and general consumer interest surrounding Opposer's FLY and FLY RACING, the FLY and FLY RACING trademarks are widely recognized and firmly associated with Western Power Sports, Inc.

8. Opposer is the exclusive owner of rights under the common law in the marks FLY and FLY RACING for the goods referenced above.

Applicant and Its Application to Register FLY

9. On March 24, 2021, Applicant filed its intent-to-use based Application for Applicant's Mark for "Shoes for skateboarding" in class 025, and Skateboard wheels in class 028 ("Applicant's Goods").

10. Applicant's Mark was published on December 7, 2021.

11. Applicant's Mark consists of the literal English word "FLY."

Likelihood of Confusion, 15 U.S.C. § 1052(d)

12. Opposer has priority over both the first use and first use in commerce date of Applicant based on its common law rights since at least February, 1998.

13. Applicant's Mark FLY is similar to Opposer's FLY and FLY RACING trademarks.

14. Applicant's goods are commercially definable as exactly or closely related to Opposer's goods.

15. Opposer's trademark is a strong and a well-known trademark, especially to customers.

16. Registration of the mark of application serial number 90/600,226 is barred by the provisions of 15 U.S.C. § 1052(d) because the mark consists of a mark, FLY, which so resembles a mark previously used in the United States by Opposer, and not abandoned, as to be likely, when used in connection with Applicant's goods, to cause confusion, mistake, or deception,

17. Applicant's Mark so closely resembles Opposer's mark that it falsely suggests a connection with Opposer within the meaning of § 2(a) of the Trademark Act, because consumers will mistakenly believe that goods offered under Applicant's mark are associated with or approved by Opposer.

18. Based on the foregoing, Applicant's Mark is not entitled to registration on the Principal Register because Opposer would be damaged by registration of Applicant's Mark.

WHEREFORE, Opposer prays that Application Serial No. 90/600,226 be refused registration, that no registration be issued thereon to Applicant and that this opposition be sustained favor of Opposer. A filing fee for the Notice of Opposition in the amount of \$600.00 per class has been provided to the USPTO per its rules.

Date: April 5, 2022

Respectfully submitted,

By: /Darren J Jones/

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Attorneys for Opposer

CERTIFICATE OF TRANSMITTAL

I hereby certify that on April 5, 2022, this correspondence is being electronically transmitted in PDF format to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA).

/Bridgett Barrett/
Bridgett Barrett