

ESTTA Tracking number: **ESTTA1220306**

Filing date: **07/08/2022**

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                                  | Formula One Licensing BV  |
| Granted to date of previous extension | 07/10/2022  |
| Address                               | BEURSPLEIN 37<br>ROTTERDAM, 3011AA<br>NETHERLANDS   |
| Attorney information                  | LAURA C. MILLER<br>KILPATRICK TOWNSEND & STOCKTON LLP<br>1001 WEST FOURTH STREET<br>WINSTON-SALEM, NC 27101<br>UNITED STATES<br>Primary email: lamiller@kilpatricktownsend.com<br>Secondary email(s): lpearson@kilpatricktownsend.com, ABerman@kilpatricktownsend.com, Agarcia@kilpatricktownsend.com, tmadmin@kilpatricktownsend.com<br>336-607-7300 |
| Docket no.                            |   |

**Applicant information**

|                        |   |                        |            |
|------------------------|---|------------------------|------------|
| Application no.        | 90827394  | Publication date       | 01/11/2022 |
| Opposition filing date | 07/08/2022  | Opposition period ends | 07/10/2022 |
| Applicant              | Fairway Independent Mortgage Corporation<br>4750 S. BILTMORE LANE<br>MADISON, WI 53718<br>UNITED STATES |                        |            |


**Goods/services affected by opposition**

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| <p>Class 009. First Use: Nov 10, 2020 First Use In Commerce: Nov 10, 2020<br/>All goods and services in the class are opposed, namely: Downloadable mobile application software for providing access to an Internet website portal featuring customer service, appointment scheduling services, and mortgage registration, screening, and verification services, all in the field of mortgage lending and mortgage brokerage</p> |
| <p>Class 042. First Use: Nov 10, 2020 First Use In Commerce: Nov 10, 2020<br/>All goods and services in the class are opposed, namely: Providing temporary use of non-downloadable computer software for providing customer service, appointment scheduling services, and mortgage registration, screening, and verification services, all in the field of mortgage lending and mortgage brokerage</p>                           |

## Grounds for opposition


|                                      |                                    |
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| 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

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|-----------------------|---|-----------------------|------------|
| U.S. registration no. | 3014297   | Application date      | 09/10/1997 |
| Register              | Principal   |                       |            |
| Registration date     | 11/15/2005  | Foreign priority date | 05/30/1997 |
| Word mark             | F1 FORMULA 1  |                       |            |
| Design mark           |    |                       |            |
| Description of mark   | NONE  |                       |            |
| Goods/services        | <p>Class 009. First use: First Use: None First Use In Commerce: None<br/>         [ clothing, footwear, headgear, helmets, gloves, seatbelts, goggles, all of a protective nature; luminous and mechanical signs and signposts; antiglare screens; sun glasses and spectacles; cords, frames, lenses and cases for use with spectacles, sunglasses; and optical; apparatus for anti-intrusion and burglar alarms; remote controls for locking and unlocking doors; remote controls for turning television sets, video cassette recorders and stereos on and off; remote controls for controlling speed and directions of miniature vehicles; portable alarms and sirens used for personal security; ] magnetic coded cards; [ batteries; movies, photographic and slide projectors; videocassette recorders; video and photographic cameras; exposed films; flash bulbs; magnets; pedometers; speedometers; odometers; calculators; radios; car radios; stereo receivers, amplifiers and tuners; phonograph record players; digital audio tape players; blank digital audio tapes; television sets; telephones; cellular and radio telephones; telephone answering machines; satellite apparatus; directional or magnetic compasses; compact disc players; digitizers for converting analog signals to digital signals; ] pre-recorded tapes and discs featuring music, auto races, car engine noises and programming related to sports personalities; [films relating to autoracing, automotive products and services, car engine noises and sports personalities; electronic scoreboards and timing display apparatus; ] computer and</p> |                       |            |

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|  | <p>electronic game programs; computer software for use in games in the field of motor sport</p> <p>Class 016. First use: First Use: None First Use In Commerce: None<br/>Stationary; books, magazines, [ catalogs, charts and plants, newspaper, magazines, manuals, ] annuals, [ business paper, albums and computer documentation, ] all relating to autoracing, automotive products and services, car engine noises, and sports personalities [ almanacs; ] printed paper signs; calendars; [ photographs; ] stickers and stickers albums; transfers; bumper stickers; [ trading cards; address books; desktop organizers; writing pads; printing blocks; ] route maps [ ; printing, painting and drawing sets; catalogues relating to autoracing automotive products and services, car engine noises, and sports, personalities; poster; drawing or uncalibrated rulers; pens; plastic bags for packaging; plastic bags for merchandise packaging; wrapping paper; gift wrapping paper; and portraits ]</p> <p>Class 018. First use: First Use: None First Use In Commerce: None<br/>[ Luggage; attache cases; umbrellas; parasols; walking sticks; trunks and traveling bags, namely, duffel bags, carry-on bags, backpacks, and briefcases ]</p> <p>Class 025. First use: First Use: None First Use In Commerce: None<br/>[ Articles of clothing; ] sportswear; leisurewear, namely, shirts, tee-shirts, sweat-shirts, [ sweatpants, ] jackets, [ pants, ] headwear, cap; hats; and footwear [ , pajamas and wristbands ]</p> <p>Class 028. First use: First Use: None First Use In Commerce: None<br/>[ games, toys and playthings, namely, board games, balls for sports and play, dolls, stuffed toys, balloons, building blocks, puzzles, toy cars, model cars; exercise equipment, namely, exercise bicycles, rowing machines, treadmills, step machines and dumbbells; non-electric Christmas tree ornaments and decorations; balloons ]</p> <p>Class 038. First use: First Use: None First Use In Commerce: None<br/>Radio and television broadcasting; satellite and cable broadcasting; radio and television broadcasting via the digital networks including the internet and interactive services relating thereto; telecommunications services; electronic transmission of data, images and sound via computer terminal and networks</p> <p>Class 041. First use: First Use: None First Use In Commerce: None<br/>arranging, organizing and staging of sports events, tournaments and competitions in the field of motor sport; production of sports events, tournaments and competitions for radio, film and television in the field of motor sport; provision of recreation facilities for events, tournaments and competitions in the field of motor sport; providing access to an interactive computer database in the field of motor sport</p> |
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| U.S. registration no. | 3337611    | Application date      | 09/26/2002 |
| Register              | Principal  |                       |            |
| Registration date     | 11/20/2007 | Foreign priority date | NONE       |
| Word mark             | F1         |                       |            |


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|-----------------------|---|-----------------------|------------|
| Design mark           |   |                       |            |
| Description of mark   | NONE  |                       |            |
| Goods/services        | <p>Class 009. First use: First Use: 1996 First Use In Commerce: 1996<br/> [ PRERECORDED VIDEOCASSETTES FEATURING AUTO RACES, RACE CAR ENGINE NOISES AND MOTOR SPORT PERSONALITIES AND INTERVIEWS;COMPUTER GAME SOFTWARE TN THE FIELD OF MOTOR SPORT ]<br/> * (( video recordings featuring auto races, race car engine noisesand motor sport personalities and interviews; )) computer game software in the field of motor sport *</p> <p>Class 016. First use: First Use: Mar 2001 First Use In Commerce: Mar 2001<br/> PRINTED MAGAZINES ABOUT AUTO RACING, AUTOMOTIVE PRODUCTS AND SERVICES, CAR ENGINE NOISES AND MOTOR SPORT PERSONALITIES;PRINTED PROGRAM BOOKS ABOUT MOTOR SPORTS AND PRINTED SOUVENIR PROGRAMS ABOUT MOTOR SPORTS; PRINTED TICKETS AND PRINTED ENTRY PASSES</p> <p>Class 041. First use: First Use: 1986 First Use In Commerce: 1986<br/> [ ARRANGING, ORGANIZING AND STAGING OF SPORTS EVENTS AND CAR RACES ] * arranging, organizing and staging of sports events and car races; (( providing online non-downloadable videos featuring auto races, race car engine noises and motor sport personalities and interviews )) *</p> |                       |            |
| U.S. registration no. | 4124039   | Application date      | 01/27/2011 |
| Register              | Principal   |                       |            |
| Registration date     | 04/10/2012  | Foreign priority date | NONE       |
| Word mark             | F1  |                       |            |


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|-------------|-------------|
| Design mark | <h1>F1</h1> |
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|                     |      |
|---------------------|------|
| Description of mark | NONE |
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| Goods/services | <p>Class 038. First use: First Use: None First Use In Commerce: None</p> <p>Broadcasting and transmission of analogue television, digital television, cable television, satellite television, pay television, interactive television, interactive entertainment and interactive competitions, radio and Internet programmes; broadcasting of entertainment programmes via television[ and radio; broadcasting of music events via television and radio]; broadcasting of programmes provided over the Internet; broadcasting of sports programmes via television[ and radio; ]Internet broadcasting services;[ telecommunications services, namely, wireless telephone services; communications by and/or between computer terminals; communications by cellular telephone; communications by fibre optic networks; communications by telegrams; communications by telephone; communications by facsimile communication;] providing access to a database; [computer aided transmission of messages and images;] streaming of audio, video, audiovisual material on the Internet; transfer of data by telecommunications; [dissemination of television programs relayed by satellite, namely, television broadcasting; electronic mail; communications services for the electronic, digital and analogue display of information, messages, images and data; facsimile transmission; electronic message sending; mobile telephone services; multimedia telecommunications services, namely, local and long distance transmission of voice, data by means of telephone, telegraph, cable and satellite transmission; news agency services for electronic transmission; providing Internet access, namely, providing access to real time data via the Internet; providing access to a multiple user network system which allows for the access to gaming and betting information and services over the Internet;] providing telecommunications connections to a global computer network; provision of access to interactive computer databases in the field of sports;[ provision of broadcasting equipment for outside broadcasts; provision of telecommunications facilities for interactive discussion and conversation; radio broadcasting;] receiving and exchange of information, messages, images, and data via mobile phone networks; [rental of message sending apparatus; satellite communications services. sending of telegrams; ]providing telecommunications connections to the Internet, intranet and extranet; [teleconferencing services; telegraph services; telephone communication services;] transferring and disseminating information and data via computer networks and the Internet; transmission of digital information by means of cable, wire or fibre;[ transmission of information by communications satellite, microwave or electronic, digital or analogue means;] transmission of information by mobile telephones,[ facsimiles and facsimile communication; transmission of telegrams; ]transmission services, namely, transmission of digital files; video text and teletext transmission services;[ voice mail services; wire services, namely, telephony communication services;] transmission of sound and video recordings via the Internet</p> |
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| U.S. registration no. | 5544036 | Application date | 08/01/2017 |
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|---------------------|--|-----------------------|------|
| Register            | Principal  |                       |      |
| Registration date   | 08/21/2018   | Foreign priority date | NONE |
| Word mark           | F1   |                       |      |
| Design mark         |   |                       |      |
| Description of mark | NONE   |                       |      |
| Goods/services      | <p>Class 041. First use: First Use: None First Use In Commerce: None</p> <p>Operating lotteries, namely, prize draws; arranging contests; betting services relating to sports; gaming services, in the nature of casino gaming, relating to sports; providing online video games relating to sports; sports and entertainment hospitality services, namely, arranging, organizing, conducting and hosting parties and social entertainment events in conjunction with sporting events; organizing community sporting and cultural activities; hospitality services for consumers, namely, providing and operating facilities for receptions including the provision of entrance tickets to sports or entertainment events; providing and operating facilities for sports events; organization of sporting and cultural events and activities; organization of sports competitions; organization of events relating to motor sport; providing and operating sports facilities; entertainment services in the form of public viewing of live and delayed broadcast of sports events; rental of video and audio-visual presentations; production, presentation, distribution and/or rental of film recordings and sound and video recordings; production of radio and television programs featuring coverage of sports and sports events; radio and television program and video tape production services; editing services, namely, post-production editing services in the field of music, videos and film; ticket reservation services for motor sports events; issuing of tickets for events, including motor sports events, namely, ticket agency services for sporting events; providing information relating to purchasing tickets for entertainment or sporting events; purchasing services for sports events or entertainment, namely, seat booking services for shows and sporting events; timing of sports events; arranging of beauty contests; arranging and conducting of concerts, conferences and training workshops in the field of auto racing; operating night clubs and amusement parks; organization of exhibitions for cultural or educational purposes; interactive entertainment services, namely, providing temporary use of non-downloadable interactive computer games; betting and gaming services in the nature of casino gaming, on-line on the Internet or on any wireless electronic communication network; providing sports entertainment information on-line from a computer database or via the Internet or via any wireless electronic communication network; electronic games services provided by means of the Internet or on mobile telephones; organization of computer games competitions; publication of books; publication of books and electronic journals on-line; audio and video recording services; production of animated cartoons for the cinema, production of animated cartoons for television; rental of sound and picture recordings for entertainment purposes; distribution of sound and images recordings via the internet; providing information relating to education on-line from a computer database or via the Internet or via any wireless electronic communication network; provision of sports information relating to statistical information; translation services; pho-</p> |                       |      |

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| topography services; provision of recreation facilities |   |                       |            |
| U.S. registration no.                                   | 5859778   | Application date      | 11/17/2017 |
| Register  | Principal   |                       |            |
| Registration date                                       | 09/17/2019  | Foreign priority date | 08/14/2017 |
| Word mark   | F1  |                       |            |
| Design mark   |   |                       |            |
| Description of mark                                     | <p>The mark consists of three black line elements, all angled to the right. One of the two left hand lines is placed above the other and both curve from left to right, being intended to form a highly stylised letter "F". The right hand element is a parallelogram, being intended to form a stylised number "1". The white lines which the black elements create are intended to evoke a race track.</p>   |                       |            |
| Goods/services  | <p>Class 041. First use: First Use: None First Use In Commerce: None</p> <p>Organizing community sporting and cultural events; educational services, namely, conducting classes, seminars and workshops in the field of racing; entertainment services, namely, arranging and conducting of auto races, conducting entertainment exhibitions in the nature of auto races, providing live musical performances, providing non-downloadable playback of audio and video via global communications networks, providing online computer games, entertainment in the nature of light shows, providing an on-going radio and television program in the field of auto racing; providing training in the use of race cars; providing training in the form of courses, seminars, and workshops in the field of auto racing; betting and casino gaming services on-line on the Internet or on any wireless electronic communication network; news reporting services, namely, providing news related to sporting events via radio and television; production of radio and television programs featuring coverage of sports and sports events; timing of sports events; operating night clubs; entertainment services, namely, providing sound and images recordings via the internet; ticket agency services for motor sport events; entertainment services in the nature of production of films and television shows; interactive entertainment, namely, providing temporary use of non-downloadable interactive games; practical training, namely, providing training in the field of auto racing; information about education provided on-line from a computer database or via the Internet or via any wireless electronic communication network; entertainment information in the field of sports, provided on-line from a computer database or via the Internet or via any wireless electronic communication network; rental of sound and picture recordings for entertainment purposes; rental of video and audio-visual equipment; providing of a website featuring online, non-downloadable music; organization of sporting and cultural events and activities; organization of events relating to motor sport; organization of exhibitions for cultural and educational purposes; organization of sports competitions; arranging contests; arranging of beauty contests; organization of computer games competitions; operating lotteries; arranging and conducting of concerts; arranging educational conferences and training workshops in the field of auto racing; operating amusement parks; party planning (entertainment); providing sports facilities; providing recreation facilities; production of animated cartoons for the cinema, production of animated cartoons for television; production of programs for radio, television and videotape; production, presentation, distribution and rental of film recordings and sound and</p> |                       |            |

videorecordings; publication of books; publication of books and electronic journals on-line; reservation of entry tickets to sports or entertainment events; betting services relating to sports; customer reception services including providing access tickets for sports and entertainment events; editing services, namely, post-production editing services in the field of music, videos and film; entertainment services in the form of public viewing of live and delayed broadcast of sports events; entertainment services in connection with sports events, namely, organizing motor sport events; information services concerning sports events; hospitality services, namely, planning, arranging, organizing, conducting, and hosting parties and social entertainment events in conjunction with sporting events; audio and video recording and production services; entertainment services, namely, providing online electronic games by means of the Internet or mobile telephones; ticket reservation services for entertainment, sporting and cultural events; arranging of contests featuring prize draws; provision of entertainment amusement, recreation, and sports facilities; translation services; photography services; provision of sports information relating to statistical information; providing facilities for sports events

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|-----------------------|--|-----------------------|------------|
| U.S. registration no. | 5700542  | Application date      | 11/17/2017 |
| Register              | Principal  |                       |            |
| Registration date     | 03/19/2019   | Foreign priority date | 08/14/2017 |
| Word mark             | F1   |                       |            |
| Design mark           |   |                       |            |
| Description of mark   | <p>The mark consists of three black line elements, all angled to the right. One of the two left hand lines is placed above the other and both curve from left to right, being intended to form a highly stylised letter "F". The right hand element is a parallelogram, being intended to form a stylised number "1". The white lines which the black elements create are intended to evoke a race track.</p>  |                       |            |
| Goods/services        | <p>Class 035. First use: First Use: None First Use In Commerce: None<br/>           Business administration; business management in the field of marketing, business project management, business development; advertising; providing office functions; advertising agencies- publicity agencies; search for financial sponsorship in relation to motor sport events; compilation and recording of data and information on sports performances; dissemination services of advertising matter; compilation of statistics for business or commercial purposes; conducting marketing study services; rental of advertising space; rental of advertising time on communications media; organization of exhibitions for commercial or advertising purposes; presentation of goods on any communication media for retail purposes, namely, sales promotion; benefits programs for clients and sales promotion services, namely, implementing preferential programs for customers in the nature of customer loyalty services and consumer club services, for commercial, promotion and/or advertising purposes; loyalty, incentive and bonus programs for customers at sports venues by means of distributing loyalty and encoded member cards which may hold personal user data; promotion of events, sports, cultural and leisure activities of others; promoting goods and services of others by means of issuing of loyalty reward cards for supporters, containing personal information on the identity of the card holder and enabling control of access to</p> |                       |            |



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|  | <p>sports stadiums; promotion of the goods and services of third parties; promotion of third parties through ads; sales promotion for others, namely, implementing preferential programs for customers; provision of space on websites for advertising of goods and services; providing online business directories in relation to the reservation of temporary lodgings, and the rankings, ratings, reviews, referrals and recommendations in relation to reservation of temporary lodgings; on-line advertising on a computer network; advertising for sports events; television advertising, radio advertising; the bringing together, for the benefit of others, of various goods, except the transportation thereof, in order to give customers the opportunity to view and purchase those goods conveniently in a store or via the Internet or via wireless electronic communication devices; sponsorship search; compilation of advertisements and information for use in a web page or a web page in relation to an electronic network or Internet; compilation of information into computer databases, namely, still or animated images; collection of business directories for publication on the Internet and on a wireless electronic communication network; compilation of information into computer databases; commercial business administration services for processing commercial transactions on the Internet or via wireless electronic communication devices; promotional agency services for sports and public relations; services of an advertising agency on the Internet or via wireless electronic communication devices; electronic commerce services, namely, making product information available via telecommunication networks for advertising and sales purposes; promotion services provided by a commercial company through a customer loyalty card, namely, promoting the goods and services of others by means of the issuance of loyalty reward cards; advertising and promotional services concerning the goods of others, information services concerning advertising and promotion, all the aforesaid services being provided on-line from a computer data bank or via the Internet or via wireless electronic communication devices; marketing services, namely, consumer marketing research; retail store and on-line retail store services featuring aromatic solvents, paraffin, waxes, bitumen, and gasoline; promotional services, namely, advertising agency services for promoting the goods and services of others; systemization of information into computer databases; public opinion polling; auctioneering on the Internet or via wireless electronic communication devices; retailing of goods of all kinds, namely, retail store and on-line retail store services featuring general consumer merchandise; retail store and on-line retail store services featuring interactive educational and entertainment products, interactive compact discs, CD-ROMs, and computer games</p> |
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| Attachments | <p>75355934#TMSN.png( bytes )<br/> 76454798#TMSN.png( bytes )<br/> 85227419#TMSN.png( bytes )<br/> 87551716#TMSN.png( bytes )<br/> 87689792#TMSN.png( bytes )<br/> 87689694#TMSN.png( bytes )<br/> 2022.07.08 Notice of Opposition_90827394_Exh A.pdf(420825 bytes )</p> |
|-------------|--|

|           |                   |
|-----------|-------------------|
| Signature | /Laura C. Miller/ |
| Name      | Laura C. Miller   |
| Date      | 07/08/2022        |

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

In the Matter of Serial No.: 90827394

Mark:



Filing Date: July 14, 2021

Publication Date: January 11, 2022

FORMULA ONE LICENSING BV,

Opposer,

v.

FAIRWAY INDEPENDENT MORTGAGE  
CORPORATION,

Applicant.

Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

Formula One Licensing BV, a company organized and existing under the laws of the Netherlands, located at Beursplein 37, 3011 AA, Rotterdam, The Netherlands (“Opposer”), believes that it will be damaged by registration for the trademark shown below (“Applicant’s Mark”) as identified in Application Serial No. 90827394 (the “Application”):



and hereby opposes registration of the Application.

As grounds for its opposition, Opposer alleges as follows:

1. Opposer, together with its affiliated companies, Formula One World Championship Ltd. and Formula One Management Ltd. (collectively, the “Formula 1 Companies”), own and control all intellectual property rights related to the world-renowned series of automotive races

known as the FIA Formula One World Championship (the “F1 Championship”), including the F1 Marks described more fully below.

2. The Formula 1 Companies have established strong trademark rights in their F1 marks, which include the word marks F1 and design marks incorporating F1, including its F1 and F1 FORMULA 1 logos (collectively, the “F1 Marks”).

3. The F1 Championship is an international motor racing series regulated by the Federation Internationale de L’Automobile (“FIA”). The FIA first held the prestigious F1 Championship in 1950 and it has been held every year since. The F1 Championship represents the pinnacle of automotive racing. Each year, usually from March through December, the F1 Championship tours internationally through motor racing venues around the world, including in Europe, Asia, Australia, South America, and North America, including in the United States.

4. The F1 Championship is one of the three most influential sporting events in the world (the other two being the Olympic Games and FIFA World Cup). For example, the F1 Championship and related F1 programs, which display the F1 Marks, attracted a cumulative audience of over 47 million television viewers in the United States alone in the 2021 season. The Formula 1 Companies’ official website at [www.formula1.com](http://www.formula1.com) and accessed via [www.fl.com](http://www.fl.com), which also display the F1 Marks, has tens of millions of unique users annually.

5. The Formula 1 Companies also use the F1 Marks extensively on their social media accounts, including on their Twitter account (which utilizes the handle “@f1” and has attracted over 8.1 million followers), their Facebook account (which is labeled the “Official F1® Facebook Account” and has attracted over 12.1 million followers), their YouTube page (which has over 7.4 million subscribers and has attracted more than 4.6 billion views), and their Instagram page (which uses the handle “f1” and has attracted 19.8 million followers).

6. The Formula 1 Companies further promote the F1 Marks through their online F1 Store, *f1store.formula1.com*, through which it sells a variety of merchandise and services under and bearing the F1 Marks, including apparel, collectables, and accessories.

7. Since the series began in 1950, there have been dozens of rounds of the F1 Championship in the United States, including venues at Sebring, California; Watkins Glen, New York; Las Vegas, Nevada; Detroit, Michigan; Phoenix, Arizona; Indianapolis, Indiana; Dallas, Texas; Long Beach, California; Riverside, California; Austin, Texas; and as recently as May 2022, Miami, Florida. In addition, F1 races in other international venues receive widespread U.S. media coverage and are typically shown on television throughout the United States.

8. The FIA adopted the marks FORMULA 1 and F1 as early as 1948 to identify the new championship series it was planning to launch, and those marks have been used to identify the F1 Championship racing series and other goods and services continuously since at least as early as 1950. Since 1996, the exclusive rights to commercially exploit the F1 Championship, including the right to use the F1 Marks, have been granted by the FIA to the Formula 1 Companies.

9. Since 1950, the FIA, the Formula 1 Companies, and authorized third parties, have used the F1 Marks as source identifiers designating the F1 Championship and for or in association with a wide range of goods and services related to the F1 Championship.

10. The Formula 1 Companies currently enjoy commercial relationships with various prestigious Partners, Sponsors, and Suppliers. The popularity and marketing appeal of the F1 Championship can be seen by the investment made, in particular by such global brands and related companies, to sponsor the races or otherwise associate themselves with the Formula 1 Companies and the F1 Marks. For example, in February 2022 the Formula 1 Companies named Crypto.com as an Official Title Partner.

11. Motor sports enthusiasts, the press, and the general public typically use the word mark F1 to identify the F1 Championship and the Formula 1 Companies' other branded goods and services. Because the F1 mark has been so widely used for so many years to identify the Formula 1 Companies' goods and services, the F1 word mark serves as a strong and unique identifier of source for the Formula 1 Companies.

12. By virtue of the extensive use of the F1 Marks in the United States, the Formula 1 Companies have established strong trademark rights in the F1 Marks and have, under United States law, the exclusive right to use the F1 Marks in connection not only with motorsports but also with a broad array of other goods and services.

13. In addition to the common law rights the Formula 1 Companies have developed through use, Opposer owns dozens of valid and subsisting registrations for the F1 Marks with the United States Patent and Trademark Office ("USPTO") for a wide variety of goods and services, including but not limited to Reg. Nos. 3014297, 3337611, 4124039, 5544036, 5859778, 5700542 (collectively referred to as the "F1 Registrations"). Current printouts of information from the USPTO's electronic records database regarding the F1 Registrations are attached as **Exhibit A**.

14. The presence of the F1 Marks indicates to consumers that the goods and services bearing or provided under them originate from or are otherwise sponsored, licensed, or authorized by the Formula 1 Companies.

15. On July 14, 2021, well after the Formula 1 Companies began using their F1 Marks and well after the Formula 1 Companies' F1 Marks achieved international renown, Fairway Independent Mortgage Corporation (the "Applicant") filed the Application to register the mark shown above, depicting prominently "F1" for "Downloadable mobile application software for providing access to an Internet website portal featuring customer service, appointment scheduling

services, and mortgage registration, screening, and verification services, all in the field of mortgage lending and mortgage brokerage” in International Class 9 and “Providing temporary use of non-downloadable computer software for providing customer service, appointment scheduling services, and mortgage registration, screening, and verification services, all in the field of mortgage lending and mortgage brokerage” in International Class 42 (collectively, “Applicant’s Goods and Services”).

**FIRST GROUND FOR OPPOSITION**  
**LIKELIHOOD OF CONFUSION**  
**15 U.S.C. § 1052(d)**

16. The Formula 1 Companies incorporates each of the preceding paragraphs as if fully set forth herein.

17. There is no issue as to priority. The Formula 1 Companies and FIA, its predecessor in interest, began using their F1 Marks in commerce for its world renowned motorsports competition and for licensed automotive products well prior to Applicant’s filing date of July 14, 2021 and claimed first use date of November 10, 2020.

18. Applicant’s Mark is identical to Opposer’s F1 word mark in sound and commercial impression, and highly similar to the F1 Marks in appearance.

19. Applicant’s Mark is confusingly similar in sight, sound, meaning and commercial impression to the F1 Marks and to the registered marks shown in Opposer’s F1 Registrations.

20. Applicant’s Mark so resembles Opposer’s previously used F1 Marks as to be likely to cause confusion, mistake, and/or to deceive consumers concerning an affiliation, connection, association or sponsorship with the source of goods and services sold under the F1 Marks, in violation of 15 U.S.C. § 1052(d), with consequent injury to Opposer, the Formula 1 Companies, the public, and the trade.

21. Applicant's Mark so resembles the previously registered marks shown in the F1 Registrations as to be likely to cause confusion, mistake, and/or to deceive consumers concerning an affiliation, connection, association or sponsorship with the source of goods and services sold under the marks shown in the F1 Registrations, in violation of 15 U.S.C. § 1052(d), with consequent injury to Opposer, the Formula 1 Companies, the public, and the trade.

22. Pursuant to Section 13(a) of the Lanham Act, 15 U.S.C. § 1063(a), Opposer believes that it will be damaged by registration of Applicant's Mark in that members of the purchasing public are likely to be confused or mistaken that Applicant's Goods and Services offered under Applicant's Mark originate from the Formula 1 Companies, or from the same source as goods and services offered under the F1 Marks and the marks shown in the F1 Registrations, or that such services of Applicant are sponsored by, endorsed by, or affiliated with the source of goods and services offered under the F1 Marks and the marks shown in the F1 Registrations. Such likelihood of confusion results in damage to the goodwill among purchasers and the trade that the F1 Marks symbolize.

23. If Applicant is granted the registration herein opposed, it would thereby obtain a *prima facie* exclusive right to the use of Applicant's Mark. Such registration would be a source of damage and injury to Opposer.

**SECOND GROUND FOR OPPOSITION**  
**LIKELIHOOD OF DILUTION**  
**15 U.S.C. § 1125(c)**

24. The Formula 1 Companies incorporates each of the preceding paragraphs as if fully set forth herein.

25. The F1 Marks are inherently distinctive in relation to the Formula 1 Companies' goods and services under the marks.

26. The F1 Marks also are widely recognized by the general consuming public of the United States as designating the Formula 1 Companies' as the source of its goods and services under the marks. The F1 Marks therefore are famous and distinctive within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

27. The F1 Marks have been famous within the meaning of Section 43(c) since prior to the filing date of the Application and any first date of *bona fide* use in United States commerce that Applicant may be able to establish.

28. The Formula 1 Companies also has engaged in substantially exclusive use of the F1 Marks.

29. Applicant's Mark is highly similar to the F1 Marks, in that Applicant's Mark is identical in sound to the F1 word marks and is simply another graphical representation of the mark F1.

30. Applicant's use of Applicant's Mark in connection with Applicant's Goods and Services likely would cause consumers to associate Applicant's Mark with the F1 Marks.

31. Applicant's Mark therefore is likely to dilute the distinctiveness of the F1 Marks by eroding consumers' identification of those marks with Opposer and the Formula 1 Companies, and by otherwise lessening the capacity of those marks to identify and distinguish the Opposer's goods and services, in violation of Section 43(c)(1).

32. If Applicant is granted the registration herein opposed, it would thereby obtain a *prima facie* exclusive right to the use of Applicant's Mark. Such registration would be a source of damage and injury to Opposer.

WHEREFORE, Opposer requests that the registrations of Application Serial No. 90827394 be denied pursuant to 15 U.S.C. §§ 1052(d), 1125(c) and 1063(a).



The opposition fee for a notice of opposition in one class for each application is submitted herewith. If for any reason this amount is insufficient, it is requested that Kilpatrick Townsend & Stockton LLP's Deposit Account No. 11-0860 be charged with any deficiency.

Please recognize Lisa Pearson, Laura Miller, and the law firm of Kilpatrick Townsend & Stockton LLP as attorneys for Opposer in connection with this opposition proceeding. Please address all correspondence regarding this proceeding to Laura Miller at Kilpatrick Townsend & Stockton LLP, 1001 West Fourth Street, Winston-Salem, NC 27101.

Date: July 8, 2022

Respectfully submitted,

**KILPATRICK TOWNSEND & STOCKTON LLP**

By: /Laura Miller/

Laura Miller  
1001 West Fourth Street  
Winston-Salem, NC 27101-2400  
Telephone: (336) 607-7300

Lisa Pearson  
1114 Avenue of the Americas, 21<sup>st</sup> Floor  
New York, New York 10036  
Telephone: (212) 775-8700

*Attorneys for Opposer Formula One Licensing BV*

**CERTIFICATE OF TRANSMITTAL**

I hereby certify that a true and correct copy of the foregoing **NOTICE OF OPPOSITION** is being filed electronically with the TTAB via ESTTA on July 8, 2022.

*/Laura Miller/*  
KILPATRICK TOWNSEND & STOCKTON LLP

## **EXHIBIT A**

Generated on: This page was generated by TSDR on 2022-07-08 11:00:14 EDT

Mark: F1 FORMULA 1



US Serial Number: 75355934

Application Filing Date: Sep. 10, 1997

US Registration Number: 3014297

Registration Date: Nov. 15, 2005

Register: Principal

Mark Type: Trademark, 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: Sep. 19, 2015

Publication Date: Aug. 23, 2005

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## Mark Information

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Mark Literal Elements: F1 FORMULA 1

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Color(s) Claimed: Color is not claimed as a feature of the mark.

Design Search Code(s): 26.17.01 - Straight line(s), band(s) or bar(s); Lines, straight; Bars, straight; Bands, straight  
26.17.05 - Lines, horizontal; Horizontal line(s), band(s) or bar(s); Bars, horizontal; Bands, horizontal

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## Related Properties Information

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Claimed Ownership of US Registrations: 2117160, 2133606

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## Foreign Information

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Priority Claimed: Yes

Foreign Application Number: AM2883/971

Foreign Application Filing Date: May 30, 1997

Foreign Registration Number: 0640101

Foreign Registration Date: Aug. 28, 1998

Foreign Application/Registration Country: AUSTRIA

Foreign Expiration Date: Aug. 28, 2008

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## Goods and Services

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**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:** [ clothing, footwear, headgear, helmets, gloves, seatbelts, goggles, all of a protective nature; luminous and mechanical signs and signposts; antiglare screens; sun glasses and spectacles; cords, frames, lenses and cases for use with spectacles, sunglasses; and optical; apparatus for anti-intrusion and burglar alarms; remote controls for locking and unlocking doors; remote controls for turning television sets, video cassette recorders and stereos on and off; remote controls for controlling speed and directions of miniature vehicles; portable alarms and sirens used for personal security; ] magnetic coded cards; [ batteries; movies, photographic and slide projectors; video cassette recorders; video and photographic cameras; exposed films; flash bulbs; magnets; pedometers; speedometers; odometers; calculators; radios; car radios; stereo receivers, amplifiers and tuners; phonograph record players; digital audio tape players; blank digital audio tapes; television sets; telephones; cellular and radio telephones; telephone answering machines; satellite apparatus; directional or magnetic compasses; compact disc players; digitizers for converting analog signals to digital signals; ] pre-recorded tapes and discs featuring music, auto races, car engine noises and programming related to sports personalities; [ films relating to autoracing, automotive products and services, car engine noises and sports personalities; electronic scoreboards and timing display apparatus; ] computer and electronic game programs; computer software for use in games in the field of motor sport

**International Class(es):** 009 - Primary Class

**U.S Class(es):** 021, 023, 026, 036, 038

**Class Status:** ACTIVE

**Basis:** 44(e)

**For:** Stationary; books, magazines, [ catalogs, charts and plants, newspaper, magazines, manuals, ] annuals, [ business paper, albums and computer documentation, ] all relating to autoracing, automotive products and services, car engine noises, and sports personalities [ almanacs; ] printed paper signs; calendars; [ photographs; ] stickers and stickers albums; transfers; bumper stickers; [ trading cards; address books; desktop organizers; writing pads; printing blocks; ] route maps [ ; printing, painting and drawing sets; catalogues relating to autoracing automotive products and services, car engine noises, and sports, personalities; poster; drawing or uncalibrated rulers; pens; plastic bags for packaging; plastic bags for merchandise packaging; wrapping paper; gift wrapping paper; and portraits ]

**International Class(es):** 016 - Primary Class

**U.S Class(es):** 002, 005, 022, 023, 029, 037, 038, 050

**Class Status:** ACTIVE

**Basis:** 44(e)

**For:** [ Luggage; attache cases; umbrellas; parasols; walking sticks; trunks and travelling bags, namely, duffel bags, carry-on bags, backpacks, and briefcases ]

**International Class(es):** 018 - Primary Class

**U.S Class(es):** 001, 002, 003, 022, 041

**Class Status:** SECTION 8 - CANCELLED

**Basis:** 44(e)

**For:** [ Articles of clothing; ] sportswear; leisurewear, namely, shirts, tee-shirts, sweatshirts, [ sweatpants, ] jackets, [ pants, ] headwear, cap; hats; and footwear [ , pajamas and wristbands ]

**International Class(es):** 025 - Primary Class

**U.S Class(es):** 022, 039

**Class Status:** ACTIVE

**Basis:** 44(e)

**For:** [ games, toys and playthings, namely, board games, balls for sports and play, dolls, stuffed toys, balloons, building blocks, puzzles, toy cars, model cars; exercise equipment, namely, exercise bicycles, rowing machines, treadmills, step machines and dumbbells; non-electric Christmas tree ornaments and decorations; balloons ]

**International Class(es):** 028 - Primary Class

**U.S Class(es):** 022, 023, 038, 050

**Class Status:** SECTION 8 - CANCELLED

**Basis:** 44(e)

**For:** Radio and television broadcasting; satellite and cable broadcasting; radio and television broadcasting via the digital networks including the internet and interactive services relating thereto; telecommunications services; electronic transmission of data, images and sound via computer terminal and networks

**International Class(es):** 038 - Primary Class

**U.S Class(es):** 100, 101, 104

**Class Status:** ACTIVE

**Basis:** 44(e)

**For:** arranging, organizing and staging of sports events, tournaments and competitions in the field of motor sport; production of sports events, tournaments and competitions for radio, film and television in the field of motor sport; provision of recreation facilities for events, tournaments and competitions in the field of motor sport; providing access to an interactive computer database in the field of motor sport

**International Class(es):** 041 - Primary Class

**U.S Class(es):** 100, 101, 107

Class Status: ACTIVE

Basis: 44(e)

## Basis Information (Case Level)

|                 |     |                     |     |
|-----------------|-----|---------------------|-----|
| Filed Use:      | No  | Currently Use:      | No  |
| Filed ITU:      | Yes | Currently ITU:      | No  |
| Filed 44D:      | No  | Currently 44E:      | Yes |
| Filed 44E:      | No  | Currently 66A:      | No  |
| Filed 66A:      | No  | Currently No Basis: | No  |
| Filed No Basis: | No  |                     |     |

## Current Owner(s) Information

Owner Name: FORMULA ONE LICENSING B.V.  
Owner Address: Beursplein 37  
Rotterdam 3011AA NETHERLANDS  
Legal Entity Type: CORPORATION  
State or Country Where Organized: NETHERLANDS

## Attorney/Correspondence Information

### Attorney of Record

Attorney Name: Jill K. Tomlinson  
Attorney Primary Email Address: [NYTrademarks@kilpatricktownsend.com](mailto:NYTrademarks@kilpatricktownsend.com)  
Attorney Email Authorized: Yes

### Correspondent

Correspondent Name/Address: Jill K. Tomlinson  
Kilpatrick Townsend & Stockton LLP  
1114 Avenue of the Americas  
New York, NEW YORK UNITED STATES 10036  
Phone: 212-775-8700  
Fax: 212-775-8800  
Correspondent e-mail: [NYTrademarks@kilpatricktownsend.com](mailto:NYTrademarks@kilpatricktownsend.com)  
Correspondent e-mail Authorized: Yes

### Domestic Representative

Domestic Representative Name: Jill K. Tomlinson  
Phone: 212-775-8700  
Fax: 212-775-8800  
Domestic Representative e-mail: [NYTrademarks@kilpatricktownsend.com](mailto:NYTrademarks@kilpatricktownsend.com)  
Domestic Representative e-mail Authorized: Yes

## Prosecution History

| Date          | Description  | Proceeding Number |
|---------------|--|-------------------|
| Nov. 15, 2017 | NOTICE OF SUIT                                       |                   |
| Jan. 05, 2016 | ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED            |                   |
| Jan. 05, 2016 | TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED |                   |
| Sep. 18, 2015 | TEAS CHANGE OF CORRESPONDENCE RECEIVED               |                   |
| Sep. 19, 2015 | NOTICE OF ACCEPTANCE OF SEC. 8 - E-MAILED            |                   |
| Sep. 19, 2015 | REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)      | 64591             |
| Sep. 19, 2015 | REGISTERED - SEC. 9 GRANTED/CHECK RECORD FOR SEC. 8  | 64591             |
| Sep. 19, 2015 | REGISTERED - PARTIAL SEC. 8 (10-YR) ACCEPTED         | 64591             |
| Sep. 18, 2015 | TEAS SECTION 8 & 9 RECEIVED                          |                   |
| Oct. 17, 2014 | NOTICE OF SUIT                                       |                   |
| Dec. 06, 2011 | NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED       |                   |

|               |  |       |
|---------------|--|-------|
| Dec. 06, 2011 | REGISTERED - PARTIAL SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK. | 64591 |
| Oct. 26, 2011 | REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED                 | 64591 |
| Dec. 05, 2011 | CASE ASSIGNED TO POST REGISTRATION PARALEGAL               | 64591 |
| Oct. 26, 2011 | TEAS SECTION 8 & 15 RECEIVED                               |       |
| Aug. 24, 2011 | AMENDMENT UNDER SECTION 7 A- PROCESSED                     | 76293 |
| Aug. 20, 2011 | CASE ASSIGNED TO POST REGISTRATION PARALEGAL               | 76293 |
| Aug. 18, 2011 | TEAS SECTION 7 REQUEST RECEIVED                            |       |
| Aug. 16, 2011 | APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED  | 88888 |
| Aug. 16, 2011 | TEAS CHANGE OF OWNER ADDRESS RECEIVED                      |       |
| Mar. 02, 2006 | TEAS CHANGE OF CORRESPONDENCE RECEIVED                     |       |
| Nov. 15, 2005 | REGISTERED-PRINCIPAL REGISTER                              |       |
| Aug. 23, 2005 | PUBLISHED FOR OPPOSITION                                   |       |
| Aug. 03, 2005 | NOTICE OF PUBLICATION                                      |       |
| Feb. 01, 2005 | TEAS CHANGE OF OWNER ADDRESS RECEIVED                      |       |
| Feb. 01, 2005 | TEAS CHANGE OF OWNER ADDRESS RECEIVED                      |       |
| Sep. 21, 2004 | ASSIGNED TO LIE  | 66230 |
| Sep. 02, 2004 | LAW OFFICE PUBLICATION REVIEW COMPLETED                    | 66230 |
| Sep. 02, 2004 | Sec. 1(B) CLAIM DELETED                                    | 66230 |
| Aug. 31, 2004 | ASSIGNED TO LIE  | 66230 |
| Aug. 27, 2004 | APPROVED FOR PUB - PRINCIPAL REGISTER                      |       |
| Feb. 04, 2004 | CORRESPONDENCE RECEIVED IN LAW OFFICE                      |       |
| Feb. 24, 2004 | CASE FILE IN TICRS   |       |
| Feb. 04, 2004 | TEAS RESPONSE TO OFFICE ACTION RECEIVED                    |       |
| Sep. 18, 2003 | TEAS CHANGE OF CORRESPONDENCE RECEIVED                     |       |
| Sep. 18, 2003 | TEAS CHANGE OF CORRESPONDENCE RECEIVED                     |       |
| Jun. 09, 2003 | PAPER RECEIVED   |       |
| Jan. 07, 2003 | CORRESPONDENCE RECEIVED IN LAW OFFICE                      |       |
| Jan. 07, 2003 | PAPER RECEIVED   |       |
| Aug. 22, 2002 | LETTER OF SUSPENSION MAILED                                |       |
| Jul. 26, 2002 | TEAS CHANGE OF CORRESPONDENCE RECEIVED                     |       |
| Jul. 05, 2002 | CORRESPONDENCE RECEIVED IN LAW OFFICE                      |       |
| Jul. 05, 2002 | PAPER RECEIVED   |       |
| May 19, 2000  | UNRESPONSIVE/DUPLICATE PAPER RECEIVED                      |       |
| Nov. 03, 1999 | LETTER OF SUSPENSION MAILED                                |       |
| Aug. 02, 1999 | CORRESPONDENCE RECEIVED IN LAW OFFICE                      |       |
| Jul. 02, 1999 | LETTER OF SUSPENSION MAILED                                |       |
| May 21, 1999  | CORRESPONDENCE RECEIVED IN LAW OFFICE                      |       |
| Mar. 02, 1999 | LETTER OF SUSPENSION MAILED                                |       |
| Dec. 22, 1998 | CORRESPONDENCE RECEIVED IN LAW OFFICE                      |       |
| Jun. 23, 1998 | NON-FINAL ACTION MAILED                                    |       |
| May 07, 1998  | ASSIGNED TO EXAMINER                                       | 62126 |
| Apr. 24, 1998 | ASSIGNED TO EXAMINER                                       | 72519 |
| Nov. 17, 1997 | CORRESPONDENCE RECEIVED IN LAW OFFICE                      |       |

## TM Staff and Location Information

**TM Staff Information - None**

**File Location**

**Current Location:** TMEG LAW OFFICE 108

**Date in Location:** Sep. 19, 2015

## Assignment Abstract Of Title Information

### Summary

**Total Assignments:** 2

**Registrant:** FORMULA ONE LICENSING B.V.

Conveyance: CHANGE OF NAME

Reel/Frame: [1923/0461](#)

Pages: 17

Date Recorded: Jul. 02, 1999

Supporting Documents: [assignment-tm-1923-0461.pdf](#)

**Assignor**

Name: [GISS LICENSING B.V.](#)

Execution Date: May 11, 1999

Legal Entity Type: PRIVATE LIMITED COMPANY UNDER DUTCH LAW

State or Country Where Organized: No Place Where Organized Found

**Assignee**

Name: [FORMULA ONE LICENSING B.V.](#)

State or Country Where Organized: No Place Where Organized Found

Legal Entity Type: PRIVATE LIMITED COMPANY UNDER DUTCH LAW

Address: KONINGIN EMMAPLEIN 13  
3016 AB ROTTERDAM, NETHERLANDS

**Correspondent**

Correspondent Name: LIMBACH & LIMBACH L.L.P.

Correspondent Address: VERONICA COLBY DEVITT  
2001 FERRY BUILDING  
SAN FRANCISCO, CALIFORNIA 94111

Domestic Representative - Not Found

**Assignment 2 of 2**

Conveyance: CHANGE OF ADDRESS

Reel/Frame: [3020/0688](#)

Pages: 10

Date Recorded: Feb. 02, 2005

Supporting Documents: [assignment-tm-3020-0688.pdf](#)

**Assignor**

Name: [FORMULA ONE LICENSING BV](#)

Execution Date: Jul. 01, 2004

Legal Entity Type: CORPORATION

State or Country Where Organized: NETHERLANDS

**Assignee**

Name: [FORMULA ONE LICENSING BV](#)

State or Country Where Organized: NETHERLANDS

Legal Entity Type: CORPORATION

Address: ROKIN 55  
1012 KK  
AMSTERDAM, NETHERLANDS

**Correspondent**

Correspondent Name: PAUL W. KRUSE

Correspondent Address: 315 DEADERICK STREET  
SUITE 2700  
NASHVILLE, TN 37238-3001

Domestic Representative - Not Found



Generated on: This page was generated by TSDR on 2022-07-08 11:00:58 EDT

Mark: F1

# F1

US Serial Number: 76454798

Application Filing Date: Sep. 26, 2002

US Registration Number: 3337611

Registration Date: Nov. 20, 2007

Register: Principal

Mark Type: Trademark, 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: Jun. 12, 2018

Publication Date: Sep. 04, 2007

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## Mark Information

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Mark Literal Elements: F1

Standard Character Claim: No

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

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## Goods and Services

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**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:** [ PRERECORDED VIDEOCASSETTES FEATURING AUTO RACES, RACE CAR ENGINE NOISES AND MOTOR SPORT PERSONALITIES AND INTERVIEWS; COMPUTER GAME SOFTWARE TN THE FIELD OF MOTOR SPORT ] \* (( video recordings featuring auto races, race car engine noises and motor sport personalities and interviews; )) computer game software in the field of motor sport \*

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 1(a)

First Use: 1996

Use in Commerce: 1996

**For:** PRINTED MAGAZINES ABOUT AUTO RACING, AUTOMOTIVE PRODUCTS AND SERVICES, CAR ENGINE NOISES AND MOTOR SPORT PERSONALITIES; PRINTED PROGRAM BOOKS ABOUT MOTOR SPORTS AND PRINTED SOUVENIR PROGRAMS ABOUT MOTOR SPORTS; PRINTED TICKETS AND PRINTED ENTRY PASSES

International Class(es): 016 - Primary Class

U.S Class(es): 002, 005, 022, 023, 029, 037, 038, 050

Class Status: ACTIVE

Basis: 1(a)

First Use: Mar. 2001

Use in Commerce: Mar. 2001

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**For:** [ ARRANGING, ORGANIZING AND STAGING OF SPORTS EVENTS AND CAR RACES ] \* arranging, organizing and staging of sports events and car races; (( providing online non-downloadable videos featuring auto races, race car engine noises and motor sport personalities and interviews )) \*

**International Class(es):** 041 - Primary Class

**U.S Class(es):** 100, 101, 107

**Class Status:** ACTIVE

**Basis:** 1(a)

**First Use:** 1986

**Use in Commerce:** 1986

## 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:** Formula One Licensing B.V.

**Owner Address:** BEURSPLEIN 37  
ROTTERDAM NETHERLANDS 3011AA

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** NETHERLANDS

## Attorney/Correspondence Information

### Attorney of Record

**Attorney Name:** Jill K. Tomlinson

**Attorney Primary Email Address:** [NYTrademarks@kilpatricktownsend.com](mailto:NYTrademarks@kilpatricktownsend.com)

**Attorney Email Authorized:** Yes

### Correspondent

**Correspondent Name/Address:** Jill K. Tomlinson  
Kilpatrick Townsend & Stockton LLP  
1114 Avenue of the Americas  
New York, NEW YORK UNITED STATES 10036

**Phone:** 212-775-8700

**Fax:** 212-775-8800

**Correspondent e-mail:** [NYTrademarks@kilpatricktownsend.com](mailto:NYTrademarks@kilpatricktownsend.com)

**Correspondent e-mail Authorized:** Yes

### Domestic Representative

**Domestic Representative Name:** Jill K. Tomlinson

**Phone:** 212-775-8700

**Fax:** 212-775-8800

**Domestic Representative e-mail:** [NYTrademarks@kilpatricktownsend.com](mailto:NYTrademarks@kilpatricktownsend.com)

**Domestic Representative e-mail Authorized:** Yes

## Prosecution History

| Date          | Description   | Proceeding Number |
|---------------|---|-------------------|
| Jun. 12, 2018 | NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED       |                   |
| Jun. 12, 2018 | REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)     | 67657             |
| Jun. 12, 2018 | REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED | 67657             |
| Jun. 12, 2018 | AMENDMENT UNDER SECTION 7 Â- PROCESSED              | 67657             |
| Jun. 12, 2018 | CASE ASSIGNED TO POST REGISTRATION PARALEGAL        | 67657             |
| Jun. 04, 2018 | PETITION TO DIRECTOR - GRANTED                      | 78196             |

|               |   |       |
|---------------|---|-------|
| Apr. 17, 2018 | PETITION PENDING - AMENDMENT COMMENT PERIOD               | 78196 |
| Apr. 11, 2018 | TEAS RESPONSE TO PETITION TO DIRECTOR INQUIRY             |       |
| Apr. 04, 2018 | PETITION INQUIRY LETTER ISSUED                            |       |
| Apr. 03, 2018 | ASSIGNED TO PETITION STAFF                                | 78196 |
| Nov. 20, 2017 | PETITION TO DIRECTOR RECEIVED                             | 80807 |
| Jan. 17, 2018 | CASE ASSIGNED TO POST REGISTRATION PARALEGAL              | 73376 |
| Jan. 08, 2018 | CASE ASSIGNED TO POST REGISTRATION PARALEGAL              | 75461 |
| Dec. 16, 2017 | CASE ASSIGNED TO POST REGISTRATION PARALEGAL              | 30004 |
| Nov. 20, 2017 | TEAS SECTION 8 & 9 RECEIVED                               |       |
| Nov. 20, 2017 | TEAS SECTION 7 REQUEST RECEIVED                           |       |
| Nov. 15, 2017 | NOTICE OF SUIT  |       |
| Nov. 20, 2016 | COURTESY REMINDER - SEC. 8 (10-YR)/SEC. 9 E-MAILED        |       |
| Jan. 05, 2016 | ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED                 |       |
| Jan. 05, 2016 | TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED      |       |
| Oct. 17, 2014 | NOTICE OF SUIT  |       |
| Jun. 15, 2013 | NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - MAILED              |       |
| Jun. 15, 2013 | REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.        | 70131 |
| Jun. 14, 2013 | CASE ASSIGNED TO POST REGISTRATION PARALEGAL              | 70131 |
| May 30, 2013  | TEAS SECTION 8 & 15 RECEIVED                              |       |
| Dec. 16, 2011 | AMENDMENT UNDER SECTION 7 A- PROCESSED                    | 74886 |
| Dec. 16, 2011 | SEC 7 REQUEST FILED                                       | 74886 |
| Oct. 07, 2011 | TEAS RESPONSE TO OFFICE ACTION-POST REG RECEIVED          |       |
| Sep. 09, 2011 | POST REGISTRATION ACTION MAILED - SEC. 7                  | 74886 |
| Aug. 22, 2011 | CASE ASSIGNED TO POST REGISTRATION PARALEGAL              | 74886 |
| Aug. 18, 2011 | TEAS SECTION 7 REQUEST RECEIVED                           |       |
| Aug. 16, 2011 | APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED | 88888 |
| Aug. 16, 2011 | TEAS CHANGE OF OWNER ADDRESS RECEIVED                     |       |
| Nov. 20, 2007 | REGISTERED-PRINCIPAL REGISTER                             |       |
| Sep. 04, 2007 | PUBLISHED FOR OPPOSITION                                  |       |
| Aug. 15, 2007 | NOTICE OF PUBLICATION                                     |       |
| Jul. 31, 2007 | LAW OFFICE PUBLICATION REVIEW COMPLETED                   | 78288 |
| Jul. 31, 2007 | APPROVED FOR PUB - PRINCIPAL REGISTER                     |       |
| Jul. 18, 2007 | TEAS/EMAIL CORRESPONDENCE ENTERED                         | 78288 |
| Jul. 18, 2007 | CORRESPONDENCE RECEIVED IN LAW OFFICE                     | 78288 |
| Jul. 10, 2007 | ASSIGNED TO LIE   | 78288 |
| Jul. 03, 2007 | TEAS RESPONSE TO OFFICE ACTION RECEIVED                   |       |
| Feb. 20, 2007 | REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED    | 78413 |
| Feb. 20, 2007 | ASSIGNED TO LIE   | 78413 |
| Aug. 08, 2006 | REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED    | 76537 |
| Mar. 02, 2006 | TEAS CHANGE OF CORRESPONDENCE RECEIVED                    |       |
| Feb. 16, 2005 | ASSIGNED TO EXAMINER                                      | 76638 |
| Feb. 15, 2006 | ASSIGNED TO EXAMINER                                      | 62520 |
| Feb. 06, 2006 | REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED    | 76537 |
| Jul. 14, 2005 | REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED    | 74193 |
| Feb. 01, 2005 | TEAS CHANGE OF OWNER ADDRESS RECEIVED                     |       |
| Dec. 01, 2004 | REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED    | 74193 |
| Oct. 23, 2003 | LETTER OF SUSPENSION E-MAILED                             |       |
| Sep. 10, 2003 | CORRESPONDENCE RECEIVED IN LAW OFFICE                     |       |
| Oct. 11, 2003 | CASE FILE IN TICRS  |       |
| Sep. 10, 2003 | PAPER RECEIVED  |       |
| Sep. 18, 2003 | TEAS CHANGE OF CORRESPONDENCE RECEIVED                    |       |
| Mar. 11, 2003 | NON-FINAL ACTION MAILED                                   |       |
| Feb. 19, 2003 | ASSIGNED TO EXAMINER                                      | 76638 |

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## TM Staff and Location Information

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**TM Staff Information - None****File Location**

Current Location: GENERIC WEB UPDATE

Date in Location: Jun. 12, 2018

**Assignment Abstract Of Title Information****Summary**

Total Assignments: 1

Registrant: Formula One Licensing B.V.

**Assignment 1 of 1**

Conveyance: CHANGE OF ADDRESS

Reel/Frame: [3020/0688](#)

Pages: 10

Date Recorded: Feb. 02, 2005

Supporting [assignment-tm-3020-0688.pdf](#)

Documents:

**Assignor**Name: [FORMULA ONE LICENSING BV](#)

Execution Date: Jul. 01, 2004

Legal Entity Type: CORPORATION

State or Country: NETHERLANDS  
Where Organized:**Assignee**Name: [FORMULA ONE LICENSING BV](#)

Legal Entity Type: CORPORATION

State or Country: NETHERLANDS  
Where Organized:Address: ROKIN 55  
1012 KK  
AMSTERDAM, NETHERLANDS**Correspondent**

Correspondent Name: PAUL W. KRUSE

Correspondent Address: 315 DEADERICK STREET  
SUITE 2700  
NASHVILLE, TN 37238-3001**Domestic Representative - Not Found****Proceedings****Summary**

Number of Proceedings: 10

**Type of Proceeding: Opposition**Proceeding Number: [91270672](#)

Filing Date: Jul 23, 2021

Status: Suspended

Status Date: Dec 02, 2021

Interlocutory Attorney: MARY CATHERINE FAINT

**Defendant**

Name: F1 Solutions, Inc.

Correspondent Address: JEREMY A SMITH  
LANIER FORD SHAVER & PAYNE, PC  
2101 WEST CLINTON AVENUE, SUITE 102  
HUNTSVILLE AL UNITED STATES , 35805Correspondent e-mail: [jas@lanierford.com](mailto:jas@lanierford.com) , [ipdocket@lanierford.com](mailto:ipdocket@lanierford.com)**Associated marks**

| Mark         | Application Status | Serial Number            | Registration Number |
|--------------|--------------------|--------------------------|---------------------|
| F1 SOLUTIONS | Opposition Pending | <a href="#">88851353</a> |                     |
| F1 SOLUTIONS | Opposition Pending | <a href="#">88851352</a> |                     |

**Plaintiff(s)**

**Name:** Formula One Licensing BV

**Correspondent** LAURA MILLER

**Address:** KILPATRICK TOWNSEND & STOCKTON LLP  
1001 WEST FOURTH STREET  
WINSTON-SALEM NC UNITED STATES , 27101-2400

**Correspondent e-mail:** [lamiller@kilpatricktownsend.com](mailto:lamiller@kilpatricktownsend.com) , [lamiller@kilpatricktownsend.com](mailto:lamiller@kilpatricktownsend.com) , [lpearson@kilpatricktownsend.com](mailto:lpearson@kilpatricktownsend.com) , [ABerman@kilpatricktownsend.com](mailto:ABerman@kilpatricktownsend.com) , [d.com](mailto:d.com) , [Agarcia@kilpatricktownsend.com](mailto:Agarcia@kilpatricktownsend.com) , [tadmin@kilpatricktownsend.com](mailto:tadmin@kilpatricktownsend.com)

**Associated marks**

| Mark         | Application Status                           | Serial Number            | Registration Number     |
|--------------|--|--------------------------|-------------------------|
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">75446228</a> | <a href="#">2714785</a> |
| F1           | Registered                                   | <a href="#">87551641</a> | <a href="#">5479340</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">75355934</a> | <a href="#">3014297</a> |
| F1           | Registered                                   | <a href="#">87551696</a> | <a href="#">5467481</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550990</a> | <a href="#">3031049</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227390</a> | <a href="#">4124036</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227438</a> | <a href="#">4137640</a> |
| F1           | Registered                                   | <a href="#">87551621</a> | <a href="#">5442618</a> |
| F1 FORMULA 1 | Registered                                   | <a href="#">87551836</a> | <a href="#">5473736</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550983</a> | <a href="#">3043305</a> |
| F1           | CANCELLED - SECTION 71                       | <a href="#">79030989</a> | <a href="#">3294323</a> |
| F1           | Registered                                   | <a href="#">87551672</a> | <a href="#">5457508</a> |
| F1           | Registered                                   | <a href="#">87551699</a> | <a href="#">5473727</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227391</a> | <a href="#">4124037</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227426</a> | <a href="#">4124041</a> |
| F1 FORMULA 1 | Cancelled - Section 8                        | <a href="#">85228535</a> | <a href="#">4244239</a> |
| F1           | Cancelled - Section 8                        | <a href="#">85227387</a> | <a href="#">4296976</a> |
| F1 FORMULA 1 | Registered                                   | <a href="#">87551831</a> | <a href="#">5457512</a> |
| F1           | Registered                                   | <a href="#">87551676</a> | <a href="#">5473725</a> |
| F1           | Registered                                   | <a href="#">87551689</a> | <a href="#">5473726</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550987</a> | <a href="#">2951002</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550982</a> | <a href="#">2975282</a> |
| F1           | REGISTERED AND RENEWED                       | <a href="#">76454798</a> | <a href="#">3337611</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227380</a> | <a href="#">4124034</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227395</a> | <a href="#">4124038</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227421</a> | <a href="#">4124040</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227404</a> | <a href="#">4130536</a> |
| F1 FORMULA 1 | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85228550</a> | <a href="#">4133997</a> |
| F1           | Cancelled - Section 8                        | <a href="#">85227369</a> | <a href="#">4228567</a> |
| F1 FORMULA 1 | CANCELLED - SECTION 71                       | <a href="#">79151513</a> | <a href="#">4714486</a> |
| F1           | Registered                                   | <a href="#">87551654</a> | <a href="#">5457506</a> |
| F1           | Registered                                   | <a href="#">87551681</a> | <a href="#">5467480</a> |
| F1 FORMULA 1 | Registered                                   | <a href="#">87551842</a> | <a href="#">5473737</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">75502698</a> | <a href="#">2633750</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550986</a> | <a href="#">2951001</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227412</a> | <a href="#">4127681</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227400</a> | <a href="#">4181715</a> |
| F1           | Cancelled - Section 8                        | <a href="#">85227418</a> | <a href="#">4220183</a> |
| F1           | Registered                                   | <a href="#">87551660</a> | <a href="#">5457507</a> |
| F1           | Registered                                   | <a href="#">87551710</a> | <a href="#">5473728</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550988</a> | <a href="#">2951003</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550985</a> | <a href="#">2975283</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227419</a> | <a href="#">4124039</a> |

|              |  |                          |                         |
|--------------|--|--------------------------|-------------------------|
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227433</a> | <a href="#">4212315</a> |
| F1 FORMULA 1 | Cancelled - Section 8                        | <a href="#">85228607</a> | <a href="#">4216261</a> |
| F1 FORMULA 1 | Cancelled - Section 8                        | <a href="#">85228592</a> | <a href="#">4223998</a> |
| F1 FORMULA 1 | Registered                                   | <a href="#">87551847</a> | <a href="#">5467484</a> |
| F1           | Registered                                   | <a href="#">87551752</a> | <a href="#">5473729</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550989</a> | <a href="#">2964603</a> |

#### Prosecution History

| Entry Number | History Text                                     | Date         | Due Date     |
|--------------|--|--------------|--------------|
| 17           | SUSPENDED  | Jun 15, 2022 |              |
| 16           | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Jun 15, 2022 |              |
| 15           | SUSPENDED  | May 31, 2022 |              |
| 14           | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | May 31, 2022 |              |
| 13           | P CHANGE OF CORRESP ADDRESS                      | May 31, 2022 |              |
| 12           | SUSPENDED  | Apr 29, 2022 |              |
| 11           | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Apr 29, 2022 |              |
| 10           | SUSPENDED  | Mar 01, 2022 |              |
| 9            | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Mar 01, 2022 |              |
| 8            | SUSPENDED  | Dec 02, 2021 |              |
| 7            | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Dec 02, 2021 |              |
| 6            | ANSWER   | Oct 04, 2021 |              |
| 5            | EXTENSION OF TIME GRANTED                        | Aug 26, 2021 |              |
| 4            | D MOT FOR EXT W/ CONSENT                         | Aug 26, 2021 |              |
| 3            | INSTITUTED                                       | Jul 26, 2021 |              |
| 2            | NOTICE AND TRIAL DATES SENT; ANSWER DUE:         | Jul 26, 2021 | Sep 04, 2021 |
| 1            | FILED AND FEE                                    | Jul 23, 2021 |              |

#### Type of Proceeding: Opposition

**Proceeding Number:** [91268965](#)

**Filing Date:** Apr 26, 2021

**Status:** Terminated

**Status Date:** Oct 28, 2021

**Interlocutory Attorney:** LAWRENCE (LARRY) T STANLEY

#### Defendant

**Name:** F1 Infrastructure Solutions

**Correspondent Address:** BRYAN J. SCHOMER  
DICKINSON WRIGHT PLLC  
2600 W. BIG BEAVER RD., STE. 300  
TROY MI UNITED STATES , 48084

**Correspondent e-mail:** [dwtrademarks@dickinsonwright.com](mailto:dwtrademarks@dickinsonwright.com) , [bschomer@dickinsonwright.com](mailto:bschomer@dickinsonwright.com) , [krusso@dickinsonwright.com](mailto:krusso@dickinsonwright.com) , [malcantara@dickinsonwright.com](mailto:malcantara@dickinsonwright.com)

#### Associated marks

| Mark                        | Application Status        | Serial Number            | Registration Number |
|-----------------------------|---------------------------|--------------------------|---------------------|
| F1 INFRASTRUCTURE SOLUTIONS | First Extension - Granted | <a href="#">88793935</a> |                     |

#### Plaintiff(s)

**Name:** Formula One Licensing BV

**Correspondent Address:** JENNIFER FAIRBAIRN DEAL  
KILPATRICK TOWNSEND & STOCKTON LLP  
1100 PEACHTREE STREET NE  
ATLANTA GA UNITED STATES , 30309

**Correspondent e-mail:** [jdeal@kilpatricktownsend.com](mailto:jdeal@kilpatricktownsend.com) , [lpearson@kilpatricktownsend.com](mailto:lpearson@kilpatricktownsend.com) , [ABerman@kilpatricktownsend.com](mailto:ABerman@kilpatricktownsend.com) , [Agarcia@kilpatricktownsend.com](mailto:Agarcia@kilpatricktownsend.com) , [tadmin@kilpatricktownsend.com](mailto:tadmin@kilpatricktownsend.com)

#### Associated marks

| Mark         | Application Status | Serial Number            | Registration Number     |
|--------------|--------------------|--------------------------|-------------------------|
| F1           | Registered         | <a href="#">87551716</a> | <a href="#">5544036</a> |
| F1 FORMULA 1 | Registered         | <a href="#">87689229</a> | <a href="#">5865142</a> |

|              |  |                          |                         |
|--------------|--|--------------------------|-------------------------|
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550988</a> | <a href="#">2951003</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">75355934</a> | <a href="#">3014297</a> |
| F1           | Registered                                   | <a href="#">87689792</a> | <a href="#">5859778</a> |
| F1           | REGISTERED AND RENEWED                       | <a href="#">76454798</a> | <a href="#">3337611</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227426</a> | <a href="#">4124041</a> |

#### Prosecution History

| Entry Number | History Text                                     | Date         | Due Date     |
|--------------|--|--------------|--------------|
| 18           | TERMINATED                                       | Oct 28, 2021 |              |
| 17           | BD DECISION: OPP DISMISSED W/O PREJ              | Oct 28, 2021 |              |
| 16           | W/DRAW OF OPPOSITION                             | Oct 27, 2021 |              |
| 15           | AMDT APPROVED; RESP DUE                          | Oct 18, 2021 |              |
| 14           | MOT TO AMEND APPLICATION                         | Oct 13, 2021 |              |
| 13           | SUSPENDED  | Oct 06, 2021 |              |
| 12           | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Oct 06, 2021 |              |
| 11           | SUSPENDED  | Aug 31, 2021 |              |
| 10           | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Aug 31, 2021 |              |
| 9            | SUSPENDED  | Aug 03, 2021 |              |
| 8            | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Aug 03, 2021 |              |
| 7            | SUSPENDED  | Jun 29, 2021 |              |
| 6            | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Jun 29, 2021 |              |
| 5            | SUSPENDED  | Jun 03, 2021 |              |
| 4            | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Jun 03, 2021 |              |
| 3            | INSTITUTED                                       | Apr 26, 2021 |              |
| 2            | NOTICE AND TRIAL DATES SENT; ANSWER DUE:         | Apr 26, 2021 | Jun 05, 2021 |
| 1            | FILED AND FEE                                    | Apr 26, 2021 |              |

#### Type of Proceeding: Opposition

**Proceeding Number:** [91255481](#)

**Filing Date:** Apr 17, 2020

**Status:** Terminated

**Status Date:** Jul 27, 2020

**Interlocutory Attorney:** SHANNA K SANDERS

#### Defendant

**Name:** Xiaomi Inc.

**Correspondent Address:** BEN NATTER  
HAUG PARTNERS LLP  
745 FIFTH AVE, 10TH FLOOR  
NEW YORK NY UNITED STATES , 10151

**Correspondent e-mail:** [bnatter@haugpartners.com](mailto:bnatter@haugpartners.com) , [doCKET@haugpartners.com](mailto:doCKET@haugpartners.com) , [kkoemm@haugpartners.com](mailto:kkoemm@haugpartners.com)

#### Associated marks

| Mark         | Application Status                     | Serial Number            | Registration Number |
|--------------|--|--------------------------|---------------------|
| POCOPHONE F1 | IR CANCELLED; US APPLICATION ABANDONED | <a href="#">79250185</a> |                     |

#### Plaintiff(s)

**Name:** Formula One Licensing BV

**Correspondent Address:** JENNIFER FAIRBAIRN DEAL  
KILPATRICK TOWNSEND & STOCKTON LLP  
1100 PEACHTREE STREET NE  
ATLANTA GA UNITED STATES , 30309

**Correspondent e-mail:** [ideal@kilpatricktownsend.com](mailto:ideal@kilpatricktownsend.com) , [lpearson@kilpatricktownsend.com](mailto:lpearson@kilpatricktownsend.com) , [Agarcia@kilpatricktownsend.com](mailto:Agarcia@kilpatricktownsend.com) , [tmadmin@kilpatricktownsend.com](mailto:tmadmin@kilpatricktownsend.com)

#### Associated marks

| Mark | Application Status     | Serial Number            | Registration Number     |
|------|------------------------|--------------------------|-------------------------|
| F1   | REGISTERED AND RENEWED | <a href="#">76454798</a> | <a href="#">3337611</a> |
| F1   | Registered             | <a href="#">87689799</a> | <a href="#">5712118</a> |

|              |  |                          |                         |
|--------------|--|--------------------------|-------------------------|
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227433</a> | <a href="#">4212315</a> |
| F1 FORMULA 1 | Registered                                   | <a href="#">87551824</a> | <a href="#">5479344</a> |
| F1           | Registered                                   | <a href="#">87551641</a> | <a href="#">5479340</a> |
| F1 FORMULA 1 | Registered                                   | <a href="#">87689139</a> | <a href="#">5760380</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227380</a> | <a href="#">4124034</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">75355934</a> | <a href="#">3014297</a> |
| F1           | Registered                                   | <a href="#">87689564</a> | <a href="#">5694535</a> |

#### Prosecution History

| Entry Number | History Text                             | Date         | Due Date     |
|--------------|--|--------------|--------------|
| 6            | TERMINATED                               | Jul 27, 2020 |              |
| 5            | BD DECISION: OPP SUSTAINED               | Jul 27, 2020 |              |
| 4            | NOTICE OF DEFAULT                        | Jun 16, 2020 |              |
| 3            | INSTITUTED                               | Apr 27, 2020 |              |
| 2            | NOTICE AND TRIAL DATES SENT; ANSWER DUE: | Apr 27, 2020 | Jun 06, 2020 |
| 1            | FILED AND FEE                            | Apr 17, 2020 |              |

#### Type of Proceeding: Opposition

**Proceeding Number:** [91242921](#)

**Filing Date:** Aug 08, 2018

**Status:** Terminated

**Status Date:** Nov 21, 2018

**Interlocutory Attorney:** MIKE WEBSTER

#### Defendant

**Name:** A-ONE CO., LTD

**Correspondent Address:** XIAOYAN YANG  
333W GARVEY AVE STE 396  
MONTEREY PARK CA UNITED STATES , 91754

**Correspondent e-mail:** [memorytechcenter@hotmail.com](mailto:memorytechcenter@hotmail.com)

#### Associated marks

| Mark | Application Status                      | Serial Number            | Registration Number |
|------|---|--------------------------|---------------------|
| A1   | Abandoned - After Inter-Partes Decision | <a href="#">87690147</a> |                     |

#### Plaintiff(s)

**Name:** Formula One Licensing BV

**Correspondent Address:** JENNIFER FAIRBAIRN DEAL  
KILPATRICK TOWNSEND & STOCKTON LLP  
1100 PEACHTREE STREET NE, STE 2800  
ATLANTA GA UNITED STATES , 30309

**Correspondent e-mail:** [ideal@kilpatricktownsend.com](mailto:ideal@kilpatricktownsend.com) , [lpearson@kilpatricktownsend.com](mailto:lpearson@kilpatricktownsend.com) , [Agarcia@ktslaw.com](mailto:Agarcia@ktslaw.com) , [tmadmin@ktslaw.com](mailto:tmadmin@ktslaw.com)

#### Associated marks

| Mark         | Application Status     | Serial Number            | Registration Number     |
|--------------|------------------------|--------------------------|-------------------------|
| F1 FORMULA 1 | REGISTERED AND RENEWED | <a href="#">76550985</a> | <a href="#">2975283</a> |
| F1 FORMULA 1 | Registered             | <a href="#">87551831</a> | <a href="#">5457512</a> |
| F1 FORMULA 1 | Cancelled - Section 8  | <a href="#">85228589</a> | <a href="#">4111027</a> |
| F1 FORMULA 1 | Cancelled - Section 8  | <a href="#">85228597</a> | <a href="#">4133998</a> |
| F1 FORMULA 1 | CANCELLED - SECTION 71 | <a href="#">79151513</a> | <a href="#">4714486</a> |
| F1 FORMULA 1 | Registered             | <a href="#">87551847</a> | <a href="#">5467484</a> |
| F 1          | CANCELLED - SECTION 71 | <a href="#">79009600</a> | <a href="#">3587198</a> |
| F1 FORMULA 1 | Registered             | <a href="#">87551824</a> | <a href="#">5479344</a> |
| F1 FORMULA 1 | Registered             | <a href="#">87551827</a> | <a href="#">5479345</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED | <a href="#">76550986</a> | <a href="#">2951001</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED | <a href="#">76550987</a> | <a href="#">2951002</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED | <a href="#">76550988</a> | <a href="#">2951003</a> |



|               |  |                          |                         |
|---------------|--|--------------------------|-------------------------|
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228603</a> | <a href="#">4130540</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228538</a> | <a href="#">4133996</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228592</a> | <a href="#">4223998</a> |
| F1 FORMULA 1  | Registered                                   | <a href="#">87551836</a> | <a href="#">5473736</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227391</a> | <a href="#">4124037</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227395</a> | <a href="#">4124038</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">75502698</a> | <a href="#">2633750</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550990</a> | <a href="#">3031049</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550983</a> | <a href="#">3043305</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">77170204</a> | <a href="#">3429737</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228578</a> | <a href="#">4111026</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228559</a> | <a href="#">4120482</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228599</a> | <a href="#">4130539</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228535</a> | <a href="#">4244239</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">75446228</a> | <a href="#">2714785</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228571</a> | <a href="#">4111024</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228556</a> | <a href="#">4120481</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228584</a> | <a href="#">4152625</a> |
| F1 FORMULA 1  | Registered                                   | <a href="#">87551842</a> | <a href="#">5473737</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227419</a> | <a href="#">4124039</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227426</a> | <a href="#">4124041</a> |
| F 1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">75446140</a> | <a href="#">2893656</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228575</a> | <a href="#">4111025</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228612</a> | <a href="#">4111028</a> |
| F1 FORMULA 1  | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85228550</a> | <a href="#">4133997</a> |
| F1            | REGISTERED AND RENEWED                       | <a href="#">76454798</a> | <a href="#">3337611</a> |
| F1            | Cancelled - Section 8                        | <a href="#">85227385</a> | <a href="#">4124035</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227390</a> | <a href="#">4124036</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227421</a> | <a href="#">4124040</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550982</a> | <a href="#">2975282</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227380</a> | <a href="#">4124034</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550989</a> | <a href="#">2964603</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228564</a> | <a href="#">4111023</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228567</a> | <a href="#">4152624</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228607</a> | <a href="#">4216261</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">75355934</a> | <a href="#">3014297</a> |

**Prosecution History**

| Entry Number | History Text                             | Date         | Due Date     |
|--------------|--|--------------|--------------|
| 6            | TERMINATED                               | Nov 21, 2018 |              |
| 5            | BD DECISION: OPP SUSTAINED               | Nov 21, 2018 |              |
| 4            | NOTICE OF DEFAULT                        | Sep 27, 2018 |              |
| 3            | PENDING, INSTITUTED                      | Aug 08, 2018 |              |
| 2            | NOTICE AND TRIAL DATES SENT; ANSWER DUE: | Aug 08, 2018 | Sep 17, 2018 |
| 1            | FILED AND FEE                            | Aug 08, 2018 |              |

**Type of Proceeding: Opposition**

**Proceeding Number:** [91238047](#)

**Filing Date:** Nov 28, 2017

**Status:** Terminated

**Status Date:** Mar 08, 2018

**Interlocutory Attorney:** MARY CATHERINE FAINT

**Defendant**

**Name:** F11T Performance Training, Venisha J. Lee and Sloane S. Lennon

**Correspondent:** F11T PERFORMANCE TRAINING LLC

**Address:** 4241 SW 24TH ST  
WEST PARK FL UNITED STATES , 33023

**Correspondent e-mail:** [F11tperformancetraining@gmail.com](mailto:F11tperformancetraining@gmail.com) , [KuntreeF11t@gmail.com](mailto:KuntreeF11t@gmail.com)

| Mark | Application Status                      | Serial Number            | Registration Number |
|------|---|--------------------------|---------------------|
| F11T | Abandoned - After Inter-Partes Decision | <a href="#">87334601</a> |                     |

**Plaintiff(s)**

**Name:** Formula One Licensing BV

**Correspondent Address:** JENNIFER FAIRBAIRN DEAL  
KILPATRICK TOWNSEND & STOCKTON LLP  
1100 PEACHTREE STREET NE, SUITE 2800  
ATLANTA GA UNITED STATES , 30309

**Correspondent e-mail:** [ideal@kilpatricktownsend.com](mailto:ideal@kilpatricktownsend.com) , [lpearson@kilpatricktownsend.com](mailto:lpearson@kilpatricktownsend.com) , [Agarcia@ktslaw.com](mailto:Agarcia@ktslaw.com) , [tmadmin@ktslaw.com](mailto:tmadmin@ktslaw.com)

| Mark | Application Status                           | Serial Number            | Registration Number     |
|------|--|--------------------------|-------------------------|
| F1   | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227426</a> | <a href="#">4124041</a> |
| F1   | REGISTERED AND RENEWED                       | <a href="#">76454798</a> | <a href="#">3337611</a> |

**Prosecution History**

| Entry Number | History Text                             | Date         | Due Date     |
|--------------|--|--------------|--------------|
| 6            | TERMINATED                               | Mar 08, 2018 |              |
| 5            | BD DECISION: SUSTAINED                   | Mar 08, 2018 |              |
| 4            | NOTICE OF DEFAULT                        | Jan 17, 2018 |              |
| 3            | PENDING, INSTITUTED                      | Nov 28, 2017 |              |
| 2            | NOTICE AND TRIAL DATES SENT; ANSWER DUE: | Nov 28, 2017 | Jan 07, 2018 |
| 1            | FILED AND FEE                            | Nov 28, 2017 |              |

**Type of Proceeding: Opposition**

**Proceeding Number:** [91234905](#)

**Filing Date:** Jun 05, 2017

**Status:** Terminated

**Status Date:** Mar 06, 2018

**Interlocutory Attorney:** MARY B MYLES

**Defendant**

**Name:** Ghassan Abboud

**Correspondent Address:** SAMUEL OSBORNE  
ATOM LAW GROUP LLC  
770 N LASALLE ST SUITE 700  
CHICAGO IL UNITED STATES , 60654

**Correspondent e-mail:** [sahn@atom.law](mailto:sahn@atom.law) , [sosborne@atom.law](mailto:sosborne@atom.law) , [tatac@atom.law](mailto:tatac@atom.law)

| Mark    | Application Status | Serial Number            | Registration Number     |
|---------|--------------------|--------------------------|-------------------------|
| 1ST F D | Registered         | <a href="#">87013393</a> | <a href="#">5440929</a> |

**Plaintiff(s)**

**Name:** Formula One Licensing BV

**Correspondent Address:** JENNIFER FAIRBAIRN DEAL  
KILPATRICK TOWNSEND & STOCKTON LLP  
1100 PEACHTREE STREET NE STE 2800  
ATLANTA GA UNITED STATES , 30309

**Correspondent e-mail:** [lpearson@kilpatricktownsend.com](mailto:lpearson@kilpatricktownsend.com) , [ideal@kilpatricktownsend.com](mailto:ideal@kilpatricktownsend.com) , [Agarcia@ktslaw.com](mailto:Agarcia@ktslaw.com) , [tmadmin@ktslaw.com](mailto:tmadmin@ktslaw.com)

| Mark | Application Status | Serial Number | Registration Number |
|------|--------------------|---------------|---------------------|
|------|--------------------|---------------|---------------------|

|               |  |                          |                         |
|---------------|--|--------------------------|-------------------------|
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550988</a> | <a href="#">2951003</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227391</a> | <a href="#">4124037</a> |
| F 1           | CANCELLED - SECTION 71                       | <a href="#">79009600</a> | <a href="#">3587198</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227380</a> | <a href="#">4124034</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227395</a> | <a href="#">4124038</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550985</a> | <a href="#">2975283</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228607</a> | <a href="#">4216261</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228592</a> | <a href="#">4223998</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227419</a> | <a href="#">4124039</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550989</a> | <a href="#">2964603</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228571</a> | <a href="#">4111024</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228578</a> | <a href="#">4111026</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228567</a> | <a href="#">4152624</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227390</a> | <a href="#">4124036</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550990</a> | <a href="#">3031049</a> |
| F1 FORMULA 1  | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85228550</a> | <a href="#">4133997</a> |
| F1 FORMULA 1  | CANCELLED - SECTION 71                       | <a href="#">79151513</a> | <a href="#">4714486</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227421</a> | <a href="#">4124040</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227426</a> | <a href="#">4124041</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228575</a> | <a href="#">4111025</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228559</a> | <a href="#">4120482</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228599</a> | <a href="#">4130539</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228597</a> | <a href="#">4133998</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228535</a> | <a href="#">4244239</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550987</a> | <a href="#">2951002</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">75355934</a> | <a href="#">3014297</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228589</a> | <a href="#">4111027</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228584</a> | <a href="#">4152625</a> |
| F1            | Cancelled - Section 8                        | <a href="#">85227385</a> | <a href="#">4124035</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227412</a> | <a href="#">4127681</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">75446228</a> | <a href="#">2714785</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550983</a> | <a href="#">3043305</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">77170204</a> | <a href="#">3429737</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228612</a> | <a href="#">4111028</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228603</a> | <a href="#">4130540</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228538</a> | <a href="#">4133996</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">75502698</a> | <a href="#">2633750</a> |
| F 1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">75446140</a> | <a href="#">2893656</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550986</a> | <a href="#">2951001</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228564</a> | <a href="#">4111023</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228556</a> | <a href="#">4120481</a> |
| F1            | REGISTERED AND RENEWED                       | <a href="#">76454798</a> | <a href="#">3337611</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550982</a> | <a href="#">2975282</a> |

#### Prosecution History

| Entry Number | History Text                     | Date         | Due Date |
|--------------|----------------------------------|--------------|----------|
| 13           | TERMINATED                       | Mar 06, 2018 |          |
| 12           | BD DECISION: DISMISSED W/O PREJ  | Mar 06, 2018 |          |
| 11           | W/DRAW OF OPPOSITION             | Feb 28, 2018 |          |
| 10           | D APPEARANCE / POWER OF ATTORNEY | Jan 09, 2018 |          |
| 9            | TRIAL DATES REMAIN AS SET        | Oct 18, 2017 |          |
| 8            | D MOT FOR EXT W/ CONSENT         | Oct 13, 2017 |          |
| 7            | D CHANGE OF CORRESP ADDRESS      | Sep 13, 2017 |          |
| 6            | ANSWER                           | Sep 13, 2017 |          |

|   |  |              |              |
|---|--|--------------|--------------|
| 5 | EXTENSION OF TIME GRANTED                | Jul 17, 2017 |              |
| 4 | D MOT FOR EXT W/ CONSENT                 | Jul 14, 2017 |              |
| 3 | PENDING, INSTITUTED                      | Jun 05, 2017 |              |
| 2 | NOTICE AND TRIAL DATES SENT; ANSWER DUE: | Jun 05, 2017 | Jul 15, 2017 |
| 1 | FILED AND FEE                            | Jun 05, 2017 |              |

**Type of Proceeding: Opposition**

**Proceeding Number:** [91228802](#)

**Filing Date:** Jul 05, 2016

**Status:** Terminated

**Status Date:** Jan 08, 2018

**Interlocutory Attorney:** JENNIFER KRISP

**Defendant**

**Name:** Stryker Corporation

**Correspondent Address:** EUGENE J RATH III  
FLYNN THIEL BOUTELL & TANIS PC  
2026 RAMBLING RD  
KALAMAZOO MI UNITED STATES , 49008

**Correspondent e-mail:** [docket@flynnthiel.com](mailto:docket@flynnthiel.com)

**Associated marks**

| Mark       | Application Status | Serial Number            | Registration Number     |
|------------|--------------------|--------------------------|-------------------------|
| STRYKER F1 | Registered         | <a href="#">86583206</a> | <a href="#">5475849</a> |

**Plaintiff(s)**

**Name:** Formula One Licensing BV

**Correspondent Address:** JENNIFER FAIRBAIRN DEAL  
KILPATRICK TOWNSEND & STOCKTON LLP  
1100 PEACHTREE STREET NE STE 2800  
ATLANTA GA UNITED STATES , 30309

**Correspondent e-mail:** [ideal@kilpatricktownsend.com](mailto:ideal@kilpatricktownsend.com) , [lpearson@kilpatricktownsend.com](mailto:lpearson@kilpatricktownsend.com) , [Agarcia@ktslaw.com](mailto:Agarcia@ktslaw.com) , [tmadmin@ktslaw.com](mailto:tmadmin@ktslaw.com)

**Associated marks**

| Mark         | Application Status                           | Serial Number            | Registration Number     |
|--------------|--|--------------------------|-------------------------|
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227426</a> | <a href="#">4124041</a> |
| F1           | Cancelled - Section 8                        | <a href="#">85227387</a> | <a href="#">4296976</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550988</a> | <a href="#">2951003</a> |
| F1 FORMULA 1 | Cancelled - Section 8                        | <a href="#">85228538</a> | <a href="#">4133996</a> |
| FORMULA 1    | REGISTERED AND RENEWED                       | <a href="#">76454795</a> | <a href="#">2831397</a> |
| F 1          | CANCELLED - SECTION 71                       | <a href="#">79009600</a> | <a href="#">3587198</a> |
| F1           | Cancelled - Section 8                        | <a href="#">85227385</a> | <a href="#">4124035</a> |
| F1           | Cancelled - Section 8                        | <a href="#">85227378</a> | <a href="#">4130535</a> |
| F1 FORMULA 1 | Cancelled - Section 8                        | <a href="#">85228603</a> | <a href="#">4130540</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227400</a> | <a href="#">4181715</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227380</a> | <a href="#">4124034</a> |
| FORMULA 1    | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227586</a> | <a href="#">4124042</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">75355934</a> | <a href="#">3014297</a> |
| FORMULA 1    | REGISTERED AND RENEWED                       | <a href="#">75983207</a> | <a href="#">3016540</a> |
| F1           | REGISTERED AND RENEWED                       | <a href="#">76454798</a> | <a href="#">3337611</a> |
| F1 FORMULA 1 | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85228550</a> | <a href="#">4133997</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227433</a> | <a href="#">4212315</a> |

**Prosecution History**

| Entry Number | History Text             | Date         | Due Date |
|--------------|--------------------------|--------------|----------|
| 19           | TERMINATED               | Jan 08, 2018 |          |
| 18           | BD DECISION: DISMISSED   | Jan 08, 2018 |          |
| 17           | MOT TO AMEND APPLICATION | Dec 27, 2017 |          |

|    |  |              |              |
|----|--|--------------|--------------|
| 16 | D APPEARANCE / POWER OF ATTORNEY         | Dec 22, 2017 |              |
| 15 | EXTENSION OF TIME GRANTED                | Nov 03, 2017 |              |
| 14 | D MOT FOR EXT W/ CONSENT                 | Nov 02, 2017 |              |
| 13 | EXTENSION OF TIME GRANTED                | Aug 08, 2017 |              |
| 12 | D MOT FOR EXT W/ CONSENT                 | Aug 03, 2017 |              |
| 11 | EXTENSION OF TIME GRANTED                | May 04, 2017 |              |
| 10 | D MOT FOR EXT W/ CONSENT                 | May 04, 2017 |              |
| 9  | EXTENSION OF TIME GRANTED                | Feb 07, 2017 |              |
| 8  | D MOT FOR EXT W/ CONSENT                 | Feb 07, 2017 |              |
| 7  | EXTENSION OF TIME GRANTED                | Nov 09, 2016 |              |
| 6  | D MOT FOR EXT W/ CONSENT                 | Nov 04, 2016 |              |
| 5  | EXTENSION OF TIME GRANTED                | Aug 10, 2016 |              |
| 4  | D MOT FOR EXT W/ CONSENT                 | Aug 05, 2016 |              |
| 3  | PENDING, INSTITUTED                      | Jul 05, 2016 |              |
| 2  | NOTICE AND TRIAL DATES SENT; ANSWER DUE: | Jul 05, 2016 | Aug 14, 2016 |
| 1  | FILED AND FEE                            | Jul 05, 2016 |              |

**Type of Proceeding: Opposition**

**Proceeding Number:** [91226532](#) **Filing Date:** Feb 24, 2016  
**Status:** Terminated **Status Date:** Mar 28, 2016  
**Interlocutory Attorney:** JENNIFER KRISP

**Defendant**

**Name:** F1FPV  
**Correspondent Address:** F1FPV  
6401 MILL CV  
RALEIGH NC UNITED STATES , 27617-7622  
**Correspondent e-mail:** [markvollrath@yahoo.com](mailto:markvollrath@yahoo.com)

**Associated marks**

| Mark  | Application Status                      | Serial Number            | Registration Number |
|-------|---|--------------------------|---------------------|
| F1FPV | Abandoned - After Inter-Partes Decision | <a href="#">86656440</a> |                     |

**Plaintiff(s)**

**Name:** Formula One Licensing BV  
**Correspondent Address:** JENNIFER FAIRBAIRN DEAL  
KILPATRICK TOWNSEND & STOCKTON LLP  
1100 PEACHTREE STREET NE, SUITE 2800  
ATLANTA GA UNITED STATES , 30309  
**Correspondent e-mail:** [lpearson@kilpatricktownsend.com](mailto:lpearson@kilpatricktownsend.com) , [jdeal@kilpatricktownsend.com](mailto:jdeal@kilpatricktownsend.com) , [Agarcia@ktslaw.com](mailto:Agarcia@ktslaw.com) , [tmadmin@ktslaw.com](mailto:tmadmin@ktslaw.com)

**Associated marks**

| Mark         | Application Status                           | Serial Number            | Registration Number     |
|--------------|--|--------------------------|-------------------------|
| F1           | REGISTERED AND RENEWED                       | <a href="#">76454798</a> | <a href="#">3337611</a> |
| FORMULA 1    | REGISTERED AND RENEWED                       | <a href="#">76454795</a> | <a href="#">2831397</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227426</a> | <a href="#">4124041</a> |
| F1 FORMULA 1 | Cancelled - Section 8                        | <a href="#">85228603</a> | <a href="#">4130540</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550988</a> | <a href="#">2951003</a> |
| F1 FORMULA 1 | Cancelled - Section 8                        | <a href="#">85228575</a> | <a href="#">4111025</a> |
| FORMULA 1    | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227586</a> | <a href="#">4124042</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">75355934</a> | <a href="#">3014297</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227400</a> | <a href="#">4181715</a> |
| F 1          | CANCELLED - SECTION 71                       | <a href="#">79009600</a> | <a href="#">3587198</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227395</a> | <a href="#">4124038</a> |

FORMULA 1 REGISTERED AND RENEWED [75983207](#) [3016540](#)  
 F FORMULA 1 REGISTERED AND RENEWED [74527520](#) [2133606](#)

| Prosecution History |  |              |              |
|---------------------|--|--------------|--------------|
| Entry Number        | History Text                             | Date         | Due Date     |
| 6                   | TERMINATED                               | Mar 28, 2016 |              |
| 5                   | BD DECISION: SUSTAINED                   | Mar 28, 2016 |              |
| 4                   | W/DRAW OF APPLICATION                    | Mar 22, 2016 |              |
| 3                   | PENDING, INSTITUTED                      | Feb 24, 2016 |              |
| 2                   | NOTICE AND TRIAL DATES SENT; ANSWER DUE: | Feb 24, 2016 | Apr 04, 2016 |
| 1                   | FILED AND FEE                            | Feb 24, 2016 |              |

**Type of Proceeding: Opposition**

|  |                                  |
|--|----------------------------------|
| <b>Proceeding Number:</b> <a href="#">91223082</a> | <b>Filing Date:</b> Aug 03, 2015 |
| <b>Status:</b> Terminated                          | <b>Status Date:</b> Oct 22, 2015 |
| <b>Interlocutory Attorney:</b> GEORGE POLOGEORGIS  |                                  |

| Defendant                     |  |
|-------------------------------|--|
| <b>Name:</b>                  | Lightforce U.S.A., Inc. dba Nightforce Optics, Inc.  |
| <b>Correspondent Address:</b> | GLENN D BELLAMY<br>WOOD HERRON & EVANS LLP<br>2700 CAREW TOWER, 441 VINE STREET<br>CINCINNATI OH UNITED STATES , 45202-2814  |
| <b>Correspondent e-mail:</b>  | <a href="mailto:gbellamy@whe-law.com">gbellamy@whe-law.com</a> , <a href="mailto:tpiening@whe-law.com">tpiening@whe-law.com</a> , <a href="mailto:usptodock@whe-law.com">usptodock@whe-law.com</a> |

| Associated marks |   |                          |                     |
|------------------|---|--------------------------|---------------------|
| Mark             | Application Status                      | Serial Number            | Registration Number |
| F1               | Abandoned - After Inter-Partes Decision | <a href="#">86451781</a> |                     |

| Plaintiff(s)                  |   |
|-------------------------------|---|
| <b>Name:</b>                  | Formula One Licensing B.V.  |
| <b>Correspondent Address:</b> | PAUL W KRUSE<br>BONE MCALLESTER NORTON PLLC<br>511 UNION STREET SUIT 1600<br>NASHVILLE TN UNITED STATES , 37219 |
| <b>Correspondent e-mail:</b>  | <a href="mailto:trademarks@bonelaw.com">trademarks@bonelaw.com</a>  |

| Associated marks |  |                          |                         |
|------------------|--|--------------------------|-------------------------|
| Mark             | Application Status                           | Serial Number            | Registration Number     |
| F1 FORMULA 1     | REGISTERED AND RENEWED                       | <a href="#">76550990</a> | <a href="#">3031049</a> |
| F1 FORMULA 1     | REGISTERED AND RENEWED                       | <a href="#">75355934</a> | <a href="#">3014297</a> |
| F 1              | CANCELLED - SECTION 71                       | <a href="#">79009600</a> | <a href="#">3587198</a> |
| F1               | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227380</a> | <a href="#">4124034</a> |
| F1 FORMULA 1     | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85228550</a> | <a href="#">4133997</a> |
| F1               | REGISTERED AND RENEWED                       | <a href="#">76454798</a> | <a href="#">3337611</a> |

| Prosecution History |  |              |              |
|---------------------|--|--------------|--------------|
| Entry Number        | History Text                             | Date         | Due Date     |
| 10                  | TERMINATED                               | Oct 22, 2015 |              |
| 9                   | BD DECISION: SUSTAINED                   | Oct 22, 2015 |              |
| 8                   | W/DRAW OF APPLICATION W/O CONSENT        | Oct 20, 2015 |              |
| 7                   | EXTENSION OF TIME GRANTED                | Oct 13, 2015 |              |
| 6                   | D MOT FOR EXT W/ CONSENT                 | Oct 13, 2015 |              |
| 5                   | EXTENSION OF TIME GRANTED                | Sep 09, 2015 |              |
| 4                   | D MOT FOR EXT W/ CONSENT                 | Sep 09, 2015 |              |
| 3                   | PENDING, INSTITUTED                      | Aug 03, 2015 |              |
| 2                   | NOTICE AND TRIAL DATES SENT; ANSWER DUE: | Aug 03, 2015 | Sep 12, 2015 |

### Type of Proceeding: Opposition

**Proceeding Number:** [91211620](#)

**Filing Date:** Jul 17, 2013

**Status:** Terminated

**Status Date:** Nov 03, 2013

**Interlocutory Attorney:** GEORGE POLOGEORGIS

#### Defendant

**Name:** EAJ PERFORMANCE LLC

**Correspondent Address:** EAJ PERFORMANCE LLC  
5960 NW 186TH ST APT 308  
HIALEAH FL UNITED STATES , 33015-8038

**Correspondent e-mail:** [Eajperformance2@gmail.com](mailto:Eajperformance2@gmail.com)

#### Associated marks

| Mark       | Application Status                      | Serial Number            | Registration Number |
|------------|---|--------------------------|---------------------|
| F12 RACING | Abandoned - After Inter-Partes Decision | <a href="#">85736489</a> |                     |

#### Plaintiff(s)

**Name:** Formula One Licensing BV

**Correspondent Address:** PAUL W KRUSE  
BONE MCALLESTER NORTON PLLC  
511 UNION STREET , SUITE 1600  
NASHVILLE TN UNITED STATES , 37219

**Correspondent e-mail:** [trademarks@bonelaw.com](mailto:trademarks@bonelaw.com)

#### Associated marks

| Mark        | Application Status     | Serial Number            | Registration Number     |
|-------------|------------------------|--------------------------|-------------------------|
| F1          | REGISTERED AND RENEWED | <a href="#">76454798</a> | <a href="#">3337611</a> |
| F FORMULA 1 | REGISTERED AND RENEWED | <a href="#">74527520</a> | <a href="#">2133606</a> |

#### Prosecution History

| Entry Number | History Text                             | Date         | Due Date     |
|--------------|--|--------------|--------------|
| 6            | TERMINATED                               | Nov 03, 2013 |              |
| 5            | BD DECISION: SUSTAINED                   | Nov 03, 2013 |              |
| 4            | NOTICE OF DEFAULT                        | Sep 17, 2013 |              |
| 3            | PENDING, INSTITUTED                      | Jul 17, 2013 |              |
| 2            | NOTICE AND TRIAL DATES SENT; ANSWER DUE: | Jul 17, 2013 | Aug 26, 2013 |
| 1            | FILED AND FEE                            | Jul 17, 2013 |              |

Generated on: This page was generated by TSDR on 2022-07-08 11:01:32 EDT

Mark: F1

F1

US Serial Number: 85227419

Application Filing Date: Jan. 27, 2011

US Registration Number: 4124039

Registration Date: Apr. 10, 2012

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: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Status Date: Nov. 14, 2018

Publication Date: Jan. 24, 2012

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## Mark Information

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Mark Literal Elements: F1

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Color(s) Claimed: Color is not claimed as a feature of the mark.

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## Related Properties Information

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Claimed Ownership of US Registrations: 2975282

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## Foreign Information

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Foreign Registration Number: 0892023

Foreign Registration Date: Jun. 29, 2010

Foreign Application/Registration Country: BENELUX

Foreign Expiration Date: Jun. 29, 2020

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## Goods and Services

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**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:** Broadcasting and transmission of analogue television, digital television, cable television, satellite television, pay television, interactive television, interactive entertainment and interactive competitions, radio and Internet programmes; broadcasting of entertainment programmes via television[ and radio; broadcasting of music events via television and radio]; broadcasting of programmes provided over the Internet; broadcasting of sports programmes via television[ and radio; ]Internet broadcasting services;[ telecommunications services, namely, wireless telephone services; communications by and/or between computer terminals; communications by cellular



telephone; communications by fibre optic networks; communications by telegrams; communications by telephone; communications by facsimile communication;] providing access to a database; [computer aided transmission of messages and images;] streaming of audio, video, audiovisual material on the Internet; transfer of data by telecommunications; [dissemination of television programs relayed by satellite, namely, television broadcasting; electronic mail; telecommunications services for the electronic, digital and analogue display of information, messages, images and data; facsimile transmission; electronic message sending; mobile telephone services; multimedia telecommunications services, namely, local and long distance transmission of voice, data by means of telephone, telegraph, cable and satellite transmission; news agency services for electronic transmission; providing Internet access, namely, providing access to real time data via the Internet; providing access to a multiple user network system which allows for the access to gaming and betting information and services over the Internet;] providing telecommunications connections to a global computer network; provision of access to interactive computer databases in the field of sports;[ provision of broadcasting equipment for outside broadcasts; provision of telecommunications facilities for interactive discussion and conversation; radio broadcasting;] receiving and exchange of information, messages, images, and data via mobile phone networks; [rental of message sending apparatus; satellite communications services. sending of telegrams; ]providing telecommunications connections to the Internet, intranet and extranet; [teleconferencing services; telegraph services; telephone communication services;] transferring and disseminating information and data via computer networks and the Internet; transmission of digital information by means of cable, wire or fibre;[ transmission of information by communications satellite, microwave or electronic, digital or analogue means;] transmission of information by mobile telephones.[ facsimiles and facsimile communication; transmission of telegrams; ]transmission services, namely, transmission of digital files; video text and teletext transmission services;[ voice mail services; wire services, namely, telephony communication services;] transmission of sound and video recordings via the Internet

**International Class(es):** 038 - Primary Class

**U.S Class(es):** 100, 101, 104

**Class Status:** ACTIVE

**Basis:** 44(e)

## Basis Information (Case Level)

**Filed Use:** No

**Currently Use:** No

**Filed ITU:** Yes

**Currently ITU:** No

**Filed 44D:** No

**Currently 44E:** Yes

**Filed 44E:** No

**Currently 66A:** No

**Filed 66A:** No

**Currently No Basis:** No

**Filed No Basis:** No

## Current Owner(s) Information

**Owner Name:** Formula One Licensing BV

**Owner Address:** Beursplein 37  
Rotterdam NETHERLANDS 3011AA

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** NETHERLANDS

## Attorney/Correspondence Information

### Attorney of Record

**Attorney Name:** Jill K. Tomlinson

**Docket Number:** 0963429

**Attorney Primary Email Address:** [jtomlinson@kilpatricktownsend.com](mailto:jtomlinson@kilpatricktownsend.com)

**Attorney Email Authorized:** Yes

### Correspondent

**Correspondent Name/Address:** Jill K. Tomlinson  
Kilpatrick Townsend & Stockton LLP  
1114 Avenue of the Americas  
New York, NEW YORK UNITED STATES 10036

**Phone:** 212-775-8700

**Fax:** 212-775-8800

**Correspondent e-mail:** [jtomlinson@kilpatricktownsend.com](mailto:jtomlinson@kilpatricktownsend.com) [tmadmin@kilpatricktownsend.com](mailto:tmadmin@kilpatricktownsend.com) [nytrademarks@kilpatricktownsend.com](mailto:nytrademarks@kilpatricktownsend.com)

**Correspondent e-mail Authorized:** Yes

### Domestic Representative

**Domestic Representative Name:** Jill K. Tomlinson

**Phone:** 212-775-8700

**Fax:** 212-775-8800

**Domestic Representative e-mail:** [jtomlinson@kilpatricktownsend.com](mailto:jtomlinson@kilpatricktownsend.com)

**Domestic Representative e-mail Authorized:** Yes

## Prosecution History

| Date          | Description   | Proceeding Number |
|---------------|---|-------------------|
| Mar. 07, 2022 | TEAS SECTION 8 & 9 RECEIVED                               |                   |
| Apr. 10, 2021 | COURTESY REMINDER - SEC. 8 (10-YR)/SEC. 9 E-MAILED        |                   |
| Nov. 14, 2018 | NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED            |                   |
| Nov. 14, 2018 | REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.        | 70132             |
| Oct. 25, 2018 | CASE ASSIGNED TO POST REGISTRATION PARALEGAL              | 70132             |
| Oct. 10, 2018 | TEAS SECTION 8 & 15 RECEIVED                              |                   |
| Apr. 10, 2017 | COURTESY REMINDER - SEC. 8 (6-YR) E-MAILED                |                   |
| Jan. 05, 2016 | ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED                 |                   |
| Jan. 05, 2016 | TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED      |                   |
| Apr. 10, 2012 | REGISTERED-PRINCIPAL REGISTER                             |                   |
| Jan. 24, 2012 | OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED        |                   |
| Jan. 24, 2012 | PUBLISHED FOR OPPOSITION                                  |                   |
| Jan. 04, 2012 | NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED            |                   |
| Dec. 21, 2011 | LAW OFFICE PUBLICATION REVIEW COMPLETED                   | 70138             |
| Dec. 20, 2011 | APPROVED FOR PUB - PRINCIPAL REGISTER                     |                   |
| Dec. 16, 2011 | EXAMINER'S AMENDMENT ENTERED                              | 70138             |
| Dec. 14, 2011 | NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED              | 6328              |
| Dec. 14, 2011 | EXAMINERS AMENDMENT E-MAILED                              | 6328              |
| Dec. 14, 2011 | EXAMINERS AMENDMENT -WRITTEN                              | 69197             |
| Dec. 05, 2011 | NOTIFICATION OF NON-FINAL ACTION E-MAILED                 | 6325              |
| Dec. 05, 2011 | NON-FINAL ACTION E-MAILED                                 | 6325              |
| Dec. 05, 2011 | NON-FINAL ACTION WRITTEN                                  | 69197             |
| Nov. 22, 2011 | TEAS/EMAIL CORRESPONDENCE ENTERED                         | 70138             |
| Nov. 22, 2011 | CORRESPONDENCE RECEIVED IN LAW OFFICE                     | 70138             |
| Nov. 10, 2011 | ASSIGNED TO LIE   | 70138             |
| Oct. 26, 2011 | TEAS RESPONSE TO OFFICE ACTION RECEIVED                   |                   |
| Aug. 16, 2011 | APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED | 88888             |
| Aug. 16, 2011 | TEAS CHANGE OF OWNER ADDRESS RECEIVED                     |                   |
| Apr. 29, 2011 | NOTIFICATION OF NON-FINAL ACTION E-MAILED                 | 6325              |
| Apr. 29, 2011 | NON-FINAL ACTION E-MAILED                                 | 6325              |
| Apr. 29, 2011 | NON-FINAL ACTION WRITTEN                                  | 69197             |
| Apr. 28, 2011 | ASSIGNED TO EXAMINER                                      | 69197             |
| Apr. 26, 2011 | ASSIGNED TO EXAMINER                                      | 76625             |
| Feb. 01, 2011 | NOTICE OF PSEUDO MARK MAILED                              |                   |
| Jan. 31, 2011 | NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM      |                   |
| Jan. 31, 2011 | NEW APPLICATION ENTERED IN TRAM                           |                   |

## TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: TMO LAW OFFICE 110

Date in Location: Nov. 14, 2018

## Proceedings

### Summary

Number of Proceedings: 3

Type of Proceeding: Opposition

Proceeding Number: [91270672](#)

Filing Date: Jul 23, 2021

Status: Suspended

Status Date: Dec 02, 2021

Interlocutory Attorney: MARY CATHERINE FAINT

**Defendant**

Name: F1 Solutions, Inc.

Correspondent Address: JEREMY A SMITH  
LANIER FORD SHAVER & PAYNE, PC  
2101 WEST CLINTON AVENUE, SUITE 102  
HUNTSVILLE AL UNITED STATES , 35805

Correspondent e-mail: [jas@lanierford.com](mailto:jas@lanierford.com) , [ipdocket@lanierford.com](mailto:ipdocket@lanierford.com)

**Associated marks**

| Mark         | Application Status | Serial Number            | Registration Number |
|--------------|--------------------|--------------------------|---------------------|
| F1 SOLUTIONS | Opposition Pending | <a href="#">88851353</a> |                     |
| F1 SOLUTIONS | Opposition Pending | <a href="#">88851352</a> |                     |

**Plaintiff(s)**

Name: Formula One Licensing BV

Correspondent Address: LAURA MILLER  
KILPATRICK TOWNSEND & STOCKTON LLP  
1001 WEST FOURTH STREET  
WINSTON-SALEM NC UNITED STATES , 27101-2400

Correspondent e-mail: [lamiller@kilpatricktownsend.com](mailto:lamiller@kilpatricktownsend.com) , [lamiller@kilpatricktownsend.com](mailto:lamiller@kilpatricktownsend.com) , [lpearson@kilpatricktownsend.com](mailto:lpearson@kilpatricktownsend.com) , [ABerman@kilpatricktownsend.com](mailto:ABerman@kilpatricktownsend.com) , [d.com](mailto:d.com) , [Agarcia@kilpatricktownsend.com](mailto:Agarcia@kilpatricktownsend.com) , [tadmin@kilpatricktownsend.com](mailto:tadmin@kilpatricktownsend.com)

**Associated marks**

| Mark         | Application Status                           | Serial Number            | Registration Number     |
|--------------|--|--------------------------|-------------------------|
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">75446228</a> | <a href="#">2714785</a> |
| F1           | Registered                                   | <a href="#">87551641</a> | <a href="#">5479340</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">75355934</a> | <a href="#">3014297</a> |
| F1           | Registered                                   | <a href="#">87551696</a> | <a href="#">5467481</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550990</a> | <a href="#">3031049</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227390</a> | <a href="#">4124036</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227438</a> | <a href="#">4137640</a> |
| F1           | Registered                                   | <a href="#">87551621</a> | <a href="#">5442618</a> |
| F1 FORMULA 1 | Registered                                   | <a href="#">87551836</a> | <a href="#">5473736</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550983</a> | <a href="#">3043305</a> |
| F1           | CANCELLED - SECTION 71                       | <a href="#">79030989</a> | <a href="#">3294323</a> |
| F1           | Registered                                   | <a href="#">87551672</a> | <a href="#">5457508</a> |
| F1           | Registered                                   | <a href="#">87551699</a> | <a href="#">5473727</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227391</a> | <a href="#">4124037</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227426</a> | <a href="#">4124041</a> |
| F1 FORMULA 1 | Cancelled - Section 8                        | <a href="#">85228535</a> | <a href="#">4244239</a> |
| F1           | Cancelled - Section 8                        | <a href="#">85227387</a> | <a href="#">4296976</a> |
| F1 FORMULA 1 | Registered                                   | <a href="#">87551831</a> | <a href="#">5457512</a> |
| F1           | Registered                                   | <a href="#">87551676</a> | <a href="#">5473725</a> |
| F1           | Registered                                   | <a href="#">87551689</a> | <a href="#">5473726</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550987</a> | <a href="#">2951002</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550982</a> | <a href="#">2975282</a> |
| F1           | REGISTERED AND RENEWED                       | <a href="#">76454798</a> | <a href="#">3337611</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227380</a> | <a href="#">4124034</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227395</a> | <a href="#">4124038</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227421</a> | <a href="#">4124040</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227404</a> | <a href="#">4130536</a> |
| F1 FORMULA 1 | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85228550</a> | <a href="#">4133997</a> |
| F1           | Cancelled - Section 8                        | <a href="#">85227369</a> | <a href="#">4228567</a> |

|              |  |                          |                         |
|--------------|--|--------------------------|-------------------------|
| F1 FORMULA 1 | CANCELLED - SECTION 71                       | <a href="#">79151513</a> | <a href="#">4714486</a> |
| F1           | Registered                                   | <a href="#">87551654</a> | <a href="#">5457506</a> |
| F1           | Registered                                   | <a href="#">87551681</a> | <a href="#">5467480</a> |
| F1 FORMULA 1 | Registered                                   | <a href="#">87551842</a> | <a href="#">5473737</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">75502698</a> | <a href="#">2633750</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550986</a> | <a href="#">2951001</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227412</a> | <a href="#">4127681</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227400</a> | <a href="#">4181715</a> |
| F1           | Cancelled - Section 8                        | <a href="#">85227418</a> | <a href="#">4220183</a> |
| F1           | Registered                                   | <a href="#">87551660</a> | <a href="#">5457507</a> |
| F1           | Registered                                   | <a href="#">87551710</a> | <a href="#">5473728</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550988</a> | <a href="#">2951003</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550985</a> | <a href="#">2975283</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227419</a> | <a href="#">4124039</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227433</a> | <a href="#">4212315</a> |
| F1 FORMULA 1 | Cancelled - Section 8                        | <a href="#">85228607</a> | <a href="#">4216261</a> |
| F1 FORMULA 1 | Cancelled - Section 8                        | <a href="#">85228592</a> | <a href="#">4223998</a> |
| F1 FORMULA 1 | Registered                                   | <a href="#">87551847</a> | <a href="#">5467484</a> |
| F1           | Registered                                   | <a href="#">87551752</a> | <a href="#">5473729</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550989</a> | <a href="#">2964603</a> |

#### Prosecution History

| Entry Number | History Text                                     | Date         | Due Date     |
|--------------|--|--------------|--------------|
| 17           | SUSPENDED  | Jun 15, 2022 |              |
| 16           | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Jun 15, 2022 |              |
| 15           | SUSPENDED  | May 31, 2022 |              |
| 14           | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | May 31, 2022 |              |
| 13           | P CHANGE OF CORRESP ADDRESS                      | May 31, 2022 |              |
| 12           | SUSPENDED  | Apr 29, 2022 |              |
| 11           | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Apr 29, 2022 |              |
| 10           | SUSPENDED  | Mar 01, 2022 |              |
| 9            | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Mar 01, 2022 |              |
| 8            | SUSPENDED  | Dec 02, 2021 |              |
| 7            | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Dec 02, 2021 |              |
| 6            | ANSWER   | Oct 04, 2021 |              |
| 5            | EXTENSION OF TIME GRANTED                        | Aug 26, 2021 |              |
| 4            | D MOT FOR EXT W/ CONSENT                         | Aug 26, 2021 |              |
| 3            | INSTITUTED                                       | Jul 26, 2021 |              |
| 2            | NOTICE AND TRIAL DATES SENT; ANSWER DUE:         | Jul 26, 2021 | Sep 04, 2021 |
| 1            | FILED AND FEE                                    | Jul 23, 2021 |              |

#### Type of Proceeding: Opposition

**Proceeding Number:** [91242921](#)

**Filing Date:** Aug 08, 2018

**Status:** Terminated

**Status Date:** Nov 21, 2018

**Interlocutory Attorney:** MIKE WEBSTER

#### Defendant

**Name:** A-ONE CO., LTD

**Correspondent Address:** XIAOYAN YANG  
333W GARVEY AVE STE 396  
MONTEREY PARK CA UNITED STATES , 91754

**Correspondent e-mail:** [memorytechcenter@hotmail.com](mailto:memorytechcenter@hotmail.com)

#### Associated marks

| Serial | Registration |
|--------|--------------|
|--------|--------------|

| Mark | Application Status                      | Number                   | Number |
|------|---|--------------------------|--------|
| A1   | Abandoned - After Inter-Partes Decision | <a href="#">87690147</a> |        |

**Plaintiff(s)**

**Name:** Formula One Licensing BV

**Correspondent Address:** JENNIFER FAIRBAIRN DEAL  
KILPATRICK TOWNSEND & STOCKTON LLP  
1100 PEACHTREE STREET NE, STE 2800  
ATLANTA GA UNITED STATES , 30309

**Correspondent e-mail:** [ideal@kilpatricktownsend.com](mailto:ideal@kilpatricktownsend.com) , [lpearson@kilpatricktownsend.com](mailto:lpearson@kilpatricktownsend.com) , [Agarcia@ktslaw.com](mailto:Agarcia@ktslaw.com) , [tmadmin@ktslaw.com](mailto:tmadmin@ktslaw.com)

**Associated marks**

| Mark          | Application Status                           | Serial Number            | Registration Number     |
|---------------|--|--------------------------|-------------------------|
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550985</a> | <a href="#">2975283</a> |
| F1 FORMULA 1  | Registered                                   | <a href="#">87551831</a> | <a href="#">5457512</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228589</a> | <a href="#">4111027</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228597</a> | <a href="#">4133998</a> |
| F1 FORMULA 1  | CANCELLED - SECTION 71                       | <a href="#">79151513</a> | <a href="#">4714486</a> |
| F1 FORMULA 1  | Registered                                   | <a href="#">87551847</a> | <a href="#">5467484</a> |
| F 1           | CANCELLED - SECTION 71                       | <a href="#">79009600</a> | <a href="#">3587198</a> |
| F1 FORMULA 1  | Registered                                   | <a href="#">87551824</a> | <a href="#">5479344</a> |
| F1 FORMULA 1  | Registered                                   | <a href="#">87551827</a> | <a href="#">5479345</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550986</a> | <a href="#">2951001</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550987</a> | <a href="#">2951002</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550988</a> | <a href="#">2951003</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228603</a> | <a href="#">4130540</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228538</a> | <a href="#">4133996</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228592</a> | <a href="#">4223998</a> |
| F1 FORMULA 1  | Registered                                   | <a href="#">87551836</a> | <a href="#">5473736</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227391</a> | <a href="#">4124037</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227395</a> | <a href="#">4124038</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">75502698</a> | <a href="#">2633750</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550990</a> | <a href="#">3031049</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550983</a> | <a href="#">3043305</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">77170204</a> | <a href="#">3429737</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228578</a> | <a href="#">4111026</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228559</a> | <a href="#">4120482</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228599</a> | <a href="#">4130539</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228535</a> | <a href="#">4244239</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">75446228</a> | <a href="#">2714785</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228571</a> | <a href="#">4111024</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228556</a> | <a href="#">4120481</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228584</a> | <a href="#">4152625</a> |
| F1 FORMULA 1  | Registered                                   | <a href="#">87551842</a> | <a href="#">5473737</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227419</a> | <a href="#">4124039</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227426</a> | <a href="#">4124041</a> |
| F 1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">75446140</a> | <a href="#">2893656</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228575</a> | <a href="#">4111025</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228612</a> | <a href="#">4111028</a> |
| F1 FORMULA 1  | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85228550</a> | <a href="#">4133997</a> |
| F1            | REGISTERED AND RENEWED                       | <a href="#">76454798</a> | <a href="#">3337611</a> |
| F1            | Cancelled - Section 8                        | <a href="#">85227385</a> | <a href="#">4124035</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227390</a> | <a href="#">4124036</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227421</a> | <a href="#">4124040</a> |

|              |  |                          |                         |
|--------------|--|--------------------------|-------------------------|
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550982</a> | <a href="#">2975282</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227380</a> | <a href="#">4124034</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550989</a> | <a href="#">2964603</a> |
| F1 FORMULA 1 | Cancelled - Section 8                        | <a href="#">85228564</a> | <a href="#">4111023</a> |
| F1 FORMULA 1 | Cancelled - Section 8                        | <a href="#">85228567</a> | <a href="#">4152624</a> |
| F1 FORMULA 1 | Cancelled - Section 8                        | <a href="#">85228607</a> | <a href="#">4216261</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">75355934</a> | <a href="#">3014297</a> |

**Prosecution History**

| Entry Number | History Text                             | Date         | Due Date     |
|--------------|--|--------------|--------------|
| 6            | TERMINATED                               | Nov 21, 2018 |              |
| 5            | BD DECISION: OPP SUSTAINED               | Nov 21, 2018 |              |
| 4            | NOTICE OF DEFAULT                        | Sep 27, 2018 |              |
| 3            | PENDING, INSTITUTED                      | Aug 08, 2018 |              |
| 2            | NOTICE AND TRIAL DATES SENT; ANSWER DUE: | Aug 08, 2018 | Sep 17, 2018 |
| 1            | FILED AND FEE                            | Aug 08, 2018 |              |

**Type of Proceeding: Opposition**

**Proceeding Number:** [91234905](#)

**Filing Date:** Jun 05, 2017

**Status:** Terminated

**Status Date:** Mar 06, 2018

**Interlocutory Attorney:** MARY B MYLES

**Defendant**

**Name:** Ghassan Abboud

**Correspondent Address:** SAMUEL OSBORNE  
ATOM LAW GROUP LLC  
770 N LASALLE ST SUITE 700  
CHICAGO IL UNITED STATES , 60654

**Correspondent e-mail:** [sahn@atom.law](mailto:sahn@atom.law) , [sosborne@atom.law](mailto:sosborne@atom.law) , [tatac@atom.law](mailto:tatac@atom.law)

**Associated marks**

| Mark    | Application Status | Serial Number            | Registration Number     |
|---------|--------------------|--------------------------|-------------------------|
| 1ST F D | Registered         | <a href="#">87013393</a> | <a href="#">5440929</a> |

**Plaintiff(s)**

**Name:** Formula One Licensing BV

**Correspondent Address:** JENNIFER FAIRBAIRN DEAL  
KILPATRICK TOWNSEND & STOCKTON LLP  
1100 PEACHTREE STREET NE STE 2800  
ATLANTA GA UNITED STATES , 30309

**Correspondent e-mail:** [lpearson@kilpatricktownsend.com](mailto:lpearson@kilpatricktownsend.com) , [ideal@kilpatricktownsend.com](mailto:ideal@kilpatricktownsend.com) , [Agarcia@ktslaw.com](mailto:Agarcia@ktslaw.com) , [tmadmin@ktslaw.com](mailto:tmadmin@ktslaw.com)

**Associated marks**

| Mark         | Application Status                           | Serial Number            | Registration Number     |
|--------------|--|--------------------------|-------------------------|
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550988</a> | <a href="#">2951003</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227391</a> | <a href="#">4124037</a> |
| F 1          | CANCELLED - SECTION 71                       | <a href="#">79009600</a> | <a href="#">3587198</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227380</a> | <a href="#">4124034</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227395</a> | <a href="#">4124038</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550985</a> | <a href="#">2975283</a> |
| F1 FORMULA 1 | Cancelled - Section 8                        | <a href="#">85228607</a> | <a href="#">4216261</a> |
| F1 FORMULA 1 | Cancelled - Section 8                        | <a href="#">85228592</a> | <a href="#">4223998</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227419</a> | <a href="#">4124039</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550989</a> | <a href="#">2964603</a> |
| F1 FORMULA 1 | Cancelled - Section 8                        | <a href="#">85228571</a> | <a href="#">4111024</a> |

|               |  |                          |                         |
|---------------|--|--------------------------|-------------------------|
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228578</a> | <a href="#">4111026</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228567</a> | <a href="#">4152624</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227390</a> | <a href="#">4124036</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550990</a> | <a href="#">3031049</a> |
| F1 FORMULA 1  | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85228550</a> | <a href="#">4133997</a> |
| F1 FORMULA 1  | CANCELLED - SECTION 71                       | <a href="#">79151513</a> | <a href="#">4714486</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227421</a> | <a href="#">4124040</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227426</a> | <a href="#">4124041</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228575</a> | <a href="#">4111025</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228559</a> | <a href="#">4120482</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228599</a> | <a href="#">4130539</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228597</a> | <a href="#">4133998</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228535</a> | <a href="#">4244239</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550987</a> | <a href="#">2951002</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">75355934</a> | <a href="#">3014297</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228589</a> | <a href="#">4111027</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228584</a> | <a href="#">4152625</a> |
| F1            | Cancelled - Section 8                        | <a href="#">85227385</a> | <a href="#">4124035</a> |
| F1            | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227412</a> | <a href="#">4127681</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">75446228</a> | <a href="#">2714785</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550983</a> | <a href="#">3043305</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">77170204</a> | <a href="#">3429737</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228612</a> | <a href="#">4111028</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228603</a> | <a href="#">4130540</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228538</a> | <a href="#">4133996</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">75502698</a> | <a href="#">2633750</a> |
| F 1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">75446140</a> | <a href="#">2893656</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550986</a> | <a href="#">2951001</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228564</a> | <a href="#">4111023</a> |
| F1 FORMULA 1  | Cancelled - Section 8                        | <a href="#">85228556</a> | <a href="#">4120481</a> |
| F1            | REGISTERED AND RENEWED                       | <a href="#">76454798</a> | <a href="#">3337611</a> |
| F1 FORMULA 1  | REGISTERED AND RENEWED                       | <a href="#">76550982</a> | <a href="#">2975282</a> |

**Prosecution History**

| Entry Number | History Text                             | Date         | Due Date     |
|--------------|--|--------------|--------------|
| 13           | TERMINATED                               | Mar 06, 2018 |              |
| 12           | BD DECISION: DISMISSED W/O PREJ          | Mar 06, 2018 |              |
| 11           | W/DRAW OF OPPOSITION                     | Feb 28, 2018 |              |
| 10           | D APPEARANCE / POWER OF ATTORNEY         | Jan 09, 2018 |              |
| 9            | TRIAL DATES REMAIN AS SET                | Oct 18, 2017 |              |
| 8            | D MOT FOR EXT W/ CONSENT                 | Oct 13, 2017 |              |
| 7            | D CHANGE OF CORRESP ADDRESS              | Sep 13, 2017 |              |
| 6            | ANSWER                                   | Sep 13, 2017 |              |
| 5            | EXTENSION OF TIME GRANTED                | Jul 17, 2017 |              |
| 4            | D MOT FOR EXT W/ CONSENT                 | Jul 14, 2017 |              |
| 3            | PENDING, INSTITUTED                      | Jun 05, 2017 |              |
| 2            | NOTICE AND TRIAL DATES SENT; ANSWER DUE: | Jun 05, 2017 | Jul 15, 2017 |
| 1            | FILED AND FEE                            | Jun 05, 2017 |              |

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Mark: F1

F1

US Serial Number: 87551716

Application Filing Date: Aug. 01, 2017

US Registration Number: 5544036

Registration Date: Aug. 21, 2018

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

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: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Aug. 21, 2018

Publication Date: Jun. 05, 2018

## Mark Information

Mark Literal Elements: F1

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

## Related Properties Information

Claimed Ownership of US Registrations: 4124041, 4124042, 4130540

## Foreign Information

Foreign Registration Number: 1008618

Foreign Registration Date: Jan. 30, 2017

Application/Registration Country: BENELUX

Foreign Expiration Date: Jan. 27, 2027

## 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:** Operating lotteries, namely, prize draws; arranging contests; betting services relating to sports; gaming services, in the nature of casino gaming, relating to sports; providing online video games relating to sports; sports and entertainment hospitality services, namely, arranging, organizing, conducting and hosting parties and social entertainment events in conjunction with sporting events; organizing community sporting and cultural activities; hospitality services for consumers, namely, providing and operating facilities for receptions including the provision of entrance tickets to sports or entertainment events; providing and operating facilities for sports events;



organization of sporting and cultural events and activities; organization of sports competitions; organization of events relating to motor sport; providing and operating sports facilities; entertainment services in the form of public viewing of live and delayed broadcast of sports events; rental of video and audio-visual presentations; production, presentation, distribution and/or rental of film recordings and sound and video recordings; production of radio and television programs featuring coverage of sports and sports events; radio and television program and video tape production services; editing services, namely, post-production editing services in the field of music, videos and film; ticket reservation services for motor sports events; issuing of tickets for events, including motor sports events, namely, ticket agency services for sporting events; providing information relating to purchasing tickets for entertainment or sporting events; purchasing services for sports events or entertainment, namely, seat booking services for shows and sporting events; timing of sports events; arranging of beauty contests; arranging and conducting of concerts, conferences and training workshops in the field of auto racing; operating night clubs and amusement parks; organization of exhibitions for cultural or educational purposes; interactive entertainment services, namely, providing temporary use of non-downloadable interactive computer games; betting and gaming services in the nature of casino gaming, on-line on the Internet or on any wireless electronic communication network; providing sports entertainment information on-line from a computer database or via the Internet or via any wireless electronic communication network; electronic games services provided by means of the Internet or on mobile telephones; organization of computer games competitions; publication of books; publication of books and electronic journals on-line; audio and video recording services; production of animated cartoons for the cinema, production of animated cartoons for television; rental of sound and picture recordings for entertainment purposes; distribution of sound and images recordings via the internet; providing information relating to education on-line from a computer database or via the Internet or via any wireless electronic communication network; provision of sports information relating to statistical information; translation services; photography services; provision of recreation facilities

**International Class(es):** 041 - Primary Class

**U.S Class(es):** 100, 101, 107

**Class Status:** ACTIVE

**Basis:** 44(e)

## Basis Information (Case Level)

**Filed Use:** No

**Currently Use:** No

**Filed ITU:** No

**Currently ITU:** No

**Filed 44D:** No

**Currently 44E:** Yes

**Filed 44E:** Yes

**Currently 66A:** No

**Filed 66A:** No

**Currently No Basis:** No

**Filed No Basis:** No

## Current Owner(s) Information

**Owner Name:** Formula One Licensing B.V.

**Owner Address:** Beursplein 37  
Rotterdam NETHERLANDS 3011AA

**Legal Entity Type:** CORPORATION

**State or Country** NETHERLANDS  
**Where Organized:**

## Attorney/Correspondence Information

### Attorney of Record

**Attorney Name:** Jill K. Tomlinson

**Attorney Primary Email Address:** [nytrademarks@kilpatricktownsend.com](mailto:nytrademarks@kilpatricktownsend.com)

**Attorney Email Authorized:** Yes

### Correspondent

**Correspondent Name/Address:** JILL K. TOMLINSON  
KILPATRICK TOWNSEND & STOCKTON LLP  
MAILSTOP IP DOCKETING - 22  
1100 PEACHTREE STREET, SUITE 2800  
ATLANTA, GEORGIA UNITED STATES 30309

**Phone:** 212-775-8700

**Fax:** 212-775-8800

**Correspondent e-mail:** [nytrademarks@kilpatricktownsend.com](mailto:nytrademarks@kilpatricktownsend.com) [tmadmin@kilpatricktownsend.com](mailto:tmadmin@kilpatricktownsend.com)

**Correspondent e-mail Authorized:** Yes

### Domestic Representative

**Domestic Representative Name:** Jill K. Tomlinson

**Phone:** 212-775-8700

**Fax:** 212-775-8800

**Domestic Representative e-mail:** [nytrademarks@kilpatricktownsend.com](mailto:nytrademarks@kilpatricktownsend.com)

**Domestic Representative e-mail Authorized:** Yes

## Prosecution History

| Date          | Description  | Proceeding Number |
|---------------|--|-------------------|
| Aug. 21, 2018 | REGISTERED-PRINCIPAL REGISTER                        |                   |
| Jun. 05, 2018 | OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED   |                   |
| Jun. 05, 2018 | PUBLISHED FOR OPPOSITION                             |                   |
| May 16, 2018  | NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED       |                   |
| May 03, 2018  | APPROVED FOR PUB - PRINCIPAL REGISTER                |                   |
| May 01, 2018  | TEAS/EMAIL CORRESPONDENCE ENTERED                    | 88889             |
| Apr. 30, 2018 | CORRESPONDENCE RECEIVED IN LAW OFFICE                | 88889             |
| Apr. 30, 2018 | TEAS RESPONSE TO OFFICE ACTION RECEIVED              |                   |
| Nov. 09, 2017 | NOTIFICATION OF NON-FINAL ACTION E-MAILED            | 6325              |
| Nov. 09, 2017 | NON-FINAL ACTION E-MAILED                            | 6325              |
| Nov. 09, 2017 | NON-FINAL ACTION WRITTEN                             | 76134             |
| Nov. 01, 2017 | ASSIGNED TO EXAMINER                                 | 76134             |
| Aug. 05, 2017 | NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM |                   |
| Aug. 04, 2017 | NEW APPLICATION ENTERED IN TRAM                      |                   |

## TM Staff and Location Information

### TM Staff Information - None

#### File Location

**Current Location:** PUBLICATION AND ISSUE SECTION

**Date in Location:** Aug. 21, 2018

## Proceedings

### Summary

**Number of Proceedings:** 3

### Type of Proceeding: Opposition

**Proceeding Number:** [91268965](#)

**Filing Date:** Apr 26, 2021

**Status:** Terminated

**Status Date:** Oct 28, 2021

**Interlocutory Attorney:** LAWRENCE (LARRY) T STANLEY

#### Defendant

**Name:** F1 Infrastructure Solutions

**Correspondent Address:** BRYAN J. SCHOMER  
DICKINSON WRIGHT PLLC  
2600 W. BIG BEAVER RD., STE. 300  
TROY MI UNITED STATES , 48084

**Correspondent e-mail:** [dwtrademarks@dickinsonwright.com](mailto:dwtrademarks@dickinsonwright.com) , [bschomer@dickinsonwright.com](mailto:bschomer@dickinsonwright.com) , [krusso@dickinsonwright.com](mailto:krusso@dickinsonwright.com) , [malcantara@dickinsonwright.com](mailto:malcantara@dickinsonwright.com)

### Associated marks

| Mark                        | Application Status        | Serial Number            | Registration Number |
|-----------------------------|---------------------------|--------------------------|---------------------|
| F1 INFRASTRUCTURE SOLUTIONS | First Extension - Granted | <a href="#">88793935</a> |                     |

#### Plaintiff(s)

**Name:** Formula One Licensing BV

**Correspondent Address:** JENNIFER FAIRBAIRN DEAL  
KILPATRICK TOWNSEND & STOCKTON LLP  
1100 PEACHTREE STREET NE  
ATLANTA GA UNITED STATES , 30309

**Correspondent e-mail:** [jdeal@kilpatricktownsend.com](mailto:jdeal@kilpatricktownsend.com) , [lpearson@kilpatricktownsend.com](mailto:lpearson@kilpatricktownsend.com) , [ABerman@kilpatricktownsend.com](mailto:ABerman@kilpatricktownsend.com) , [Agarcia@kilpatricktownsend.com](mailto:Agarcia@kilpatricktownsend.com) , [tadmin@kilpatricktownsend.com](mailto:tadmin@kilpatricktownsend.com)

### Associated marks

| Mark         | Application Status                           | Serial Number            | Registration Number     |
|--------------|--|--------------------------|-------------------------|
| F1           | Registered                                   | <a href="#">87551716</a> | <a href="#">5544036</a> |
| F1 FORMULA 1 | Registered                                   | <a href="#">87689229</a> | <a href="#">5865142</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">76550988</a> | <a href="#">2951003</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED                       | <a href="#">75355934</a> | <a href="#">3014297</a> |
| F1           | Registered                                   | <a href="#">87689792</a> | <a href="#">5859778</a> |
| F1           | REGISTERED AND RENEWED                       | <a href="#">76454798</a> | <a href="#">3337611</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227426</a> | <a href="#">4124041</a> |

#### Prosecution History

| Entry Number | History Text                                     | Date         | Due Date     |
|--------------|--|--------------|--------------|
| 18           | TERMINATED                                       | Oct 28, 2021 |              |
| 17           | BD DECISION: OPP DISMISSED W/O PREJ              | Oct 28, 2021 |              |
| 16           | W/DRAW OF OPPOSITION                             | Oct 27, 2021 |              |
| 15           | AMDT APPROVED; RESP DUE                          | Oct 18, 2021 |              |
| 14           | MOT TO AMEND APPLICATION                         | Oct 13, 2021 |              |
| 13           | SUSPENDED  | Oct 06, 2021 |              |
| 12           | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Oct 06, 2021 |              |
| 11           | SUSPENDED  | Aug 31, 2021 |              |
| 10           | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Aug 31, 2021 |              |
| 9            | SUSPENDED  | Aug 03, 2021 |              |
| 8            | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Aug 03, 2021 |              |
| 7            | SUSPENDED  | Jun 29, 2021 |              |
| 6            | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Jun 29, 2021 |              |
| 5            | SUSPENDED  | Jun 03, 2021 |              |
| 4            | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Jun 03, 2021 |              |
| 3            | INSTITUTED                                       | Apr 26, 2021 |              |
| 2            | NOTICE AND TRIAL DATES SENT; ANSWER DUE:         | Apr 26, 2021 | Jun 05, 2021 |
| 1            | FILED AND FEE                                    | Apr 26, 2021 |              |

#### Type of Proceeding: Opposition

**Proceeding Number:** [91249860](#)

**Filing Date:** Jul 31, 2019

**Status:** Terminated

**Status Date:** Jul 23, 2020

**Interlocutory Attorney:** YONG OH (RICHARD) KIM

#### Defendant

**Name:** LELO GmbH

**Correspondent Address:** PERRY S CLEGG  
KUNZLER BEAN & ADAMSON PC  
50 W BROADWAY, SUITE 1000  
SALT LAKE CITY UT UNITED STATES , 94101

**Correspondent e-mail:** [docket@kunzlerlaw.com](mailto:docket@kunzlerlaw.com) , [pclegg@kba.law](mailto:pclegg@kba.law) , [bmassey@kba.law](mailto:bmassey@kba.law) , [aorr@kba.law](mailto:aorr@kba.law) , [bpartis@kba.law](mailto:bpartis@kba.law)

#### Associated marks

| Mark | Application Status | Serial Number            | Registration Number     |
|------|--------------------|--------------------------|-------------------------|
| F1S  | Registered         | <a href="#">88191925</a> | <a href="#">6206310</a> |

#### Plaintiff(s)

**Name:** Formula One Licensing BV

**Correspondent Address:** JENNIFER FAIRBAIRN DEAL  
KILPATRICK TOWNSEND & STOCKTON LLP  
1100 PEACHTREE STREET NE, SUITE 2800  
ATLANTA GA UNITED STATES , 30309

**Correspondent e-mail:** [jdeal@kilpatricktownsend.com](mailto:jdeal@kilpatricktownsend.com) , [lpearson@kilpatricktownsend.com](mailto:lpearson@kilpatricktownsend.com) , [Agarcia@kilpatricktownsend.com](mailto:Agarcia@kilpatricktownsend.com) , [tadmin@kilpatricktownsend.com](mailto:tadmin@kilpatricktownsend.com)

#### Associated marks

| Mark         | Application Status                           | Serial Number            | Registration Number     |
|--------------|--|--------------------------|-------------------------|
| F1           | Registered                                   | <a href="#">87551716</a> | <a href="#">5544036</a> |
| F1           | Registered                                   | <a href="#">87689564</a> | <a href="#">5694535</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227433</a> | <a href="#">4212315</a> |
| F1           | Registered                                   | <a href="#">87551752</a> | <a href="#">5473729</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227400</a> | <a href="#">4181715</a> |
| F 1          | CANCELLED - SECTION 71                       | <a href="#">79009600</a> | <a href="#">3587198</a> |
| F1           | Registered                                   | <a href="#">87551641</a> | <a href="#">5479340</a> |
| F1 FORMULA 1 | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85228550</a> | <a href="#">4133997</a> |
| F1           | Cancelled - Section 8                        | <a href="#">85227387</a> | <a href="#">4296976</a> |
| F1           | Registered                                   | <a href="#">87551699</a> | <a href="#">5473727</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227380</a> | <a href="#">4124034</a> |

#### Prosecution History

| Entry Number | History Text                                      | Date         | Due Date     |
|--------------|---|--------------|--------------|
| 18           | TERMINATED  | Jul 23, 2020 |              |
| 17           | BD DECISION: OPP DISMISSED W/ PREJ                | Jul 23, 2020 |              |
| 16           | W/DRAW OF OPPOSITION                              | Jul 07, 2020 |              |
| 15           | SUSPENDED   | Apr 20, 2020 |              |
| 14           | P MOT TO SUSP W/ CONSENT PEND SETTLE NEGOTIATIONS | Apr 20, 2020 |              |
| 13           | SUSPENDED   | Feb 14, 2020 |              |
| 12           | P MOT TO SUSP W/ CONSENT PEND SETTLE NEGOTIATIONS | Feb 14, 2020 |              |
| 11           | ANSWER  | Jan 07, 2020 |              |
| 10           | EXTENSION OF TIME GRANTED                         | Dec 21, 2019 |              |
| 9            | D MOT FOR EXT W/ CONSENT                          | Dec 09, 2019 |              |
| 8            | EXTENSION OF TIME GRANTED                         | Oct 09, 2019 |              |
| 7            | D MOT FOR EXT W/ CONSENT                          | Oct 09, 2019 |              |
| 6            | EXTENSION OF TIME GRANTED                         | Sep 03, 2019 |              |
| 5            | D MOT FOR EXT W/ CONSENT                          | Sep 03, 2019 |              |
| 4            | D CHANGE OF CORRESP ADDRESS                       | Sep 03, 2019 |              |
| 3            | INSTITUTED  | Jul 31, 2019 |              |
| 2            | NOTICE AND TRIAL DATES SENT; ANSWER DUE:          | Jul 31, 2019 | Sep 09, 2019 |
| 1            | FILED AND FEE                                     | Jul 31, 2019 |              |

#### Type of Proceeding: Opposition

**Proceeding Number:** [91249199](#)

**Filing Date:** Jun 28, 2019

**Status:** Terminated

**Status Date:** Sep 26, 2019

**Interlocutory Attorney:** JILL M MCCORMACK

#### Defendant

**Name:** LELO GmbH

**Correspondent Address:** EVAN FELDSTEIN  
1525 E PAMA LANE  
LAS VEGAS NV UNITED STATES , 89119

**Correspondent e-mail:** [uspto@lelo.com](mailto:uspto@lelo.com)

#### Associated marks

| Mark | Application Status                      | Serial Number            | Registration Number |
|------|---|--------------------------|---------------------|
| F1   | Abandoned - After Inter-Partes Decision | <a href="#">88068056</a> |                     |

#### Plaintiff(s)

**Name:** Formula One Licensing BV

**Correspondent Address:** JENNIFER FAIRBAIRN DEAL  
KILPATRICK TOWNSEND & STOCKTON LLP  
1100 PEACHTREE STREET NE  
ATLANTA GA UNITED STATES , 30309

Correspondent e-mail: [ideal@kilpatricktownsend.com](mailto:ideal@kilpatricktownsend.com) , [SAshby@kilpatricktownsend.com](mailto:SAshby@kilpatricktownsend.com) , [lpearson@kilpatricktownsend.com](mailto:lpearson@kilpatricktownsend.com) , [Agarcia@kilpatricktownsend.com](mailto:Agarcia@kilpatricktownsend.com) , [om\\_tadmin@kilpatricktownsend.com](mailto:om_tadmin@kilpatricktownsend.com)

**Associated marks**

| Mark         | Application Status                           | Serial Number            | Registration Number     |
|--------------|--|--------------------------|-------------------------|
| F1           | Registered                                   | <a href="#">87689564</a> | <a href="#">5694535</a> |
| F1           | Registered                                   | <a href="#">87551716</a> | <a href="#">5544036</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227433</a> | <a href="#">4212315</a> |
| F1           | Cancelled - Section 8                        | <a href="#">85227387</a> | <a href="#">4296976</a> |
| F1           | Registered                                   | <a href="#">87551641</a> | <a href="#">5479340</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227400</a> | <a href="#">4181715</a> |
| F 1          | CANCELLED - SECTION 71                       | <a href="#">79009600</a> | <a href="#">3587198</a> |
| F1 FORMULA 1 | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85228550</a> | <a href="#">4133997</a> |
| F1           | Registered                                   | <a href="#">87551752</a> | <a href="#">5473729</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227380</a> | <a href="#">4124034</a> |
| F1           | Registered                                   | <a href="#">87551699</a> | <a href="#">5473727</a> |

**Prosecution History**

| Entry Number | History Text                             | Date         | Due Date     |
|--------------|--|--------------|--------------|
| 6            | TERMINATED                               | Sep 26, 2019 |              |
| 5            | BD DECISION: OPP SUSTAINED               | Sep 26, 2019 |              |
| 4            | NOTICE OF DEFAULT                        | Aug 17, 2019 |              |
| 3            | INSTITUTED                               | Jun 28, 2019 |              |
| 2            | NOTICE AND TRIAL DATES SENT; ANSWER DUE: | Jun 28, 2019 | Aug 07, 2019 |
| 1            | FILED AND FEE                            | Jun 28, 2019 |              |

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Mark: F1



US Serial Number: 87689792

Application Filing Date: Nov. 17, 2017

US Registration Number: 5859778

Registration Date: Sep. 17, 2019

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

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: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Sep. 17, 2019

Publication Date: Jul. 02, 2019

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## Mark Information

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Mark Literal Elements: F1

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of three black linear elements, all angled to the right. One of the two left hand lines is placed above the other and both curve from left to right, being intended to form a highly stylised letter "F". The right hand element is a parallelogram, being intended to form a stylised number "1". The white lines which the black elements create are intended to evoke a race track.

Color(s) Claimed: Color is not claimed as a feature of the mark.

Design Search Code(s): 07.11.07 - Streets with lines or dividers; Roads with lines or dividers; intersections (roads) with lines or dividers; Highways with lines or dividers  
26.13.21 - Quadrilaterals that are completely or partially shaded  
27.03.01 - Geometric figures forming letters, numerals or punctuation  
27.03.05 - Objects forming letters or numerals

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## Foreign Information

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Priority Claimed: Yes

Foreign Application Number: 32016

Foreign Application Filing Date: Aug. 14, 2017

Foreign Application/Registration Country: ANDORRA

Foreign Registration Number: 1024082

Foreign Registration Date: Nov. 16, 2017

Foreign Application/Registration Country: BENELUX

Foreign Expiration Date: Nov. 15, 2027

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## Goods and Services

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**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:** Organizing community sporting and cultural events; educational services, namely, conducting classes, seminars and workshops in the field of racing; entertainment services, namely, arranging and conducting of auto races, conducting entertainment exhibitions in the nature of auto races, providing live musical performances, providing non-downloadable playback of audio and video via global communications networks, providing online computer games, entertainment in the nature of light shows, providing an on-going radio and television program in the field of auto racing; providing training in the use of race cars; providing training in the form of courses, seminars, and workshops in the field of auto racing; betting and casino gaming services on-line on the Internet or on any wireless electronic communication network; news reporting services, namely, providing news related to sporting events via radio and television; production of radio and television programs featuring coverage of sports and sports events; timing of sports events; operating night clubs; entertainment services, namely, providing sound and images recordings via the internet; ticket agency services for motor sport events; entertainment services in the nature of production of films and television shows; interactive entertainment, namely, providing temporary use of non-downloadable interactive games; practical training, namely, providing training in the field of auto racing; information about education provided on-line from a computer database or via the Internet or via any wireless electronic communication network; entertainment information in the field of sports, provided on-line from a computer database or via the Internet or via any wireless electronic communication network; rental of sound and picture recordings for entertainment purposes; rental of video and audio-visual equipment; providing of a website featuring online, non-downloadable music; organization of sporting and cultural events and activities; organization of events relating to motor sport; organization of exhibitions for cultural and educational purposes; organization of sports competitions; arranging contests; arranging of beauty contests; organization of computer games competitions; operating lotteries; arranging and conducting of concerts; arranging educational conferences and training workshops in the field of auto racing; operating amusement parks; party planning (entertainment); providing sports facilities; providing recreation facilities; production of animated cartoons for the cinema, production of animated cartoons for television; production of programs for radio, television and videotape; production, presentation, distribution and rental of film recordings and sound and video recordings; publication of books; publication of books and electronic journals on-line; reservation of entry tickets to sports or entertainment events; betting services relating to sports; customer reception services including providing access tickets for sports and entertainment events; editing services, namely, post-production editing services in the field of music, videos and film; entertainment services in the form of public viewing of live and delayed broadcast of sports events; entertainment services in connection with sports events, namely, organizing motor sport events; information services concerning sports events; hospitality services, namely, planning, arranging, organizing, conducting, and hosting parties and social entertainment events in conjunction with sporting events; audio and video recording and production services; entertainment services, namely, providing online electronic games by means of the Internet or mobile telephones; ticket reservation services for entertainment, sporting and cultural events; arranging of contests featuring prize draws; provision of entertainment amusement, recreation, and sports facilities; translation services; photography services; provision of sports information relating to statistical information; providing facilities for sports events

**International Class(es):** 041 - Primary Class

**U.S Class(es):** 100, 101, 107

**Class Status:** ACTIVE

**Basis:** 44(e)

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## Basis Information (Case Level)

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**Filed Use:** No

**Currently Use:** No

**Filed ITU:** Yes

**Currently ITU:** No

**Filed 44D:** Yes

**Currently 44E:** Yes

**Filed 44E:** No

**Currently 66A:** No

**Filed 66A:** No

**Currently No Basis:** No

**Filed No Basis:** No

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## Current Owner(s) Information

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**Owner Name:** Formula One Licensing B.V.

**Owner Address:** Beursplein 37  
Rotterdam NETHERLANDS 3011AA

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** NETHERLANDS

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## Attorney/Correspondence Information

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### Attorney of Record

**Attorney Name:** Jill K. Tomlinson

**Attorney Primary Email Address:** [nytrademarks@kilpatricktownsend.com](mailto:nytrademarks@kilpatricktownsend.com)

**Attorney Email Authorized:** Yes

## Correspondent

**Correspondent Name/Address:** JILL K. TOMLINSON  
KILPATRICK TOWNSEND & STOCKTON LLP  
MAILSTOP IP DOCKETING - 22  
1100 PEACHTREE STREET, SUITE 2800  
ATLANTA, GEORGIA UNITED STATES 30309

**Phone:** 212-775-8700

**Fax:** 212-775-8800

**Correspondent e-mail:** [nytrademarks@kilpatricktownsend.com](mailto:nytrademarks@kilpatricktownsend.com) [tmadmin@kilpatricktownsend.com](mailto:tmadmin@kilpatricktownsend.com)

**Correspondent e-mail Authorized:** Yes

## Domestic Representative

**Domestic Representative Name:** Jill K. Tomlinson

**Phone:** 212-775-8700

**Fax:** 212-775-8800

**Domestic Representative e-mail:** [nytrademarks@kilpatricktownsend.com](mailto:nytrademarks@kilpatricktownsend.com)

**Domestic Representative e-mail Authorized:** Yes

## Prosecution History

| Date          | Description  | Proceeding Number |
|---------------|--|-------------------|
| Sep. 17, 2019 | REGISTERED-PRINCIPAL REGISTER                      |                   |
| Jul. 02, 2019 | OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED |                   |
| Jul. 02, 2019 | PUBLISHED FOR OPPOSITION                           |                   |
| Jun. 12, 2019 | NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED     |                   |
| May 24, 2019  | LAW OFFICE PUBLICATION REVIEW COMPLETED            | 70884             |
| May 17, 2019  | APPROVED FOR PUB - PRINCIPAL REGISTER              |                   |
| May 16, 2019  | TEAS/EMAIL CORRESPONDENCE ENTERED                  | 88889             |
| May 16, 2019  | CORRESPONDENCE RECEIVED IN LAW OFFICE              | 88889             |
| May 16, 2019  | TEAS RESPONSE TO OFFICE ACTION RECEIVED            |                   |
| Nov. 19, 2018 | NOTIFICATION OF NON-FINAL ACTION E-MAILED          | 6325              |
| Nov. 19, 2018 | NON-FINAL ACTION E-MAILED                          | 6325              |
| Nov. 19, 2018 | NON-FINAL ACTION WRITTEN                           | 76134             |
| Nov. 15, 2018 | PREVIOUS ALLOWANCE COUNT WITHDRAWN                 |                   |
| Nov. 13, 2018 | WITHDRAWN FROM PUB - OG REVIEW QUERY               | 62699             |
| Oct. 29, 2018 | CASE RETURNED TO EXAMINATION                       | 71906             |
| Oct. 29, 2018 | NOTICE OF ALLOWANCE CANCELLED                      | 71906             |
| Oct. 25, 2018 | ATTORNEY REVIEW/DECISION ON AMENDMENT REQUIRED     |                   |
| Oct. 25, 2018 | PETITION TO DIRECTOR - GRANTED                     | 70458             |
| Oct. 25, 2018 | ATTORNEY REVIEW/DECISION ON AMENDMENT REQUIRED     |                   |
| Oct. 25, 2018 | PETITION TO DIRECTOR - CHANGE BASIS - GRANTED      | 70458             |
| Oct. 23, 2018 | ASSIGNED TO PETITION STAFF                         | 70458             |
| Oct. 09, 2018 | TEAS PETITION TO AMEND BASIS RECEIVED              | 1111              |
| Sep. 18, 2018 | NOA E-MAILED - SOU REQUIRED FROM APPLICANT         |                   |
| Jul. 24, 2018 | OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED |                   |
| Jul. 24, 2018 | PUBLISHED FOR OPPOSITION                           |                   |
| Jul. 04, 2018 | NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED     |                   |
| Jun. 15, 2018 | APPROVED FOR PUB - PRINCIPAL REGISTER              |                   |
| Jun. 15, 2018 | EXAMINER'S AMENDMENT ENTERED                       | 70884             |
| Jun. 14, 2018 | NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED       | 6328              |
| Jun. 14, 2018 | EXAMINERS AMENDMENT E-MAILED                       | 6328              |
| Jun. 14, 2018 | EXAMINERS AMENDMENT -WRITTEN                       | 76134             |
| Jun. 07, 2018 | NOTIFICATION OF LETTER OF SUSPENSION E-MAILED      | 6332              |
| Jun. 07, 2018 | LETTER OF SUSPENSION E-MAILED                      | 6332              |
| Jun. 07, 2018 | SUSPENSION LETTER WRITTEN                          | 76134             |
| May 31, 2018  | TEAS/EMAIL CORRESPONDENCE ENTERED                  | 88889             |
| May 31, 2018  | CORRESPONDENCE RECEIVED IN LAW OFFICE              | 88889             |



|               |  |       |
|---------------|--|-------|
| May 31, 2018  | TEAS RESPONSE TO OFFICE ACTION RECEIVED              |       |
| Jan. 17, 2018 | NOTIFICATION OF NON-FINAL ACTION E-MAILED            | 6325  |
| Jan. 17, 2018 | NON-FINAL ACTION E-MAILED                            | 6325  |
| Jan. 17, 2018 | NON-FINAL ACTION WRITTEN                             | 76134 |
| Jan. 11, 2018 | ASSIGNED TO EXAMINER                                 | 76134 |
| Dec. 19, 2017 | PRELIMINARY/VOLUNTARY AMENDMENT - ENTERED            | 70884 |
| Dec. 15, 2017 | ASSIGNED TO LIE                                      | 70884 |
| Dec. 07, 2017 | TEAS VOLUNTARY AMENDMENT RECEIVED                    |       |
| Dec. 02, 2017 | NOTICE OF DESIGN SEARCH CODE E-MAILED                |       |
| Dec. 01, 2017 | NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM |       |
| Nov. 21, 2017 | NEW APPLICATION ENTERED IN TRAM                      |       |

## TM Staff and Location Information

### TM Staff Information - None

#### File Location

**Current Location:** PUBLICATION AND ISSUE SECTION

**Date in Location:** Sep. 17, 2019

## Proceedings

### Summary

**Number of Proceedings:** 1

### Type of Proceeding: Opposition

**Proceeding Number:** [91268965](#)

**Filing Date:** Apr 26, 2021

**Status:** Terminated

**Status Date:** Oct 28, 2021

**Interlocutory Attorney:** LAWRENCE (LARRY) T STANLEY

### Defendant

**Name:** F1 Infrastructure Solutions

**Correspondent Address:** BRYAN J. SCHOMER  
DICKINSON WRIGHT PLLC  
2600 W. BIG BEAVER RD., STE. 300  
TROY MI UNITED STATES , 48084

**Correspondent e-mail:** [dwtrademarks@dickinsonwright.com](mailto:dwtrademarks@dickinsonwright.com) , [bschomer@dickinsonwright.com](mailto:bschomer@dickinsonwright.com) , [krusso@dickinsonwright.com](mailto:krusso@dickinsonwright.com) , [malcantara@dickinsonwright.com](mailto:malcantara@dickinsonwright.com)

### Associated marks

| Mark                        | Application Status        | Serial Number            | Registration Number |
|-----------------------------|---------------------------|--------------------------|---------------------|
| F1 INFRASTRUCTURE SOLUTIONS | First Extension - Granted | <a href="#">88793935</a> |                     |

### Plaintiff(s)

**Name:** Formula One Licensing BV

**Correspondent Address:** JENNIFER FAIRBAIRN DEAL  
KILPATRICK TOWNSEND & STOCKTON LLP  
1100 PEACHTREE STREET NE  
ATLANTA GA UNITED STATES , 30309

**Correspondent e-mail:** [ideal@kilpatricktownsend.com](mailto:ideal@kilpatricktownsend.com) , [lpearson@kilpatricktownsend.com](mailto:lpearson@kilpatricktownsend.com) , [ABerman@kilpatricktownsend.com](mailto:ABerman@kilpatricktownsend.com) , [Agarcia@kilpatricktownsend.com](mailto:Agarcia@kilpatricktownsend.com) , [tadmin@kilpatricktownsend.com](mailto:tadmin@kilpatricktownsend.com)

### Associated marks

| Mark         | Application Status     | Serial Number            | Registration Number     |
|--------------|------------------------|--------------------------|-------------------------|
| F1           | Registered             | <a href="#">87551716</a> | <a href="#">5544036</a> |
| F1 FORMULA 1 | Registered             | <a href="#">87689229</a> | <a href="#">5865142</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED | <a href="#">76550988</a> | <a href="#">2951003</a> |
| F1 FORMULA 1 | REGISTERED AND RENEWED | <a href="#">75355934</a> | <a href="#">3014297</a> |
| F1           | Registered             | <a href="#">87689792</a> | <a href="#">5859778</a> |

|    |  |                          |                         |
|----|--|--------------------------|-------------------------|
| F1 | REGISTERED AND RENEWED                       | <a href="#">76454798</a> | <a href="#">3337611</a> |
| F1 | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227426</a> | <a href="#">4124041</a> |

**Prosecution History**

| Entry Number | History Text                                     | Date         | Due Date     |
|--------------|--|--------------|--------------|
| 18           | TERMINATED                                       | Oct 28, 2021 |              |
| 17           | BD DECISION: OPP DISMISSED W/O PREJ              | Oct 28, 2021 |              |
| 16           | W/DRAW OF OPPOSITION                             | Oct 27, 2021 |              |
| 15           | AMDT APPROVED; RESP DUE                          | Oct 18, 2021 |              |
| 14           | MOT TO AMEND APPLICATION                         | Oct 13, 2021 |              |
| 13           | SUSPENDED  | Oct 06, 2021 |              |
| 12           | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Oct 06, 2021 |              |
| 11           | SUSPENDED  | Aug 31, 2021 |              |
| 10           | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Aug 31, 2021 |              |
| 9            | SUSPENDED  | Aug 03, 2021 |              |
| 8            | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Aug 03, 2021 |              |
| 7            | SUSPENDED  | Jun 29, 2021 |              |
| 6            | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Jun 29, 2021 |              |
| 5            | SUSPENDED  | Jun 03, 2021 |              |
| 4            | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Jun 03, 2021 |              |
| 3            | INSTITUTED                                       | Apr 26, 2021 |              |
| 2            | NOTICE AND TRIAL DATES SENT; ANSWER DUE:         | Apr 26, 2021 | Jun 05, 2021 |
| 1            | FILED AND FEE                                    | Apr 26, 2021 |              |

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Mark: F1



US Serial Number: 87689694

Application Filing Date: Nov. 17, 2017

US Registration Number: 5700542

Registration Date: Mar. 19, 2019

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

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: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Mar. 19, 2019

Publication Date: Jan. 01, 2019

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## Mark Information

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Mark Literal Elements: F1

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of three black linear elements, all angled to the right. One of the two left hand lines is placed above the other and both curve from left to right, being intended to form a highly stylised letter "F". The right hand element is a parallelogram, being intended to form a stylised number "1". The white lines which the black elements create are intended to evoke a race track.

Color(s) Claimed: Color is not claimed as a feature of the mark.

Design Search Code(s): 07.11.07 - intersections (roads) with lines or dividers; Roads with lines or dividers; Streets with lines or dividers; Highways with lines or dividers  
26.13.21 - Quadrilaterals that are completely or partially shaded  
26.17.01 - Bars, straight; Lines, straight; Straight line(s), band(s) or bar(s); Bands, straight  
26.17.05 - Lines, horizontal; Horizontal line(s), band(s) or bar(s); Bars, horizontal; Bands, horizontal  
26.17.09 - Lines, curved; Curved line(s), band(s) or bar(s); Bars, curved; Bands, curved  
27.03.01 - Geometric figures forming letters, numerals or punctuation

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## Foreign Information

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Priority Claimed: Yes

Foreign Application Number: 32016

Foreign Application Filing Date: Aug. 14, 2017

Foreign Application/Registration Country: ANDORRA

Foreign Registration Number: 1024082

Foreign Registration Date: Nov. 16, 2017

Foreign Application/Registration Country: BENELUX

Foreign Expiration Date: Nov. 15, 2027

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## 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:** Business administration; business management in the field of marketing, business project management, business development; advertising; providing office functions; advertising agencies- publicity agencies; search for financial sponsorship in relation to motor sport events; compilation and recording of data and information on sports performances; dissemination services of advertising matter; compilation of statistics for business or commercial purposes; conducting marketing study services; rental of advertising space; rental of advertising time on communications media; organization of exhibitions for commercial or advertising purposes; presentation of goods on any communication media for retail purposes, namely, sales promotion; benefits programs for clients and sales promotion services, namely, implementing preferential programs for customers in the nature of customer loyalty services and consumer club services, for commercial, promotion and/or advertising purposes; loyalty, incentive and bonus programs for customers at sports venues by means of distributing loyalty and encoded member cards which may hold personal user data; promotion of events, sports, cultural and leisure activities of others; promoting goods and services of others by means of issuing of loyalty reward cards for supporters, containing personal information on the identity of the card holder and enabling control of access to sports stadiums; promotion of the goods and services of third parties; promotion of third parties through ads; sales promotion for others, namely, implementing preferential programs for customers; provision of space on websites for advertising of goods and services; providing online business directories in relation to the reservation of temporary lodgings, and the rankings, ratings, reviews, referrals and recommendations in relation to reservation of temporary lodgings; on-line advertising on a computer network; advertising for sports events; television advertising, radio advertising; the bringing together, for the benefit of others, of various goods, except the transportation thereof, in order to give customers the opportunity to view and purchase those goods conveniently in a store or via the Internet or via wireless electronic communication devices; sponsorship search; compilation of advertisements and information for use in a web page or a web page in relation to an electronic network or Internet; compilation of information into computer databases, namely, still or animated images; collection of business directories for publication on the Internet and on a wireless electronic communication network; compilation of information into computer databases; commercial business administration services for processing commercial transactions on the Internet or via wireless electronic communication devices; promotional agency services for sports and public relations; services of an advertising agency on the Internet or via wireless electronic communication devices; electronic commerce services, namely, making product information available via telecommunication networks for advertising and sales purposes; promotion services provided by a commercial company through a customer loyalty card, namely, promoting the goods and services of others by means of the issuance of loyalty reward cards; advertising and promotional services concerning the goods of others, information services concerning advertising and promotion, all the aforesaid services being provided on-line from a computer data bank or via the Internet or via wireless electronic communication devices; marketing services, namely, consumer marketing research; retail store and on-line retail store services featuring aromatic solvents, paraffin, waxes, bitumen, and gasoline; promotional services, namely, advertising agency services for promoting the goods and services of others; systemization of information into computer databases; public opinion polling; auctioneering on the Internet or via wireless electronic communication devices; retailing of goods of all kinds, namely, retail store and on-line retail store services featuring general consumer merchandise; retail store and on-line retail store services featuring interactive educational and entertainment products, interactive compact discs, CD-ROMs, and computer games

**International Class(es):** 035 - Primary Class

**U.S Class(es):** 100, 101, 102

**Class Status:** ACTIVE

**Basis:** 44(e)

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### Basis Information (Case Level)

---

**Filed Use:** No

**Currently Use:** No

**Filed ITU:** Yes

**Currently ITU:** No

**Filed 44D:** Yes

**Currently 44E:** Yes

**Filed 44E:** No

**Currently 66A:** No

**Filed 66A:** No

**Currently No Basis:** No

**Filed No Basis:** No

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### Current Owner(s) Information

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**Owner Name:** Formula One Licensing B.V.

**Owner Address:** Beursplein 37  
Rotterdam NETHERLANDS 3011AA

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** NETHERLANDS

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### Attorney/Correspondence Information

---

**Attorney of Record**

**Attorney Name:** Jill K. Tomlinson

Attorney Primary [nytrademarks@kilpatricktownsend.com](mailto:nytrademarks@kilpatricktownsend.com)  
Email Address:

Attorney Email Yes  
Authorized:

#### Correspondent

**Correspondent Name/Address:** JILL K. TOMLINSON  
KILPATRICK TOWNSEND & STOCKTON LLP  
MAILSTOP IP DOCKETING - 22  
1100 PEACHTREE STREET, SUITE 2800  
ATLANTA, GEORGIA UNITED STATES 30309

**Phone:** 212-775-8700

**Fax:** 212-775-8800

**Correspondent e-mail:** [nytrademarks@kilpatricktownsend.com](mailto:nytrademarks@kilpatricktownsend.com) [tmadmin@kilpatricktownsend.com](mailto:tmadmin@kilpatricktownsend.com)

**Correspondent e-mail Authorized:** Yes

#### Domestic Representative

**Domestic Representative Name:** Jill K. Tomlinson

**Phone:** 212-775-8700

**Fax:** 212-775-8800

**Domestic Representative e-mail:** [nytrademarks@kilpatricktownsend.com](mailto:nytrademarks@kilpatricktownsend.com)

**Domestic Representative e-mail Authorized:** Yes

## Prosecution History

| Date          | Description  | Proceeding Number |
|---------------|--|-------------------|
| Mar. 19, 2019 | REGISTERED-PRINCIPAL REGISTER                        |                   |
| Jan. 01, 2019 | OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED   |                   |
| Jan. 01, 2019 | PUBLISHED FOR OPPOSITION                             |                   |
| Dec. 12, 2018 | NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED       |                   |
| Nov. 28, 2018 | NOTICE OF ALLOWANCE CANCELLED                        | 71034             |
| Oct. 24, 2018 | ATTORNEY REVIEW/DECISION ON AMENDMENT REQUIRED       |                   |
| Oct. 24, 2018 | PETITION TO DIRECTOR - CHANGE BASIS - GRANTED        | 70458             |
| Oct. 23, 2018 | ASSIGNED TO PETITION STAFF                           | 70458             |
| Oct. 09, 2018 | TEAS PETITION TO AMEND BASIS RECEIVED                | 1111              |
| Sep. 25, 2018 | NOA E-MAILED - SOU REQUIRED FROM APPLICANT           |                   |
| Jul. 31, 2018 | OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED   |                   |
| Jul. 31, 2018 | PUBLISHED FOR OPPOSITION                             |                   |
| Jul. 11, 2018 | NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED       |                   |
| Jun. 26, 2018 | LAW OFFICE PUBLICATION REVIEW COMPLETED              | 70884             |
| Jun. 25, 2018 | APPROVED FOR PUB - PRINCIPAL REGISTER                |                   |
| Jun. 21, 2018 | TEAS/EMAIL CORRESPONDENCE ENTERED                    | 88889             |
| Jun. 21, 2018 | CORRESPONDENCE RECEIVED IN LAW OFFICE                | 88889             |
| Jun. 21, 2018 | TEAS RESPONSE TO OFFICE ACTION RECEIVED              |                   |
| Jan. 16, 2018 | NOTIFICATION OF NON-FINAL ACTION E-MAILED            | 6325              |
| Jan. 16, 2018 | NON-FINAL ACTION E-MAILED                            | 6325              |
| Jan. 16, 2018 | NON-FINAL ACTION WRITTEN                             | 76134             |
| Jan. 11, 2018 | ASSIGNED TO EXAMINER                                 | 76134             |
| Dec. 19, 2017 | PRELIMINARY/VOLUNTARY AMENDMENT - ENTERED            | 70884             |
| Dec. 15, 2017 | ASSIGNED TO LIE                                      | 70884             |
| Dec. 07, 2017 | TEAS VOLUNTARY AMENDMENT RECEIVED                    |                   |
| Dec. 01, 2017 | NOTICE OF DESIGN SEARCH CODE E-MAILED                |                   |
| Nov. 30, 2017 | NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM |                   |
| Nov. 21, 2017 | NEW APPLICATION ENTERED IN TRAM                      |                   |

## TM Staff and Location Information

TM Staff Information - None

File Location

**Current Location:** PUBLICATION AND ISSUE SECTION

**Date in Location:** Mar. 19, 2019

# Proceedings

## Summary

Number of  
Proceedings: 1

## Type of Proceeding: Opposition

Proceeding  
Number: [91265974](#)

Filing Date: Nov 16, 2020

Status: Terminated

Status Date: Jun 22, 2021

Interlocutory  
Attorney: JENNIFER KRISP

## Defendant

Name: SD Wheel Corp.

Correspondent  
Address: KEVIN L. EISMANN  
EPIPHANY LAW, LLC  
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APPLETON WI UNITED STATES , 54913

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## Associated marks

| Mark | Application Status                      | Serial Number            | Registration Number |
|------|---|--------------------------|---------------------|
| FI   | Abandoned - After Inter-Partes Decision | <a href="#">88767257</a> |                     |

## Plaintiff(s)

Name: Formula One Licensing BV

Correspondent  
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KILPATRICK TOWNSEND & STOCKTON LLP  
1100 PEACHTREE STREET NE  
ATLANTA GA UNITED STATES , 30309

Correspondent e-mail: [ideal@kilpatricktownsend.com](mailto:ideal@kilpatricktownsend.com) , [ideal@kilpatricktownsend.com](mailto:ideal@kilpatricktownsend.com) , [lpearson@kilpatricktownsend.com](mailto:lpearson@kilpatricktownsend.com) , [OPoppens@kilpatricktownsend.com](mailto:OPoppens@kilpatricktownsend.com) , [Agarcia@kilpatricktownsend.com](mailto:Agarcia@kilpatricktownsend.com) , [tadmin@kilpatricktownsend.com](mailto:tadmin@kilpatricktownsend.com)

## Associated marks

| Mark         | Application Status                           | Serial Number            | Registration Number     |
|--------------|--|--------------------------|-------------------------|
| F1 FORMULA 1 | Registered                                   | <a href="#">87689194</a> | <a href="#">5760385</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227395</a> | <a href="#">4124038</a> |
| F1           | Registered                                   | <a href="#">87551696</a> | <a href="#">5467481</a> |
| F1           | Section 8 and 15 - Accepted and Acknowledged | <a href="#">85227412</a> | <a href="#">4127681</a> |
| F1           | Registered                                   | <a href="#">87689650</a> | <a href="#">5816624</a> |
| F1           | Registered                                   | <a href="#">87689694</a> | <a href="#">5700542</a> |
| F1           | Registered                                   | <a href="#">87551676</a> | <a href="#">5473725</a> |
| F1           | Registered                                   | <a href="#">87689584</a> | <a href="#">5719025</a> |
| F1           | Registered                                   | <a href="#">87551654</a> | <a href="#">5457506</a> |
| F1 FORMULA 1 | Registered                                   | <a href="#">87689156</a> | <a href="#">5760382</a> |

## Prosecution History

| Entry Number | History Text                                     | Date         | Due Date |
|--------------|--|--------------|----------|
| 18           | TERMINATED                                       | Jun 22, 2021 |          |
| 17           | BD DECISION: OPP DISMISSED                       | Jun 22, 2021 |          |
| 16           | W/DRAW OF APPLICATION                            | Jun 21, 2021 |          |
| 15           | SUSPENDED  | May 20, 2021 |          |
| 14           | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | May 20, 2021 |          |
| 13           | SUSPENDED  | Apr 20, 2021 |          |
| 12           | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Apr 20, 2021 |          |
| 11           | SUSPENDED  | Mar 21, 2021 |          |
| 10           | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Mar 21, 2021 |          |

|   |  |              |              |
|---|--|--------------|--------------|
| 9 | SUSPENDED  | Feb 19, 2021 |              |
| 8 | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Feb 19, 2021 |              |
| 7 | SUSPENDED  | Jan 22, 2021 |              |
| 6 | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Jan 22, 2021 |              |
| 5 | SUSPENDED  | Dec 23, 2020 |              |
| 4 | P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS | Dec 23, 2020 |              |
| 3 | INSTITUTED                                       | Nov 16, 2020 |              |
| 2 | NOTICE AND TRIAL DATES SENT; ANSWER DUE:         | Nov 16, 2020 | Dec 26, 2020 |
| 1 | FILED AND FEE                                    | Nov 16, 2020 |              |