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Filing date: **10/16/2019**

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

**Petition for Cancellation**

Notice is hereby given that the following party has filed a petition to cancel the registration indicated below.

**Petitioner Information**

Name	Maxwill LLC		
Entity	Corporation	Citizenship	California
Address	2214 Westmoreland Ct. Walnut Creek, CA 95496 UNITED STATES		

Attorney information	Kimberly Korn 275 West 96th Street Suite 32D NY, NY 10025 UNITED STATES kimberlykornesq@aol.com 2679808704		
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**Registration Subject to Cancellation**

Registration No.	5771503	Registration date	06/04/2019
Registrant	KBCO Distributors 2541 S I H-35, Ste 200-268 Round Rock, TX 78664 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 028. First Use: 2018/12/01 First Use In Commerce: 2018/12/01 All goods and services in the class are subject to cancellation, namely: Stretch bands used for yoga and physical fitness purposes
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**Grounds for Cancellation**

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
The mark is deceptively misdescriptive	Trademark Act Sections 14(1) and 2(e)(1)
Deceptiveness	Trademark Act Sections 14(3) and 2(a)
Fraud on the USPTO	Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

Attachments	IN THE UNITED STATMaxwill-converted.pdf(194539 bytes )
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Signature	/Kimberly Korn/
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Name	Kimberly Korn
Date	10/16/2019

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

**PETITION FOR CANCELLATION**

Notice has been given that the following party has filed a petition to cancel the registration below.

**PETITIONER INFORMATION**

Name	Michael Heu
Entity	Limited Liability Company
Citizenship	United States
Address	2214 Westmoreland Ct., Walnut Creek, California, 95496
Correspondent Information	Kimberly Korn, Esq. 275 West 96 <sup>th</sup> Street, Suite 32D New York, NY 10025

**REGISTRATION SUBJECT TO CANCELLATION**

Serial No.	88097587
Registrant	KBCO Distributors c/o Ryan King 2541 S I H-35, Ste. 200-268 Round Rock, Texas 78664

**GOODS/SERVICES SUBJECT TO CANCELLATION**

Class 028. First Use: 2018/12/01 First Use in Commerce: 2018/12/01 All goods and services in the class are subject to cancellation, namely: Stretch bands used for yoga and physical fitness purposes
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**GROUNDS FOR CANCELLATION**

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
Fraud on the USPTO	Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

Signature	/Kimberly Korn/
Name	Kimberly Korn
Date	October 2, 2019

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

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MAXWILL, LLC.,

Petitioner

Mark: KICKFIX

Serial No. 88097587

KBCO Distributors/Ryan King,

Registrant,

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KBCO DISTRIBUTORS, a company organized under the laws of Texas, with an address at 2541 S IH-35, Ste. 200-268 Round Rock, Texas 78664 (“Registrant”), is listed in the records of the U.S. Patent and Trademark Office (“USPTO”) as the registrant of U.S. Serial No.

88097587 (the “Registration”) of KICKFIX (the “Mark”), issued on June 4, 2019, for “Stretch bands used for yoga and physical fitness purposes ” in International Class 028. Curt Hanley, Esq., 19540 Buckingham Drive, Suite 1, Mokena, Illinois 60448 curt@intuitlaw.com, is listed as attorney of record and as e-mail contact. MAXWILL, LLC (“Petitioner”), a company organized under the laws of California, with an address at 2214 Westmoreland Ct., Walnut Creek, California, 95496, is listed in the records of the U.S. Patent and Trademark Office (“USPTO”) as the registrant of U.S. Serial No. 87523433 of KICKBANDS (the “Kickbands”), issued on December 12, 2017, for “Stretch bands for physical fitness using feet” in International Class 028. Kickbands operates in the field of physical fitness stretch bands for feet and markets to those with ADHD, autism or sensory issues. Petitioner believes they will be damaged by the continued registration of the Mark and hereby petitions to cancel the Registration. Registrant markets their product to those with ADHD, autism and sensory issues NOT yoga and physical fitness as they have registered their mark under. As a competing product in the same field who has described their product as “chair fidget bands for kids with fidgety feet for ADHD, autism and sensory needs” and who uses these words in marketing materials, Amazon keywords, descriptions, metadata describing the product, and keywords targeted for paid advertisements. Petitioner has a direct and personal stake in the outcome of the proceeding. The continued presence of the Registration on the federal trademark register constitutes an obstacle to Petitioner’s intended use of the product, marketing materials, metadata, advertisements, or keywords. The Registration, thus, is causing injury and damage to Petitioner, and Petitioner has standing to challenge it. The grounds for cancellation are as follows:

## COUNT I

### **THE TRADEMARK IS VOID FOR PRIOR USE OF THE MARK**

1. “It is axiomatic in trademark law that the standard test of ownership is priority of use. To acquire ownership of a trademark it is not enough to have invented the mark first or even to have registered it first; the party claiming ownership must have been the first to actually use the mark in the sale of goods or services.” *Sengoku Works Ltd. v. RMC Int’l. Ltd.*, 96 F.3d 1217, 1219 (9th Cir. 1996). 7 21. Kickbands was registered with the USPTO on December 12, 2017 in Class 28 as stretch bands for physical fitness using feet particularly “bands for kids with fidgety feet for school or classroom chairs for ADHD and sensory” needs. Kickband’s first use in commerce was April 14, 2017. Kickfix was registered with the USPTO on June 4, 2019 in Class 28 as stretch bands used for yoga and physical fitness purposes. Kickfix’s first use in commerce was December 1, 2018. Because of the numerous examples of prior use of the word “kick” in reference to stretch bands for physical fitness in relation to ADHD and sensory needs, the Mark was in prior use before Registrant used it in commerce.

2. The Registration creates a legal presumption that Registrant has valid and exclusive rights in the Mark for goods identified in the Registration.

3. For the reasons set forth above, Registrant is not entitled to the Registration or to the legal presumptions that the Registration creates.

4. The continued presence of the Registration on the federal trademark register constitutes an obstacle to Petitioner’s intended use of the term “kick” in future products and in marketing materials, descriptions, or keywords. The Registration, thus, is causing injury and damage to Petitioner.

## **COUNT II**

**THE TRADEMARK IS VOID FOR FRAUD ON THE U.S. PATENT AND  
TRADEMARK OFFICE**

5. Petitioner seeks to cancel the Registration on the ground that, on information and belief, it was obtained as a result of knowingly false statements about the use of the Mark, which were made with the intent to deceive the USPTO and constitute fraud on the USPTO.

6. Kickfix was registered falsely and has received trademark registration under false pretenses as Kickfix is not marketed as a yoga and physical fitness product, but rather stretch bands for physical fitness using feet particularly “bouncy foot bands for the desk or chair for students with ADHD, autism or sensory needs.” Nowhere is Kickfix’s marketing of the product aimed at yoga. Nowhere in the trademark application does it state Kickfix is used as “stretch bands for physical fitness using feet.” Both products are marketed to the same consumer; however, Kickfix does not have a trademark to market their product to consumers other than in the yoga and physical fitness space. Registrant has directly targeted Kickband’s market with the intention of confusing consumer’s to purchase Kickfix products instead.

7. The Registration creates a legal presumption that Registrant has valid and exclusive rights in the Mark for goods identified in the Registration.

8. For the reasons set forth above, Registrant is not entitled to the Registration or to the legal presumptions that the Registration creates.

9. The continued presence of the Registration on the federal trademark register constitutes an obstacle to Petitioner’s intended use of the term “kick” in future products and in marketing materials, descriptions, or keywords. The Registration, thus, is causing injury and damage to Petitioner.

### COUNT III

#### THE TRADEMARK IS VOID FOR LIKLIHOOD OF CONFUSION –

#### SIMILARITY OF THE MARKS

10. Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. *See* 15 U.S.C.

§1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Only those factors that are “relevant and of record” need be considered. Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services.

11. Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” Registrant has applied for the standard character mark KICKFIX. Petitioner’s mark and Registrant’s mark are both merely the distinctive word KICK followed by generic wording FIX and BANDS respectively. Because of the shared use of KICK, these marks have a similar appearance, sound, and connotation, and these elements altogether lead to a very similar commercial impression. When comparing marks, “[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks



are sufficiently similar in terms of their commercial impression such that [consumers] who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, \_\_\_ F.3d \_\_\_, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re St. Helena Hosp.*, 774 F.3d 747, 750-51, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 1007, 169 USPQ 39, 40 (CCPA 1971)); TMEP §1207.01(b).

Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because “VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed Cir. 1992) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because “consumers must first notice th[e] identical lead word”); *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 1303, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”).

12. Because the marks are similar in appearance, sound, connotation and commercial impression, the marks are confusingly similar. The continued presence of the Registration on the federal trademark register constitutes an obstacle to Petitioner’s intended use of the term “kick” in future products and in marketing materials, descriptions, or keywords. The Registration, thus, is causing injury and damage to Petitioner.

## COUNT IV

### **THE TRADEMARK IS VOID FOR LIKLIHOOD OF CONFUSION – RELATEDNESS OF THE GOODS**

13. Kickbands was registered with the USPTO on December 12, 2017 in Class 28 as stretch bands for physical fitness using feet particularly “bands for kids with fidgety feet for school or classroom chairs for ADHD and sensory” needs. Kickband’s first use in commerce was April 14, 2017. Kickfix was registered with the USPTO on June 4, 2019 in Class 28 as stretch bands used for yoga and physical fitness purposes. Kickfix’s first use in commerce was December 1, 2018. Kickfix is not marketing their product in the areas their trademark is registered, but in the exact channels as Petitioner “foot bands for kids with ADHD or sensory needs.”


14 Additionally, the goods of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Thus, Petitioner’s and registrant’s goods are related.

15. Because the goods are related, there is a likelihood of confusion to relevant consumers. The continued presence of the Registration on the federal trademark register constitutes an obstacle to Petitioner’s intended use of the term “kick” in future products and in marketing materials, descriptions, or keywords. The Registration, thus, is causing injury and damage to Petitioner.

WHEREFORE, Petitioner Maxwill, LLC prays that Serial No. 88097587 be canceled.

Respectfully submitted,

Dated: October 2, 2019

A handwritten signature in black ink, appearing to read "Kimberly Korn". The signature is written in a cursive style with a long horizontal line extending to the right.

Kimberly Korn, Esq.

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the Petition for Cancellation was served by email on this 2nd day of October 2019 on counsel for Applicant: Curt Hanley, Esq., 19540 Buckingham Drive, Suite 1, Mokena, Illinois 60448  
curt@intuitlaw.com.