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Filing date: **12/06/2021**

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	Wizards of the Coast LLC		
Entity	Limited liability company	Citizenship	Delaware
Address	1600 LIND AVENUE SW SUITE 400 RENTON, WA 98055 UNITED STATES		
Attorney information	STUART DUNWOODY DAVIS WRIGHT TREMAINE LLP 920 FIFTH AVENUE SUITE 3300 SEATTLE, WA 98104 UNITED STATES Primary Email: stuartdunwoody@dwt.com Secondary Email(s): laurenrainwater@dwt.com, lisamerritt@dwt.com, seadocket@dwt.com 206-622-3150		
Docket Number			

Registration Subject to Cancellation

Registration No.	6472675	Registration date	08/31/2021
Registrant	TSR, LLC 723 WILLIAMS STREET LAKE GENEVA, WI 53147 UNITED STATES		

Goods/Services Subject to Cancellation


Class 016. First Use: 2021/03/00 First Use In Commerce: 2021/04/00 All goods and services in the class are subject to cancellation, namely: Role playing game equipment in the nature of game book manuals
Class 028. First Use: 2021/04/00 First Use In Commerce: 2021/04/00 All goods and services in the class are subject to cancellation, namely: Dice; Dice games; Equipment sold as a unit for playing role playing games; Equipment sold as a unit for playing parlour games; Role playing games; Tabletop hobby battle games in the nature of battle, war and skirmish games, and fantasy games, and playing equipment sold as a unit therewith

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)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Design Mark			
Goods/Services	Role playing game equipment in the nature of game book manuals (IC 16); Role playing games; Tabletop hobby battle games in the nature of battle, war and skirmish games, and fantasy games, and playing equipment sold as a unit therewith (IC 28)		

Attachments	TSR Mark.jpg Petition for Cancellation.pdf(159125 bytes)
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Signature	/Stuart Dunwoody/
Name	Stuart Dunwoody
Date	12/06/2021



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6 2. From a long time prior to Registrant's alleged dates of first use of the mark of
7 Registration No. 6,472,675 and continuing to the present, Petitioner engaged in substantial use of
8 the TSR Design Mark.

9 3. By reason of the long and continuous use of the TSR Design Mark, the TSR
10 Design Mark has become associated with Petitioner, and the public has come to recognize such
11 mark as signifying products sold by Petitioner. Petitioner has developed extensive and
12 substantial goodwill with respect to the TSR Design Mark.

13 4. The design mark claimed by Registration No. 6,472,675 is identical to the TSR
14 Design Mark as used by Petitioner. A copy of Registration No. 6,472,675 is attached as Exhibit
15 A.

16 5. Petitioner has used the TSR Design Mark in Commerce in connection with,
17 among others, all of the Registered Services in Classes 16 and 28. As a result of its continuous
18 longstanding use of the TSR Design Mark, Petitioner has acquired legal rights in and to the TSR
19 Design Mark.

20 6. Petitioner has not abandoned its use of the TSR Design Mark.

21 7. On information and belief, the goods of Registrant offered and sold under the
22 TSR Design Mark and the goods of Petitioner offered and sold under the TSR Design Mark are
23 of similar character and are sold to the same class of customers and travel in the same channels
24 of trade.

25 8. Petitioner's products bearing the TSR Design Mark have been extensively and
26 continuously offered to the public through various channels of trade from a long time prior to
27 Registrant's alleged first use of the TSR Design Mark.

1 9. The channels of trade for Registrant's products identified in Registration
2 No. 6,472,675 are identical to the channels of trade in which Petitioner provides its products.

3 10. The conditions under which and buyers to whom sales are made of Registrant's
4 products identified in Registration No. 6,472,675 are identical to the conditions under which and
5 buyers to whom sales are made of the products provided by Petitioner.

6 11. The TSR Design Mark as claimed by Registration No. 6,472,675 when used by
7 Registrant in association with the products claimed by Registration No. 6,472,675 is likely to
8 cause confusion, or to cause mistake, or to deceive within the meaning of Section 2(d) of the
9 Lanham Act, 15 U.S.C. §1052(d).

10 12. Registration No. 6,472,675 is *prima facie* evidence of the validity of the
11 registered mark and of the registration of the registered mark, and of Registrant's ownership and
12 exclusive right to use the TSR Design Mark for the products claimed by the Registration
13 throughout the United States, when, in fact, Registrant is not entitled to said rights by virtue of
14 Petitioner's superior and prior rights in the TSR Design Mark and the prior use of the TSR
15 Design Mark by Petitioner long prior to any date by which Registrant can claim any rights in the
16 registered mark. The Registration is in derogation of Petitioner's superior and prior rights in the
17 TSR Design Mark and is therefore causing injury and damage to Petitioner.

18 13. Petitioner is damaged by the Registration insofar as the registration is *prima facie*
19 evidence of the validity of the registered mark and of the registration of the registered mark, and
20 of Registrant's ownership and exclusive right to use the TSR Design Mark for the products
21 claimed by the Registration when, in fact, Registrant is not entitled to said rights by virtue of
22 Petitioner's superior and prior rights to continue to use the TSR Design Mark with a wide range
23 of products including the products claimed by Registration No. 6,472,675.

24 14. If Registrant is permitted to continue to maintain its registration, the same may be
25 deemed incontestable after five (5) years from the date of registration and Registrant would
26 obtain an incontestable right to use its mark in commerce and impede on Petitioner's right to
27

1 continue to use, register, and expand use of its TSR Design Mark, and Petitioner would thereby
2 suffer damage.

3 15. Continued registration of the mark of Registration No. 6,472,675 will cause injury
4 to Petitioner.

5 **Second Ground for Cancellation – Fraud**

6 16. On information and belief, Registrant has committed fraud on the United States
7 Patent and Trademark Office in connection with U.S. Trademark Application No. 90/124,839
8 (the “Application”).

9 17. Registrant obtained Registration No. 6,472,675 with actual knowledge of the use
10 of the TSR Design Mark with the services claimed by Registration No. 6,472,675 by Petitioner.
11 Registrant does not own the exclusive right to use the TSR Design Mark for the services claimed
12 by Registration No. 6,472,675. Registrant therefore obtained registration of the TSR Design
13 Mark with actual knowledge that it does not own the exclusive right to use the mark for the
14 services claimed by Registration No. 6,472,675 throughout the United States.

15 18. On August 19, 2020, Registrant filed the Application to register the TSR Design
16 Mark and, in the application, Registrant represented in a declaration and under oath that “to the
17 best of [its] knowledge and belief, no other persons, except, if applicable, concurrent users, have
18 the right to use the mark in commerce, either in the identical form or in such near resemblance as
19 to be likely, when used on or in connection with the goods/services of such other persons, to
20 cause confusion or mistake, or to deceive.” Registrant did not file a concurrent use application
21 and therefore, did not identify any concurrent users of the TSR Design Mark. Registrant instead
22 claimed in the Application the exclusive right to use the TSR Design Mark throughout the entire
23 United States.

24 19. The declaration made under oath contained in the Application to register the TSR
25 Design Mark was signed on August 18, 2020 by Justin LaNasa, Owner of Registrant.

26 20. The foregoing representations made under oath by Justin LaNasa were false at the
27 time that they were made.

1 21. Registrant and declarant, Justin LaNasa, knew that Petitioner was using the TSR
2 Design Mark in connection with services provided to the same customers in the same channels of
3 trade as Registrant well before the filing date of the Application to register the TSR Design
4 Mark.

5 22. Registrant, and declarant Justin LaNasa, knew that the representation that “no
6 other persons, except, if applicable, concurrent users, have the right to use the mark in
7 commerce, either in the identical form or in such near resemblance as to be likely, when used on
8 or in connection with the goods/services of such other persons, to cause confusion or mistake, or
9 to deceive” was false when said representation was made in support of the application filed to
10 secure Registration No. 6,472,675. When the representation was made, Registrant, and declarant
11 Justin LaNasa, were aware of the use of the TSR Design Mark by Petitioner.

12 23. Registrant knew that it did not own the exclusive right to use the TSR Design
13 Mark when it made the representation in its declaration because Registrant had actual knowledge
14 of Petitioner’s prior use of the TSR Design Mark. Declarant Justin LaNasa was aware when he
15 made the representations in the declaration that Petitioner owned legal rights in the TSR Design
16 Mark that are superior to Registrant’s rights. Registrant and declarant, Justin LaNasa, were
17 aware when Registrant filed the Application that it did not own nationwide rights to the TSR
18 Design Mark and it could not stop use of the TSR Design Mark by Petitioner, yet made the
19 statements specified in the declaration under oath.

20 24. Petitioner used the TSR Design Mark in commerce prior to, and at the time, that
21 Registrant, and declarant Justin LaNasa, signed the declaration submitted with the Application
22 on August 19, 2020 seeking to register the TSR Design Mark.

23 25. At the time that Registrant, and declarant Justin LaNasa, signed the Application to
24 register the TSR Design Mark, Petitioner had legal rights in the TSR Design Mark that were
25 superior to Registrant’s rights in the TSR Design Mark.

26 26. Registrant, and declarant Justin LaNasa, knew of Petitioner’s prior and superior
27 legal rights in the TSR Design Mark and either believed that a likelihood of confusion would

1 result or had no reasonable basis for believing otherwise, and declared otherwise with the intent
2 to deceive the U.S. Patent and Trademark Office in an effort to fraudulently obtain registration of
3 the TSR Design Mark.

4 27. Registrant failed to disclose the foregoing facts in its representations made under
5 oath in support of Registration No. 6,472,675 to the U.S. Patent and Trademark Office. By
6 knowingly failing to disclose those facts, Registrant intended to obtain a registration to which it
7 is not entitled.

8 28. Justin LaNasa's false representations made under oath supporting the Application
9 to register the TSR Design Mark were material to the U.S. Patent and Trademark Office's
10 decision to approve the Application for publication and eventual issuance into Registration
11 No. 6,472,675.

12 29. As discussed above, Registration No. 6,472,675 is *prima facie* evidence of the
13 validity of the registered mark and of the registration of the registered mark, and of Registrant's
14 ownership and exclusive right to use the TSR Design Mark for the products claimed by the
15 Registration throughout the United States, when, in fact, Registrant is not entitled to said rights.
16 The Registration is in derogation of Petitioner's superior and prior rights in the TSR Design
17 Mark and is therefore causing injury and damage to Petitioner.

18 30. Based upon the foregoing, Registration No. 6,472,675, issued August 31, 2021, is
19 causing injury and damage to Petitioner.

20 Petitioner has filed this Petition consistent with the requirements of 37 C.F.R. § 2.111 and
21 served a courtesy copy of this Petition to Registrant's counsel, Russell D. Nugent, by email sent
22 to russell@kinglawonline.com.

23 Petitioner respectfully requests that Registration No. 6,472,675 be cancelled as
24 authorized by Section 14 of the Lanham Act, 15 U.S.C. § 1064, and that this Cancellation be
25 sustained.

26 Petitioner has submitted the filing fee of \$1200.00 via electronic payment.
27

1 Please direct all correspondence to Stuart Dunwoody and Lauren Rainwater of Davis
2 Wright Tremaine LLP at the following address:

3 Stuart Dunwoody
4 Lauren Rainwater
5 Davis Wright Tremaine LLP
6 920 Fifth Avenue, Suite 3300
7 Seattle, WA 98104-1610

8 Please direct all telephone calls to Stuart Dunwoody at 206-757-8034 or Lauren Rainwater at
9 206-757-8119.

10 DATED this 6th day of December, 2021.

11 Davis Wright Tremaine LLP
12 Attorneys for Wizards of the Coast LLC

13 By /Stuart Dunwoody/
14 Stuart Dunwoody
15 Lauren Rainwater
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17 Seattle, WA 98104-1610
18 Tel: 206-757-8034
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20 Email: stuartdunwoody@dwt.com
21 laurenrainwater@dwt.com

22 **CERTIFICATE OF SERVICE**

23 I hereby certify that this PETITION FOR CANCELLATION of U.S. Trademark
24 Registration No. 6,472,675 is being duly served upon Registrant's counsel, Russell D. Nugent,
25 by email sent to russell@kinglawonline.com.

26 Date: December 6, 2021 /Stuart Dunwoody/

EXHIBIT A

United States of America

United States Patent and Trademark Office



Reg. No. 6,472,675

Registered Aug. 31, 2021

Int. Cl.: 16, 28

Trademark

Principal Register

TSR, LLC (WISCONSIN LIMITED LIABILITY COMPANY)

723 Williams Street
Lake Geneva, WISCONSIN 53147

CLASS 16: Role playing game equipment in the nature of game book manuals

FIRST USE 3-00-2021; IN COMMERCE 4-00-2021

CLASS 28: Dice; Dice games; Equipment sold as a unit for playing role playing games; Equipment sold as a unit for playing parlour games; Role playing games; Tabletop hobby battle games in the nature of battle, war and skirmish games, and fantasy games, and playing equipment sold as a unit therewith

FIRST USE 4-00-2021; IN COMMERCE 4-00-2021

The mark consists of the letters "TSR" appear above the words "The Game Wizards" and to the left of a man's face in profile with a long beard. A border extends around the words and image and connects to the T and the R in "TSR". There is a circular border inside of a half-moon-shaped border that both surround the image of the face.

No claim is made to the exclusive right to use the following apart from the mark as shown: "GAME"

SER. NO. 90-124,839, FILED 08-19-2020



Performing the Functions and Duties of the
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

