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

In the matter of Application Serial No. 76/494490
Published for Opposition in the OFFICIAL GAZETTE of October 7, 2003

ANTHONY HAWK,
Opposer,

v.

APOGEE SOFTWARE, LTD.,
Applicant.

Opposition No.:



10-14-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #39

NOTICE OF OPPOSITION

Anthony Hawk ("Opposer"), is an individual having his principal place of business at 31878 Del Obispo, Suite 118-602, San Juan Capistrano, CA 92675, believes he will be damaged by registration of the mark TOMMY HAWK shown in Serial No. 76/494,490 in International Classes 09, 28 and 41, filed by Apogee Software Ltd., ("Applicant"), and hereby opposes the same.

11/04/2003 KGIBBONS 00000130 76494490

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As grounds for this Opposition, it is alleged:

1. On or about March 4, 2003, Applicant filed an intent to use application with the United States Patent and Trademark Office to register TOMMY HAWK (hereinafter "Applicant's Mark") for:

09: Computer and video products, namely, video game machines for use with televisions; video game cartridges; video game tape cassettes; pre-recorded video tapes featuring computer games and computer game characters; pre-recorded DVD's and CD-ROMs featuring computer games and computer game characters;

motion picture films featuring video games and video game characters; television game programs featuring computer games and computer game characters; television game monitor consoles; computer game analog controllers in the nature of a hand held device for accessing computer games; computer game joysticks; memory cards, computer game software; computer game discs; computer game programs; computer game cassettes, computer game tapes, computer game cartridges, computer software featuring computer games that can be downloaded through a global computer network; multimedia software recorded on a CD-ROM featuring computer games; computers; computer hardware and computer firmware for use in operating computer games; computer mouse pads.

28: Toys, namely, action figures and accessories therefor, mechanical action toys, card games, board games, coin-operated pinball machines, role playing games, jigsaw puzzles, manipulative puzzles and cube puzzles, toy figures, plush toys, toy vehicles, and costume mask; stand alone video game machines; hand held unit for playing electronic games; and coin-operated video games.

41: Entertainment services in the nature of the production and distribution of motion picture films; production of prerecorded video cassettes, video discs and laser discs; entertainment services in the nature of a live-action and/or animated television program series and production of live-action, and/or animated motion picture films for television; entertainment services in the nature of computer games provided and played through a global computer network; entertainment services, namely, live performances by a musical rock group.

2. Opposer, commonly known as TONY HAWK, is the world's most famous skateboarder. He is one of the world's most famous athletes. He has appeared innumerable times on television, in newspapers and magazines. In addition, he has licensed the use of his name on many different types of products, the sales of which exceed hundreds of millions of dollars' worth of products.

3. Since at least as early as October 7, 1999, Opposer has been using TONY HAWK on goods in International Class 09 for computer games, including one of the best selling computer games of all times, TONY HAWK'S PRO SKATER.

4. Opposer is the owner of:

(a) U.S. Trademark Application S/N 76/327,639, for TONY HAWK, filed as an intent-to-use application on October 19, 2001, in International Class 09 (allowed January 21, 2003), with a request to divide to be filed along with a statement of use for certain goods.

(b) U.S. Trademark Registration No. 2,449,964, registered May 8, 2001, for TONY HAWK in Class 28.

(c) U.S. Trademark Application No. 76/327,637, filed as an intent-to-use application on October 10, 2001, in International Class 41 (final review before registration has been completed for this Intent to Use application and it will register in due course).

(d) U.S. Trademark Application S/N 76/505,059, for TONY HAWK'S PRO SKATER, filed April 7, 2003, claiming a first use date of October 7, 1999.

5. There is no issue as to priority. Applicant's priority date for its intent-to-use application is later than Opposer's first use of TONY HAWK and Opposer's earliest filed applications and registration. Since long prior to Applicant's filing of the application for

Applicant's Mark (no use of Applicant's Mark having been alleged by Applicant), Opposer has made substantial and continuous use of the TONY HAWK Mark in interstate, foreign, and intrastate commerce on and in connection with the advertising, promotion, and sale of its goods and services in Classes 09, 28 and 41. Specifically, it has used the TONY HAWK Mark since as early as October 7, 1999 for computer games, and long before that for other goods or services.

6. By virtue of the aforesaid advertising, promotion, and sales, and by virtue of the excellence of his products and reputation, Opposer's TONY HAWK Mark has come to represent exceedingly valuable goodwill owned by Opposer.

7. The goods and services on which Opposer uses its TOMMY HAWK Mark and the goods and services for which Applicant seeks to register Applicant's Mark are closely related, if not identical, and are sold through the same channels of trade and to the same class of purchasers.

8. Opposer's TONY HAWK Mark and Applicant's TOMMY HAWK Mark are confusingly and substantially similar. This is especially true since the only difference between the marks is consonants that are extremely similar in sound, "M" and "N."

9. Use by Applicant of Applicant's Mark will be likely to cause confusion, mistake, or deception with Opposer's Mark, and result in the belief that Applicant or Applicant's goods or services are in some way legitimately connected with, sponsored by, or approved by Opposer, resulting in damage and injury to Opposer. Persons familiar with Opposer's Mark would be likely to buy Applicant's goods or services as and for a product made and sold by Opposer. Any such confusion in trade inevitably would result in loss of sales to Opposer. Furthermore, any defect, objection, or fault found with Applicant's goods and services marketed under Applicant's

Mark would necessarily reflect upon and seriously injure the reputation that Opposer has established for its goods and services merchandised under Opposer's Mark.

10. Any use Applicant has made or may make of Applicant's Mark, is and will be without Opposer's consent or permission.

11. Applicant has no good faith intention to use Applicant's Mark.

12. Opposer has previously apposed Applicant's Application No. 76/436,318 for TOMMY HAWK in International Class 09.

WHEREFORE, registration by Applicant of the aforesaid Applicant's Mark for the aforesaid goods and services will be damaging to Opposer, and Opposer therefore requests that the Opposition be sustained.

Opposer submits herewith the requisite \$300.00 filing fee.

Please address all correspondence to John R. Sommer, Esq., Attorney-at-Law, 17426 Daimler Street, Irvine, California 92614.

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