

ESTTA Tracking number: **ESTTA1253705**

Filing date: **12/12/2022**

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	Lace Up, LLC
Granted to date of previous extension	12/11/2022
Address	5510 MERRICK ROAD MASSAPEQUA, NY 11758 UNITED STATES
Attorney information	MATTHEW D. ASBELL OFFIT KURMAN, P.A. 590 MADISON AVENUE, 6TH FLOOR NEW YORK, NY 10022 UNITED STATES Primary email: trademarks@offitkurman.com Secondary email(s): matthew.asbell@offitkurman.com, alison.pratt@offitkurman.com, chintan.desai@offitkurman.com 9294760048
Docket no.	0650-42.08

**Applicant information**

Application no.	90007210	Publication date	06/14/2022
Opposition filing date	12/12/2022	Opposition period ends	12/11/2022
Applicant	FOX MEDIA LLC 10201 WEST PICO BOULEVARD LOS ANGELES, CA 90035 UNITED STATES		

**Goods/services affected by opposition**

<p>Class 016. First Use: None First Use In Commerce: None All goods and services in the class are opposed, namely: Stationery; stickers; bookmarks; greeting cards; postcards; pens and pencils; temporary tattoo transfers; address books; date books; photographs; photo albums; paper folders; printed paper doorknob hangers; table cloths made of paper and paper napkins; lunch bags made of paper; wrapping paper; paper gift bags; comic books; trading cards, other than for games; series of fiction books; children's books; children's activity books; coloring books; cardboard stand-up cutouts featuring photographs or artwork; all of the foregoing in connection with an animated, dog-like character</p>
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**Grounds for opposition**

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

U.S. application no.	90434888	Application date	12/30/2020
Registration date	NONE	Foreign priority date	NONE
Word mark	HOTEL DIABLO		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 009. First use: First Use: None First Use In Commerce: None Downloadable musical sound recordings; video recordings featuring music; Audio recordings featuring music; Pre-recorded CDs and DVDs featuring music; electronic downloadable publications, namely, books, cartoon drawings, comics, film and television scripts in the fields of music and entertainment; downloadable series of fiction books</p> <p>Class 016. First use: First Use: None First Use In Commerce: None series of fictions books; comics</p> <p>Class 041. First use: First Use: None First Use In Commerce: None Entertainment, namely, an ongoing series featuring animation provided through television, satellite, cable television, internet, webcasts, audio and video media; Entertainment services in the nature of development, creation, production, distribution, and post-production of motion pictures, television shows, multimedia entertainment content; entertainment information; Non-downloadable electronic publications in the nature of books, comics, graphic novels in the fields of fiction and music</p>		

Attachments	DIABLO Notice of Opposition - Final 12-12-22.pdf(113539 bytes )
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Signature	/Chintan A. Desai/
Name	Chintan A. Desai
Date	12/12/2022

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

LACE UP, LLC,	)	
	)	
Opposer,	)	Opposition No. _____
	)	Mark: DIABLO
	)	Serial No. 90007210
v.	)	Published: June 14, 2022
	)	
	)	
FOX MEDIA LLC,	)	
	)	
Applicant.	)	
	)	
	)	

**NOTICE OF OPPOSITION**

Opposer, Lace Up, LLC, a limited liability company organized and existing under the laws of Delaware, with a principal place of business at 5510 Merrick Road, Massapequa, New York 11758 (“Opposer”), believes that it will be damaged by registration of the mark DIABLO shown in U.S. Trademark Application Serial No. 90007210 (“the Application”), and hereby opposes the same.

To the best of Opposer’s knowledge, the name of Applicant is Fox Media LLC, a limited liability company organized under the laws of Delaware, with a principal place of business at 10201 West Pico Boulevard, Los Angeles, California 90035 (“Applicant”).

The grounds for opposition are as follows:

1. Opposer, through its predecessors, affiliates, licensees, business units and itself has used the HOTEL DIABLO Mark in interstate commerce on or in connection with its activities as a performer, musician, singer and songwriter since at least as early as July 5, 2019.

2. In addition to the common law rights in Opposer's HOTEL DIABLO Mark, Opposer owns United States Trademark Application Serial No. 90434888 for HOTEL DIABLO (the "HOTEL DIABLO Application"), filed on December 30, 2020, in connection with *inter alia* musical sound recordings in International Class 9; comic and fiction books in International Class 16; and entertainment services in International Class 41.

3. Opposer has developed extensive goodwill and consumer recognition through its use of the HOTEL DIABLO Mark and the extensive advertising and promotion of goods and services Opposer sells under the HOTEL DIABLO Mark.

4. Applicant filed U.S. Trademark Application Serial No. 90007210 (the "DIABLO Application") for the mark DIABLO (the "DIABLO Mark") on June 17, 2020, based on an intent to use the DIABLO Mark in commerce in connection with "Stationery; stickers; bookmarks; greeting cards; postcards; pens and pencils; temporary tattoo transfers; address books; date books; photographs; photo albums; paper folders; printed paper doorknob hangers; table cloths made of paper and paper napkins; lunch bags made of paper; wrapping paper; paper gift bags; comic books; trading cards, other than for games; series of fiction books; children's books; children's activity books; coloring books; cardboard stand-up cutouts featuring photographs or artwork; all of the foregoing in connection with an animated, dog-like character" in International Class 16.

5. The DIABLO Application was cited by the USPTO against the HOTEL DIABLO Application on the grounds of a potential likelihood of confusion, and examination of the HOTEL DIABLO Application was suspended as a result.

6. The DIABLO Application was published for opposition in the Official Gazette on June 14, 2022. On July 10, 2022, Opposer requested and the USPTO granted a 30-day extension of time to oppose the DIABLO Application. On August 8, 2022, Opposer requested and the USPTO granted a 60-day extension of time to oppose the DIABLO Application. On October 11, 2022, Opposer, with Applicant's consent, requested and the USPTO granted a final 60-day extension of time to oppose the DIABLO Application.

7. At the time of filing the DIABLO Application, Applicant had at least constructive notice of the HOTEL DIABLO Mark.

8. The HOTEL DIABLO Mark has priority of use over the DIABLO Mark.

9. The DIABLO Mark is confusingly similar in overall commercial impression to the HOTEL DIABLO Mark. Specifically, both marks contain the identical element DIABLO.

10. The goods covered by the DIABLO Application in International Class 16 are related to and will move in the same channels of trade as the Class 16 goods covered under the HOTEL DIABLO Mark.

11. Because of the similarity between the DIABLO Mark and the HOTEL DIABLO Mark, and because the goods covered under the DIABLO Application are related to the goods sold under the HOTEL DIABLO Mark, consumers are likely to be confused, mistaken, or deceived into believing that Applicant's goods originate with

Opposer or are in some way associated with or connected, sponsored, or authorized by Opposer.

12. The DIABLO Application should be precluded on the grounds of Opposer's prior use of the HOTEL DIABLO Mark because Applicant's use of the DIABLO Mark is likely to cause confusion or mistake in the minds of the public and/or to lead the public and prospective purchasers to believe that Applicant's goods are those of Opposer, or that Opposer's Class 16 goods are those of Applicant, and/or that Applicant and/or Applicant's goods are endorsed or sponsored by, or are otherwise affiliated or connected with Opposer, all to the damage of Opposer.

WHEREFORE, Opposer requests that Application No. 90007210 be precluded, and that this opposition be sustained in favor of Opposer.

Respectfully submitted,

OFFIT KURMAN, P.A.

Dated: December 12, 2022

By /s/ Chintan A. Desai

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