

ESTTA Tracking number: **ESTTA1047959**

Filing date: **04/08/2020**

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	Chris W. Taylor Jr.
Granted to Date of previous extension	04/08/2020
Address	C/O LEWIS KENT LLP 235 MONTGOMERY STREET, 30TH FLOOR SAN FRANCISCO, CA 94104 UNITED STATES
Attorney information	MARINA A. LEWIS LEWIS KENT LLP 235 MONTGOMERY STREET, 30TH FLOOR SAN FRANCISCO, CA 94104 UNITED STATES docketing@lewiskentllp.com (415) 966-3402

Applicant Information

Application No	88125640	Publication date	12/10/2019
Opposition Filing Date	04/08/2020	Opposition Period Ends	04/08/2020
Applicant	Three Frog, LLC Suite 200 6087 Jackson Road Ann Arbor, MI 48103 UNITED STATES		

Goods/Services Affected by Opposition

Class 028. First Use: 2014/10/02 First Use In Commerce: 2014/10/02 All goods and services in the class are opposed, namely: Dice boxes, namely, boxes specially adapted for storing dice; wooden boxes specially adapted for storing board game components or dice; board game and tabletopgame accessories, namely, accessories in the nature of boxes specially adapted for storing board game components or dice
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Grounds for Opposition

No use of mark in commerce before application or amendment to allege use was filed	Trademark Act Sections 1(a) and (c)
Failure to function as a mark	Trademark Act Sections 1, 2 and 45
The mark is not inherently distinctive and has not acquired distinctiveness	Trademark Act Sections 1, 2 and 45; and Section 2(f)

Attachments	Notice of Opposition for Hex Chest Design by Elderwood Academy as Filed.pdf(1064699 bytes)
Signature	/Marina A. Lewis/
Name	MARINA A. LEWIS
Date	04/08/2020

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

Chris W. Taylor, Jr. Opposer, v. Three Frog LLC, Applicant.	Opposition No.: (Not yet assigned) Interlocutory Attorney: (Not yet assigned) Application No.: 88/125,640 Mark: Miscellaneous Design Publication Date: December 10, 2019 NOTICE OF OPPOSITION
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Opposer Chris J. Taylor, Jr. (“Opposer”) believes that he will be damaged by the registration of the product design depicted in Application No. 88/125,640 (“the ‘640 Application”). Specifically, Opposer alleges that Applicant’s applied-for product configuration is ineligible for registration because Applicant’s product configuration is merely functional and therefore fails to serve as a source identifier for the relevant goods. Moreover, Applicant’s registration of a functional product design harms both Opposer and the consuming public at large because it would confer an unfair monopoly upon Applicant to which it is not entitled under law.

Opposer also alleges in the alternative that Applicant’s product design is ineligible for registration on the Principal Register because the applied-for product design is not inherently distinctive as a matter of law, and Applicant has failed to show the acquired distinctiveness and secondary meaning necessary to support registration. Finally, the product design is ineligible for registration because the mark was not in use in commerce on or before the filing date of the application. Therefore, Opposer hereby opposes this application on the following grounds.

Chris Taylor and His Hexagonal Box

1. Opposer is a citizen of the United States with a mailing address of Post Office Box 842, Edgewood, New Mexico 87015.

2. Opposer designs and sells dice boxes. Opposer sells his products through various online channels, including on social media and e-commerce sites like Thingiverse.

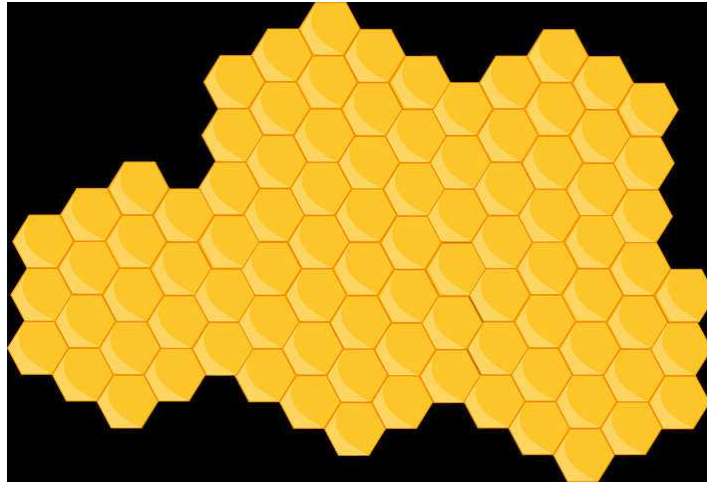
3. Opposer's designs are popular with players of the decades-old, multi-player role-playing game, Dungeons and Dragons (known affectionately by its players as "D&D"). D&D is a fantasy role-playing game played with a set of seven dice and a series of player cards. In D&D play, gamers will roll one or more of the dice and, based upon a given dice roll, will pick a card that assigns the player various moves. The dice used for D&D come in a variety of shapes, but the most-frequently used (and most iconic) is the 20-sided or "icosahedron" die, known in D&D parlance as the "D20." A D20 shown in two-dimensional view forms a hexagon, as shown below:



4. For decades, D&D fans have collected accessories and memorabilia designed for gameplay. Some of the most popular items are boxes designed to hold dice sets, and they range from the simplest boxes to exotic carrying cases. D&D dice boxes are made and sold in a variety of materials and shapes, and they often share similar characteristics designed to appeal to D&D gamers. For example, boxes commonly include seven pockets or slots to accommodate the seven-die dice sets used for gameplay. In addition, the pockets or slots are often shaped to fit the dice snugly in the box in order to prevent them from rolling around and knocking against each other. (D&D dice sets are often made of metal and fabricated with ornate designs, and can scratch easily if allowed to roll around inside a box. Therefore, gamers often seek out a box or case in which the dice will fit snugly to prevent scratching or other damage.)

5. Hexagon shapes are also quite popular, as the hexagon shape perfectly accommodates the D20 die, along with the other dice required for play.

6. Seven hexagons arranged together side-by-side will form one large hexagon, known in geometry as a “tessellation.” A naturally-occurring example of a hexagonal tessellation is a honeycomb:



7. Opposer’s dice boxes, like those of other sellers and players, were designed specifically with these factors in mind. For example, Opposer’s dice box includes exactly seven spaces for each of the dice in a D&D set, and each space is in the shape of a hexagon in order to accommodate the D20 die, regardless of which space the player places the die. The configuration of the hexagonal tessellation, such as that depicted in Opposer’s dice box, is the most efficient way to arrange the seven dice slots within a singular container.

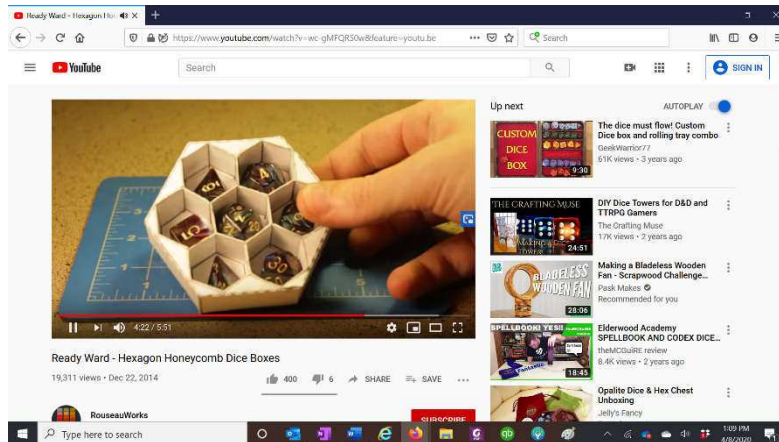
8. Opposer has been designing and fashioning these types of hexagon tessellation-shaped dice boxes for literally decades. Opposer began crafting his hexagonal tessellation-shaped boxes back in the mid-1990’s after seeing a similar box used as a model in a woodworking class. (This third-party box which Opposer used as his model was, in turn, made several years prior to the time Opposer began crafting his own boxes.) Opposer then began

selling his boxes casually to customers upon request, for which he charged a modest sum to compensate Opposer for his time and materials.

9. Originally, Opposer crafted his boxes from wood. Over time, Opposer began crafting boxes from wood-filled PLA, a composite of plastic and wood fibers, due to the material’s popularity with customers. Later still, Opposer began developing his boxes using 3D printing. Photos depicting Opposer’s designs and products appear below:



10. Over the years, others have put their own spin on the hexagon dice box used in D&D play. For example, a seller by the name of “Mr Rousseau” has been producing a template for making a hexagon dice box out of cardstock since at least December 2014:



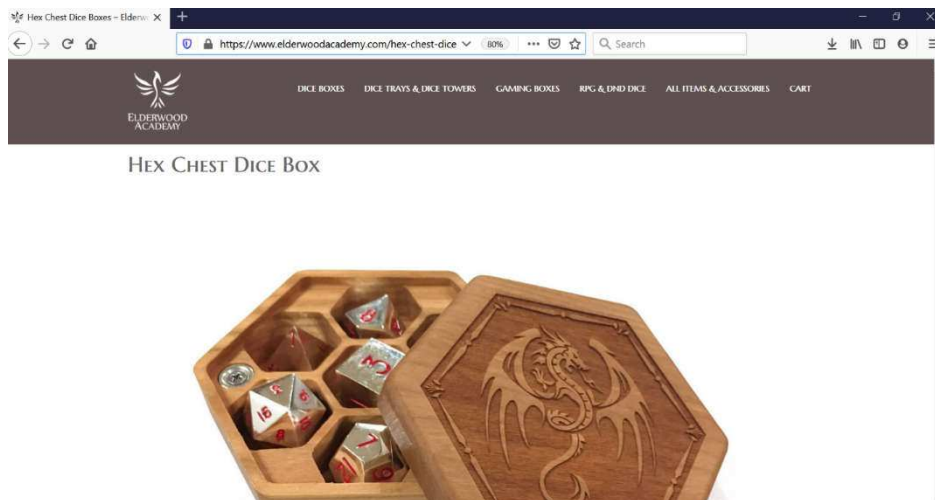
11. Knowing that the functional aspects of his boxes are common within the D&D universe, Opposer has never sought trademark or copyright protection for the general shape and configuration of his boxes, and was not aware of any other maker or seller seeking such a monopoly, prior to being notified of Applicant’s filing at issue in this proceeding.

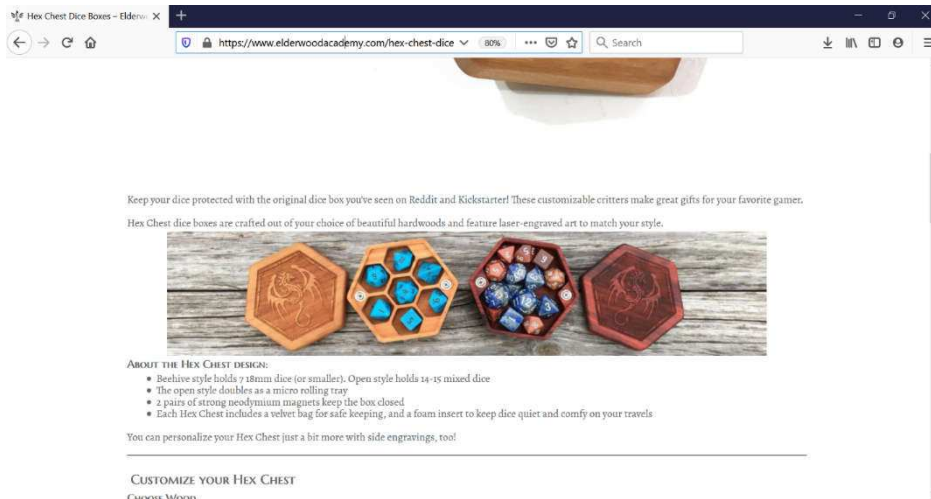
Elderwood Academy and its Activities

12. According to the USPTO file history for the ‘640 Application, Applicant Three Frog, LLC is a Michigan Limited Liability Company with a principal place of business at 6087 Jackson Road, Ann Arbor, Michigan, 48103.

13. According to its website at www.elderwood.com (the “Elderwood Website”), Elderwood Academy was founded by principals Quentin Weir and Daniel Reiss.

14. According to the Elderwood Website, Elderwood sells products and gifts related to role-player gaming (including D&D) such as dice boxes and dice trays. Included among Applicant’s product offering is a hexagon-shaped dice box featuring a 7-compartment “beehive” interior which Applicant refers to as its “Hex Chest” box. Below are screenshots from the Elderwood Website that depict its “Hex Chest” box holding the 7 dice required for D&D gameplay:





15. According to the Elderwood Website, the “beehive” interior for its Hex Chest product “holds 7 18mm dice (or smaller)”, and photos displayed at the website description for the box feature typical D&D dice sets. A separate page on the Elderwood Website titled “RPG [“Role-Playing Game”] & DND Dice features several sets of dice designed for D&D play, including those featured in the photos depicting the Hex Chest boxes. In fact, the product page for the “Mini Phoenix Dice” set states that the dice are “a perfect companion for your Mini Hex Chest.” By all accounts, it appears the boxes are intended for use with D&D gaming, and are marketed in such a way as to highlight the functional aspects of the box in terms of accommodating D&D dice sets specifically.

16. According to the USPTO file history for the ‘640 Application, the applied-for mark appears directed to the design of Applicant’s Hex Chest box with its “Beehive” interior. Specifically, the drawing page of Applicant’s Mark depicts a hexagonal tessellation described as “a three-dimensional configuration of the interior of a hex shaped box with a honeycomb configuration of seven interior hexagonal indentations on the bottom of the box and the design of a six point star, having flat points.”

17. On January 16, 2019 Opposer received a notification from Thingaverse that his listings had been removed in response to a complaint filed by Applicant under the Digital Millennium Copyright Act (DMCA). This complaint was filed on behalf of Quentin Weir and alleged that Opposer's Thingaverse listing "infringe[s] on our sculptural copyright of our Hex Chest dice boxes." Applicant's complaint asserted both trademark and copyright ownership of the hexagonal tessellation depicted in both Opposer's boxes and its own, despite the fact that Applicant had no issued trademark registration and no issued copyright registration. Instead, Applicant's complaint asserted only the serial number from the published trademark application now at issue in this opposition and a "case number" (U.S. Copyright Appln. Case No. 1-6886106851) assigned by the U.S. Copyright Office during examination of Applicant's alleged copyright application filing. Despite Opposer's claim in its DMCA notice that it "own[s] the Copyright to the sculptural design of Hex Chest products", Opposer has not located any evidence from the U.S. Copyright Office to indicate that any copyright registration has issued from this application, and Opposer is not aware of any statutory rights Applicant possesses to the hexagon configuration, despite Applicant's assertion to the contrary.

18. In response to Applicant's complaint, Opposer filed a "counter-notice" under the DMCA on January 17, 2019, pointing out that Applicant did not, in fact, possess rights in trademark or copyright, and that his listings were removed in error. Thingaverse immediately reinstated Opposer's product listings. Copies of Applicant's DMCA take-down notice and Opposer's response are attached as Exhibit A.

19. On December 5, 2019, Opposer received notice from Thingaverse that his listings were again being suspended, this time based on a complaint brought by Applicant under Thingaverse's "Other IP Rights Violation" policy. Applicant's second complaint contained essentially the same facts and allegations as Applicant's earlier complaint, although this time

Applicant filed the complaint in the name of its principal Daniel Reiss. Once again, Applicant asserted proprietary rights to the hexagonal configuration of Opposer’s dice boxes based on its filing of the ‘640 Application, which Opposer falsely characterized as “granted” – despite the fact that Opposer’s application had not yet passed the required publication period and was not yet approved for registration by the Trademark Office.

20. On December 16, 2019, Opposer submitted another counter-notice to Thingaverse, again stating that Applicant did not possess statutory rights in either copyright or trademark to the functional aspects of the dice boxes sold by Applicant, Opposer, or others. Shortly thereafter, Thingaverse again reinstated Opposer’s sales listing on their platform. Copies of Applicant’s Other IPR take-down notice and Opposer’s response are attached as Exhibit B.

21. After securing reinstatement of his Thingaverse listings, it was then that Opposer learned of Applicant’s trademark filing and Applicant’s further attempts to gain an unfair monopoly on hexagonal tessellation-shaped dice boxes. Opposer also learned from his review of industry comments that Opposer was targeting other sellers of similar box designs with its bogus claims of exclusive ownership of the hexagon tessellation box design.

22. Fearing that he and others would continue to be targeted by Opposer’s anti-competitive bullying, Opposer filed this Notice of Opposition.

Count One
Failure to Function as a Mark
(Trademark Act Sections 14(1) and 1, 2, and 45)

23. Opposer repeats and realleges each and every allegation set forth in each of the preceding paragraphs.

24. The product design depicted in the ‘640 Application contains several key features which are merely functional, including a) the use of exactly seven (7) slots to hold the seven (7) dice used for D&D play, b) hexagonal-shaped slots to accommodate the D20 and other

polygonal dice used in D&D play, and c) an overall configuration of seven (7) hexagonal-shaped slots that form a hexagonal tessellation.

25. In view of the functional aspects of Applicant's product, Applicant's product design fails to function as a source identifier for the relevant goods and is therefore ineligible for registration as a trademark on either the Principal or Supplemental Register.

26. Opposer possesses standing to bring this action under this count because Opposer will be damaged by the registration of the applied-for mark. The registration of the '640 Application would essentially grant Applicant an unfair monopoly on the use of a hexagonal tessellation for the interior of a box design, and would exclude Opposer and other sellers from using this functional and utilitarian design for their own products. Moreover, Opposer has already been targeted by Applicant twice before when Applicant attempted to remove Opposer's products from Thingaverse. Because Applicant has already attempted to use its filing as a weapon to disrupt Opposer's business, Opposer has good reason to fear that Applicant's anticompetitive behavior will intensify upon registration of the '640 Application.

Count Two
Lack of Acquired Distinctiveness
(Trademark Act Sections 14(1) and 2(e)(1))

27. Opposer repeats and realleges each and every allegation set forth in each of the preceding paragraphs.

28. In the alternative, and in the event Respondent's mark could ever be perceived as a source identifier, Applicant's product design is not eligible for registration on the Principal Register under Section 2(f) because Applicant has not made continuous and substantially exclusive use of the product design.

29. Applicant and other third-parties have been using the hexagonal tessellation design in their own products prior to both the filing date of the '640 Application and the date upon which Applicant claims to have acquired secondary meaning in its product configuration.

30. In view of this third-party prior use of the hexagon tessellation, Applicant has failed to demonstrate continuous and substantially exclusive use of the hexagonal tessellation design as a trademark for the relevant goods. As such, consumers do not view the applied-for mark as a source identifier for the goods, and the '640 Application is therefore ineligible for registration on the Principal Register under Section 2(f).

31. Opposer possesses standing to bring this action under this count because Opposer will continue to be damaged by the registration of Applicant's product design. Opposer has already been the subject of two take-down notices, and although Opposer successfully had his listings reinstated, there is a genuine concern that Applicant will continue to bully and pressure others like Opposer on the basis of this filing, notwithstanding the fact that Applicant has failed to make the required showing of acquired distinctiveness.

Count Three
No Bona Fide Use in Commerce
(Trademark Act Sections 14(1) and 1(b) and 1(c))

32. Opposer repeats and realleges each and every allegation set forth in each of the preceding paragraphs.

33. Applicant filed the present application on September 20, 2018. According to the USPTO file history, Applicant asserted a date of first use in commerce of October 2, 2014. However, upon information and belief, Applicant only began soliciting funds to launch its product on its Kickstarter website in 2017. Although alleging an incorrect date of first use is not grounds to oppose Applicant's filing per se, Opposer has reason to believe that Applicant's product design may not have been in use as of the date of filing of the '640 application.

Therefore, Opposer alleges that Applicant's applied-for mark was not in use in federal commerce as of the filing date of the application and is therefore not entitled to registration under Section 1(a).

WHEREFORE, Opposer respectfully requests that this opposition be granted and that Applicant's application be permanently abandoned. A filing fee for this Notice of Opposition is being submitted electronically.

Respectfully submitted,



Dated: April 8, 2020

By:

Marina A. Lewis
LEWIS KENT LLP
235 Montgomery Street, 30th Floor
San Francisco, CA 94104
Telephone: (415) 966-3402

Attorneys for Opposer
Christopher Taylor

EXHIBIT A

From: MakerBot Thingiverse no-reply@thingiverse.com
Subject: Content Removal Request
Date: January 14, 2019 at 4:20 PM
To: dmca@makerbot.com



Date: 01/14/2019

Dear Sir or Madam:

I, the undersigned, represent that the information in this notification is accurate and CERTIFY UNDER PENALTY OF PERJURY that I am the owner or an agent authorized to act on behalf of the owner of certain intellectual property, said owner being named **Quentin Weir** ("Owner"). I have a good faith belief that the materials identified below are not authorized by the above Owner, its agent, or the law and therefore infringe or violate the Owner's rights. Please act expeditiously to remove or disable access to the material or items claimed to be infringing or violating Owner's rights

Description of the infringing or unauthorized issues

The works infringe on our sculptural copyright of our Hex Chest dice boxes. Current and original examples can be found below: <https://www.elderwoodacademy.com/hex-chest-dice-boxes/> <https://www.kickstarter.com/projects/1584169644/hex-chests>

Identification of the material on our services that you claim is infringing and that you request us to remove. Include the URLs or Thing IDs for the content in question

<https://www.thingiverse.com/thing:3248479> <https://www.thingiverse.com/thing:2852404>
<https://www.thingiverse.com/thing:2933303> <https://www.thingiverse.com/thing:2964781>
<https://www.thingiverse.com/thing:3074181> <https://www.thingiverse.com/thing:3062079>
<https://www.thingiverse.com/thing:2703906> <https://www.thingiverse.com/thing:3338119>
<https://www.thingiverse.com/thing:2870278>

Please explain why the above identified material is unlawful. Include identification of the work(s) or rights that you claim to have been infringed, including any link or other identifying information to the work or rights in question, and any additional information regarding alleged infringement that may be relevant.

We believe the items above infringes Three Frog LLC dba Elderwood's intellectual property, including Copyright (case number 1-6886106851) and Trade Dress (serial number 8812564) for hex shaped dice boxes with beehive interior designs. We understand that there is no ill will at work here and this is likely an honest mistake, but Elderwood is obligated to enforce its intellectual property. We own the Copyright to the sculptural design of Hex Chest products, including the interior beehive design, and we further own the Trade Dress rights over the same aesthetic Hex Chest shape with the beehive interior design. Elderwood Academy was the first to create and sell this unique and the original Hex Chest design in 2014. Our designs are frequently imitated and those imitations may create the perception that the designs are open to broader use without license or permission. We ask that you respect this notice and remove the named items from the store. Thank you! <3 Quentin and Dan

I may be contacted at:

Quentin Weir
6087 jackson road, suite 200
Ann Arbor Michigan 48103
elderwoodboxes@gmail.com

7346571665 Fax:

The DMCA Takedown request provided by 3 trees is unlawful. not only is it unlawful its explicitly unlawful and they are previously aware that their actions are unlawful making their actions potentiall criminal in nature and punishable under the law

Trade Dress can not be applied

In the United States, the “functionality” doctrine exists to stop a party from obtaining exclusive trade dress or trademark rights in the functional features of a product or its packaging. The doctrine developed as a way to preserve the division between what trademark law protects and areas that are better protected by patent or copyright law. Thus, the functionality doctrine serves to prevent trademark owners from inhibiting legitimate competition

they can not trade dress the "basic concept" of a hex hole in a hex shape. this is specifically excluded from trade dress protection.

Copyright protecton

they have no valid copyright for my object

<https://www.copyright.gov/title17/92chap13.html>

copyright law is explicit and very clear. you can not copyright staple or commonplace things such as a standard geometric figure..... such as a HEXAGON box with HEXAGON HOLES. Period. this is clear and explicit.

their "claim" violates 1, 2, 3, & 4 of the points laid out in 1302 of title 17 92 chapter 13.

it would be pretty difficult to come up with something more explicitly "not permitted" copyright protection under US law.

the hexagon shape with hexagon holes is the very essence of 1302 in every respect.

Their only recourse for intellectual protection is PATENT and this would be disqualified from patent protection due to extensive prior art. which is why they are attempting this bully tactic of invalid and unlawful copyright and trade dress protection.

This is malicious and intentional as it took but 30 seconds of searching to find the relevant law regarding this issue such that its impossible that they are unaware of it on top of the fact that I LIST this in my thing listing (which makerbot ignored) and informed them of their invalid claims in advance. making their unlawful use of the DMCA system intentional and malicious in violation of US Federal law.

The penalties for misrepresentation can include actual damages and attorney’s fees. Specifically, Section 512(f) of the DMCA states that three frogs and quentin weir personally shall be liable for any damages, including costs and attorneys’ fees, incurred by the alleged infringer, by any copyright owner or copyright owner’s authorized licensee, or by a service provider, who is injured by such misrepresentation, as the result of the service provider relying upon such misrepresentation in removing or disabling access to the material or activity claimed to be infringing, or in replacing the removed material or ceasing to disable access to it.

I am also unable to locate their non existant copyright case number. the US Government copyright office has no record of 1-6886106851 or 8812564

I expect my content to be restored immediately.

EXHIBIT B

From: MakerBot Thingiverse no-reply@thingiverse.com
Subject: {Legal} Content Removal Request
Date: December 5, 2019 at 2:08 PM
To: legal@makerbot.com

Date: 12/05/2019

Dear Sir or Madam:

I, the undersigned, represent that the information in this notification is accurate and CERTIFY UNDER PENALTY OF PERJURY that I am the owner or an agent authorized to act on behalf of the owner of certain intellectual property, said owner being named **Daniel Reiss** ("Owner"). I have a good faith belief that the materials identified below are not authorized by the above Owner, its agent, or the law and therefore infringe or violate the Owner's rights. Please act expeditiously to remove or disable access to the material or items claimed to be infringing or violating Owner's rights

Description of the infringing or unauthorized issues

Numerous iterations of designs directly reproduced from or based closely on our work, reproduced either without permission or after explicit requests not to reproduce the items in question. Item: Hex Chests (<https://www.elderwoodacademy.com/hex-chest-dice-boxes/>) Hex Chest Minis (<https://www.elderwoodacademy.com/mini-hex-chest-dice-boxes/>) Hex Chest Remastered (<https://www.elderwoodacademy.com/hex-chests-remastered/>)

Identification of the material on our services that you claim is infringing and that you request us to remove. Include the URLs or Thing IDs for the content in question

<https://www.thingiverse.com/thing:1877340> <https://www.thingiverse.com/thing:3788619>
<https://www.thingiverse.com/thing:2985773> <https://www.thingiverse.com/thing:3538436>
<https://www.thingiverse.com/thing:3179972> <https://www.thingiverse.com/thing:3052506>
<https://www.thingiverse.com/thing:3074181> <https://www.thingiverse.com/thing:2987216>
<https://www.thingiverse.com/thing:3925825> <https://www.thingiverse.com/thing:2449090>
<https://www.thingiverse.com/thing:2985773> <https://www.thingiverse.com/thing:2292526>
<https://www.thingiverse.com/thing:1875077> <https://www.thingiverse.com/thing:3248479>
<https://www.thingiverse.com/thing:3788619> <https://www.thingiverse.com/thing:3636149>
<https://www.thingiverse.com/thing:3751959> <https://www.thingiverse.com/thing:3770696>
<https://www.thingiverse.com/thing:3855128>

Please explain why the above identified material is unlawful. Include identification of the work(s) or rights that you claim to have been infringed, including any link or other identifying information to the work or rights in question, and any additional information regarding alleged infringement that may be relevant.

Trade Dress - serial number 88125640 (granted, pending finalization by the office of registration) - United States (classes 022, 023, 038, 050) and International (028 - Primary Class) - first used in 10/2014. Each of these items has been reproduced based on or as direct copies of works covered by Trade Dress (above) owned by Three Frog, LLC DBA Elderwood. We have notified numerous users on a recurring basis that we have fair and legal claims to the intellectual property associated with Hex Chests. Each item is either identical or confusingly similar to IP owned by Three Frog, LLC DBA Elderwood Academy.

I may be contacted at:

Daniel Reiss
6087 Jackson road, suite 200
Ann Arbor MICHIGAN 48103
info@elderwoodacademy.com

7346571665 Fax:



Re: {Legal} Unlawful copyright takedown



Inbox



Legal@makerbot.c... 12/17/2019



to core

Dear Chris,

Thank you for contacting us. Attached is a copy of the notice we received from Three Frog, LLC DBA Elderwood Academy claiming infringement of their trade dress, not copyright.

MakerBot
One MetroTech Center, 21st Floor
Brooklyn, NY 11201
makerbot.com | thingiverse.com

On Mon, Dec 16, 2019 at 8:35 PM Life of Nerys

< > wrote:

<https://www.thingiverse.com/thing:3248479>

My thing has been taken down again by the same company and person attempting to exert a copyright over a basic shape the copyright Office of the United States has already rejected their attempt to trademark and copyright a basic shape which is illegal under us copyright law

Please stop accepting requests from this company they've already violated the law of multiple times in for me when my object will be released and made visible again

Once again they are attempting to copyright a basic shape the concept of a hexagonal hole in a hexagonal box which as you've already seen in your documentation for they are illegally using their