

ESTTA Tracking number: **ESTTA91764**

Filing date: **07/26/2006**

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	Wally Boyko Productions, Inc.
Granted to Date of previous extension	07/26/2006
Address	P.O. Box 2490 White City, OR 97503 UNITED STATES

Attorney information	John E. Halamka Law Office of John E. Halamka P.O. Box 207 Palos Verdes Estates, CA 90274 UNITED STATES halamka@usc.edu Phone:310-316-6100
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Applicant Information

Application No	76622249	Publication date	03/28/2006
Opposition Filing Date	07/26/2006	Opposition Period Ends	07/26/2006
Applicant	Gem Consulting, Inc. 5933 S.E. Division Portland, OR 97206 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 2003/07/00 First Use In Commerce: 2003/07/00
All goods and services in the class are opposed, namely: Physical fitness Consulting

Attachments	Notice of Opposition 7-26-06.pdf (5 pages)(37349 bytes)
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Signature	/s/
Name	John E. Halamka
Date	07/26/2006

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

In the matter of trademark application Serial No.76622249
For the mark MISS FIT
Published in the Official Gazette on 2006-03-28

WALLY BOYKO PRODUCTIONS, INC.

v.

WORLDSTAR FITNESS, LLC

NOTICE OF OPPOSITION

Opposer, WALLY BOYKO PRODUCTIONS, INC., a corporation duly formed under the laws of the state of California, having an address of P.O. Box 2490, Whitecity, OR 97503 believes that it will be damaged by registration of the mark shown in Serial No. 76622249, and hereby opposes the same.

Description of Applicant's Application: Mark: MISS FIT, Filed on 29 November 2004. Published for Opposition in the Official Gazette of 28 March 2006 in Class 041 for physical fitness consulting and claims a first use on 2005-07-00.

The grounds for opposition are as follows:

- A. Opposer is the owner of a family of Registered Trademarks based on MS. FITNESS, opposer has adopted and continuously used the term MS. FITNESS under the following registrations, U.S. and foreign:
1. A registered service mark R1694920, issued June 16, 1992, Declaration under Sections 8&15 (6-yr) and Sections 8&9 (10-yr) accepted, in class 41 for its services FOR ORGANIZING AND CONDUCTING PHYSICAL FITNESS CONTESTS FOR WOMEN, (First use 15 May 1985), next renewal date, 16 June 2012;
 2. A registered service mark R1742268, issued 22 December, 1992, Declaration under Sections 8&15 (6-yr) and Sections 8&9 (10-yr) accepted, in class 16 for its goods periodicals: namely, newspapers and magazines containing articles of interest for those involved in physical fitness, (First use 1 June 1992), next renewal date 22 December 2012;

3. A registered mark R1753402, issued 16 February 1993, Declaration under Sections 8&15 (6-yr) and Sections 8&9 (10-yr) accepted, in class 41, for its services of health clubs for those involved in physical fitness, (First use 15 June 1992), next renewal date 16 February 2013;
4. A registered mark R1838750, issued 7 June 1994, Declaration under Sections 8&15 (6-yr) and Sections 8&9 (10-yr) accepted, in class 25 for its goods of exercise clothing; namely swim suits, tee shirts, sweat suits, caps, leggings, and arm bands for those involved in fitness, (First use 3 August 1993), next renewal date 7 June 2014;
5. A registered mark R2353093, issued 30 May 2000, in Class 5 for its goods of Dietary Supplements, (First use 17 February 1997), next renewal date 30 May 2006;
6. A registered mark (MS. FITNESS WORLD) R2252900, issued 15 June 1999, in class 41 for its services of organizing and conducting contests for women, (First use 16 June 1993), next renewal date 15 June 2009;
7. A foreign Registration in Canada, TMA 457,680, issued 24 May 1996, in International class 3, cosmetics, namely lotions; International classes 16, periodicals, namely, newspapers and magazines containing articles of interest for those involved in physical fitness, 25, exercise clothing; namely, swim suits, sweat suits, caps, leggings, and arm bands for those involved in fitness, International class 28 exercise equipment, namely manually operated exercise equipment and 41 for organizing and conducting physical contests for women and for health clubs for those involved in fitness for the mark MS. FITNESS, next renewal date 24 May 2011;
8. A foreign Registration in the ECC, 000777318, issued 30 March 1998, in International classes 16, printed matter, periodical publications, magazines, books, photographs, posters and calendars, 25, Articles of clothing including footwear, and 41, for organizing and conducting entertainment and sporting contests and competitions; operation of sports clubs and exercise clubs for the mark MS. FITNESS, renewal date is 20 March 2008;
9. A foreign Registration in the United Kingdom, UK1539348 issued 31 October 1994 in International class 16, for publications: printed matter; books; magazines; stationery; instructional and teaching material for the mark MS. FITNESS;
10. A foreign Registration in the United Kingdom, UK 1539349 issued 19 July 1993 in International class 25, for swim suits, sweat suits, caps, leggings, arm bands; all for use in fitness training for MS. FITNESS, renewed and scheduled for further renewal 19 June 2010;
11. A pending application in the U.S. as Serial No. 78/606,503, filed 16 May 2005 for the mark MISS FITNESS in international class 41 for its services of promoting and conducting contests for physical fitness for women, (first use 12 October 1993 amended to 16 November 1985);
12. A pending application in the U.S. as Serial No. 78/630,877, filed 16 May 2005 for the mark MISS FITNESS in international class 42 for its services of health and fitness clubs for women, (First use 15 March 2003);

13. A pending application in the U.S. as Serial No. 78/730, 787, filed 11 October 2005 for registration of the mark MISS (sic) MS. FITNESS USA, in International Class 41, for Entertainment services, namely, arranging and conducting of competitions for physical fitness for women based on a first use of 15 June 1988.

14. Opposer has active domain names that promote contests and information of interest involving fitness for women:

Msfitness.proboards15.com;
www.missfitness.com;
www.msfitness.com;
www.msfitness.net;
www.msfitness.org;
www.NationalFitnessTradeShow.com; and,
www.NFTJWeb.com.

B. Opposer is informed and believes that Applicant had actual notice of Opposer's use, registrations and pending applications except for Serial No. 78/606,503, 78/630,877 and 78/730,787 before Applicant filed its application Serial No. 78/502,323 on 19, October 2004.

C. Opposer has not notified applicant of its claims to the use of the mark MS. FITNESS but believes applicant had actual notice of opposer's extensive presence in the marketplace.

D. On information and belief, opposer alleges that there is no entity in the United States or Canada using MS. FITNESS or MISS FITNESS for conducting formal fitness contests for women or any other good or service such as physical fitness consulting without licensing from opposer with the exception of applicant's recent use of MISS FITNESS to sell titles based on mere application and payment for a title with no contest between participants.

E. Since applicant's initial use of the aforementioned service and trademarks, Opposer has made substantial investment in advertising and promoting its services, especially FOR ORGANIZING AND CONDUCTING PHYSICAL FITNESS CONTESTS FOR WOMEN in class 41 in the United States, Europe, South America and world wide as broadcast by Fox Sports Network, and because the term MS. is not an internationally recognized term, the use internationally has been under the equivalent term MISS in the translation used for broadcast in countries other than the U.S. Opposer has also broadcast contests on the EUROSPORT network under unregistered marks such as MISS FITNESS USA since at least as early as 1996.

F. Since applicant's initial use of the aforementioned service and trademarks, Opposer has made substantial investment in advertising and promoting its services, especially for its goods of periodicals: namely, newspapers and magazines containing articles of interest for those involved in physical fitness in class 16 in the United States,

Europe, South America and world wide reporting on contests such as MS FITNESS USA. Many of the articles and information teach physical fitness consulting.

G. Since applicant's initial use of the aforementioned service and trademarks, Opposer has made substantial investment in advertising and promoting its services, especially for its goods of swim suits, sweat suits, caps, leggings, arm bands; all used in fitness training in class 25 in the United States, Europe, South America and world wide.

H. Since applicant's initial use of the aforementioned service and trademarks, Opposer has made substantial investment in advertising and promoting its services, especially for its service of health clubs for those involved in physical fitness in class 41 in the United States, Europe, South America and world wide.

I. Since applicant's initial use of the aforementioned service and trademarks, Opposer has made substantial investment in advertising and promoting its goods, especially for its dietary supplements in class 5 in the United States, Europe, South America and world wide.

J. Notwithstanding Opposer's rights in and to the MS. FITNESS service and trademarks, on 19 October 2004, applicant filed an application for the registration of the confusingly similar service mark MISS FIT for use in conjunction with the services of physical fitness consulting services in class 41. The application was assigned Serial Number 7622249 and was published for opposition in the Official Gazette of 28 March 2006.

K. Opposer on information and belief alleges that applicant's mark is confusingly similar to opposer's family of marks and such activity dilutes Opposer's actual judged competitions with resulting physical fitness consulting and is merely palming off opposer's services all to the damage of Opposer's good name and good will.

L. Because of Opposer's continuous use extensive promotion, Opposer is recognized in the general public as well as the fitness community as the founder of the concept and contests of fitness for women and consulting to attain physical fitness for health and competition.

M. Applicant's mark is confusingly similar to the family of registered marks and pending applications for the mark of the Opposer, and the use by Applicant of the mark MISS FIT in conjunction with the physical fitness consulting services in class 41 is thereby likely to cause confusion or mistake or to deceive within the meaning of Section 2(d) of the Trademark Act of 1946, thereby damaging the Opposer.

N. Specifically, purchasers, prospective purchasers, and other consumers of Opposer's Services and Goods are likely to be confused, mistaken or deceived into the belief, contrary to fact, that Applicant's services provided under its MISS FIT mark emanate from and/or are in some way sponsored by or approved by Opposer or are

otherwise related to Opposer's goods and services which bear the Opposer's MS. FITNESS service and trademarks, thereby damaging Opposer.

O. Opposer has expanded to world wide use of the family of MS. FITNESS marks into countries that do not recognize the meaning of the term MS. and therefore has used the term MISS instead in the family of marks.

P. Applicant is not lawfully entitled to the registration that it seeks for the reason that its mark so resembles Opposer's Service and Trademarks for its service and goods as to be likely to cause confusion or mistake or to deceive.

Q. If Applicant were granted a registration for the mark herein opposed, it would obtain thereby at least prima facie exclusive right to use such mark. Such registration would be a source of damage and injury to Opposer and Opposer's customers.

R. A duplicate copy of this Notice of Opposition is submitted herewith.

Please charge the deposit account of John E. Halamka, Deposit Account No. 080207, for the \$300.00 filing fee.

Dated July 26, 2006

Respectfully submitted,
/s/

John E. Halamka
P.O. Box 207
Palos Verdes Estates, CA 90274
310-316-6100
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WHEREFORE, Opposer prays that said application Serial No. 76622249 be rejected, that no registration be issued thereon to applicant, and that this opposition be sustained in favor of Opposer.

Opposer hereby appoints John E. Halamka, a sole practitioner and member of the bar of the State of California as well as registered to practice before the Patent Bar, to act as attorney for opposer herein, with full power to prosecute said opposition, to transact all relevant business with the Patent and Trademark Office and in the United States Courts and to receive all official communications in connection with this opposition.

Opposer: Wally Boyko Productions, Inc.

By _____/s/_____

Wally Boyko

President

Date: July 26 2006