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

Proceeding	91201448
Party	Defendant Wally Boyko Productions, Inc.
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Date	01/09/2012
Attachments	answer and counterclaim.pdf ( 8 pages )(113515 bytes )

**Registrations Subject to the filing**

Registration No	3597038	Registration date	03/31/2009
Registrant	MISS WORLD LIMITED CHANNEL ISLANDS 31 PIER ROAD ST. HELIER, JE		

**Goods/Services Subject to the filing**

Class 036. First Use: 1999/04/00 First Use In Commerce: 1999/04/00  
All goods and services in the class are requested, namely: CHARITABLE FUND RAISING SERVICES

Registration No	3587128	Registration date	03/10/2009
Registrant	MISS WORLD LIMITED 31 Pier Road CHANNEL ISLANDS ST. HELIER, JE		

**Goods/Services Subject to the filing**

Class 041. First Use: 1999/04/15 First Use In Commerce: 1999/04/15  
All goods and services in the class are requested, namely: Entertainment in the nature of beauty pageants, beauty pageant awards shows,spokesmodel talent competitions, and fashion shows

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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**MISS WORLD LIMITED,**

Opposer,

v.

**WALLY BOYKO PRODUCTIONS,  
INC.,**

Applicant.

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Opposition No. **91201448**

Application Serial No. 77/947644

Mark: MS. FITNESS WORLD

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**ANSWER AND COUNTERCLAIMS**

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Wally Boyko Productions, Inc. (“WBP”), through its undersigned counsel, responds as follows to the Notice of Opposition filed by Miss World Limited (“Opposer”):

1. WBP lacks knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 1.
2. WBP lacks knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 2.
3. WBP lacks knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 3.
4. WBP lacks knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 4.
5. WBP denies the allegations set forth in paragraph 5.

6. WBP lacks knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 6.

7. WBP denies the allegations set forth in paragraph 7.

8. WBP denies the allegations set forth in paragraph 8.

9. WBP denies the allegations set forth in paragraph 9.

10. WBP denies the allegations set forth in paragraph 10.

11. WBP denies the allegations set forth in paragraph 11.

#### AFFIRMATIVE DEFENSES

1. Opposer fails to state a claim upon which relief may be granted.

2. WBP's applied-for mark is not likely to be confused with any registered trademark asserted by Opposer and therefore is registrable.

3. The requested relief is barred by the equitable doctrines of laches, estoppel and/or acquiescence. WBP has been using the identical mark in connection with organizing and conducting physical fitness contests for women since at least as early as 1993, and held Federal Registration Number 2,252,900 for that mark (which registration inadvertently was allowed to lapse by WBP). Applicant owns other registrations for the related marks MS. FITNESS (Reg. Nos. 1,694,920; 1,742,268; 1,753,402; and 1,838,750), MS. FITNESS USA (Reg. No. 3,183,228), and MISS FITNESS (Reg. No. 3,317,157), and has used the MS. FITNESS mark since at least as early as 1985. At no time did Opposer object to or file any opposition to any of these previously registered marks. Because Opposer failed to take any action against WBP or its use of the MS. FITNESS WORLD mark for 18 years, or any of WBP's related marks for more

than 25 years, Opposer's present Opposition should be barred by the equitable doctrines of laches, estoppel and/or acquiescence.

4. Opposer is collaterally estopped from asserting that registration or use of the mark MS. FITNESS WORLD is likely to cause confusion with any of the marks held by Opposer. Although Opposer now alleges that "any use of a mark that involves a combination of the title or honorific such as "Ms.', 'Miss', or 'Mrs.', along with 'WORLD', in connection with competitions or pageants, is likely to be associated with Opposer," Opposer's predecessor in interest represented the exact opposite to the U.S.P.T.O. when responding to an office action in connection with the application to register the mark MS. WORLD—one of the marks Opposer cites in opposition to WBP's application. In that response, Opposer's predecessor in interest represented that "the marks MS. WORLD and MRS. WORLD" and "the marks MS. WORLD and MISS WORLD have different commercial impressions and are not likely to be confused." Moreover, Opposer's predecessor argued that "Registrations have been granted for many marks containing the word WORLD [for] pageant services." Indeed, Opposer's predecessor's statement to the U.S.P.T.O. specifically and expressly identified *WBP's mark MS. FITNESS WORLD as an example of "Previously Registered Marks Containing WORLD for Pageant Services" which marks co-exist **without confusion** with Opposer's marks MISS WORLD and MS. WORLD.*

5. WBP owns substantially similar registered marks for identical or substantially similar goods and/or services such that the pending Application causes no added injury to Opposer.

6. Opposer is barred from any relief by virtue of its agreement and course of conduct relative to WBP's long use of its mark.

7. WBP reserves its right to bring such other affirmative defenses as may become known during discovery in this proceeding.

WHEREFORE, WBP prays that this Opposition be dismissed with prejudice, its mark be allowed to mature to registration, and that it be awarded such other further relief as provided for by law.

### **COUNTERCLAIM PETITION FOR CANCELLATION**

WBP believes that it will be damaged by continued registration of Miss World Limited's ("MWL") Registration Nos. 3,597,038 and 3,587,128 for MS. WORLD for the respective services covered by those registrations.

As grounds for its Petition to Cancel, WBP alleges as follows:

1. MWL alleges ownership of Reg. Nos. 3,597,038 and 3,587,128 and has asserted them against registration of WBP's application for registration Serial No. 77/947644 for MS. FITNESS WORLD for "Providing recognition and incentives by the way of awards and contests to demonstrate excellence in the field of physical fitness for women."

2. Prior to MWL's adoption and use of the designation MS. WORLD, WBP used the mark MS. FITNESS WORLD in interstate commerce to denote the source of WBP's services relating to providing recognition and incentives by the way of awards and contests to demonstrate excellence in the field of physical fitness for women.

3. WBP owned U.S. Registration No. 2,252,900 for the mark MS. FITNESS WORLD for use in connection with organizing and conducting physical fitness contests for

women, and has used this mark continuously in commerce in connection with those services since as early as 1993. Recently, WBP inadvertently failed to timely renew this registration and as a result the registration was cancelled. Although it inadvertently allowed its registration to lapse, there was no interruption in WBP's use of the mark in commerce in connection with the services for which it had been registered, and there was no diminution of WBP's rights in its mark. Once WBP became aware that its registration mistakenly was allowed to lapse, it initiated the process to re-register its mark.

4. Seeking to take unfair advantage of the misfortune of others, MWL is using its junior registrations in an attempt to block WBP from correcting its error and re-registering its previously registered and long-used mark. MWL alleges that MWL's services covered by its Reg. Nos. 3,597,038 and 3,587,128 are substantially similar and related to WBP's services, and that the parties' marks are substantially similar and thus likely to cause confusion.

5. As indicated by Registration No. 3,597,038, MWL's first use date of the mark MS. WORLD in connection with charitable fundraising services was not until 1999, and, as indicated by Registration No. 3,587,128, MWL's first use date of the mark MS. WORLD in connection with entertainment in the nature of beauty pageants, beauty pageant awards shows, spokesmodel talent competitions, and fashion shows also was not until 1999. WBP's use of its MS. FITNESS mark thus predated MWL's use by 6 years. WBP holds a priority of rights over MWL.

6. Upon information and belief, at the time of the filing of the applications that matured into registrations Reg. Nos. 3,597,038 and 3,587,128, MWL or its predecessor in interest was aware of WBP's prior use of and rights in the MS. FITNESS WORLD mark, and

thus its representations to the Patent and Trademark Office that no person other than itself had the right to use a sufficiently similar mark to cause confusion was knowingly false when made. Indeed, in responding to an office action in connection with the application that ripened into Reg. No. 3,587,128, Opposer's predecessor in interest identified WBP's mark MS. FITNESS WORLD as an example of "Previously Registered Marks Containing WORLD for Pageant Services." Thus, upon information and belief, MWL's Reg. Nos. 3,597,038 and 3,587,128 were fraudulently obtained and maintained.

7. To the extent that the parties' concurrent registration and use of their respective marks is likely to cause confusion, as alleged by MWL, continued maintenance of MWL's Reg. Nos. 3,597,038 and 3,587,128 is harmful and causing damage to WBP, and should be cancelled.

WHEREFORE, WBP respectfully requests that this Opposition be denied, that U.S. trademark application number 77/947644 be registered, and U.S. trademark registration numbers 3,597,038 and 3,587,128 be cancelled.

Through undersigned counsel, WBP is filing this Answer and Petition for Cancellation with payment of the government fee of \$600.

Dated this 9th day of January, 2012.

LEVINE SULLIVAN KOCH & SCHULZ, L.L.P.



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Attorneys for  
WALLY BOYKO PRODUCTIONS, INC.

## CERTIFICATE OF SERVICE

I do hereby certify that on this 9th day of January, 2012, a true and correct copy of the foregoing **ANSWER AND PETITION FOR CANCELLATION** has been transmitted by United States Postal Service first class mail, postage prepaid, with a courtesy electronic copy also delivered by e-mail transmission, to:

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/s RobertPenchina