

ESTTA Tracking number: **ESTTA487387**

Filing date: **08/06/2012**

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	Showtime Networks Inc.
Granted to Date of previous extension	08/08/2012
Address	1633 Broadway New York, NY 10019 UNITED STATES

Attorney information	Mallory Levitt CBS Law 51 West 52nd Street New York, NY 10019 UNITED STATES trademarks@cbs.com, mallory.levitt@cbs.com, angela.lamorte@cbs.com
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**Applicant Information**

Application No	85291973	Publication date	04/10/2012
Opposition Filing Date	08/06/2012	Opposition Period Ends	08/08/2012
Applicant	Fraser, Gordon O Suite 284 44916 10th Street West Lancaster, CA 93534 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 009. All goods and services in the class are opposed, namely: Vending machines dispensing DVDs and video games; electronic displays, namely, digital signage
Class 035. All goods and services in the class are opposed, namely: Creating digital advertising and promotional campaigns for others

**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	2014877	Application Date	03/15/1995
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Registration Date	11/12/1996	Foreign Priority Date	NONE
Word Mark	FLIX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 038. First use: First Use: 1992/08/01 First Use In Commerce: 1992/08/01 television broadcasting services, cable television broadcasting services and subscription television broadcasting services		

U.S. Registration No.	3024247	Application Date	04/23/2001
Registration Date	12/06/2005	Foreign Priority Date	NONE
Word Mark	FLIX CLASSIC CLIPS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 038. First use: First Use: 2003/06/23 First Use In Commerce: 2003/06/23 TELEVISION BROADCASTING, CABLE TELEVISION, AND SATELLITE BROADCASTING OF TELEVISION PROGRAMS IN HIGH DEFINITION FORMAT</p> <p>Class 041. First use: First Use: 2003/06/23 First Use In Commerce: 2003/06/23 ENTERTAINMENT SERVICES, NAMELY, PRODUCTION AND DISTRIBUTION OF MOTION PICTURES AND TELEVISION SERIES IN THE FIELD OF COMEDY, MUSIC, DRAMA, DOCUMENTARIES AND SPORTING EVENTS FOR CABLE TELEVISION, AND SATELLITE TELEVISION AND TELEVISION BROADCASTING</p>		

U.S. Registration No.	3259285	Application Date	04/29/2005
Registration Date	07/03/2007	Foreign Priority Date	NONE
Word Mark	FLIX ON DEMAND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2005/04/30 First Use In Commerce: 2005/04/30 Education and entertainment services, namely, production and distribution of motion pictures; production of comedy, musical and dramatic television series, documentaries and sporting events rendered through the media of television, cable and satellite systems, and the Internet; distribution for others of comedy,		

	musical and dramatic television series, documentaries and sporting events rendered through the media of television, cable and satellite systems and the Internet
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U.S. Registration No.	3194926	Application Date	06/16/2004
Registration Date	01/02/2007	Foreign Priority Date	NONE
Word Mark	FLIX ON DEMAND		
Design Mark	<p style="text-align: center;"><b>FLIX ON DEMAND</b></p>		
Description of Mark	NONE		
Goods/Services	Class 038. First use: First Use: 2005/09/30 First Use In Commerce: 2005/09/30 Communication services, namely, transmitting pre-recorded streamed audio and video material through media of television, cable and satellite systems and the internet		

U.S. Registration No.	3194927	Application Date	06/16/2004
Registration Date	01/02/2007	Foreign Priority Date	NONE
Word Mark	FLIX ON DEMAND		
Design Mark	<p style="text-align: center;"><b>FLIX ON DEMAND</b></p>		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2005/09/30 First Use In Commerce: 2005/09/30 Education and entertainment services, namely, production and distribution of motion pictures; production of comedy, musical and dramatic television series, documentaries and sporting events rendered through the media of television, cable and satellite systems, and the Internet; distribution for others of comedy, musical and dramatic television series, documentaries and sporting events rendered through the media of television, cable and satellite systems and the Internet		

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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/ml/
Name	Mallory Levitt
Date	08/06/2012

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

**In the Matter of Application Serial No. 85/291,973  
Published in the Official Gazette on April 10, 2012**

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<b>SHOWTIME NETWORKS INC.,</b>	:	
	:	
<b>Opposer,</b>	:	<b>Opposition No. _____</b>
	:	
<b>-against-</b>	:	<b><u>NOTICE OF OPPOSITION</u></b>
	:	
	:	
<b>GORDON O. FRASER,</b>	:	
	:	
<b>Applicant.</b>	:	
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Showtime Networks Inc. (“Opposer”), a Delaware corporation, 1633 Broadway, New York, New York, 10019, hereby opposes the application of Gordon O. Fraser (“Applicant”) for registration of the trademark MY FLIX BOX bearing serial number 85/291,973 (the “Fraser Mark”), published in the Official Gazette on April 10, 2012 for “Vending machines dispensing DVDs and video games; electronic displays, namely, digital signage” in Class 9 and “Creating digital advertising and promotional campaigns for others” in Class 35 (the “Application”).

Opposer believes that it will be damaged by registration of the mark shown in the Application and opposes on the following grounds:

1. Opposer is a leading provider of premium television program services in the United States, including the services SHOWTIME®, THE MOVIE CHANNEL®, and FLIX®.
2. The FLIX service was launched in 1992. Its programming includes many of America’s favorite movies from the 1960s through the 1990s, shown unedited and without commercials. At the present time, the FLIX service is offered by every major satellite and cable operator, including DirecTV, Dish Network, Comcast, Time Warner Cable, Verizon FIOS,

AT&T U-Verse TV, Cablevision, Cox and Charter, making it available to tens of millions of television households nationwide. More than 27 million satellite and cable customers currently subscribe to FLIX in the United States.

3. Opposer first began using the FLIX mark on or around August 1, 1992. Opposer owns federal trademark registrations and applications for the FLIX mark and family of FLIX marks, including the registration for FLIX in Class 38 for television broadcasting services, cable television broadcasting services, and subscription television broadcasting services. Opposer owns and operates additional services under the FLIX mark including: FLIX ON DEMAND, FLIX ON DEMAND HD and FLIX CLASSIC CLIPS (collectively, together with FLIX, the “FLIX Marks”). Annexed hereto as **Exhibit A** is a list featuring Opposer’s federal trademark registrations for the FLIX Marks in the United States.

4. Opposer has devoted substantial resources to developing recognition of the FLIX Marks and the goodwill associated therewith, and these marks are of inestimable value to Opposer.

5. Opposer owns the rights to broadcast and license television broadcasting services under the FLIX Marks and to sell merchandise and services tied to the FLIX service. Opposer has license agreements with every major cable, satellite and other distributor of television broadcasting services, all of which offer SHOWTIME, THE MOVIE CHANNEL, and FLIX to their television subscribers.

6. Opposer promotes television broadcasting services under the FLIX Marks via the Internet at its official website [www.sho.com](http://www.sho.com), where visitors can access information about Opposer, its program services, newsworthy announcements and the programming lineup for the Opposer’s channels including but not limited to FLIX.

7. Since prior to the filing of the Application and any use or proposed use by the Applicant of the Fraser Mark, Opposer has extensively and continuously promoted FLIX throughout the United States in advertising and other promotional materials in various media. In addition, under license from Opposer, the national providers of satellite television and most cable systems in the country actively advertise and promote Opposer's FLIX service to their customers and potential customers.

8. As a consequence of the extensive and continuous use of FLIX by Opposer long prior to both the filing of the Application and any use or proposed use or use by Applicant of the Fraser Mark, Opposer's FLIX Marks have achieved vast public recognition in connection with television and video programming and related goods and services, and as a result, FLIX is a famous mark.

9. On or about April 11, 2011, Applicant filed the instant Application in the United States Patent and Trademark Office for registration on the Principal Register of the Fraser Mark on an intent-to-use basis for the goods and services covered by the Application. To Opposer's knowledge, upon information and belief, Applicant has not made any use of the Fraser Mark in commerce in the United States.

10. Given the extensive and continuous use of the FLIX Marks by Opposer and the widespread public identification of the FLIX Marks with Opposer, its services, and related merchandising, it is likely that a prospective purchaser faced with Applicant's goods and services utilizing the Fraser Mark will be confused and otherwise likely to assume, erroneously, that the Applicant's goods and services were sold, approved, licensed, sponsored, or in some other way connected with, or authorized by, Opposer.

11. Applicant will improperly benefit if permitted to proceed with the Application, as the Applicant and the Application will continue to be falsely associated with Opposer and the FLIX Marks and their substantial goodwill and recognition.

12. Registration and use of the Applicant's Fraser Mark will lessen the capacity of Opposer's FLIX Marks to identify and distinguish Opposer's goods and services.

13. Opposer would thus be seriously injured by the granting of a certificate of registration to Applicant for the Fraser Mark covered by the Application because, when used in connection with Applicant's goods and services, such mark:

- a. would be likely to cause confusion, or to cause mistake, or to deceive in violation of Sections 2(d) and 13(a) of the Lanham Act, 15 U.S.C. §§ 1052(d), 1063(a);
- b. would falsely and erroneously suggest a connection with Opposer in violation of Section 2(a) of the Lanham Act, 15 U.S.C. §§ 1052(a); and
- c. would tend to damage and interfere with and cause dilution of Opposer's valuable goodwill in its FLIX mark in violation of Sections 2(f), 13(a), and 43(c) of the Lanham Act, 15 U.S.C. §§ 1052(f), 1063(a), and 1125(c).

WHEREFORE, Opposer believes that it will be seriously damaged by the registration of the Fraser Mark, and, therefore, Opposer, by and through its undersigned attorneys, respectfully requests that its opposition be sustained and that the Application for registration be denied.

Dated: New York, New York  
August 6, 2012

Respectfully submitted,

SHOWTIME NETWORKS INC.

By: 

Mallory Levitt  
Counsel for Opposer

EXHIBIT A

<u>Mark</u>	<u>Registration No.</u>	<u>Registration Date</u>	<u>Int. Class(es)</u>	<u>Description of Goods/Services</u>
FLIX	2014877	Nov. 12, 1996	38	Television broadcasting services, cable broadcasting services and subscription television broadcasting services.
FLIX CLASSIC CLIPS	3024247	Dec. 6, 2005	38 41	Television broadcasting, cable television, and satellite broadcasting of television programs in high definition format.  Entertainment services, namely production and distribution of motion pictures and television series in the field of comedy, music, drama, documentaries and sporting events for cable television, and satellite television and television broadcasting.
FLIX ON DEMAND & Design	3259285	July 3, 2007	41	Education and entertainment services, namely production and distribution of motion pictures; production of comedy, musical and dramatic television series, documentaries and sporting events rendered through the media of television, cable and satellite systems, and the Internet; distribution for others of comedy, musical and dramatic television series, documentaries and sporting events rendered through the media of television, cable and satellite systems and the Internet.
FLIX ON DEMAND	3194926	Jan. 2, 2007	38	Communication services, namely, transmitting pre-recorded streamed audio and video material through media of television, cable and satellite systems and the Internet.
FLIX ON DEMAND	3194927	Jan. 2, 2007	41	Education and entertainment services, namely, production and distribution of motion pictures; production of comedy, musical and dramatic television series, documentaries and sporting events rendered through the media of television, cable and satellite systems, and the Internet; distribution for others of comedy, musical and dramatic television series, documentaries and sporting events rendered through the media of television, cable and satellite systems and the Internet.