

ESTTA Tracking number: **ESTTA519638**

Filing date: **02/04/2013**

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	VIX SWIMWEAR, INC.
Granted to Date of previous extension	02/06/2013
Address	5735 Kearny Villa Road #108 San Diego, CA 92123 UNITED STATES

Attorney information	Michael J. Leonard Panitch Schwarze Belisario & Nadel LLP 2005 Market Street - Suite 2200 Philadelphia, PA 19103 UNITED STATES usptotm@panitchlaw.com, mleonard@panitchlaw.com
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Applicant Information

Application No	85612038	Publication date	10/09/2012
Opposition Filing Date	02/04/2013	Opposition Period Ends	02/06/2013
Applicant	BLUE GORILLA LLC 333 PARK AVENUE SOUTH SUITE 42 NEW YORK, NY 10010 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2012/02/01 First Use In Commerce: 2012/02/01 All goods and services in the class are opposed, namely: Clothing, namely, socks; footwear
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2692225	Application Date	04/16/2001
Registration Date	03/04/2003	Foreign Priority Date	NONE
Word Mark	VIX		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1998/11/25 First Use In Commerce: 1999/02/26 Clothing, namely, swimwear, [sarongs or] coverups, bikinis [and hats]

U.S. Application No.	85627052	Application Date	05/16/2012
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	VIX
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Design Mark	
Description of Mark	NONE
Goods/Services	Class 018. First use: First Use: 2010/11/29 First Use In Commerce: 2010/11/29 All-purpose carrying bags; Beach bags; Book bags; Carry-all bags; Cosmetic bags sold empty; Handbags; Leather handbags; Pouches for holding make-up, keys and other personal items; Purses; Shoulder bags; Tote bags

Attachments	76239953#TMSN.gif (1 page)(bytes) 85627052#TMSN.jpeg (1 page)(bytes) 00486443.PDF (7 pages)(271590 bytes) 00486445.PDF (2 pages)(54911 bytes)
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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	/michael leonard/
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Name	Michael J. Leonard
Date	02/04/2013

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

RE: U.S. Trademark Application Serial No. 85/612,038
Published in the Official Gazette on 9 October 2012

VIX SWIMWEAR, INC.)

Opposer)

-v-)

BLUE GORILLA LLC)

Applicant)

Opposition No. _____

NOTICE OF OPPOSITION

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22314

Commissioner:

In the matter of Application Serial No. 85/612,038 filed 30 April 2012 by The Ovadafut Hosiery Company, Inc. and assigned on 1 June 2012 to Blue Gorilla LLC (“Applicant”), to register the mark UGLY VIX GOOD TASTE GONE BAD for goods described as “clothing, namely socks; footwear” in International Class 25 (“Applicant’s Goods”), which was published in the Official Gazette on 9 October 2012, Vix Swimwear Inc. (“Opposer”) of San Diego, California believes it will be damaged by the registration of the UGLY VIX GOOD TASTE GONE BAD mark and opposes same. The grounds for this opposition are as follows:

1. Upon information and belief, Applicant is a United States corporation having an address in New York, NY. On 30 April 2012, Applicant filed Application Serial No. 85/612,038 for the mark UGLY VIX GOOD TASTE GONE BAD for Applicant's Goods based on a claim of use in commerce since 1 February 2012.

2. Opposer is the owner of all right, title and interest in and to the VIX mark of U.S. Trademark Registration No. 2,692,225 covering goods described as "clothing, namely swimwear, coverups, bikinis" in International Class 25. Opposer has been using its VIX mark in connection with the foregoing goods since at least as early as 25 November 1998. Opposer's Registration is valid, subsisting, and incontestable pursuant to 15 U.S.C. § 1065, and is conclusive evidence of the validity of the registered mark, the registration of the mark, Opposer's ownership of the mark, and Opposer's exclusive right to use the VIX Mark in connection with the goods specified in the registration.

3. Opposer is also the owner of pending U.S. Trademark Application Serial No. 85/627,052 for the mark VIX covering goods described as "all-purpose carrying bags; Beach bags; Book bags; Carry-all bags; Cosmetic bags sold empty; Handbags; Leather handbags; Pouches for holding make-up, keys and other personal items; Purses; Shoulder bags; Tote bags;" in Class 18. Opposer has been using its VIX mark in connection with the foregoing goods since at least as early as 29 November 2010. Application Serial No. 85/612,038 for UGLY VIX GOOD TASTE GONE BAD has been noted as a potential bar to the registration of Opposer's Application Serial No. 85/627,052.

4. Opposer and will rely upon its ownership of the foregoing Registration, Application and the common law rights it has obtained through its long prior and continuous use of the VIX Mark in commerce.

5. Commencing long prior to Applicant's filing date and any alleged date of first use that can be claimed by Applicant, Opposer's VIX Mark was used and registered in connection with clothing-related goods.

6. Since the initial use and registration of the VIX Mark, Opposer's VIX branded clothing and bags have been advertised and promoted under the VIX Mark. Opposer's customers and the public in general have come to know and recognize Opposer's VIX Mark and associate the Mark with Opposer and/or Opposer's clothing and bags.

7. Applicant's filing of Application Serial No. 85/612,038 for UGLY VIX GOOD TASTE GONE BAD is without license, authorization or permission from Opposer.

**FIRST GROUND FOR OPPOSITION
(LIKELIHOOD OF CONFUSION - COMMON LAW)**

8. Opposer re-alleges the allegations contained in Paragraphs 1 through 7 of this Notice of Opposition.

9. Opposer uses the VIX Mark to identify various items of clothing and types of bags that are offered and sold to a wide variety of consumers through a variety of retail and wholesale outlets.

10. Applicant's mark wholly incorporates the VIX term and is likely, when used in connection with Applicant's Goods, to cause confusion or mistake or to deceive purchasers resulting in damage to Opposer and its reputation.

11. The 1 February 2012 alleged date of first use of the UGLY VIX GOOD TASTE GONE BAD mark of Application Serial No. 85/612,038 is subsequent to Opposer's 25 November 1998 date of first use of its VIX Mark on clothing and its 29 November 2010 date of first use of the VIX mark on various types of bags.

12. The use of Applicant's UGLY VIX GOOD TASTE GONE BAD mark on Applicant's Goods is closely related and overlapping to Opposer's use of its VIX mark on clothing and bags as Opposer's VIX branded clothing and bags are routinely offered and sold in retail stores featuring socks and footwear.

13. Opposer's customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin, affiliation, endorsement or sponsorship of Applicant's Goods offered and sold under Applicant's mark and misled into believing that such goods are offered by, sold by, emanate from or are in some way associated with Opposer, to the damage and detriment of Opposer and its reputation.

14. Opposer will be damaged by the registration of the UGLY VIX GOOD TASTE GONE BAD mark as set forth in Application Serial No. 85/612,038, in that the mark is confusingly similar to Opposer's VIX Mark, thereby violating Opposer's common law rights to its VIX Mark.

15. Registration of Applicant's mark should not be granted, as it is contrary to 15 U.S.C. § 1052(d) and would violate and diminish the prior and superior rights of Opposer to its VIX Mark.

**SECOND GROUND FOR OPPOSITION
(LIKELIHOOD OF CONFUSION - FEDERAL)**

16. Opposer re-alleges the allegations contained in Paragraphs 1 through 15 of this Notice of Opposition.

17. Applicant's mark fully incorporates the identical VIX term and is likely, when used in connection with Applicant's Goods, to cause confusion or mistake or to deceive purchasers resulting in damage and detriment to Opposer and its reputation.

18. Applicant's filing date of 30 April 2012 is subsequent to the 4 March 2003 registration date of U.S. Registration No. 2,692,225 and the 29 November 2010 date of first use of the VIX mark of Application Serial No. 85/627,052.

19. Applicant's Goods as identified in Application Serial No. 85/612,038 are not limited by channels of trade and/or classes of purchasers. As such, Opposer's VIX branded clothing and bags and Applicant's Goods can be deemed to be so closely related and overlapping that they are offered and sold and/or are likely to be offered and sold through the same channels of trade and purchased by the same class of purchasers.

20. Opposer's customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin, affiliation, endorsement and sponsorship of Applicant's Goods sold, offered and marketed under Applicant's mark and misled into believing that such Goods are offered, sold by, or are in some way associated with Opposer, to the damage and detriment of Opposer and its reputation.

21. The combination of the negatively viewed term UGLY, Opposer's well known VIX trademark, and the wording GOOD TASTE GONE BAD to form Applicant's composite UGLY VIX GOOD TASTE GONE BAD mark evokes a commercial impression that is derogatory and serves to tarnish and damage the valuable goodwill earned as a result of Opposer's longtime use of its VIX trademark.

22. Opposer will be damaged by Applicant's registration of the UGLY VIX GOOD TASTE GONE BAD mark as set forth in Application Serial No.85/612,038 in that Applicant's UGLY VIX GOOD TASTE GONE BAD mark is confusingly similar to Opposer's VIX Mark and is being used or intended to be used in connection with Goods that are similar, overlapping and/or closely related to Opposer's VIX branded clothing and bags.

23. Applicant's registration of the UGLY VIX GOOD TASTE GONE BAD mark would be contrary to 15 U.S.C. § 1052(d) and would violate and diminish the prior and superior rights of Opposer to its VIX Mark.

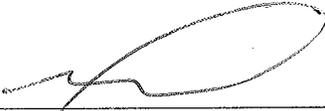
WHEREFORE, Opposer prays that its Opposition be sustained, that Application Serial No. 85/612,038 be refused and that the registration of UGLY VIX GOOD TASTE GONE BAD as a trademark to Applicant be refused, and for such other relief as may be deemed just and proper.

Respectfully submitted,

VIX SWIMWEAR, INC.

Date: 4 Feb 2013

By: _____

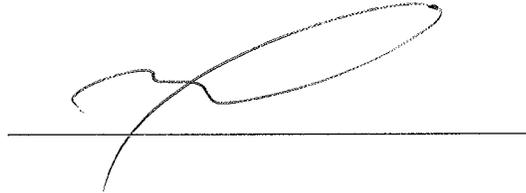

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Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Notice of Opposition was served on Applicant this 4th day of February 2013 by sending same via First Class Mail, postage prepaid, to:

Susan M. Natland
Knobbe Martens Olson & Bear LLP
2040 Main St Fl 14
Irvine, CA 92614-8214



Side - 1

**NOTICE OF ACCEPTANCE AND
ACKNOWLEDGEMENT OF §§8 & 15
DECLARATION
MAILING DATE: Mar 6, 2009**

The combined declaration of use and incontestability filed in connection with the registration identified below meets the requirements of Sections 8 and 15 of the Trademark Act, 15 U.S.C. §1058 and 1065. The combined declaration is accepted and acknowledged. The registration remains in force.

For further information about this notice, visit our website at: <http://www.uspto.gov>. To review information regarding the referenced registration, go to <http://tarr.uspto.gov>.

REG NUMBER: 2692225
MARK: VIX
OWNER: VIX SWIMWEAR, INC.

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UNITED STATES PATENT AND TRADEMARK OFFICE
COMMISSIONER FOR TRADEMARKS
P.O. BOX 1451
ALEXANDRIA, VA 22313-1451

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CRAIG O CORRELL
4245 SUNNYHILL DR
CARLSBAD, CA 92008-3647

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 2,692,225

United States Patent and Trademark Office

Registered Mar. 4, 2003

**TRADEMARK
PRINCIPAL REGISTER**

VIX

VIX SWIMWEAR, INC. (CALIFORNIA CORPORATION)
315 WESTBOURNE ST
LA JOLLA, CA 92037

FIRST USE 11-25-1998; IN COMMERCE 2-26-1999.

SER. NO. 76-239,953, FILED 4-16-2001.

FOR: CLOTHING, NAMELY, SWIMWEAR, SARONGS OR COVERUPS, BIKINIS AND HATS, IN CLASS 25 (U.S. CLS. 22 AND 39).

ALICE SUE CARRUTHERS, EXAMINING ATTORNEY