

ESTTA Tracking number: **ESTTA588721**

Filing date: **02/21/2014**

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	RockIt Body Pilates, LLC
Granted to Date of previous extension	02/23/2014
Address	1834 N. Sepulveda Blvd. Manhattan Beach, CA 90266 UNITED STATES

Attorney information	David K. Caplan Kilpatrick Townsend & Stockton LLP 9720 Wilshire Blvd.Penthouse Suite Beverly Hills, CA 90212 UNITED STATES dcaplan@kilpatricktownsend.com
----------------------	---

Applicant Information

Application No	85401311	Publication date	08/27/2013
Opposition Filing Date	02/21/2014	Opposition Period Ends	02/23/2014
Applicant	Rock It Brands, LLC 54 W. Green St. Pasadena, CA 91105 CANADA		

Goods/Services Affected by Opposition

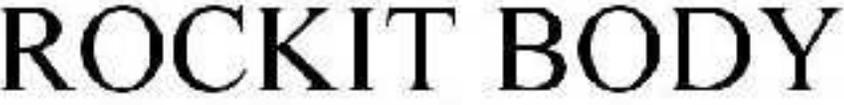
Class 005. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Dietary and nutritional supplements
Class 018. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Bags, namely, handbags, shoulder bags, and sport bags
Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Men's and women's clothing, namely, pants, shorts, jeans, t-shirts, polos, sweatshirts, tank tops, sweatpants, jackets,dresses, shirts, hats, headbands, underwear, swim wear, gym shorts, underwear and socks; footwear, namely, running shoes, sneakers

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4333576	Application Date	11/29/2011
Registration Date	05/14/2013	Foreign Priority Date	NONE
Word Mark	ROCKIT BODY		
Design Mark			
Description of Mark	The mark consists of the literal elements "ROCKIT BODY", all in upper case letters, with the term "ROCK" in black letters, the term IT next to it in gray letters, and underneath of which in green letters is the term "BODY".		
Goods/Services	Class 041. First use: First Use: 2009/01/01 First Use In Commerce: 2009/01/01 Physical fitness and exercise instruction solely in a class setting; instruction services, namely, instruction in the field of health and physical fitness solely in a class setting; educational services, namely, instruction and training in the fields of fitness and nutrition; instruction programs, namely, providing exercise classes for groups of individuals solely in a class setting		

U.S. Registration No.	4437645	Application Date	04/05/2012
Registration Date	11/19/2013	Foreign Priority Date	NONE
Word Mark	ROCKIT BODY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2009/02/28 First Use In Commerce: 2009/02/28 (Based on Use in Commerce) SHORT-SLEEVED T-SHIRTS, LONGSLEEVED T-SHIRTS, TANK TOPS, SWEAT SHIRTS, JACKETS, SOCKS, SHIRTS FOR INFANTS, BABIES, TODDLERS AND CHILDREN; ATHLETIC APPAREL, NAMELY, SHIRTS, PANTS, LEGGINGS, CAPRIS, GLOVES; CLOTHING FOR INFANTS AND CHILDREN, NAMELY, ONE PIECE BODYSUITS, CREEPERS		

Attachments	85482656#TMSN.jpeg(bytes) 85980235#TMSN.jpeg(bytes)
-------------	--

	NOTICE OF OPPOSITION to 85401311.pdf(54986 bytes)
--	--

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	/David K. Caplan/
Name	David K. Caplan
Date	02/21/2014

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

ROCKIT BODY PILATES, LLC,)	
)	In the matter of Application
Opposer,)	Serial No. 85/401,311
)	
)	Mark:
)	
v.)	
)	
)	⊥
)	Opposition No. _____
ROCK IT BRANDS, LLC,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

RockIt Body Pilates, LLC (“Opposer”), a California Limited Liability Company having its principal place of business at 1834 N. Sepulveda Blvd., Manhattan Beach, California 90266, believes that it will be damaged by the registration of the trademark ROCK IT WORKOUTS and design, as shown in U.S. Trademark App. Ser. No. 85/401,311 for the goods identified therein (the “Application”), and hereby opposes the same.

As grounds for the opposition, Opposer alleges the following:

1. Opposer believes that it will be damaged by the registration of the Application.
2. The Application was published for opposition on August 27, 2013 in the Official Gazette and Opposer is timely filing its opposition.
3. Opposer is the exclusive owner of all trademark and other intellectual property rights in and to the ROCKIT BODY mark, which Opposer has used continuously and exclusively since at least as early as January 1, 2009.

4. Opposer owns the U.S. Trademark Reg. No. 4,333,576 for ROCKIT BODY design mark, registered May 14, 2013, in international class 041 for “Physical fitness and exercise instruction solely in a class setting; instruction services, namely, instruction in the field of health and physical fitness solely in a class setting; educational services, namely, instruction and training in the fields of fitness and nutrition; instruction programs, namely, providing exercise classes for groups of individuals solely in a class setting” with a stated first use date of January 1, 2009.

5. Opposer owns the U.S. Trademark Reg. No. 4,437,645 for ROCKIT BODY, registered November 19, 2013, in international class 025 for “Short-sleeved t-shirts, longsleeved t-shirts, tank tops, sweat shirts, jackets, socks, shirts for infants, babies, toddlers and children; athletic apparel, namely, shirts, pants, leggings, capris, gloves; clothing for infants and children, namely, one piece bodysuits, creepers” with a stated first use date of February 28, 2009.

6. In addition to its various federal trademark registrations, Opposer also has common law rights for its ROCKIT BODY mark based on long-standing, extensive use of the mark in commerce (collectively the “ROCKIT BODY Marks”).

7. As a result of Opposer’s use in commerce of the ROCKIT BODY Marks, the ROCKIT BODY Marks symbolize the extensive goodwill and consumer recognition established by Opposer. The ROCKIT BODY Marks identify and distinguish Opposer’s goods and services from competing goods and services offered by others in the physical fitness industry.

8. On August 18, 2011, Applicant Rock It Brands, LLC (“Applicant”) filed the Application under Lanham Act § 1(b), 15 U.S.C. § 1051(b), by which Applicant seeks to register the mark ROCK IT WORKOUTS and design (the “ROCK IT WORKOUTS Mark”) in connection with “Dietary and nutritional supplements” in International Class 5, “Bags, namely,

handbags, shoulder bags, and sport bags” in class 18, and “men’s and women’s clothing, namely, pants, shorts, jeans, t-shirts, polos, sweatshirts, tank tops, sweatpants, jackets, dresses, shirts, hats, headbands, underwear, swim wear, gym shorts, underwear and socks; footwear, namely, funning shoes, sneakers” in class 25.

9. The text portion of Applicant’s ROCK IT WORKOUTS Mark is virtually identical in appearance, sound and commercial impression to Opposer’s ROCKIT BODY Marks. The first two words of Applicant’s mark are identical to the first word of Opposer’s mark.

10. The goods identified in the opposed Application are identical or highly related to the goods and services identified in Opposer’s ROCKIT BODY registrations, and are identical or highly related to the goods and services in connection with which Opposer uses its ROCKIT BODY Marks.

11. Applicant’s ROCK IT WORKOUTS Mark, when used in connection with Applicant’s goods as identified in the Application, so resembles Opposer’s previously used ROCKIT BODY Marks as to be likely to cause confusion, to cause mistake, and/or to deceive members of the public concerning a sponsorship or endorsement of, or an affiliation, connection, or association with the sources of goods sold under Opposer’s ROCKIT BODY Marks in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), with consequent injury to Opposer, the public, and the trade.

12. The public has come to associate the ROCKIT BODY Marks with Opposer and Opposer’s physical fitness-related goods and services. In view of the similarity of Applicant’s ROCK IT WORKOUTS Mark with Opposer’s ROCKIT BODY Marks, it is alleged that Applicant’s Mark consists of and comprises matter that may disparage and falsely suggest a connection with Opposer.

13. Pursuant to Section 13(a) of the Lanham Act, 15 U.S.C. § 1063(a), Opposer believes it will be damaged by registration of Applicant's ROCK IT WORKOUTS Mark in that members of the purchasing public and/or the trade are likely to be confused or mistaken that Applicant's goods offered under Applicant's ROCK IT WORKOUTS Mark originate from Opposer, or from the same source as goods sold under Opposer's ROCKIT BODY Marks, or that such goods of Applicant are sponsored by, endorsed by, or affiliated with the source of goods sold under the Opposer's ROCKIT BODY Marks. Such likelihood of confusion results in damage to the goodwill among purchasers and the trade that Opposer's ROCKIT BODY Marks symbolize. Registration of Applicant's ROCK IT WORKOUTS Mark will support and assist Applicant in the confusing and misleading use of Applicant's ROCK IT WORKOUTS Mark, and, in addition, will give color and exclusive statutory right to Applicant in violation and derogation of the prior and superior rights of Opposer.

WHEREFORE, Opposer requests that registration of Applicant's ROCK IT WORKOUTS Mark, as shown in the Application, be refused.

The required fee for instituting this opposition proceeding is being submitted herewith. Please charge any deficiency or refund in the filing fee to Deposit Account No. 20-1430.

Please recognize David K. Caplan and the law firm of Kilpatrick Townsend & Stockton LLP as attorneys for Opposer in connection with this opposition proceeding. Please address all correspondence regarding this proceeding to David K. Caplan at Kilpatrick Townsend & Stockton LLP, 9720 Wilshire Blvd., Penthouse Suite, Beverly Hills, CA, 90404.

This the 21st day of February, 2014.

/David K. Caplan/

David K. Caplan

Caroline Y. Bussin

KILPATRICK TOWNSEND & STOCKTON LLP

9720 Wilshire Blvd., Penthouse Suite

Beverly Hills, CA 90212

Telephone: (310) 248-3830

dcaplan@kilpatricktownsend.com

cbussin@kilpatricktownsend.com

tadmin@kilpatricktownsend.com

Attorneys for Opposer

RockIt Body Pilates, LLC

