

TTAB

TRADEMARK

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office



01-14-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #26

In the matter of trademark application Serial No. 76/151,890
published in the Official Gazette (Trademarks) on September 11, 2001
Mark: ACE ROSS STUDIOS

AMERICAN COUNCIL ON EXERCISE,)	
)	
Opposer,)	
)	
vs.)	Opposition No. _____
)	
SHERWIN "ACE" ROSS,)	
)	
Applicant.)	
_____)	

Box TTAB
FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

NOTICE OF OPPOSITION

AMERICAN COUNCIL ON EXERCISE, (hereinafter "the Opposer") believes that it will be damaged by the above-referenced registration by SHERWIN "ACE" ROSS (hereinafter "the Applicant") of the above-identified mark (ACE ROSS STUDIOS) and hereby opposes the same.

As grounds of opposition, it is alleged that:

1. The Applicant seeks to register ACE ROSS STUDIOS as a trademark for "Men's,

Women's, and Children's Wearing Apparel, namely, Bandanas, Bathing Suits, Beach Coverups,

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Belts, Blouses, Body Suits, Boleros, Boxer Shorts, Briefs, Bustiers, Camisoles, Chemises, Coats, Leather Coats, Dresses, Halter Tops, Jackets, Jeans, Jogging Suits, Jumpers, Jumpsuits, Kerchiefs, Leggings, Leotards, Lounge-wear, Mini-Skirts, Overcoats, Pajamas, Panties, Pants, Pantsuits, Pantyhose, Ponchos, Pullovers, Raincoats, Shirts, Casual Shirts, Dress Shirts, Undershirts, Shorts, Gym Shorts, Sweat Shorts, Skirts, Slacks, Sleepwear, Socks, Suits, Sweaters, Sweat Pants, Sweat Shirts, T-Shirts, Trousers, Underpants, Vests, Warm-up Suits, Shoes and Hats” in International Class 25, as is evidenced by the publication of said mark in the Official Gazette of the September 11, 2001 issue.

2. Opposer has used the marks ACE AMERICAN COUNCIL ON EXERCISE and ACE since at least as early as May 1, 1991, and has used the marks ACE AMERICAN COUNCIL ON EXERCISE and ACE in interstate commerce since at least as early as May 1, 1991, on and in connection with “clothing; namely, T-shirts, shorts, sweatshirts, and cover-ups” in International Class 025, and on or in connection with other related goods and services. Opposer registered ACE AMERICAN COUNCIL ON EXERCISE as a trademark with the U. S. Patent and Trademark Office on March 21, 1995, (Registration No. 1,884,858) and the registration has since achieved incontestable status under 15 U.S.C. Sec. 1065. In addition, Opposer has registered the mark ACE for “physical fitness training manuals and printed exam materials pertaining to physical fitness; namely, combined informational brochures and applications for exams and sample test questions,” in International Class 016, and for “educational services, namely providing training such as classes and seminars in the field of physical fitness,” in International Class 041 (U.S. Registration No. 1,898,868).

5. There is no issue of priority. Applicant has not yet claimed a date of first use of the

mark. Opposer's date of first use is at least as early as May 1, 1991, and Opposer's date of first use in interstate commerce is at least as early as May 1, 1991. Opposer's use of the ACE AMERICAN COUNCIL ON EXERCISE and ACE marks has not been abandoned.

6. Opposer's long time use of the marks ACE AMERICAN COUNCIL ON EXERCISE and ACE has developed exceedingly valuable goodwill and recognition in respect to the marks ACE AMERICAN COUNCIL ON EXERCISE and ACE.

7. By virtue of its efforts and the expenditure of considerable sums for promotional materials and advertisements and the quality of his services, Opposer has gained a valuable reputation for the marks ACE AMERICAN COUNCIL ON EXERCISE and ACE, particularly with respect to clothing in International Class 025.

8. If Applicant is permitted to use and register its mark as specified in the application herein opposed, confusion is likely to result because of the use of the identical term "ACE" in Applicant's mark and Opposer's mark. Person's familiar with Opposer's mark would be likely to assume that Applicant was associated with Opposer and any such confusion would inevitably result in damage to Opposer. Furthermore, any objection or fault found with Applicant's goods would necessarily reflect upon and seriously injure the reputation which Opposer has established under its mark. Thus, if Applicant is allowed to use and register ACE ROSS STUDIOS the resulting confusion and assumed affiliation will be damaging to the Opposer's established goodwill under ACE AMERICAN COUNCIL ON EXERCISE and ACE, and/or Applicant's use of ACE ROSS STUDIOS as a mark will dilute the Opposer's mark in violation of Section 43 (c) of the Trademark Act.

10. If Applicant is granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to the use of its mark, and would appropriate the considerable

goodwill and recognition that Opposer has established through years of exclusive use and marketing. Such registration would be a source of damage and injury to Opposer.

WHEREFORE, Opposer prays that the application Serial No. 76/151,890 be rejected, and that registration of the mark therein sought be denied and refused.

A duplicate copy of this Notice of Opposition and the fee required in Section 2.6(1) are enclosed herewith.

Opposer has hereby appointed David P. Branfman of BRANFMAN & ASSOCIATES, 12750 High Bluff Drive, Suite 100, San Diego, California 92130, a member of the bar of the State of California, as agent and attorney in the matter of the opposition above-identified, to prosecute said opposition, to transact all business in the United States Patent & Trademark Office and in the United States courts in connection with this opposition, to sign his name to all papers which may hereinafter be filed in connection therewith, and to receive all communications relating to the same.

Respectfully submitted,

By: 

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Attorney for Opposer

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box TTAB, FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington VA 22202-3513, on this 9th day of

January, 2002.

01/09/02
Date


Rhianna C. Bowers, Paralegal