

ESTTA Tracking number: **ESTTA12768**

Filing date: **08/02/2004**

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	American Council on Exercise
Granted to Date of previous extension	08/04/2004
Address	American Council on Exercise 4851 Paramount Dr. San Diego, CA 92123 UNITED STATES

Attorney information	David P. Branfman Branfman & Associates 12750 High Bluff Dr., Ste. 100 San Diego, CA 92130 UNITED STATES dbranfman@branfman.com, jmandour@branfman.com Phone:858-481-5800
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Applicant Information

Application No	76367633	Publication date	04/06/2004
Opposition Filing Date	08/02/2004	Opposition Period Ends	08/04/2004
Applicant	ACE INTERNATIONAL BEAUTY, INC.		

Goods/Services Affected by Opposition

Class 025. First Use: 19980101 First Use In Commerce: 19980101
All goods and services in the class are opposed, namely: Clothing, namely shirts, pants, skirts, dresses; footwear and headgear, namely hats and caps

Attachments	Ace Intl Beauty Notice of Opposition Final-080204.pdf (4 pages)
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Signature	/JAM/
Name	Joe A. Mandour
Date	08/02/2004

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

In the matter of trademark application Serial No. 76/367,633
Published in the Official Gazette (Trademarks) on April 6, 2004
Mark: ACE (+Design)

AMERICAN COUNCIL ON EXERCISE,)	
)	
Opposer,)	
)	
vs.)	Opposition No. _____
)	
ACE INTERNATIONAL BEAUTY, INC.)	
)	
Applicant.)	
_____)	

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

NOTICE OF OPPOSITION

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

As grounds of opposition, it is alleged that:

1. The Applicant seeks to register ACE (+DESIGN) as a trademark for "Clothing, namely shirts, pants, skirts, dresses; footwear and headgear, namely hats and caps" in International

Class 025, as is evidenced by the publication of said mark in the Official Gazette on April 6, 2004.

2. Opposer 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 a wide array of 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, U.S. 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.

3. There is no issue of priority. Applicant claims a date of first use of January 1, 1998. 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.

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

5. By virtue of its efforts and the expenditure of considerable sums for promotional materials, advertisements, and the quality of its 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.

6. 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. Persons 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 that Opposer has established under its mark. Thus, if Applicant is allowed to use and register ACE (+DESIGN) 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 (+DESIGN) as a mark will dilute the Opposer's mark in violation of Section 43 (c) of the Trademark Act.

7. 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 its years of exclusive marketing and use. Such registration would be a source of damage and injury to Opposer.

WHEREFORE, Opposer prays that the application Serial No. 76/367,633 be rejected, and that registration of the mark therein sought be denied and refused.

Two duplicate copies 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,

/JAM/

By: _____
Joe A. Mandour, Esq.
BRANFMAN & ASSOCIATES
12750 High Bluff Drive, Suite 100
San Diego, California 92130
(858) 481-5800

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: Commissioner for Trademarks, 2900 Crystal Drive, Arlington VA 22202-3514, on this _____ day of _____, 2004.

Date

Eric E. Beener