

ESTTA Tracking number: **ESTTA311871**

Filing date: **10/16/2009**

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	Bally Total Fitness Holding Corporation
Granted to Date of previous extension	10/31/2009
Address	8700 West Bryn Mawr Chicago, IL 60631 UNITED STATES

Correspondence information	Scott J. Slavick Brinks Hofer Gilson & Lione P. O. Box 10395 Chicago, IL 60610 UNITED STATES officeactions@brinkshofer.com Phone:312-321-4200
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**Applicant Information**

Application No	77713458	Publication date	09/01/2009
Opposition Filing Date	10/16/2009	Opposition Period Ends	10/31/2009
Applicant	Garcia, Kimberly J. 15 Fairmont Dr Spring Hill, FL 34609 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 041. First Use: 2004/01/01 First Use In Commerce: 2007/01/19 All goods and services in the class are opposed, namely: Providing assistance, personal training and physical fitness consultation to individuals to help them make physical fitness, strength, conditioning, and exercise improvement in their daily living
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**Grounds for Opposition**

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


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

U.S. Registration No.	2217664	Application Date	10/10/1996
Registration Date	01/12/1999	Foreign Priority Date	NONE
Word Mark	BFIT		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 1998/02/01 First Use In Commerce: 1998/02/01 health club services

U.S. Registration No.	2533193	Application Date	10/09/1996
Registration Date	01/29/2002	Foreign Priority Date	NONE
Word Mark	BFIT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1996/11/10 First Use In Commerce: 1996/11/10 nutritional supplements and vitamins		

U.S. Registration No.	2840454	Application Date	04/10/1998
Registration Date	05/11/2004	Foreign Priority Date	NONE
Word Mark	BFIT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 2002/12/01 First Use In Commerce: 2002/12/01 exercise equipment, namely, hand-held and portable exercise equipment, jump ropes, ankle weights, wrist weights, leg weights, free weights, handgrips, stretch bands, slimmer belts, workout belts, weight lifting gloves, pedometers, chinning bars, hip cycles, pushup stands, sit up bars, wrist wraps, aerobic bands, reading racks, lifting stands, bar bell pads, body fat gages, exercise wheels, support suspender belts, aerobic steps, aerobic slides, portable abdominal trainers, portable thigh trainers, magnetic belts, tension bars, chest expanders, running weights, dumbbell trees, rowers, squeeze balls; platforms, mats, tables, benches, and accessories for use therewith		

U.S. Registration No.	2518918	Application Date	03/05/1997
Registration Date	12/18/2001	Foreign Priority Date	NONE
Word Mark	BFIT-RX		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 005. First use: First Use: 1997/08/01 First Use In Commerce: 1997/08/01 meal replacement drink in liquid and powder; vitamin supplements

U.S. Registration No.	2464838	Application Date	06/02/1998
Registration Date	07/03/2001	Foreign Priority Date	NONE

Word Mark BFIT BABY CLUB

Design Mark

Description of Mark	NONE
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Goods/Services	Class 041. First use: First Use: 1998/12/01 First Use In Commerce: 1998/12/01 HEALTH CLUB SERVICES; EXERCISE CLASSES FOR PREGNANT WOMEN; PROVIDING INFORMATION ABOUT EXERCISES RECOMMENDED FOR PREGNANT WOMEN
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U.S. Registration No.	3029648	Application Date	02/15/2002
Registration Date	12/13/2005	Foreign Priority Date	NONE

Word Mark BFIT COMMUNITIES

Design Mark

**BFIT COMMUNITIES**

Description of Mark	NONE
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Goods/Services	Class 036. First use: First Use: 2002/08/01 First Use In Commerce: 2002/08/01 Philanthropic services concerning donation of money Class 041. First use: First Use: 2002/08/01 First Use In Commerce: 2002/08/01 Charitable services, namely, providing donations of exercise equipment for charitable purposes
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U.S. Registration No.	2846657	Application Date	10/21/2002
Registration Date	05/25/2004	Foreign Priority Date	NONE

Word Mark BFIT COMMUNITIES

Design Mark

Description of Mark	NONE
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Goods/Services	Class 041. First use: First Use: 2002/08/01 First Use In Commerce: 2002/08/01 Charitable services, namely providing the use of health club facilities for charitable purposes
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U.S. Registration No.	2912905	Application Date	07/16/2003
Registration Date	12/21/2004	Foreign Priority Date	NONE
Word Mark	BFIT GEAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 2002/12/01 First Use In Commerce: 2002/12/01 exercise equipment, namely, hand-held and portable exercise equipment, jump ropes, ankle weights, wrist weights, leg weights, free weights, handgrips, stretchbands, slimmer belts, workout belts, weight lifting gloves, pedometers, chinning bars, hip cycles, pushup stands, sit up bars, wrist wraps, aerobics bands, reading racks, lifting stands, bar bell pads, body fat gages, exercise wheels, support suspender belts, aerobic steps, aerobic slides, portable abdominal trainers, portable thigh trainers, magnetic belts, tension bars, chest expanders, running weights, dumbbell trees, rowers, squeeze balls; exercise platforms, exercise mats, exercise tables, exercise benches, and parts therefor		

Attachments	75252001#TMSN.gif ( 1 page )( bytes ) 76371903#TMSN.gif ( 1 page )( bytes ) Notice of Opposition.pdf ( 6 pages )(392957 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	/Scott J. Slavick/
Name	Scott J. Slavick
Date	10/16/2009

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

In the Matter of:     Application Serial No. 77/713,458

Mark:                 KIM2BFIT

Int'l Class:         41

Published:           September 1, 2009

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BALLY TOTAL FITNESS HOLDING  
CORPORATION,

Opposer,

v.

KIMBERLY J. GARCIA,

Applicant.

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Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

BALLY TOTAL FITNESS HOLDING CORPORATION, a Delaware corporation having its principal place of business at 8700 W. Bryn Mawr Avenue, Chicago, Illinois 60631 (“Opposer”), believes that it will be damaged by the registration of the designation KIM2BFIT, Application Serial No. 77/713,458, applied for by KIMBERLY J. GARCIA, a United States citizen residing at 15 Fairmont Dr., Spring Hill, FL, 34609 (“Applicant”), and hereby opposes said application for registration.

As grounds for the Opposition, Opposer states as follows:

1.     Opposer is now and has been for a number of years involved in providing health club services, exercise equipment, nutritional supplements and philanthropic services.

Opposer has adopted, used and continues to use its BFIT mark in connection with its health club services, exercise equipment, nutritional supplements and philanthropic services since at least as early as 1996.

2. Opposer is the owner of all right, title and interest in the following United States trademark registrations that incorporate the BFIT mark:

- A. U.S. Reg. No. 2,217,664, registered January 12, 1999, for the trademark BFIT for “health club services” in International Class 41;
- B. U.S. Reg. No. 2,533,193, registered January 29, 2002, for the trademark BFIT for “nutritional supplements and vitamins” in International Class 5;
- C. U.S. Reg. No. 2,840,454, registered May 11, 2004, for the trademark BFIT for “exercise equipment, namely, hand-held and portable exercise equipment, jump ropes, ankle weights, wrist weights, leg weights, free weights, handgrips, stretch bands, slimmer belts, workout belts, weight lifting gloves, pedometers, chinning bars, hip cycles, pushup stands, sit up bars, wrist wraps, aerobic bands, reading racks, lifting stands, bar bell pads, body fat gages, exercise wheels, support suspender belts, aerobic steps, aerobic slides, portable abdominal trainers, portable thigh trainers, magnetic belts, tension bars, chest expanders, running weights, dumbbell trees, rowers, squeeze balls; platforms, mats, tables, benches, and accessories for use therewith” in International Class 28;
- D. U.S. Reg. No. 2,518,918, registered December 18, 2001, for the trademark BFIT-RX for “meal replacement drink in liquid and powder; vitamin supplements” in International Class 5;
- E. U.S. Reg. No. 2,464,838, registered July 3, 2001, for the trademark BFIT BABY CLUB for “health club services; exercise classes for pregnant women; providing information about exercises recommended for pregnant women” in International Class 41;
- F. U.S. Reg. No. 3,029,648, registered December 13, 2005, for the trademark BFIT COMMUNITIES for “philanthropic services concerning donation of money” in International Class 36 and

“charitable services, namely, providing donations of exercise equipment for charitable purposes” in International Class 41;

- G. U.S. Reg. No. 2,846,657, registered May 25, 2004, for the trademark BFIT COMMUNITIES for “charitable services, namely providing the use of health club facilities for charitable purposes” in International Class 41;
- H. U.S. Reg. No. 2,912,905, registered December 21, 2004, for the trademark BFIT GEAR for “exercise equipment, namely, hand-held and portable exercise equipment, jump ropes, ankle weights, wrist weights, leg weights, free weights, handgrips, stretchbands, slimmer belts, workout belts, weight lifting gloves, pedometers, chinning bars, hip cycles, pushup stands, sit up bars, wrist wraps, aerobics bands, reading racks, lifting stands, bar bell pads, body fat gages, exercise wheels, support suspender belts, aerobic steps, aerobic slides, portable abdominal trainers, portable thigh trainers, magnetic belts, tension bars, chest expanders, running weights, dumbbell trees, rowers, squeeze balls; exercise platforms, exercise mats, exercise tables, exercise benches, and parts therefor” in International Class 28.

3. Opposer has made a substantial investment in marketing, promoting and advertising its BFIT mark. Opposer has so widely used its BFIT mark in commerce in connection with its health club services, exercise equipment, nutritional supplements and philanthropic services that the BFIT mark has achieved widespread public recognition in the United States as a mark signifying high quality health club services, exercise equipment, nutritional supplements and philanthropic services. The trade and purchasing public have come to recognize the BFIT mark as indicating that the aforementioned services and products sold under the BFIT mark originate from Opposer. Opposer has built substantial and invaluable goodwill in the BFIT mark with respect to health club services, exercise equipment, nutritional supplements and philanthropic services. By reason of such advertising,

promotion, and sale of Opposer's goods and services under the BFIT, Opposer has developed overwhelming goodwill in connection with the BFIT mark.

4. Notwithstanding Opposer's prior rights in and to its BFIT mark, on April 14, 2009, Applicant applied to register KIM2BFIT for "providing assistance, personal training and physical fitness consultation to individuals to help them make physical fitness, strength, conditioning, and exercise improvement in their daily living" in International Class 41. The application was given Application Serial No. 77/713,458 and was published for opposition on September 1, 2009.

5. Applicant's use of KIM2BFIT has not been approved, authorized or consented to by Opposer.

6. Applicant's KIM2BFIT and Opposer's BFIT marks are confusingly similar visually, orally, and in meaning.

7. Applicant uses KIM2BFIT on services that compete with the goods and services marketed by Opposer in association with its BFIT mark.

8. Upon information and belief, the services listed in Applicant's application bearing the designation KIM2BFIT and the goods marketed by Opposer in association with its BFIT mark are sold through the same channels of trade and to the same general class of purchasers.

9. Applicant's registration and use of KIM2BFIT is likely to cause confusion, or to cause mistake, or to deceive the purchasing public, all to Opposer's damage. The purchasing public, upon encountering Applicant's KIM2BFIT mark used in connection with providing assistance, personal training and physical fitness consultation to individuals to help them make physical fitness, strength, conditioning, and exercise improvement in their daily



living, is likely to mistakenly believe that such services originate with, have some connection with, or are sponsored by Opposer, or are in some way connected with Opposer, all likely to cause confusion, mistake and deception resulting in damage, loss and injury to the goodwill established by Opposer in its BFIT mark.

10. Applicant's registration of KIM2BFIT will further interfere with Opposer's use and registration of its BFIT mark, and will seriously damage Opposer.

WHEREFORE, Opposer, BALLY TOTAL FITNESS HOLDING CORPORATION, prays that its Opposition be sustained and that Application Serial No. 77/713,458 be denied registration.

Respectfully submitted,

BALLY TOTAL FITNESS HOLDING  
CORPORATION

Dated: 10/16/09

By: Scott Slavick

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Scott J. Slavick  
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Attorneys for Opposer

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing NOTICE OF OPPOSITION was served on Applicant at the following address by U.S. mail, postage prepaid and via email to kim@kim2bfit.com on this 16<sup>th</sup> day of October, 2009.

KIMBERLY J. GARCIA  
15 FAIRMONT DR  
SPRING HILL, FL 34609-2038

  
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