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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

#77658440

Mailed: March 15, 2014

Opposition No. 91199495

Vixen Fitness LLC (MI)

v.

Vixen Fitness, LLC (FL)

Concurrent Use No. 94002597

Vixen Fitness, LLC (FL)

V.

Vixen Fitness LLC (MI)

Benjamin U. Okeke, Interlocutory Attorney:

On June 12, 2013 the Board conducted a telephone conference with the parties. Participating in the conference were opposer's counsel, Becky Wilson, applicant's counsel Josh Gerben, and Board interlocutory attorney Benjamin U. Okeke.

On April 19, 2011, Vixen Fitness LLC ("opposer") filed a notice of opposition (instituted as Opposition No. 91199495) against Vixen Fitness, LLC's application Serial No. 77658440 for the mark VIXEN FITNESS for "entertainment services, namely, conducting parties; [and] providing fitness and exercise facilities," alleging likelihood of confusion with its previously used mark VIXEN FITNESS used in connection with "dance instruction; [and] dance studios."¹

¹ Opposer filed application Serial No. 85281887 on March 30, 2011, alleging current use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. 1051(a), which is currently suspended pending, in part, the disposition of the opposed application. Opposer should note that where a pending trademark application owned by an excepted user has not yet cleared the opposition period, the concurrent use proceeding will be instituted with the owner of that application being included as a common law user, rather than as an applicant. TBMP § 1104 (3d ed. rev. 2012).



03-31-2014

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On February 10, 2013, applicant filed, with opposer's consent, a motion to amend its application to include a geographic restriction to applicant's use of the mark. On the same day the parties filed stipulated motions to withdraw the opposition and to "convert" the opposition into a concurrent use proceeding.

By its amendment applicant seeks to amend its application to exclude the following states from its exclusive rights to use the mark VIXEN FITNESS in the United States:

North Dakota, South Dakota, Minnesota, Wisconsin, Nebraska, Iowa, Illinois, Kansas, Missouri, Michigan, Indiana, Ohio, Maine, Vermont, New Hampshire, Massachusetts, Rhode Island, Connecticut, New York, New Jersey, Pennsylvania, Delaware, Washington DC, Maryland, Montana, West Virginia and Kentucky.

Applicant consents to opposer's withdrawal of this opposition, contingent upon institution of a concurrent use proceeding.

The disposition of an opposition determines whether the involved applicant is entitled to a geographically unrestricted registration. The question whether an applicant is entitled to a trademark registration with geographic limitations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use proceeding. See Trademark Rule 2.133(c). Where, as here, the parties stipulate to terminate an opposition in favor of a concurrent use proceeding, the opposition proceeding will be dismissed without prejudice, with respect to applicant's right to an unrestricted registration; the amendment will be approved; and a concurrent use proceeding involving the amended application will be instituted, all in one Board action. TBMP § 1113.01 (3d ed. rev. 2012).

However, in order for opposer's application to be brought into the concurrent use proceeding an inverse amendment, claiming all or at least some of the remaining states, will need to be entered into opposer's application by filing the amendment with the trademark examiner

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currently handling the application. Once the amendment is entered, and any other examination issues are resolved, the application can be published for opposition. If the application is unopposed it will then be added to the concurrent use proceeding instituted by this order.

Accordingly, applicant's amendment to a concurrent use application is accepted and Opposition No. 91199495 is **DISMISSED** without prejudice.

A concurrent use proceeding is instituted under the provisions of Section 2(d) of the Trademark Act. This concurrent use proceeding involves the following parties:

Concurrent Use Applicant:	Vixen Fitness, LLC (Florida)
Serial Number:	77658440
Trademark:	VIXEN FITNESS
Services:	Entertainment services, namely, conducting parties; Providing fitness and exercise facilities
Filing Date:	1/28/2009
Territory of Use:	All states other than North Dakota, South Dakota, Minnesota, Wisconsin, Nebraska, Iowa, Illinois, Kansas, Missouri, Michigan, Indiana, Ohio, Maine, Vermont, New Hampshire, Massachusetts, Rhode Island, Connecticut, New York, New Jersey, Pennsylvania, Delaware, Washington DC, Maryland, Montana, West Virginia and Kentucky.
Attorney:	JOHN M GERBEN GERBEN LAW FIRM PLLC 1615 L STREET NW 10TH FLOOR WASHINGTON, DC 20036
Excepted User:	Vixen Fitness LLC (Michigan)
Trademark:	VIXEN FITNESS
Services:	Dance instruction; Dance studios
Territory of Use:	[To be determined]
Attorney:	JOHN VANOPHEM BECKY WILSON DOBRUSIN THENNISCH PC 29 W LAWRENCE STREET, STE 210

The proceeding will be conducted in accordance with the Rules of Practice in Trademark cases, as set out in Title 37 of the Code of Federal Regulations. Trademark Rule 2.99(d), under which this notice is given, provides that:

(2) An answer to the notice is not required in the case of an applicant or registrant whose application or registration is specified as a concurrent user in the application, but a statement, if desired, may be filed within forty days after the mailing of the notice; in the case of any other party specified as a concurrent user in the application, an answer must be filed within forty days after the mailing of the notice.

(3) If an answer, when required, is not filed, judgment will be entered precluding the specified user from claiming any right more extensive than that acknowledged in the application(s) for concurrent use registration, but the applicant(s) will remain with the burden of proving entitlement to registration(s).

As noted above, while opposer has a pending trademark application, because the application has not cleared the opposition period, until opposer's application clears the opposition period opposer will be treated in this concurrent use proceeding as a common law user, as will be the case if opposer's application does not clear the opposition period.

Proceedings are **SUSPENDED** pending the examination of opposer's application and its clearance of the opposition period.²

Both parties are requested to advise the Board of any relevant applications or registrations, other than those already listed, which should be included in this concurrent use proceeding. The notice, if

²Opposer will be required to file an answer to this notice within **FORTY DAYS** of the resumption of the concurrent use proceeding. Failure to file an answer may result in entry of judgement as provided by Rule 2.99(d)(3).

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any, should be in writing and should be filed on or before **FORTY DAYS** from the date the concurrent use proceeding is resumed.

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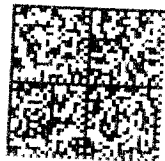
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