

ESTTA Tracking number: **ESTTA27020**

Filing date: **02/28/2005**

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	The North Face Apparel Corp.		
Entity	Corporation	Citizenship	Delaware
Address	3411 Silverside Road Wilmington, DE 19810 UNITED STATES		

Attorney information	Susan M. Kayser Howrey Simon Arnold & White, LLP 1299 Pennsylvania Avenue, N.W. Washington, DC 20004 UNITED STATES kaysers@howrey.com, basilek@howrey.com, yaghmain@howrey.com, IPDocketing@howrey.com, colemant@howrey.com Phone:(202) 783-0800		
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Applicant Information

Application No	78311205	Publication date	02/15/2005
Opposition Filing Date	02/28/2005	Opposition Period Ends	03/17/2005
Applicant	Northface Holdings, LLC 10701 S. River Front Parkway, Suite 300 South Jordan, UT 84095 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 20030319First Use In Commerce: 20030602
All goods and services in the class are opposed, namely: Education services in the nature of courses at the university level

Related Proceedings	Opposition No. 91163177 (Serial No.78305655)
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Attachments	Notice of Opposition.pdf (8 pages)
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Signature	/susan kayser/
Name	Susan M. Kayser
Date	02/28/2005

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

The North Face Apparel Corp.,	§	
	§	
Opposer,	§	Opposition No. _____
	§	
v.	§	Application Serial No. 78/311,205
	§	
Northface Holdings, LLC,	§	Published: February 15, 2005
	§	
_____ Applicant.	§	

BOX TTAB/FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

NOTICE OF OPPOSITION

Opposer, The North Face Apparel Corp., a Delaware corporation, with its principal place of business at 3411 Silverside Road, Wilmington, Delaware 19810, believes it will be damaged by the registration of the mark shown in Application Serial No. 78/311,205, and therefore opposes registration of this mark under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. § 1063.

Application Serial No. 78/311,205 for the mark NORTHFACE UNIVERSITY and Design was filed by Northface Holdings, LLC on October 8, 2003, for “[e]ducation services in the nature of courses at the university level” in International Class 41. The mark was published for opposition in the *Trademark Official Gazette* on February 15, 2005.

The grounds for opposition are as follows:

1. Opposer The North Face Apparel Corp. (hereinafter “The North Face”), through its licensee VF Outdoor, Inc., formerly known as The North Face, Inc., has been engaged in the business, *inter alia*, of developing, manufacturing and selling outdoor and athletic clothing and gear and has built a large and successful business in the clothing and outdoor gear field.
2. Since at least as early as 1968, long prior to the filing of the application opposed herein, Opposer The North Face, through its licensee, has used and continues to use the mark THE NORTH FACE in connection with mountaineering apparel and equipment under THE NORTH FACE name and mark.
3. Since that time, The North Face, through its licensee, has expanded its THE NORTH FACE line to include other high-performance products including, but not limited to, sportswear, outerwear, accessories, camping products and equipment, bags, and shoes. The North Face, through its licensee, has for many years preceding the filing of the application opposed herein, sponsored and supported world-class athletes, outdoor sporting events and expeditions, conducted educational programs and seminars relating to nature conservation and environmental consciousness, and supported environmental advocacy groups.
4. The North Face has registered multiple marks incorporating its THE NORTH FACE mark with the United States Patent and Trademark Office, including the following:

- a. Opposer The North Face owns an incontestable Registration No. 983,624, registered on May 14, 1974, for the trademark THE NORTH FACE for “backpacks” in International Class 22, “camping clothing, namely, rainwear, parkas, vests, trousers, shoes, gloves and headgear” in International Class 25, and “sleeping bags, tents, snowshoes, and skis” in International Class 28. The date of first use in commerce for each of the above noted classes is March 10, 1969.
- b. Opposer The North Face also owns an incontestable Registration No. 2,097,715, registered on September 16, 1997, for the trademark THE NORTH FACE & Design [Half-Dome] for “backpacks” in International Class 18, “sleeping bags” in International Class 20, “tents” in International Class 22, and “clothing, namely, parkas, vests, jackets, anoraks, pants, ski bibs, gloves, mittens, underwear, hats, headbands, caps, ski suits, gaiters, shorts, shirts and belts” in International Class 25. The date of first use in commerce for each of the above noted classes is December 1971.
- c. Opposer The North Face owns Registration No. 2,300,758, registered on December 14, 1999, for the trademark THE NORTH FACE & Design [Half-Dome] for “shoes” in International Class 25. The date of first use in commerce is June 1998.
- d. Opposer The North Face owns Registration No. 2,830,478, registered on April 6, 2004, for the trademark THE NORTH FACE & Design [Half-Dome] and Registration No. 2,836,848, registered on April 27,

2004, for the trademark THE NORTH FACE for “sunglasses, sports glasses and protective eyewear, and replacement lenses for all of the foregoing; optical frames for men, women and children, and eyeglass cases, goggles, eyeglass and sunglass chains and bands” in International Class 9. The date of first use in commerce for both marks is May 30, 2003.

5. Opposer The North Face’s use of the THE NORTH FACE registered trademarks noted above pre-date Applicant’s filing date and claimed first use in commerce date.
6. Further, The North Face currently owns pending applications to federally register two additional THE NORTH FACE trademarks, namely Application Serial Numbers 78/361,524 and 78/361,558 for retail store, mail order, and distributorship services in the fields of camping and outdoor gear, books, food, hardware and sports equipment, and Application Serial Number 78/182,154 for bicycles, bicycle frames, and structural parts. Opposer The North Face’s registered trademarks and pending applications noted above are collectively referred to as “THE NORTH FACE marks.”
7. Over the years, and continuing today, Opposer The North Face, through its licensee, has prominently and extensively used, promoted and advertised its THE NORTH FACE marks. The North Face, through its licensee, has spent substantial sums advertising and promoting its THE NORTH FACE products and services. Further, The North Face, through its licensee, has

spent millions of dollars on sponsorship of athletes, clinics and other educational ventures.

8. The North Face, through its licensee, has and continues to sponsor numerous world-class athletes that conduct speaking tours, clinics, coaching and guiding services around the nation to educate the public on environmental ethics and responsibility as well as outdoor climbing clinics and other outdoor activities.
9. The North Face, through its licensee, has and continues to sponsor numerous expeditions to identify and fund social and economic development programs in the regions where the aforesaid expeditions take place.
10. The North Face, through its licensee, conducts community outreach programs in its retail stores at which The North Face athletes often provide training seminars. The North Face sales representatives regularly participate in educational ventures for the public.
11. The North Face, through its licensee, is a “partner organization” and sponsor of many organizations, including Leave No Trace, Conservation Alliance, American Alpine Club, and American Mountain Guides Association, which provide education to the outdoor community. Some of these partner organizations, through the financial support of The North Face’s licensee and other companies, offer tuition scholarships to qualified students.
12. The North Face, through its licensee, maintains an active website,

<http://www.thenorthface.com>. Because it is the most obvious term that the general public and customers would associate with the brand, The North Face uses the THE NORTH FACE word mark as the domain name so consumers can most easily access the website. The thenorthface.com web site features detailed information about THE NORTH FACE® branded goods, as well as the The North Face sponsored athletes and educational programs and events. The thenorthface.com web site is regularly visited by numerous consumers.

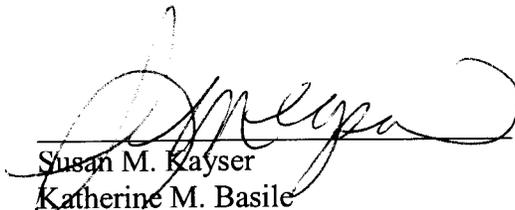
13. As a result of its extensive sales, marketing efforts, advertising, and promotional efforts in promoting THE NORTH FACE marks, these designations have developed enormous recognition in the United States among consumers for these products and services, and are uniquely associated with Opposer. Opposer owns all valuable goodwill represented by each of THE NORTH FACE marks.
14. Upon information and belief, applicant, Northface Holdings, LLC, is a Delaware limited liability company with a principal place of business at 10701 S. River Front Parkway, Suite 300, South Jordan, Utah 84095.
15. On October 8, 2003, Applicant filed a use-based application for the mark NORTHFACE UNIVERSITY and design for “[e]ducation services in the nature of courses at the university level.”
16. Applicant’s mark consists of the words “NORTHFACE UNIVERSITY” and the stylized representation of a mountain. Applicant’s mark claims a first use date of June 2, 2003.

17. Applicant's alleged NORTHFACE UNIVERSITY mark is substantially similar in sound, appearance and commercial impression to each of Opposer The North Face's THE NORTH FACE marks. Further, the stylized representation of a mountain included in Applicant's mark is similar in commercial impression and connotation to the Half-Dome mountain design of Opposer The North Face's THE NORTH FACE marks.
18. Upon information and belief, the services to be offered by Applicant under the mark NORTHFACE UNIVERSITY are related to the services now being offered and promoted by Opposer The North Face's licensee under the THE NORTH FACE marks.
19. If Applicant's mark is registered, Applicant will receive a *prima facie* nationwide exclusive right to use its mark that is likely to cause confusion, mistake or deception under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and would be damaging to Opposer.
20. Registration of NORTHFACE UNIVERSITY and design for the services identified in Paragraph 19 above will dilute the distinctive qualities of each of the THE NORTH FACE marks in violation of Sections 2(f) and 43(c) of the United States Trademark Act of 1946, 15 U.S.C. §§ 1052(f) and 1125 (c).

WHEREFORE, for the foregoing reasons, Opposer The North Face will be damaged by registration of Applicant's mark and prays that this opposition be sustained and that Application Serial No. 78/311,205 be refused registration.

Respectfully submitted,

Date: February 28, 2005 By:



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