

ESTTA Tracking number: **ESTTA312283**

Filing date: **10/19/2009**

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

Proceeding	91190565
Party	Defendant Children's Learning Adventure Licensing, LLC
Correspondence Address	David W. Schnell The Noblitt Group PLLC 4800 N. Scottsdale Rd., Suite 6000 Scottsdale, AZ 85251 UNITED STATES dwschnell@ngtechlaw.com
Submission	Answer and Counterclaim
Filer's Name	David W. Schnell
Filer's e-mail	dwschnell@ngtechlaw.com
Signature	/David W. Schnell/
Date	10/19/2009
Attachments	10176.0200_2009-10-19_scanned answer to amended notice of opposition.pdf (12 pages)(254293 bytes)

Registrations Subject to the filing

Registration No	3296777	Registration date	09/25/2007
Registrant	Knowledge Learning Corporation 650 N.E. Holladay Street Portland, OR 97232 UNITED STATES		

Goods/Services Subject to the filing

Class 016. First Use: 2006/03/06 First Use In Commerce: 2006/03/06 All goods and services in the class are requested, namely: Printed instructional, educational, and teaching materials, in the subjects of mathematics, reading, phonics, writing, and foreign language skills and foreign culture, at the kindergarten and the elementary and middle school levels; pencils
Class 041. First Use: 2006/03/06 First Use In Commerce: 2006/03/06 All goods and services in the class are requested, namely: educational services, namely providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith

Registration No	3296778	Registration date	09/25/2007
Registrant	Knowledge Learning Corporation 650 N.E. Holladay Street Portland, OR 97232 UNITED STATES		

Goods/Services Subject to the filing

Class 016. First Use: 2006/03/06 First Use In Commerce: 2006/03/06 All goods and services in the class are requested, namely: Printed instructional, educational, and teaching materials, in the subject of mathematics, at the kindergarten and the elementary and middle school levels
Class 041. First Use: 2006/03/06 First Use In Commerce: 2006/03/06

All goods and services in the class are requested, namely: educational services, namely providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith

Registration No	3296780	Registration date	09/25/2007
Registrant	Knowledge Learning Corporation 650 N.E. Holladay Street Portland, OR 97232 UNITED STATES		

Goods/Services Subject to the filing

Class 016. First Use: 2006/10/01 First Use In Commerce: 2006/10/01
All goods and services in the class are requested, namely: Printed instructional, educational, and teaching materials, in the subject of reading, at the kindergarten and the elementary and middle school levels

Class 041. First Use: 2006/10/01 First Use In Commerce: 2006/10/01
All goods and services in the class are requested, namely: educational services, namely providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith

Registration No	3322735	Registration date	10/30/2007
Registrant	Knowledge Learning Corporation 650 N.E. Holladay Street Portland, OR 97232 UNITED STATES		

Goods/Services Subject to the filing

Class 016. First Use: 2006/03/06 First Use In Commerce: 2006/03/06
All goods and services in the class are requested, namely: Printed instructional, educational, and teaching materials, in the subjects of foreign language skills and foreign culture, at the kindergarten and the elementary and middle school levels

Class 041. First Use: 2006/03/06 First Use In Commerce: 2006/03/06
All goods and services in the class are requested, namely: educational services, namely providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith

Registration No	3322736	Registration date	10/30/2007
Registrant	Knowledge Learning Corporation 650 N.E. Holladay Street Portland, OR 97232 UNITED STATES		

Goods/Services Subject to the filing

Class 016. First Use: 2006/03/06 First Use In Commerce: 2006/03/06
All goods and services in the class are requested, namely: printed instructional, educational, and teaching materials, in the subjects of phonics, reading, and writing, at the kindergarten and the elementary and middle school levels

Class 041. First Use: 2006/03/06 First Use In Commerce: 2006/03/06
All goods and services in the class are requested, namely: educational services, namely providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith

Registration No	3430921	Registration date	05/20/2008
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Registrant	Knowledge Learning Corporation 650 N.E. Holladay Street Portland, OR 97232 UNITED STATES
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Goods/Services Subject to the filing

Class 041. First Use: 1982/00/00 First Use In Commerce: 1982/00/00 All goods and services in the class are requested, namely: Educational services, namely, providing courses of instruction and programs at the kindergarten and the elementary school levels; providing before and after school educational programs for kindergarten and elementary school students in the areas of reading, writing, history, science, math, and art; recreational camp services

Registration No	3674061	Registration date	08/25/2009
Registrant	Knowledge Learning Corporation 650 N.E. Holladay Street Portland, OR 97232 UNITED STATES		

Goods/Services Subject to the filing

Class 041. First Use: 2008/06/01 First Use In Commerce: 2008/06/01 All goods and services in the class are requested, namely: educational services, namely, providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith

Registration No	3674066	Registration date	08/25/2009
Registrant	Knowledge Learning Corporation 650 N.E. Holladay Street Portland, OR 97232 UNITED STATES		

Goods/Services Subject to the filing

Class 041. First Use: 2008/06/01 First Use In Commerce: 2008/06/01 All goods and services in the class are requested, namely: educational services, namely, providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith

Registration No	3674063	Registration date	08/25/2009
Registrant	Knowledge Learning Corporation 650 N.E. Holladay Street Portland, OR 97232 UNITED STATES		

Goods/Services Subject to the filing

Class 041. First Use: 2008/06/01 First Use In Commerce: 2008/06/01 All goods and services in the class are requested, namely: educational services, namely, providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith

Registration No	3674062	Registration date	08/25/2009
Registrant	Knowledge Learning Corporation 650 N.E. Holladay Street Portland, OR 97232 UNITED STATES		

Goods/Services Subject to the filing

Class 041. First Use: 2008/06/01 First Use In Commerce: 2008/06/01

All goods and services in the class are requested, namely: educational services, namely, providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith

Registration No	3674064	Registration date	08/25/2009
Registrant	Knowledge Learning Corporation 650 N.E. Holladay Street Portland, OR 97232 UNITED STATES		

Goods/Services Subject to the filing

Class 041. First Use: 2008/06/01 First Use In Commerce: 2008/06/01

All goods and services in the class are requested, namely: educational services, namely, providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith

Registration No	3674065	Registration date	08/25/2009
Registrant	Knowledge Learning Corporation 650 N.E. Holladay Street Portland, OR 97232 UNITED STATES		

Goods/Services Subject to the filing

Class 041. First Use: 2008/06/01 First Use In Commerce: 2008/06/01

All goods and services in the class are requested, namely: educational services, namely, providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith

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

KNOWLEDGE LEARNING CORPORATION)	
)	Opposition No. 91190565
)	
Opposer,)	Serial No. 77/576,125
)	Filed: September 22, 2008
)	Published on: February 10, 2009
v.)	Mark: WHERE LEARNING IS
)	THE GREATEST
CHILDREN'S LEARNING ADVENTURE LICENSING, LLC)	ADVENTURE OF ALL
)	
Applicant.)	
)	

ANSWER TO AMENDED NOTICE OF OPPOSITION, AFFIRMATIVE DEFENSES, AND COUNTERCLAIMS

Applicant, Children's Learning Adventure Licensing, LLC, is the owner of the above identified application and is an Arizona Corporation, with a business address of 3131 East Camelback Road, Suite 410, Phoenix, Arizona 85016.

In response to Opposer's amended notice of opposition, Applicant, through its attorneys, The Noblitt Group, PLLC, answers as follows:

1. With regard to numbered paragraph 1 of the Amended Notice of Opposition, Applicant admits Opposer's allegations.
2. With regard to numbered paragraph 2 of the Amended Notice of Opposition, Applicant admits Opposer's allegations.
3. With regard to numbered paragraph 3 of the Amended Notice of Opposition, Applicant admits Opposer's allegations.

4. With regard to numbered paragraph 4 of the Amended Notice of Opposition, Applicant admits Opposer's allegations.
5. With regard to numbered paragraph 5 of the Amended Notice of Opposition, Applicant admits Opposer's allegations.
6. With regard to numbered paragraph 6 of the Amended Notice of Opposition, Applicant admits Opposer's allegations.
7. With regard to numbered paragraph 7 of the Amended Notice of Opposition, Applicant admits Opposer's allegations.
8. With regard to numbered paragraph 8 of the Amended Notice of Opposition, Applicant admits Opposer's allegations.
9. With regard to numbered paragraph 9 of the Amended Notice of Opposition, Applicant admits Opposer's allegations.
10. With regard to numbered paragraph 10 of the Amended Notice of Opposition, Applicant admits Opposer's allegations.
11. With regard to numbered paragraph 11 of the Amended Notice of Opposition, Applicant admits Opposer's allegations.
12. With regard to numbered paragraph 12 of the Amended Notice of Opposition, Applicant admits Opposer's allegations.
13. With regard to numbered paragraph 13 of the Amended Notice of Opposition, Applicant admits Opposer's allegations.
14. With regard to numbered paragraph 14 of the Amended Notice of Opposition, Applicant admits Opposer's allegations.

15. With regard to numbered paragraph 15 of the Amended Notice of Opposition, Applicant admits Opposer's allegations.
16. With regard to numbered paragraph 16 of the Amended Notice of Opposition, Applicant admits Opposer's allegations.
17. With regard to numbered paragraph 17 of the Amended Notice of Opposition, Applicant admits Opposer's allegations.
18. With regard to numbered paragraph 18 of the Amended Notice of Opposition, Applicant admits Opposer's allegations.
19. With regard to numbered paragraph 19 of the Amended Notice of Opposition, Applicant agrees with Opposer's statement.
20. With regard to numbered paragraph 19 of the Amended Notice of Opposition, Applicant denies Opposer's allegations.
21. With regard to numbered paragraph 20 of the Amended Notice of Opposition, Applicant denies Opposer's allegations.
22. With regard to numbered paragraph 21 of the Amended Notice of Opposition, Applicant denies Opposer's allegations.
23. With regard to numbered paragraph 22 of the Amended Notice of Opposition, Applicant denies Opposer's allegations.
24. With regard to numbered paragraph 23 of the Amended Notice of Opposition, Applicant denies Opposer's allegations.

AFFIRMATIVE DEFENSES

By way of further answer and affirmative defenses, Applicant alleges as follows:

25. Opposer's alleged rights in its trademarks utilizing ADVENTURES are highly diluted as a trademark formative, and hence weak, and Opposer's purported rights extend no further than to the specific marks which Opposer alleges it owns, none of which are the same or confusingly similar to Applicant's mark in terms of connotation, appearance, and of pronunciation, and thus not entitled to a wide scope of protection, in part because of extensive third-party use of marks containing the term ADVENTURES.
26. Upon information and belief, Opposer's pleaded marks already coexist with numerous third-party "ADVENTURES" marks for similar goods and services, as reflected in the Principal Register. Opposer is coexisting with such third-party marks without confusion. By virtue of Opposer's ability to coexist with such third party marks, Opposer can coexist with Applicant's mark.
27. Opposer is precluded, by virtue of the doctrine of estoppel, laches, and estoppel by acquiescence, from asserting its purported rights.
28. Opposer is precluded, by virtue of a lack of validity, from asserting its purported rights.
29. Opposer is precluded, by virtue of a lack of standing, from asserting its purported rights.
30. Opposer is precluded, by the doctrine of fair use, from asserting its purported rights.

31. Applicant's use of its marks will not mistakenly be thought by the public to derive from the same source as Opposer's goods or services, nor will such use be thought by the public to be a use by Opposer or with Opposer's authorization or approval.
32. Applicant's mark in its entirety is sufficiently distinctively different from Opposer's marks to avoid confusion, deception or mistake as to the source or sponsorship of association of Applicant's goods.
33. Applicant's mark, when used on Applicant's good or services, is not likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Applicant with Opposer, or as to the origin, sponsorship, or approval of Applicant's goods or services by Opposer.
34. There is no likelihood of damage to Opposer if the mark is registered.
35. Applicant reserves its rights to affirmative defenses, to assert additional grounds to support a counterclaim, and to seek cancellation of any registered marks by Opposer as part of its grounds for opposing registration of Applicant's mark, as may be determined through discovery and/or the testimony periods in this opposition proceeding.

COUNTERCLAIM FOR CANCELLATION

Applicant believes that it will be injured by the continued registration of the marks shown in Registration Nos. 3,296,777, 3,296,778, 3,296,780, 3,322,735, 3,322,736, 3,430,921, 3,674,061, 3,674,066, 3,674,063, 3,674,062, 3,674,065, and 3,674,064 and hereby petitions for the cancellation of said registrations for the marks owned by Knowledge Learning Corporation (“Registrant”) pursuant to Trademark Rule 2.106(b)(2)(i). As grounds in support of the counterclaim, Applicant alleges as follows:

1. Applicant, Children’s Learning Adventure Licensing, LLC, an Arizona Corporation, with a business address of 3131 East Camelback Road, Suite 410, Phoenix, Arizona 85016 believes that it will be injured by the continued registration of the marks shown in Registration Nos. 3,296,777, 3,296,778, 3,296,780, 3,322,735, 3,322,736, 3,430,921, 3,674,061, 3,674,066, 3,674,063, 3,674,062, 3,674,065, and 3,674,064 and hereby petitions for the cancellation of the same.
2. The current name and address of the owner of the registrations at issue is Knowledge Learning Corporation, a Delaware Corporation, 650 N.E. Holladay Street, Portland Oregon 97232.
3. Registration No. 3,296,777, sought to be cancelled as being merely descriptive is for the mark KELSEY’S LEARNING ADVENTURES, registered for use in connection with printed instructional, educational, and teaching materials, in the subjects of mathematics, reading, phonics, writing, and foreign language skills and foreign culture, at the kindergarten and the elementary and middle school

levels; pencils in Class 16 and educational services, namely providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith in Class 41.

4. Registration No. 3,296,778, sought to be cancelled as being merely descriptive is for the mark KELSEY'S MATH ADVENTURES, registered for use in connection with printed instructional, educational, and teaching materials, in the subject of mathematics, at the kindergarten and the elementary and middle school levels in Class 16 and educational services, namely providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith in Class 41.
5. Registration No. 3,296,780, sought to be cancelled as being merely descriptive is for the mark KELSEY'S READING ADVENTURES, registered for use in connection with printed instructional, educational, and teaching materials, in the subject of reading, at the kindergarten and the elementary and middle school levels in Class 16 and educational services, namely providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith in class 41.
6. Registration No. 3,322,735, sought to be cancelled as being merely descriptive is for the mark KELSEY'S SPANISH ADVENTURES, registered for use in connection with printed instructional, educational, and teaching materials, in the subjects of foreign language skills and foreign culture, at the kindergarten and the elementary and middle school levels in Class 16 and educational services, namely providing courses of instruction at the pre-school, kindergarten, primary, and

elementary school level and providing course material in connection therewith in Class 41.

7. Registration No. 3,322,736, sought to be cancelled as being merely descriptive is for the mark KELSEY'S PHONICS ADVENTURES, registered for use in connection with printed instructional, educational, and teaching materials, in the subjects of phonics, reading, and writing, at the kindergarten and the elementary and middle school levels in Class 16 and educational services, namely providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith in Class 41.
8. Registration No. 3,430,921, sought to be cancelled as being merely descriptive is for the mark SCIENCE ADVENTURES, registered for use in connection with educational services, namely, providing courses of instruction and programs at the kindergarten and the elementary school levels; providing before and after school educational programs for kindergarten and elementary school students in the areas of reading, writing, history, science, math, and art; recreational camp services in Class 41.
9. Registration No. 3,674,061, sought to be cancelled as being merely descriptive is for the mark LEARNING ADVENTURES, registered for use in connection with educational services, namely, providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith in class 41.
10. Registration No. 3,674,066, sought to be cancelled as being merely descriptive is for the mark ACTIVE ADVENTURES, registered for use in connection with

educational services, namely, providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith in Class 41.

11. Registration No. 3,674,063, sought to be cancelled as being merely descriptive is for the mark MATH ADVENTURES, registered for use in connection with educational services, namely, providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith in Class 41.
12. Registration No. 3,674,062, sought to be cancelled as being merely descriptive is for the mark PHONICS ADVENTURES, registered for use in connection with educational services, namely, providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith in Class 41.
13. Registration No. 3,674,065, sought to be cancelled as being merely descriptive is for the mark READING ADVENTURES, registered for use in connection with educational services, namely, providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith in Class 41.
14. Registration No. 3,674,064, sought to be cancelled as being merely descriptive is for the mark SPANISH ADVENTURES, registered for use in connection with educational services, namely, providing courses of instruction at the pre-school, kindergarten, primary, and elementary school level and providing course material in connection therewith in Class 41.

15. Each of the registrant's registered marks, KELSEY'S LEARNING ADVENTURES, KELSEY'S MATH ADVENTURES, KELSEY'S READING ADVENTURES, KELSEY'S SPANISH ADVENTURES, KELSEY'S PHONICS ADVENTURES, SCIENCE ADVENTURES, LEARNING ADVENTURES, ACTIVE ADVENTURES, MATH ADVENTURES, PHONICS ADVENTURES, READING ADVENTURES, and SPANISH ADVENTURES, at the time of registration, consisted of a term which, when applied to registrant's goods, was merely descriptive.

16. Each of the registrant's registered marks, KELSEY'S LEARNING ADVENTURES, KELSEY'S MATH ADVENTURES, KELSEY'S READING ADVENTURES, KELSEY'S SPANISH ADVENTURES, KELSEY'S PHONICS ADVENTURES, SCIENCE ADVENTURES, LEARNING ADVENTURES, ACTIVE ADVENTURES, MATH ADVENTURES, PHONICS ADVENTURES, READING ADVENTURES, and SPANISH ADVENTURES, currently consists of a term which, when applied to registrant's goods, is merely descriptive and has not achieved secondary meaning.

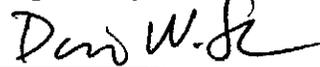
WHEREFORE, Applicant prays:

1. That the Amended Notice of Opposition be dismissed with prejudice in all respects;
2. That the Opposer's request for refusal of registration be denied;

3. That Applicant's application be permitted to proceed to registration at any early date; and
4. That any such further relief be granted Applicant as may be deemed reasonable and appropriate.

Dated: 19 October 2009

Respectfully submitted,



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Attorney for Applicant
Children's Learning Adventure Licensing,
LLC

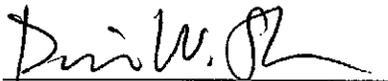
CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing documents entitled, "ANSWER TO AMENDED NOTICE OF OPPOSITION AND AFFIRMATIVE DEFENSES," was served on counsel of record for Opposer, on 19 October 2009, by enclosing it in a properly addressed, postage paid envelope, a true and correct copy of the same, and causing such documents to be deposited in an official depository under the exclusive care and custody of the United States

Postal Service for delivery to:

Scott B. Schwartz
Cozen O'Conner
1900 Market Street
Intellectual Property Group
Philadelphia, PA 19103

Dated: 19 October 2009



David W. Schnell