

ESTTA Tracking number: **ESTTA593050**

Filing date: **03/18/2014**

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.
Granted to Date of previous extension	03/19/2014
Address	3411 Silverside Road Wilmington, DE 19810 UNITED STATES

Attorney information	Brooks R. Bruneau Porzio, Bromberg & Newman 29 Thanet Road Suite 201 Princeton, NJ 08540 UNITED STATES brbruneau@pbnlaw.com Phone:609 924-8555
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**Applicant Information**

Application No	85971820	Publication date	11/19/2013
Opposition Filing Date	03/18/2014	Opposition Period Ends	03/19/2014
Applicants	Mahoney, Andrew 688 Essex St. Bangor, ME 04401 USX  St. John, Tom 688 Essex St. Bangor, ME 04401 USX		

**Goods/Services Affected by Opposition**

Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Clothing, namely, athletic t-shirts, sweatsuits, socks, hats, head bands, wristbands, gloves, and sneakers
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**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	Trademark Act Section 1(b). No bona fide intention to use the mark with all the listed goods at the time of filing.

## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2897197	Application Date	05/15/2003
Registration Date	10/26/2004	Foreign Priority Date	NONE
Word Mark	NEVER STOP EXPLORING		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 018. First use: First Use: 1997/01/00 First Use In Commerce: 1997/01/00 backpacks, luggage, duffel bags, waist packs</p> <p>Class 020. First use: First Use: 1997/01/00 First Use In Commerce: 1997/01/00 Sleeping bags</p> <p>Class 022. First use: First Use: 1997/01/00 First Use In Commerce: 1997/01/00 tents</p> <p>Class 025. First use: First Use: 1997/01/00 First Use In Commerce: 1997/01/00 Clothing, namely, t-shirts, tops, shorts, sweatshirt, sweaters, pants, jackets, vests, anoraks, ski suits, ski jackets, ski vests, rain jackets, and rain pants, footwear and headwear</p>		

U.S. Registration No.	3630564	Application Date	10/16/2008
Registration Date	06/02/2009	Foreign Priority Date	NONE
Word Mark	NEVER STOP EXPLORING		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1997/01/01 First Use In Commerce: 1997/01/01 Retail store and on-line retail store services in the field of apparel, camping and outdoor gear, and outdoor sporting goods equipment		

U.S. Registration No.	3454860	Application Date	04/04/2007
Registration Date	06/24/2008	Foreign Priority Date	NONE
Word Mark	THE NORTH FACE NEVER STOP EXPLORING SPEAKER SERIES		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2007/04/26 First Use In Commerce: 2007/04/26 Arranging seminars and lectures in the fields of adventure and endurance sports, namely, skiing, snowboarding, running, climbing, and hiking; conducting seminars and lectures in the fields of adventure and endurance sports, namely, skiing, snowboarding, running, climbing, and hiking

Attachments	77594166#TMSN.jpeg( bytes ) 77148131#TMSN.jpeg( bytes ) NEVER_STOP_TRAINING_Opposition.PDF(56029 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	/brooks r. bruneau/
Name	Brooks R. Bruneau
Date	03/18/2014



TRADEMARK	REG. NO.	REG. DATE	GOODS
NEVER STOP EXPLORING	2897197	October 26, 2004	Class 018.: backpacks, luggage, duffel bags, waist packs. FIRST USE: 19970100. FIRST USE IN COMMERCE: 19970100 IC 020. US 002 013 022 025 032 050. G & S: Sleeping bags.  Class 22. tents.  Class 25.: Clothing, namely, t-shirts, tops, shorts, sweatshirt, sweaters, pants, jackets, vests, anoraks, ski suits, ski jackets, ski vests, rain jackets, and rain pants, footwear and headwear.
NEVER STOP EXPLORING	3630564	June 2, 2009	Class 35. Retail store and on-line retail store services in the field of apparel, camping and outdoor gear, and outdoor sporting goods equipment.
THE NORTH FACE NEVER STOP EXPLORING SPEAKER SERIES	3454860	June 24, 2008	Class 41. Arranging seminars and lectures in the fields of adventure and endurance sports, namely, skiing, snowboarding, running, climbing, and hiking; conducting seminars and lectures in the fields of adventure and endurance sports, namely, skiing, snowboarding, running, climbing, and hiking.

5. The above listed goods and services registered with Opposer's Marks are hereinafter referred to as "Opposer's Products and Related Services."

6. Since at least as early as 1997, Opposer has used its NEVER STOP EXPLORING Mark in connection with Opposer's Products and Related Services, including athletic and causal outdoor apparel.

7. Opposer has made a substantial investment in advertising and promoting Opposer's Products and Related Services in a wide variety of media.

8. Opposer's marketing efforts, combined with its attention to quality, design and construction of its products, have resulted in substantial sales worldwide.

9. By virtue of a long history of use throughout the world and in the United States, and Opposer's sales and promotional activities, Opposer's Marks have generated valuable goodwill and reputation in connection with Opposer's Products and Related Services.

10. Through prolonged and continuous usage, Opposer's Marks have come to be known among the consuming public as a symbol of ultimate quality and reliability emanating from Opposer and of Opposer's company.

11. Upon information and belief, Applicants, Tom St. John and Andrew Mahoney are U.S. citizens with a common business address of 688 Essex St. Bangor, Maine 04401.

12. Applicants filed Application serial No. 85971820 based upon intent to use for the mark NEVER STOP TRAINING in connection with the following goods:

Clothing, namely, athletic t-shirts, sweatsuits, socks, hats, head bands, wristbands, gloves, and sneakers.

(Hereinafter referred to as "Applicants' Mark").

## **COUNT 1**

### **LIKELIHOOD OF CONFUSION**

13. Opposer repeats and realleges the statements and allegations set forth above as if fully set forth in this Count.

14. Opposer's Marks are famous in the United States and throughout the world.

15. The commercial impression created by Applicants' Mark is similar to that of Opposer's Marks.

16. The goods identified in the application are identical and or similar or related to Opposer's Products and Related Services as used with Opposer's Marks.

17. Applicants' mark NEVER STOP TRAINING is confusingly similar to Opposer's Marks and/or appear to be, at the very least, an extension of Opposer's Marks based upon sound, appearance, and connotation. Besides having the identical first two words, Applicant has adopted the "ing" verb form of "Train" to coincide with the "Exploring" portion of Opposer's Marks. Moreover, consumers would readily link the marks as being related because many consumers *train* to *explore* popular and challenging outdoor destinations, and outdoor enthusiasts are a part of Opposer's consumer base. Additionally, NEVER STOP TRAINING presents the same connotation as Opposer's NEVER STOP EXPLORING marks as a phrase of encouragement or action.

18. Accordingly, registration of Applicants' Mark is likely to cause confusion, mistake or deception among consumers as to the source of Applicants' goods and is likely to falsely suggest a common association, affiliation, sponsorship or origin of said goods between Applicants and Opposer, causing damage to Opposer. Moreover, any fault, disappointments, complaints or other dissatisfaction a consumer might experience with the goods of Applicants under NEVER STOP TRAINING will inure to the detriment of Opposer. As such, Applicants are not entitled to registration pursuant to 15 U.S.C. §§1052(a) and (d).

19. Furthermore, the modest differences between Applicants' NEVER STOP TRAINING mark and Opposer's Marks are so minor that it is likely to cause confusion or to cause mistake and deception in the industry and among wholesale purchasers and potential purchasers of Opposer's Products and Related Services, resulting in damage to Opposer by

creating a false suggestion of association or sponsorship, or likelihood of confusion pursuant to 15 U.S.C. §§1052(a) and (d).

**COUNT 2**

**DILUTION**

20. Opposer repeats and realleges the statements and allegations set forth above as if fully set forth in this Count.

21. Through Opposer's extensive advertisement and promotion and substantial sales, Opposer's Marks have become famous.

22. Upon information and belief, any use by Applicants of Applicants' Mark has or will occur after Opposer's Marks became famous.

23. Applicants' Mark is likely to blur and or tarnish the positive association of Opposer's Marks.

24. Thus, if Applicants are permitted to register and use Applicants' mark, it is likely to cause dilution of the distinctive quality of Opposer's Marks.

**COUNT 3**

**NO BONA FIDE INTENTION**

25. Opposer repeats and realleges the statements and allegations set forth above as if fully set forth in this Count.

26. Opposer asserts that in violation of Trademark Act Section 1(b) Applicants did not have a bona fide intention to use their NEVER STOP TRAINING mark in U.S. commerce in connection with the goods listed in U.S. Application Serial No. 85971820 at the time of filing that application.

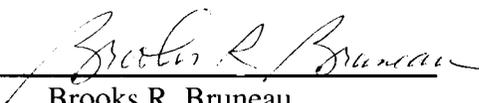
27. Due to the failure of Applicants to have a genuine bona fide intention to use the NEVER STOP TRAINING trademark with all the goods listed in Application Serial No. 85971820 that application is void.

WHEREFORE, Opposer prays that the Board sustain the Opposition and refuse the registration of Applicants' Mark.

Respectfully submitted:

**THE NORTH FACE APPAREL CORP.**

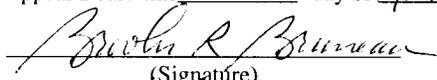
Dated: 3/18/2014

By: 

Brooks R. Bruneau  
Attorney for Opposer  
PORZIO, BROMBERG & NEWMAN, PC  
29 Thanet Road, Suite 201  
Princeton, NJ 08540  
Tel: 609-924-8555

**CERTIFICATE OF ELECTRONIC FILING**

I hereby certify this Notice of Opposition was electronically filed with the Trademark Trial and Appeal Board this 18<sup>th</sup> day of March, 2014.



(Signature)

3/18/2014

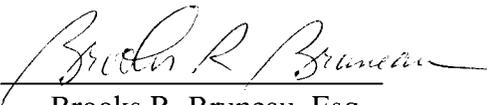
(Date of Signature)

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the combined Notice of Opposition was served upon Applicants, via First Class Mail, Postage Prepaid, on this 18<sup>th</sup> day of March, 2014 addressed to:

**Tom St. John  
Andrew Mahoney  
688 Essex Street  
Bangor, Maine 04401**

Dated: 3/18/2014

By: 

Brooks R. Bruneau, Esq.  
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