

ESTTA Tracking number: **ESTTA606423**

Filing date: **05/27/2014**

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

| | |
|---------------------------|---|
| Proceeding | 91215480 |
| Party | Defendant Andrew Mahoney & Tom St. John |
| Correspondence Address | REGINA VON GOOTKIN BROWN PAINDIRIS & SCOTT LLP 2252 MAIN STREET GLASTONBURY, CT 06033 UNITED STATES amahoney84@hotmail.com, rvongootkin@bpslawyers.com |
| Submission | Answer |
| Filer's Name | Regina von Gootkin |
| Filer's e-mail | rvongootkin@bpslawyers.com |
| Signature | /Regina von Gootkin/ |
| Date | 05/27/2014 |
| Attachments | Answer 5.27.14.pdf(31592 bytes) |

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

Opposition No. 91215480

In The Matter Of Application Serial No. 85971820

-----X
The North Face Apparel Corp.

ESTTA593050

Opposer

Mark: NEVER STOP TRAINING

Serial No.: 85971820

Filed: June 27, 2013

v.

Mahoney, Andrew, St. John, Tom

Applicants

-----X

**APPLICANTS' ANSWER TO
OPPOSER'S NOTICE OF OPPOSITION**

In the matter of Trademark Application Serial No. 85971820 for NEVER STOP TRAINING (hereinafter the "Mark"), COMES NOW the Applicants, Andrew Mahoney and Tom St. John (individually and collectively the "Applicant") by and through its counsel of record, Regina von Gootkin, Esq., to Answer the Notice of Opposition filed by The North Face Apparel Corp. (the "Opposer") with respect to Opposer's trademarks NEVER STOP EXPLORING (Reg. No. 2897197), NEVER STOP EXPLORING (Reg. No. 3630564) and THE NORTH FACE NEVER STOP EXPLORING SPEAKER SERIES (Reg. No. 3454860) (collectively "Opposer's Marks"), as follows:

Applicant specifically denies any confusing similarity, likelihood of confusion or damage to Opposer. The numbered allegations are answered as follows:

1. Applicant lacks sufficient knowledge or information to either admit or deny the allegations of Paragraph 1 of the Opposition, and thus, those allegations are denied.

2. Applicant lacks sufficient knowledge or information to either admit or deny the allegations of Paragraph 2 of the Opposition, and thus, those allegations are denied.

3. Applicant lacks sufficient knowledge or information to either admit or deny the allegations of Paragraph 3 of the Opposition, and thus, those allegations are denied.

4. Applicant lacks sufficient knowledge or information to either admit or deny the allegations of Paragraph 4 of the Opposition, and thus, those allegations are denied.

5. This paragraph does not set forth a claim for relief or aver facts in support of a claim to which an answer is required.

6. Applicant lacks sufficient knowledge or information to either admit or deny the allegations of Paragraph 6 of the Opposition, and thus, those allegations are denied.

7. Applicant lacks sufficient knowledge or information to either admit or deny the allegations of Paragraph 7 of the Opposition, and thus, those allegations are denied.

8. Applicant lacks sufficient knowledge or information to either admit or deny the allegations of Paragraph 8 of the Opposition, and thus, those allegations are denied.

9. Applicant lacks sufficient knowledge or information to either admit or deny the allegations of Paragraph 9 of the Opposition, and thus, those allegations are denied.

10. Applicant lacks sufficient knowledge or information to either admit or deny the allegations of Paragraph 10 of the Opposition, and thus, those allegations are denied.

11. Applicant admits the allegations of Paragraph 11 of the Opposition.

12. Applicant admits the allegations of Paragraph 12 of the Opposition.

COUNT 1 LIKELIHOOD OF CONFUSION

13. The responses to Paragraphs 1 through 12 of the Opposition are hereby incorporated and made the responses to the allegations of this Paragraph 13.

14. Applicant denies the allegations of Paragraph 14 of the Opposition and specifically denies that Opposer's Marks are famous.

15. Applicant denies the allegations of Paragraph 15.

16. Applicant denies the allegations of Paragraph 16 that the goods in the Applicant's application are identical to the goods used with Opposer's Marks.

17. The allegations contained in Paragraph 17 of the Opposition are denied. Applicant believes that the Applicant's Mark is sufficiently distinct and unrelated to Opposer's Marks such that no mistake, deception, injury or damage will occur by virtue of Applicant's use of Applicant's Mark.

18. The allegations contained in Paragraph 18 of the Opposition are denied. Applicant believes that the Applicant's Mark is sufficiently distinct and unrelated to Opposer's Marks such that no mistake, deception, injury or damage will occur by virtue of Applicant's use of Applicant's Mark.

19. The allegations contained in Paragraph 19 of the Opposition are denied. Applicant believes that the Applicant's Mark is sufficiently distinct and unrelated to Opposer's Marks such that no mistake, deception, injury or damage will occur by virtue of Applicant's use of Applicant's Marks.

COUNT 2 DILUTION

20. The responses to Paragraphs 1 through 19 of the Opposition are hereby incorporated and made the responses to the allegations of this Paragraph 20.

21. Applicant lacks sufficient knowledge or information to either admit or deny the allegations of Paragraph 21 relating to Opposer's advertisements, promotions and sales, and thus, those allegations are denied. Applicant specifically denies that Opposer's Marks are famous.

22. Applicant denies the allegations of Paragraph 22.

23. Applicant denies the allegations of Paragraph 23.

24. Applicant denies the allegations of Paragraph 24.

COUNT 3 NO BONA FIDE INTENTION

25. The responses to Paragraphs 1 through 24 of the Opposition are hereby incorporated made the responses to the allegations of Paragraph 25.

26. Applicant denies the allegations of Paragraph 26.

27. Applicant denies the allegations of Paragraph 27.

AFFIRMATIVE DEFENSES

1. Applicant reserves the right to assert affirmative defenses that may become known in the course of this proceeding.

2. Opposer fails to state a claim upon which relief can be granted.

3. There is no likelihood of confusion, mistake or deception, because, inter alia, Opposer's Marks and Applicant's Mark are not confusingly similar based on the inherent and unmistakable differences in the marks.

4. The Applicant's Mark and Opposer's Marks are sufficiently dissimilar in appearance, sound and meaning to avoid a likelihood of confusion.

5. Opposer has not been and will not be damaged by Applicant's Mark.

6. Opposer's Marks are not famous, and thus Opposer's Marks cannot be tarnished or diluted.

7. Applicant is a small business that is harmed by Opposer's litigation tactics wherein Opposer attempts to enforce its alleged trademark rights beyond a reasonable interpretation of the scope of the rights legitimately granted to the trademark owner.

8. Applicant's goods and services are sufficiently distinct from Opposer's goods and services.

WHEREFORE, Applicant requests that the Opposition be dismissed with prejudice and that Application Serial No. 85971820 be allowed to register.

RESPECTFULLY SUBMITTED,
APPLICANTS
Tom St. John and Andrew Mahoney

Date: May 27, 2014

By /s/ Regina von Gootkin
Regina von Gootkin
Attorney for the Applicants
Brown, Paindiris & Scott, LLP
2252 Main Street
Glastonbury, CT 06033
860 659-0700
rvongootkin@bpslawyers.com

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

Opposition No. 91215480

In The Matter Of Application Serial No. 85971820

-----X
The North Face Apparel Corp.

ESTTA593050

Opposer

Mark: NEVER STOP TRAINING

Serial No.: 85971820

Filed: June 27, 2013

v.

Mahoney, Andrew, St. John, Tom

Applicants

CERTIFICATION OF SERVICE

I hereby certify that a copy of the foregoing Answer was sent by first class and electronic mail, this 27th day of May, 2014 to all counsel and pro se parties as follows:

Brooks R. Bruneau
Porzio, Bromberg & Newman
29 Thanet Road Suite 201
Princeton, NJ 08540
brbruneau@pbnlaw.com

/s/ Regina von Gootkin
Regina von Gootkin