

ESTTA Tracking number: **ESTTA629125**

Filing date: **09/24/2014**

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

Proceeding	91217020
Party	Defendant Gregory Adam Dunlap
Correspondence Address	MARC BAUMGARTNER BAUMGARTNER PATENT LAW 3439 NE SANDY BLVD STE 285 PORTLAND, OR 97232 1959 UNITED STATES marc@bapalaw.com
Submission	Response to Board Order/Inquiry
Filer's Name	Dana B. Robinson
Filer's e-mail	dana@techlawllp.com, kayla@techlawllp.com, jess@techlawllp.com
Signature	/Dana B. Robinson/
Date	09/24/2014
Attachments	RUN FREE Response to Order to Show Cause and Answer.pdf(1097137 bytes)

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

Serial No.:	86141075)	
Mark:	RUN FREE)	
Filed:	12/11/2013)	
Published:	5/27/2014 in the Official Gazette)	
)	Opposition No. 91217020
)	
)	
SIGNMEUP.COM, INC.)	
<i>Opposer,</i>)	
)	
v.)	
)	
GREGORY ADAM DUNLAP,)	
)	
<i>Applicant.</i>)	

**RESPONSE TO ORDER TO SHOW CAUSE WHY JUDGEMENT BY DEFAULT
SHOULD NOT BE ENTERED**

On August 25, the Trademark Trial and Appeal Board (TTAB) issued an order granting Applicant “thirty days from the mailing date of this order to show cause why judgment by default should not be entered against applicant in accordance with Fed. R. Civ. P. 55(b)(2).” Applicant hereby responds to the TTAB’s order to show cause, and attaches the Answer to the Opposition to this Response.

Applicant will demonstrate in this Response that Applicant has good cause for why default should not be entered, and respectfully asks the Board to accept the Answer and allow this Opposition to proceed.

I. PROCEDURAL AND FACTUAL BACKGROUND

A. Applicant and Applicant’s Mark

Applicant is the owner of an apparel business called Take Flight (“Take Flight”), which designs, manufactures, markets, and distributes apparel primarily in the urban and athletic genres.

(Declaration of Gregory Adam Dunlap, attached as Exhibit B to this Response, hereinafter “Dunlap Decl.” at 3). Take Flight began in 2009 in the niche market of Parkour and Freerunning, but has gained popularity so that now athletes and customers all over the world and from all sports are wearing Take Flight products. (Dunlap Decl. at 3-4). Applicant’s RUN FREE trademark is an important brand in Take Flight’s portfolio. (Dunlap Decl. at 6). Applicant’s RUN FREE trademark was first used in commerce on apparel as early as April 2013. (Dunlap Decl. at 5). On December 11, 2013, Applicant filed a trademark application for RUN FREE (Serial No. 86141075). Applicant’s RUN FREE trademark was published in the Official Gazette on May 27, 2014.

B. Opposer’s Mark and this Opposition

Opposer filed its trademark application for RUNFREE (Serial No. 86314490) on June 19, 2014, claiming a date of first use back to August 31, 2012. Five days later, on June 24, 2014, Opposer filed this Opposition on June 24, 2014. The grounds for this Opposition are priority and likelihood of confusion, and the mark cited by Opposer as basis for this Opposition is the RUNFREE (Serial No. 86314490) mark.

Due to a miscommunication between Applicant and Applicant’s attorney, Applicant was not made aware of the date to answer the Opposition. (Dunlap Decl. at 7). Applicant affirms he did not willfully delay answering this Opposition, and was genuinely unaware there was any deadline to answer the Opposition. (Dunlap Decl. at 8-9). Applicant even made it clear to the President of SignMeUp.com, Inc. (Opposer) that he believed he still had time to proceed in the action before the USPTO. (Dunlap Decl. at 17).

Applicant’s answer to this Opposition was due August 3, 2014. Notice of Default and the order to show cause was entered on August 25, 2014.

C. Interaction between Applicant and Opposer.

After Applicant became aware of the Opposition, Applicant searched for a way to contact Opposer directly to resolve the dispute. (Dunlap Decl. at 9). Applicant first began communication with Mr. Harrington, the President of SignMeUp.com, on August 18, 2014 after finding Mr. Harrington's contact information on LinkedIn and Opposer's website, SignMeUp.com. (Dunlap Decl. at 10). On August 19th, 2014, Mr. Harrington responded to Applicant's question regarding a co-existence opportunity by stating "let me chat with our trademark attorney and then I'll follow up with you." (Exhibit 1 to Dunlap Decl. at pg. 4). Mr. Harrington did not respond to Applicant, so on or about August 20-26, Applicant called Mr. Harrington. Mr. Harrington responded that he was open to a pragmatic discussion regarding co-existence, but still needed to speak with legal counsel. (Dunlap Decl. at 12).

Applicant did not hear from Mr. Harrington again until August 29, 2014, when Applicant asked if Mr. Harrington in an e-mail if he had any news regarding resolving the matter. (Dunlap Decl. at 13; Exhibit 1 to Dunlap Decl. at pg. 3). Mr. Harrington responded on August 29, 2014 and stated "we're ok with licensing the Run Free brand to you, we'll just have to figure out the details." (Dunlap Decl. at 13; Exhibit 1 to Dunlap Decl. at pg. 3).

Time continued to pass without word from Opposer or Mr. Harrington. Applicant again contacted Mr. Harrington, asking about co-existence. (Exhibit 1 to Dunlap Decl. at 14). Two days later, on September 4, 2014, Mr. Harrington responded that Opposer would enter into a co-existence agreement in exchange for \$5,000 from Applicant. (Dunlap Decl. at 15; Exhibit 1 to Dunlap Decl. at pg. 2). Applicant was surprised by Opposer's offer since Applicant had made it clear to Opposer that Applicant would not agree to pay money to co-exist when he owned the RUN FREE mark. (Dunlap Decl. at 15). Thus, Applicant rejected Opposer's offer of co-

existence on September 4, 2014. (Dunlap Decl. at 16). Applicant then proposed a counteroffer via E-mail the same day, offering a co-existence agreement with Applicant in exchange for Opposer paying Applicant \$5,000. (Dunlap Decl. at 16). Mr. Harrington did not respond to Applicant. (Dunlap Decl. at 17).

Applicant then contacted counsel, and became aware that a notice of default had been issued in this instant Opposition. (Dunlap Decl. at 18). Applicant immediately began preparing this Response. (Dunlap Decl. at 18).

II. ARGUMENT

The standard for determining whether default judgment should be entered against applicant for its failure to file a timely answer is governed by the Fed. R. Civ. P. 55(c) standard, that is, whether the defendant has shown good cause why default judgment should not be entered against it.

Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 312 provides that “Good cause why default judgment should not be entered against a defendant, for failure to file a timely answer to the complaint, is usually found when the defendant shows that (1) the delay in filing an answer was not the result of willful conduct or gross neglect on the part of the defendant, (2) the plaintiff will not be substantially prejudiced by the delay, and (3) the defendant has a meritorious defense to the action.” TBMP § 312 (2014). Applicant will prove it meets each of these elements for good cause, and will address why the Board should accept Applicant’s answer.

A. Applicant’s Delay in Filing the Answer was not the Result of Willful Conduct or Gross Negligence.

The TTAB affirms, “Good cause is usually found to have been established if the delay in filing is not the result of willful conduct or gross neglect on the part of the defendant, if the delay

will not result in substantial prejudice to the plaintiff, and if the defendant has a meritorious defense.” *Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 USPQ2d 1556, 1557 (TTAB 1991). When applicant’s failure to file an answer is “clearly due to an inadvertence on the part of applicant's counsel and not the result of any willful conduct or gross negligence” on the part of applicant itself, then the delay in filing is not the result of willful conduct or gross negligence. *Id.* (good cause found when the delay in filing was due to a mix up during vacation scheduling at a law firm, and was not due to applicant’s willful conduct).

In this case, delay in filing the answer was not the result of willful conduct or gross negligence on the part of Applicant. Due to a miscommunication between Applicant and Applicant’s attorney, Applicant was not made aware of the date to answer the Opposition. (Dunlap Decl. at 7). Applicant also affirms he did not willfully delay answering this Opposition (Dunlap Decl. at 8). In short, Applicant was genuinely unaware there was any deadline to answer the Opposition. (Dunlap Decl. at 9).

When Applicant received the Notice of Opposition, Applicant immediately went to try to reach out to Opposer to resolve the issue, but was never informed that there was a deadline to answer. (Dunlap Decl. at 9; 17). Applicant’s communications with Opposer and Mr. Harrington, president of SignMeUp.com, Inc., demonstrate that Applicant was not aware of the Opposition deadlines, and was trying to enter into a co-existence with Opposer. (Exhibit 1 to Dunlap Decl. and Dunlap Decl. at 10-16). Applicant even made it clear to Opposer’s President, Mr. Harrington, that he believed he still had time to proceed in the action before the USPTO. (Dunlap Decl. at 17). Again, Applicant was unaware of any deadline to answer the Opposition. (Dunlap Decl. at 7-9). Like in *Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, Applicant was unaware the deadline to answer had passed, despite the fact counsel received the Notice of Opposition.

The TTAB in *Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.* found this was not willful or gross negligence to delay, and such is the case here.

From the communications between Applicant and Mr. Harrington, it appears Opposer deliberately strung Applicant along for several weeks, promising to get back to Applicant about a co-existence agreement. Opposer knew the deadline for this Opposition was ticking, yet Opposer slowly responded to Applicant's communications regarding a co-existence agreement and did not inform Applicant of any deadlines with the Opposition. (Dunlap Decl. at 10-16; 17). It is evident by the E-mails attached as Exhibit 1 to the Declaration of Gregory Adam Dunlap that Opposer was aware Applicant genuinely did not know there was a deadline to answer the Opposition. Opposer was also aware Applicant was making a good-faith effort to negotiate a co-existence during the time Applicant could have answered, yet it seems that the end game for Opposer was to extract \$5,000 from Applicant. (Dunlap Decl. at 17). Opposer should not be rewarded for its tactics, and Applicant certainly should not be punished for failing to answer the Opposition when, through no fault of Applicant, Applicant was unaware of the deadline.

Given the foregoing, Applicant certainly did not willfully delay filing the answer, and was not grossly negligent in missing the deadline to file the answer.

B. Opposer will not be Substantially Prejudiced by the Delay

The TTAB has found opposer was not caused substantial prejudice when an applicant filed its answer over two months late. *See NetScout Systems, Inc. v. ForeScout Technologies, Inc.*, Opposition No. 91158578 (2004). Even a delay of six months may not be prejudicial to an Opposer. *See Delorme Publishing Company, Inc. v. Eartha's, Inc.*, 60 USPQ2d (BNA) 1222 (TTAB 2000) (noting that a delaying answer for 6 months was not prejudicial, and stating if “opposer desired certainty as to the status of this proceeding, it could have filed a motion for

default judgment at any time after [applicant's] answer was due"). Substantial delay is not caused simply by applicant's mark being present as a live trademark application. *Id.*

Opposer will not be prejudiced if the Board accepted Applicant's answer, attached to this motion as Exhibit A. Opposer has been in communication with Applicant during August and September, and did not object or alert Applicant to any prejudice it would suffer should Applicant fail to file a timely answer. (Dunlap Decl. at 10-17). In fact, Opposer attempted to negotiate a co-existence agreement with Applicant. (Exhibit 1 to Dunlap Decl. at pg 1-5; Dunlap Decl. at 10-17). Such a discussion regarding a co-existence agreement would be grounds to continue the time for Applicant to answer, thus Opposer is no less prejudiced if Applicant answers now than if Applicant motioned to extend the time to answer.

In any event, an answer that is less than two months late does not substantially prejudice Opposer. *See NetScout Systems, Inc. v. ForeScout Technologies, Inc.*, Opposition No. 91158578 (2004) (where the applicant was allowed to answer even though the deadline to answer passed over two months prior); *see also Delorme Publishing Company, Inc. v. Eartha's, Inc.*, 60 USPQ2d (BNA) 1222 (TTAB 2000) (noting an answer that was 6 months was not prejudicial, but denying applicant showed good cause on other grounds). Applicant notes "the TTAB is lenient in accepting late-filed answers especially when the answer is filed relatively soon after the due date." *Mattel, Inc. v. Henson*, 88 Fed. Appx. 401 at n.1 (Fed. Cir. 2004); *see also National Football League*, 85 USPQ2d at 1855. Again, Applicant's answer will be less than two months late, and during that time Applicant and Opposer were attempting to negotiate a co-existence. Thus, the delay in Applicant's late-filed answer is not excessive, and will not cause Opposer substantial prejudice.

C. Applicant has a Meritorious Defense to the Action.

The TTAB “typically considers the filing of an answer... as evidence of a meritorious defense to the action and as satisfying the third element of the required showing for good cause in the case of a default.” *NetScout Systems, Inc. v. ForeScout Technologies, Inc.*, Opposition No. 91158578 (2004). In short, if applicant submits “an answer which is not frivolous, applicant has adequately shown that it has a meritorious defense.” *Fred Hayman Beverly Hills, Inc.*, 21 USPQ2d at 1557. Additionally, the TTAB keeps “in mind that the law strongly favors determination of cases on their merits.” *CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2d 1300, 1301 (TTAB 1999). Here, Applicant has attached its answer as Exhibit A to this Response, and thus has a meritorious defense in this action.

In fact, Applicant has several meritorious defenses in this Opposition. Applicant has first use of its RUN FREE mark on clothing, as Applicant began selling clothing bearing the RUN FREE trademark as early as April, 2013. (Dunlap Decl. at 5). Opposer filed its RUNFREE trademark application (Serial No. 86314490) for clothing on June 19, 2014, claiming first use back to 8/21/2012. However, Applicant intends to show that Opposer never had use in commerce of RUNFREE on apparel on that date, that the specimen Opposer filed for trademark application Serial No. 86314490 was fraudulent, and that Opposer never had an intent to use RUNFREE in commerce on clothing. Therefore, Applicant is the prior user and has superior trademark rights in the mark.

Applicant also claims Opposer acted in bad faith, and only filed the RUNFREE mark on clothing to prevent others such as Applicant from using the phrase “run free” or “runfree” as a trademark. Interestingly enough, Opposer filed the RUNFREE trademark application at issue here (Serial No. 86314490) a mere five days before filing this Opposition. Applicant’s Answer

and Affirmative defenses, attached as Exhibit A, show that Applicant has several grounds for defense in this action, including fraud, unclean hands, and bad faith. In sum, it is clear Applicant has several meritorious defenses to this Opposition, and is ready to move forward with them.

D. The TTAB is Lenient in Accepting late-filed Answers.

“The TTAB is lenient in accepting late-filed answers, especially when the answer is filed relatively soon after the due date.” *Mattel, Inc.*, 88 Fed. Appx. at n.1; *see also National Football League v. DNH Management, LLC*, 85 USPQ2d 1852, 1855 (TTAB 2008) (“Generally, the Board is liberal in granting extensions of time before the period to act has elapsed so long as the moving party has not been guilty of negligence or bad faith...”). Here, Applicant was not grossly negligent or acting in bad faith to delay answering. Applicant attempted to resolve the conflict with Opposer directly for several weeks, and was misinformed and never corrected that an answer was due. (Dunlap Decl. at 7-17). As soon as Applicant became aware of the default, Applicant responded by directing counsel to file this Response and attached answer. (Dunlap Decl. at 18). This Response and answer are less than two months late. Therefore, good cause exists and Applicant asks that the Board accept his late-filed answer.

III. CONCLUSION

The law and evidence attached to this motion demonstrate that Applicant has good cause for failing to answer the Opposition. Applicant, through no fault of his own, was unaware of the deadline to answer the Opposition. Moreover, Opposer should not be rewarded for stringing Applicant along for weeks over the possibility of co-existence while the deadline to answer ticked away, unbeknownst to Applicant. Opposer also will not be substantially prejudiced, since Applicant’s answer was due less than two months ago and Applicant is ready to answer now. Therefore, Applicant respectfully submits that it has shown good and sufficient cause to warrant

overcoming the default. Applicant further asks to be allowed to submit its answer, attached as Exhibit A.

Dated: September 24, 2014

Respectfully submitted,

By: /Dana B. Robinson/

Dana B. Robinson
P.O. Box 1416
La Jolla, CA 92038
dana@techlawllp.com
Attorney for Applicant

EXHIBIT A

Answer and Affirmative Defenses

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

Serial No.:	86141075)	
Mark:	RUN FREE)	
Filed:	12/11/2013)	
Published:	5/27/2014 in the Official Gazette)	
)	Opposition No. 91217020
)	
)	
SIGNMEUP.COM, INC.)	
<i>Opposer,</i>)	
)	
v.)	
)	
GREGORY ADAM DUNLAP,)	
)	
<i>Applicant.</i>)	

ANSWER AND AFFIRMATIVE DEFENSES

Applicant, Gregory Adam Dunlap (hereinafter “Applicant” or “Mr. Dunlap”) hereby submits an Answer to the Notice of Opposition (“Opposition”) filed by SignMeUp.Com, Inc., (hereinafter “Opposer”).

1. Applicant admits the allegations of paragraph 1 of the Opposition.
2. Applicant admits the allegations of paragraph 2 of the Opposition.
3. Applicant admits that Applicant’s Application states that Applicant’s first use of the mark and first use of the mark in commerce began on March 21, 2014, but denies the remainder of the allegations in paragraph 3.
4. Applicant denies the allegations of paragraph 4 of the Opposition.
5. Applicant denies the allegations of paragraph 5 of the Opposition.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth of Opposer's claim that if Applicant is granted the registration being opposed in this Notice, it would interfere with Opposer's exclusive right to use its mark and would result in detriment and damage to Opposer, and therefore denies the allegations in paragraph 6.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth of Opposer's claim that Opposer would be damaged by a grant of a registration certificate to the Applicant of the trademark which is the subject of Serial No. 86/141,075, and therefore denies the allegations in paragraph 7.

As for Affirmative Defenses, Applicant states as follows:

AFFIRMATIVE DEFENSES

1. Applicant has been using Applicant's Mark and developing consumer recognition and goodwill therein since at least April 2013, such use being known to the general public and Opposer. Opposer failed to take meaningful action to assert the claims on which it bases this Opposition, on which inaction Applicant has relied to its detriment. Opposer's claims are consequently barred by the doctrines of laches, acquiescence and estoppel.

2. Opposer has engaged in a practice of "trademark bullying" whereby it has used its trademark application (Serial No. 86314490), and rights as a trademark owner to harass and intimidate another business beyond what the law might reasonably be interpreted to allow, and as a result, Opposer is barred from asserting this Opposition by the doctrine of unclean hands.

3. Opposer's file wrapper history estops Opposer from asserting the claims set forth in the opposition.

4. Opposer has instituted this action in bad faith.

5. The Opposer's registrations are invalid or void *ab initio* due to a fraudulent Statement of Use or other invalidity or cancellation.

6. The Opposer has acted fraudulently to the Trademark Office by filing its application for RUNFREE (Serial No. 86314490) based on use in commerce when in fact it does not and did not have use or a bona fide intent to use its mark for all goods and services identified in the application. Opposer stated RUNFREE (Serial No. 86314490) was used in commerce as early as 8/21/2012, but in fact Opposer made this statement knowing it did not have actual use or a bona fide intent to use the mark in commerce. Opposer made this statement so that RUNFREE (Serial No. 86314490) would proceed to registration.

7. Opposer's use of RUNFREE (Serial No. 86314490) is ornamental and has not become distinctive as an indication of the source of the goods offered under said mark. As such, RUNFREE (Serial No. 86314490) as used by Opposer is unable to function as a trademark, and thus Opposer has no grounds for the Opposition.

8. Opposer's Opposition fails to state a claim upon which the relief sought may be granted. WHEREFORE, Applicant respectfully requests that the Notice of Opposition be rejected and that Applicant's marks be allowed to proceed to registration.

Dated: September 24, 2014

Respectfully submitted,

By: _____/Dana B. Robinson/_____

Dana B. Robinson
P.O. Box 1416
La Jolla, CA 92038
dana@techlawllp.com
Attorney for Applicant

EXHIBIT B

Declaration of Gregory Adam Dunlap

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

Serial No.:	86141075)	
Mark:	RUN FREE)	
Filed:	12/11/2013)	
Published:	5/27/2014 in the Official Gazette)	
)	Opposition No. 91217020
)	
)	
	SIGNMEUP.COM, INC.)	
	<i>Opposer,</i>)	
)	
	v.)	
)	
	GREGORY ADAM DUNLAP,)	
)	
	<i>Applicant.</i>)	
)	

DECLARATION OF GREGORY ADAM DUNLAP

I, Gregory Adam Dunlap, declare as follows:

1. I am the Applicant in this action, Opposition No. 91217020.
2. I am the owner of the RUN FREE trademark application (Serial No. 86141075).
3. I am the owner of an apparel business called Take Flight (“Take Flight”), which designs, manufactures, markets, and distributes apparel primarily in the urban and athletic genres. Take Flight sells hats, beanies, t-shirts, thermals, long sleeve shirts, sweatshirts, sweatpants, training pants, shoes and other supplemental products such as sling bags and water bottles. Take Flight began in the niche market of Parkour and Freerunning, but has gained popularity and now athletes and customers all over the world and from all sports are wearing Take Flight products. Take Flight’s goal is to continue growing and to become an international corporation with a globally respected and revered brand based on urban and athletic apparel and shoes.

4. I have been selling apparel through Take Flight since March 2009.

5. I began using the mark RUN FREE on apparel in commerce in April 2013.

6. The RUN FREE mark is a very popular brand under the Take Flight brand portfolio. RUN FREE is meant to suggest association with Parkour and Freerunning. On December 11, 2013, I filed the RUN FREE trademark application (Serial No. 86141075). Our plan is to continue expanding the RUN FREE brand to all of our products.

7. Due to a miscommunication, while I was made aware of the Opposition by the attorney who filed the trademark application for RUN FREE, I was not aware of the date an answer was due.

8. I did not willfully delay answering this Opposition.

9. I was not aware of any deadline to answer the Notice of Opposition. Once I became aware of the Opposition, I searched for a way to contact Opposer directly to solve the dispute.

10. I first began communication with Ralph Harrington, who is the President of Opposer SignMeUp.Com, Inc. ("Mr. Harrington"), on August 18, 2014, by looking up Opposer on LinkedIn and reviewing Opposer's website, SignMeUp.com. I wrote Mr. Harrington an introductory E-mail that I sent through LinkedIn.com and the contact tab of SignMeUp.com.

11. I had several E-mail communications with Mr. Harrington from August 19, 2014 to September 4, 2014 regarding co-existence and the RUN FREE/RUNFREE marks. True and correct copies of these E-mails are attached as Exhibit 1 to this Declaration.

12. On or about August 20 through 26, Mr. Harrington called me to discuss our mutual intent to have a "pragmatic discussion" and find a solution to issues of co-existence between my RUN FREE mark and Opposer's RUNFREE mark. During our conversation, I came to believe that Opposer was not using RUNFREE on apparel.

13. I did not hear from Mr. Harrington again after the above-mentioned phone call until August 29, 2014, which is the same day I wrote him an email to follow up on our phone conversation. Mr. Harrington responded to my E-mail the same day, stating, "We're ok with licensing the Run Free brand to you, we'll just have to figure out the details." True and correct copies of these E-mails are attached as Exhibit 1 to this Declaration.

14. I did not hear from Mr. Harrington after the aforementioned August 29, 2014 E-mails, so I contacted him on or about September 2, 2014 and recommended a co-existence agreement.

15. Mr. Harrington sent me an E-mail on September 4, 2014 letting me know that Opposer would enter into a co-existence agreement if I paid \$5,000. I was surprised by this offer to enter into a co-existence agreement for money, as I believed that I made it clear to Mr. Harrington that I would not pay to co-exist when I owned and had the right to use RUN FREE.

16. I rejected Opposer's offer to enter into a co-existence agreement for \$5,000, and offered Mr. Harrington the same agreement he offered me except that Opposer would pay me \$5,000. Mr. Harrington did not reply to my offer.

17. At no time did Mr. Harrington or Opposer mention that there was a deadline for the answer to the Notice of Opposition, despite all the communications we had. In fact, I mentioned to Mr. Harrington on the phone between August 20-26 that I believed I still had time to proceed in the action before the USPTO. In my last email on September 4, 2014 with Mr. Harrington (attached as Exhibit 1), I even stated this belief.

18. After my communication with Opposer on September 4, 2014, I contacted counsel, and became aware that a notice of default had been issued in this instant Opposition. I then began preparing the Response to Order to Show Cause.

I declare under penalty of perjury that the foregoing is true and correct.

Executed on September 23, 2014, in Portland, Oregon.

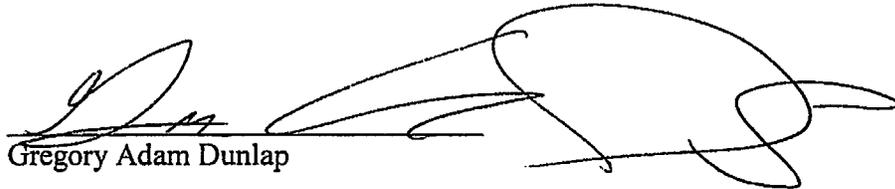

Gregory Adam Dunlap

Exhibit 1 to Declaration of Gregory Adam Dunlap

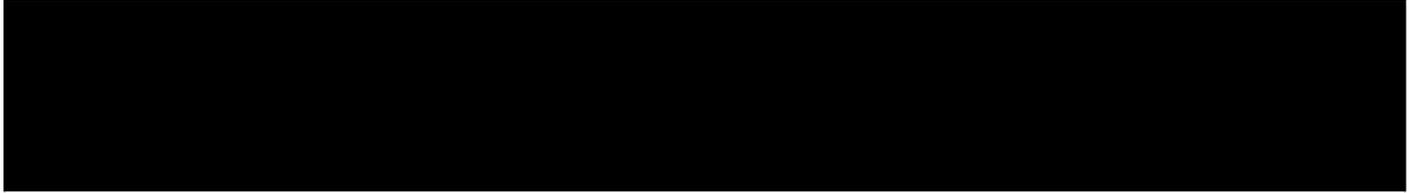


Kayla Jimenez <kayla@techlawllp.com>

Re: Quick Brand Question - Challenging the Challenge

Adam Dunlap | Take Flight <adam@takeflightapparel.com>
To: Kayla Jimenez <kayla@techlawllp.com>

Tue, Sep 23, 2014 at 6:05 PM



Ralph,

Thank you for your time and offer.

I don't like that set-up. It's not a true co-existence agreement, but rather a modified licensing version that set a precedent for your ownership.

You told me you don't know a lot about trademarks and that makes this discussion a bit tricky. Nevertheless, I'll explain where we are and what I understand. Per our additional research, you guys clearly aren't using the Run Free mark in commerce as an apparel brand. It sounds like you are using it as a slogan for the end goal of a program, and in that you've somehow applied for a classification that doesn't pertain to your business model. I'm sure you did this in order to try to protect the name, but the reality is your application was and is fraudulent. What this means in short is you don't actually have rights to Run Free as a trademark for clothing - we have rights to it, and co-existing is actually quite dumb in our case since we don't have to co-exist with you, we can just own it outright.

Based on all this, we'll take the legal route with this one and gain control of the mark through the USPTO. Since you're in a different industry and using it in a different way, you'll be able to keep using it as you are in your classifications. I guess that'll leave us both happy.

If you want to license the brand for us on clothing, then we'll do the \$5,000 co-existent with you. And of course in the same way we'll write it up so you won't have that cost.

If you'd like to do this, please let me know in the next couple days. Otherwise we'll go the legal route as original anticipated.

Thank you again for your time and willingness to discuss this.

Sincerely,

Adam

Adam Dunlap
Parkour 91, LLC
US: +1.503.758.7755
France: +33.06.17.54.84.55
adam@parkour91.com
www.Parkour91.com



Paris | France
Portland, OR | United States

NOTICE: This transmission may contain information that is privileged, confidential, legally protected, and/or exempt from disclosure under applicable law. This e-mail message is intended only for the individual or entity to which it is addressed. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution, or use of the information contained herein (including any reliance thereon) is strictly prohibited. Although this transmission and any attachments are believed to be free of any virus or other defect that might affect any computer system into which it is received and opened, it is the responsibility of the recipient to ensure that it is virus free and no responsibility is accepted by the sender, its subsidiaries and affiliates, as applicable, for any loss or damage arising in any way from its use. If you received this transmission in error, please immediately contact the sender and destroy the material in its entirety, whether in electronic or hard copy format. Thank you.

On Thu, Sep 4, 2014 at 6:50 AM, Ralph Harrington <ralph@signmeup.com> wrote:

Hi Adam,

I've talked with our attorney, not a lot of easy answers. We're willing to do a co-existing agreement + \$5,000. Our attorney can write it up, so you won't have that cost.

Best regards,

Ralph Harrington
President, SignMeUp.com, Inc
[866.526.5111](tel:866.526.5111) x5 (toll free)
[312.343.1263](tel:312.343.1263) (direct)
[312.577.0431](tel:312.577.0431) (fax)

On Sep 2, 2014, at 3:38 PM, Adam Dunlap | Parkour 91 <adam@parkour91.com> wrote:

> Ralph,
>
> Let's go with co-existing. What do you think?
>
> Adam
>
>
> Adam Dunlap
> Parkour 91, LLC
> US: [+1.503.758.7755](tel:+1.503.758.7755)
> France: [+33.06.17.54.84.55](tel:+33.06.17.54.84.55)
> adam@parkour91.com
> www.Parkour91.com
>
>
>

> Paris | France
> Portland, OR | United States
>
>
> NOTICE: This transmission may contain information that is privileged, confidential, legally protected, and/or exempt from disclosure under applicable law. This e-mail message is intended only for the individual or entity to which it is addressed. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution, or use of the information contained herein (including any reliance thereon) is strictly prohibited. Although this transmission and any attachments are believed to be free of any virus or other defect that might affect any computer system into which it is received and opened, it is the responsibility of the recipient to ensure that it is virus free and no responsibility is accepted by the sender, its subsidiaries and affiliates, as applicable, for any loss or damage arising in any way from its use. If you received this transmission in error, please immediately contact the sender and destroy the material in its entirety, whether in electronic or hard copy format. Thank you.
>
>
> On Fri, Aug 29, 2014 at 5:38 PM, Ralph Harrington <ralph@signmeup.com> wrote:
> Hi Adam,
>
> We're ok with licensing the Run Free brand to you. We'll just have to figure out the details.
>
>
> Best regards,
>
> Ralph Harrington
> President, SignMeUp.com, Inc
> [866.526.5111](tel:866.526.5111) x5 (toll free)
> [312.343.1263](tel:312.343.1263) (direct)
> [312.577.0431](tel:312.577.0431) (fax)
>
>
>
> On Aug 29, 2014, at 5:23 PM, Adam Dunlap | Parkour 91 <adam@parkour91.com> wrote:
>
>> Hi Ralph,
>>
>> We spoke earlier this week and you said you'd speak with your legal council and get back to me. Do you have any news? I'd like to move ahead and get this resolved by early/mid next week.
>>
>> Thank you and kindest,
>>
>> Adam
>>
>>
>> Adam Dunlap
>> Parkour 91, LLC
>> US: [+1.503.758.7755](tel:+1.503.758.7755)
>> France: [+33.06.17.54.84.55](tel:+33.06.17.54.84.55)
>> adam@parkour91.com
>> www.Parkour91.com
>>
>>
>>
>> Paris | France
>> Portland, OR | United States
>>
>>
>> NOTICE: This transmission may contain information that is privileged, confidential, legally protected, and/or exempt from disclosure under applicable law. This e-mail message is intended only for the individual or entity to which it is addressed. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution, or use of the information contained herein (including any reliance thereon) is

strictly prohibited. Although this transmission and any attachments are believed to be free of any virus or other defect that might affect any computer system into which it is received and opened, it is the responsibility of the recipient to ensure that it is virus free and no responsibility is accepted by the sender, its subsidiaries and affiliates, as applicable, for any loss or damage arising in any way from its use. If you received this transmission in error, please immediately contact the sender and destroy the material in its entirety, whether in electronic or hard copy format. Thank you.

>>

>>

>> On Tue, Aug 19, 2014 at 12:12 PM, Adam Dunlap | Parkour 91 <adam@parkour91.com> wrote:

>> Ralph,

>>

>> Sounds good. Awaiting your word.

>>

>> Kindest,

>>

>> Adam

>>

>>

>> Adam Dunlap

>> Parkour 91, LLC

>> US: [+1.503.758.7755](tel:+1.503.758.7755)

>> France: [+33.06.17.54.84.55](tel:+33.06.17.54.84.55)

>> adam@parkour91.com

>> www.Parkour91.com

>>

>>

>>

>> Paris | France

>> Portland, OR | United States

>>

>>

>> NOTICE: This transmission may contain information that is privileged, confidential, legally protected, and/or exempt from disclosure under applicable law. This e-mail message is intended only for the individual or entity to which it is addressed. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution, or use of the information contained herein (including any reliance thereon) is strictly prohibited. Although this transmission and any attachments are believed to be free of any virus or other defect that might affect any computer system into which it is received and opened, it is the responsibility of the recipient to ensure that it is virus free and no responsibility is accepted by the sender, its subsidiaries and affiliates, as applicable, for any loss or damage arising in any way from its use. If you received this transmission in error, please immediately contact the sender and destroy the material in its entirety, whether in electronic or hard copy format. Thank you.

>>

>>

>> On Tue, Aug 19, 2014 at 6:30 AM, Ralph Harrington <ralph@signmeup.com> wrote:

>> Hi Adam,

>>

>> Trademarks are not really my area of expertise. I'd like to think we're pretty pragmatic too. Let me chat with our trademark attorney and then I'll follow up with you.

>>

>> Best regards,

>>

>> Ralph Harrington

>> President, SignMeUp.com, Inc

>> [866.526.5111](tel:866.526.5111) x5 (toll free)

>> [312.343.1263](tel:312.343.1263) (direct)

>> [312.577.0431](tel:312.577.0431) (fax)

>>

>>

>>

>>

>>

>>

>
>

Adam

Adam Dunlap
Take Flight
USA: +1.503.758.7755
France: +33.06.17.54.84.55
adam@takeflightapparel.com
www.TakeFlightApparel.com
Jump. Fly. Dream.



"The Official Clothing of Parkour. Endorsed and Worn by Traceurs Worldwide."

NOTICE: This transmission may contain information that is privileged, confidential, legally protected, and/or exempt from disclosure under applicable law. This e-mail message is intended only for the individual or entity to which it is addressed. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution, or use of the information contained herein (including any reliance thereon) is strictly prohibited. Although this transmission and any attachments are believed to be free of any virus or other defect that might affect any computer system into which it is received and opened, it is the responsibility of the recipient to ensure that it is virus free and no responsibility is accepted by the sender, its subsidiaries and affiliates, as applicable, for any loss or damage arising in any way from its use. If you received this transmission in error, please immediately contact the sender and destroy the material in its entirety, whether in electronic or hard copy format. Thank you.

[Quoted text hidden]

