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TTAB

May 10, 2006

Express Mail

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
Madison East, Concourse Level Room C 55
600 Dulany Street
Alexandria, VA 22314

TS/801862

Re: Cancellation Proceeding No. 92045655

Dear Commissioner:

In connection with the above referenced cancellation proceeding, enclosed please find three (3) copies of Registrant Father's Day/Mother's Day Council, Inc.'s Answer, certificate of service and certificate of mailing.

Please call me if you have any questions.

Respectfully submitted,



Donald L. Kreindler

Enclosures

cc: Clinton G. Newton, Esq.



05-15-2006

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #34

967995.1

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

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NATIONAL CENTER FOR FATHERING, INC. :
Petitioner,: **Cancellation No. 92045655**
-against- : **Reg. No. 2,440,274**
FATHER'S DAY/MOTHER'S DAY COUNCIL, INC., : **ANSWER OF FATHER'S**
: **DAY/MOTHER'S DAY**
: **COUNCIL INC.**
Registrant.:
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Registrant, Father's Day/Mother's Day Council, Inc. ("Registrant"), by its attorneys, Phillips Nizer LLP, answers the Petition to Cancel of Petitioner, National Center for Fathering, Inc. ("Petitioner"), as follows:

1. Registrant admits the allegations set forth in paragraph 1 of the Petition to Cancel, and refers the Board to the file of Registration No. 2,440,274 regarding such application.
2. Registrant denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 2 of the Petition to Cancel.
3. Registrant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 3 of the Petition to Cancel.
4. Registrant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 4 of the Petition to Cancel.
5. Registrant denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 5 of the Petition to Cancel.
6. Registrant denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 6 of the Petition to Cancel.

7. Registrant denies the allegations set forth in Paragraph 7 of the Petition to Cancel.
8. Registrant denies the allegations set forth in Paragraph 8 of the Petition to Cancel.
9. Registrant denies the allegations set forth in Paragraph 9 of the Petition to Cancel.
10. Registrant denies the allegations set forth in Paragraph 10 of the Petition to Cancel.

AFFIRMATIVE DEFENSES

As and for its affirmative defenses to Petitioner's Petition, Registrant alleges as follows:

11. Registrant has utilized the mark "FATHER OF THE YEAR" in interstate commerce since 1946 on a substantially exclusive basis. In the course of those 60 years, the mark "FATHER OF THE YEAR" has become distinctive of Registrant's service (Trademark Act §2(f), 15 U.S.C. §1052(f)). Registrant's mark is therefore not merely descriptive of its service.
12. By letter dated June 8, 2004 Registrant, through its counsel, advised Petitioner of its exclusive legal right to the "FATHER OF THE YEAR" trademark and demanded that Petitioner cease and desist from any further use of the name "FATHER OF THE YEAR". By letter dated June 24, 2004, Petitioner responded to Registrant's counsel "we have never used the trademark, FATHER-OF-THE-YEAR, and will respect your request to refrain from using it in the future." In consideration of this representation by Petitioner, Registrant refrained from initiating legal action against Petitioner. Petitioner has breached the representation and contractual commitment set forth in its June 26, 2004 letter. In addition, either Petitioner's representation in said letter that it had never used the trademark "FATHER OF THE YEAR" was false, or the allegation in its present Petition (para. 2) that it has used the phrase "FATHER OF THE YEAR" for at least seven years is false.

13. If Petitioner had any right to challenge Registrant's registration of the mark "FATHER OF THE YEAR", Petitioner has waived any such right by its actions as set forth above and should be estopped from challenging Registrant's registration. Petitioner's Petition, filed on April 3, 2006, the very last day of the five-year period for objections, is invalid and without merit.

14. Petitioner's unclean hands further precludes granting it any right to cancellation of Registrant's registration.

WHEREFORE, Registrant respectfully requests that:

- (a) The TTAB dismiss the Petition to Cancel with prejudice; and
- (b) The TTAB award Registrant such other relief that is just and proper.

Dated: New York, New York
May 10, 2006

Phillips Nizer LLP



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Barry H. Fishkin
John F. Wilk
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To: Clinton G. Newton, Esq.
Shook, Hardy & Bacon LLP
Attorneys for Petitioner
2555 Grand Boulevard
Kansas City, MO 64108
Tel: (816) 474-6550

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of Registrant's Answer dated May 15, 2006 is being mailed on this fifteenth day of May, 2006 as first class mail, postage prepaid, in an envelope directed to attorney for Petitioner as follows:

Clinton G. Newton, Esq.
Shook, Hardy & Bacon LLP
Attorneys for Petitioner
2555 Grand Boulevard
Kansas City, MO 64108

By: 
Julie Velocci
Paralegal

Phillips Nizer LLP
666 Fifth Avenue
New York, New York 10103
Attorneys for Registrant
Father's Day/Mother's Day Council, Inc.

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

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In the matter of Registration No. 2,440,274 :
NATIONAL CENTER FOR FATHERING, INC. : Opposition No. 92045655
Petitioner, :
- against- :
FATHER'S DAY/MOTHER'S DAY COUNCIL, :
INC., :
Registrant. :
-----X

CERTIFICATE OF MAILING

It is hereby certified that three copies of Registrant's foregoing Answer dated May 15, 2006, have been deposited and transmitted by United States Postal Service Express Mail "Post Office to Addressee" Service (Serial No. EV 594172059 US) on this fifteenth day of May, 2006 to:

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
Madison East, Concourse Level Room C 55
600 Dulany Street
Alexandria, VA 22314

By: 
Julie Velocci
Paralegal

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Father's Day/Mother's Day Council, Inc.,