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

Proceeding	92048879
Party	Defendant IRENE J. ORTEGA DBA GOGIRL ACTIVEWEAR
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Date	06/17/2009
Attachments	Amended Answer to Petition of Cancellation GO GIRL.pdf (7 pages)(42538 bytes)

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

In the matter of Trademark Registration No. 2,227,005

For the Trademark: GO GIRL

Date Registered: March 3, 1999

As to Counter Claim:)
In the Matter of Trade Mark: GO GIRL)
Registration No. 3,235,947)
Registered: May 1, 2007)
Principal Register)
Registrant: NOR-CAL BEVERAGE CO., INC.)
For: Non-Alcoholic Beverages, namely, energy)
drinks)
International Class 32)

NOR-CAL BEVERAGE CO., INC.)
Petitioner and Counter-Defendant,)
IRENE J. ORTEGA, dba GO GIRL)
ACTIVEWEAR)
Respondent and Counter-Claimant.)

Cancellation No. 92048879

**RESPONDENT’S AMENDED ANSWER TO PETITION TO CANCEL,
AFFIRMATIVE DEFENSES, AND COUNTER-CLAIM
TO CANCEL REGISTRATION NO. 3,235,947**

Respondent, IRENE J. ORTEGA (aka IRENE J. ELTON, by marriage) dba GO GIRL ACTIVEWEAR (“Respondent” or “GGA”), submits the following in response to the Amended Petition to Cancel filed by NOR-CAL BEVERAGE CO., INC. (“Petitioner” or “NOR-CAL”):

Petitioner’s Amended Petition to Cancel contains introductory paragraphs. Nothing in these paragraphs appears to be stated as grounds for the Amended Petition to Cancel. To the

extent that any response is required, Respondent denies any statement or allegation contained in the introduction.

1. Respondent admits that NOR-CAL is marketing, distributing and selling an energy drink and clothing under the mark “GO GIRL”, and that Petitioner is the owner of record of Registration No. 3,235,947, but Respondent is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 1 and therefore denies the same.

2. Respondent admits that Petitioner is producing, advertising, promoting, distributing and selling energy drinks and a line of clothing under the “GO GIRL” and “GO GIRL SUGAR FREE ENERGY DRINK” marks, but Respondent is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 2 and therefore denies the same.

3. Respondent admits that she is the owner of the GO GIRL mark for clothing, Registration No. 2,227,005 issued March 2, 1999, for clothing and headgear for women and girls, namely, hats, caps, sweatshirts, sweatpants, leggings, T-shirts and shorts, but Respondent is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 3 and therefore denies the same.

4. Respondent admits that her current business address is P.O. Box 502547, St. Thomas, U.S. Virgin Islands, 00805, and that Respondent is the owner of Registration No. 2,227,005, but Respondent is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 4 and therefore denies the same.

5. Respondent admits that Petitioner sought a license from Respondent, and that the parties were unable to agree upon the terms of such license, and therefore Respondent requested, through its counsel, that Petitioner discontinue use of “GO GIRL” with respect to clothing, but Respondent denies the remaining allegations of Paragraph 5.

6. Respondent admits that she has been using the “GO GIRL” mark since at least as early as 1998, and that Respondent subsequently acquired Registration No. 2,227,005 by assignment, but Respondent denies the remaining allegations of Paragraph 6.

7. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 7 and therefore denies the same.

8. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 8 and therefore denies the same.

9. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 9 and therefore denies the same.

10. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 10 and therefore denies the same.

11. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 11 and therefore denies the same.

12. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 12 and therefore denies the same.

13. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 13 and therefore denies the same.

14. Denied.

15. Respondent admits that she obtained an assignment of Registration No. 2,227,005 and recorded the same with the USPTO Assignment Branch on September 2001, but Respondent is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in Paragraph 15 and therefore denies the same.

16. Denied.

17. Nothing in this paragraph appears to be stated as requiring an admission or denial in support of the Petition to Cancel, but to the extent any response is required Respondent denies any statement or allegation contained in Paragraph 17.

18. Denied.

19. Respondent admits that the Section 8 Affidavit of Use respecting Registration No. 2,227,005 was properly filed by the Respondent as owner of record, and Respondent denies the remaining allegations of Paragraph 19 of the Petition to Cancel.

20. Denied.

21. Denied.

22. Respondent incorporates herein its admissions and denials alleged in Paragraph Nos. 1-21, as if fully set forth herein.

23. Respondent admits that an appropriate Affidavit of Use was filed on her behalf with respect to Registration No. 2,227,005, and Respondent denies the remaining allegations of Paragraph 23 of the Amended Petition to Cancel.

24. Denied.

25. Denied.

AFFIRMATIVE DEFENSES

26. Respondent is informed and believes, and thereon alleges, that the facts set forth in the Petition to Cancel are insufficient to show damage and/or grounds sufficient to cancel the subject matter registration and that the Petition to Cancel fails to state a claim upon which relief can be granted.

27. Petitioner does not have the exclusive right to use and/or register GO GIRL, alone or in combination with other words, including, without limitation, GO GIRL SUGAR-FREE ENERGY DRINK and/or GO GIRL GLO.

28. Petitioner lacks standing to commence or maintain the Petition to Cancel Registration No. 2,227,005.

29. Respondent has long prior common law use of and rights to the GO GIRL mark, notwithstanding any rights under Registration No. 2,227,005.

30. Petitioner cannot show that it will be damaged by Respondent's Registration No. 2,227,005 because of Respondent's common law trademark rights which predate any rights claimed by Petitioner under any of its GO GIRL marks.

31. Petitioner's claims are barred by the doctrines of waiver, estoppel, acquiescence, unclean hands and laches.

32. On information and belief, Petitioner has at all times mentioned herein known of Respondent's prior common law rights to the GO GIRL mark and registration thereof, and it is incumbent upon Petitioner to adopt a mark that is not likely to cause confusion, mistake or deception with prior common law or registered trademark rights of others, namely Respondent.

33. On information and belief, at all times herein, Petitioner was fully aware of Respondent's trademark rights and did or should have conducted a trademark search prior to adopting its use of the GO GIRL mark in connection with energy drinks or clothing.

34. Petitioner cannot show that it has been damaged by its subsequent adoption of a mark that creates a likelihood of confusion with prior common law or federally registered trademark rights of others, namely Respondent.

WHEREFORE, Respondent prays that NOR-CAL's Petition to Cancel Registration No. 2,227,005 be denied and the NOR-CAL Petition be dismissed with prejudice, and further prays that GGA's counterclaim to cancel NOR-CAL's Registration No. 3,235,947 for GO GIRL for energy drinks be granted.

**COUNTER-CLAIM FOR CANCELLATION OF NOR-CAL's
REGISTRATION NO. 3,235,947**

IRENE J. ORTEGA-ELDON, dba GO GIRL ACTIVEWEAR ("GGA"), having a principal place of business at P.O. Box 502547, St. Thomas, U.S. Virgin Islands, 00805, believes she has been, and will continue to be damaged by U.S. Registration No. 3,235,947 and hereby petitions to cancel such registration pursuant to the provisions of 15 USC §1064 and hereby appoints the law firm of Procopio Cory Hargreaves & Savitch, LLP as its attorneys with full power of substitution and revocation, to present this Petition for Cancellation and to transact all business before the United States Patent and Trademark Office connected herewith.

As grounds for this Petition, Petitioner GGA alleges:

35. That IRENE J. ORTEGA-ELDON, is an individual residing in Temecula, California doing business as GO GIRL ACTIVEWEAR, a sole proprietorship, having a principal place of business at P.O. Box 502547, St. Thomas, U.S. Virgin Islands, 00805.

36. That Petitioner GGA has used the GO GIRL mark in connection with the operation of its GO GIRL ACTIVEWEAR business activities since at least as early as October 1998, and has undertaken efforts to publicly identify its activewear clothing line and is and has been engaged in the manufacture, sales and distribution of activewear clothing since that time directed primarily to women's athletic wear, biking, wake boarding, exercise apparel and active sportswear.

37. On information and belief, Petitioner GGA secured the GOGIRLACTIVEWEAR.COM domain name and Web site became operational as a commercial site in long prior to any use of GO GIRL by NOR-CAL; Petitioner's goods were offered and sold to customers since 1998, and Petitioner GGA has since 1998 regularly attended sporting events selling her clothing line directly to customers, through her web site, via mail order, through wholesale channels of trade, and through licensees under the GO GIRL mark, all since at least as early as 1998, and continuously thereafter. Petitioner GGA continues to currently use the GO GIRL mark for clothing and on-line retail services and mail order retail services in the field of women's clothing, activewear and exercisewear, and to identify its business to the public in interstate commerce.

38. That Petitioner GGA has continuously used and advertised said mark and name in interstate commerce in conjunction with the promotion and sales of its aforesaid goods, services and business; that the aforesaid mark and name is owned by Petitioner GGA and are well-known and recognized by a significant portion of the public as identifying the products, services and business of Petitioner GGA, and therefore said marks and name and the goodwill associated therewith are valuable assets of the Petitioner and have acquired a secondary meaning.

39. That Petitioner's first use and engagement in substantial commercial endeavors under the GO GIRL mark and name commenced long prior to NOR-CAL's alleged date of first use and/or the filing of any of its GO GIRL applications, including Registration No. 3,235,947 for GO GIRL in class 32 for energy drinks which recites a date of first use of May 15, 2005.

40. That GGA's use of its GO GIRL mark and name throughout the United States since at least as early as 1998, creates common law rights in the GO GIRL mark and name, which rights are superior to NOR-CAL's rights.

41. That NOR-CAL's "GO GIRL" mark so resembles Petitioner GGA's "GO GIRL" mark and name as to create confusion or mistake or to deceive the public when used on or in connection with the promotion and sales of NOR-CAL's GO GIRL energy drinks as identified in its registration, and particularly in connection with its use of GO GIRL on clothing activewear used to promote its GO GIRL energy drink; that the foregoing use by NOR-CAL of the mark shown in Registration No. 3,235,947 is likely to create confusion, mistake or deception with GGA's goods, leading customers and the public to believe that NOR-CAL's GO GIRL goods are

offered by, sponsored by or in some way associated with GGA, resulting in loss of revenue to GGA and damaging its reputation and goodwill.

42. The GO GIRL registration of NOR-CAL in class 32 for energy drinks is related to the GGA goods sold under its GO GIRL mark and registration for clothing, primarily consisting of activewear and exercisewear directed to women, sold through similar channels of trade, to the same potential customers insofar as NOR-CAL's energy drinks are directed to athletic oriented women, as supported by NOR-CAL's sales of the same types of activewear/exercisewear clothing sold through its distributors and in connection with its on-line store.

43. That on information and belief, NOR-CAL knew at the time it adopted its GO GIRL mark and acquired its GO GIRL registration that the mark was conceived of and used by GGA prior to NOR-CAL's first use thereof; that if the NOR-CAL registration is allowed to remain registered it will create a likelihood of public confusion as to ownership of the GO GIRL mark by Petitioner, and damage GGA's sales of goods and reputation in the market place.

44. That by virtue of GGA's prior and continuous common law use of GO GIRL as a trademark, domain name and business tradename for women's activewear and exercisewear clothing, and based on GGA's incontestable federal Registration No. 2,227,005 for GO GIRL for clothing, Respondent is not entitled to Registration No. 3,235,947; and the aforesaid registration should be cancelled pursuant to the provisions of 15 USC § 1064.

Please charge any additional fee or credit any overpayment to Deposit Account No. 502075-5217 in connection with the filing of this Petition.

WHEREFORE, Petitioner believes and avers that it is and will continue to be damaged by the Registration No. 3,235,947 as aforesaid and requests that NOR-CAL be required to answer the allegations of this Petition for Cancellation and that said registration be cancelled and the cancellation be sustained.

Service has been made on Petitioners as shown in the attached Certificate of Service.

Respectfully submitted,



Barry F. Soalt, Esq.
Attorneys for IRENE J. ORTEGA-ELDON
dba GO GIRL ACTIVEWEAR
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Dated: June 17, 2009

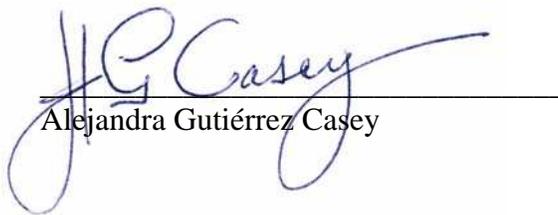
Docket No.: 111642-1

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and complete copy of the foregoing RESPONDENT'S AMENDED ANSWER TO PETITION TO CANCEL, AFFIRMATIVE DEFENSES, AND COUNTER-CLAIM TO CANCEL REGISTRATION NO. 3,235,947 is being mailed on June 17, 2009, first-class, postage prepaid, to counsel for Petitioner, as follows:

R. Michael West
Law Offices of R. Michael West
1922 21st Street
Sacramento, CA 95811

Dated: June 17, 2009


Alejandra Gutiérrez Casey