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

Proceeding	91183180
Party	Defendant American Racing Equipment, Inc.
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Date	01/02/2009
Attachments	91,183,180 - Answer to Notice of Opposition.pdf (5 pages)(178840 bytes)

TRADEMARK
Docket No. 067705.0001

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

In the matter of Application. No. 78/937,929
for the Mark **Star Design**

Upward Unlimited Opposer, v. American Racing Equipment, LLC Applicant.	Opposition No.: 91,183,180

ANSWER TO NOTICE OF OPPOSITION

Applicant American Racing Equipment, LLC ("Applicant"), formerly known as American Racing Equipment, Inc., answers the Notice of Opposition ("Opposition") filed by Upward Unlimited ("Opposer") on March 26, 2008. In response to the grounds set forth in the Opposition, Applicant responds as follows:

1. Answering paragraph 1, Applicant admits that it seeks to register Application No. 78/937,929 for the items listed in paragraph 1 of the Opposition, among other items. Except as so expressly admitted, Applicant denies the allegations of paragraph 1 of the Opposition.
2. Answering paragraph 2, Applicant alleges that the prosecution history of the referenced application speaks for itself. Except as so expressly alleged, Applicant denies the allegations of paragraph 2 of the Opposition.
3. Answering paragraph 3, Applicant ARE alleges that the prosecution history of the referenced application speaks for itself. Except as so expressly alleged, Applicant denies the allegations of paragraph 3 of the Opposition.
4. Answering paragraph 4, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegation in paragraph 4 of the Opposition.

5. Answering paragraph 5, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegation in paragraph 5 of the Opposition.
6. Answering paragraph 6, Applicant denies each and every allegation set forth in paragraph 6 of the Opposition.
7. Answering paragraph 7, Applicant denies each and every allegation set forth in paragraph 7 of the Opposition.
8. Answering paragraph 8, Applicant denies each and every allegation set forth in paragraph 8 of the Opposition.
9. Answering paragraph 9, Applicant incorporates its answers to paragraphs 1 through 8 of the Opposition as if fully set forth in this paragraph.
10. Answering paragraph 10, Applicant denies each and every allegation in paragraph 10 of the Opposition.
11. Answering paragraph 11, Applicant denies each and every allegation in paragraph 11 of the Opposition.
12. Answering paragraph 12, Applicant denies each and every allegation in paragraph 12 of the Opposition.
13. Answering paragraph 13, Applicant denies each and every allegation in paragraph 13 of the Opposition.
14. Answering paragraph 14, Applicant denies each and every allegation in paragraph 14 of the Opposition.

AFFIRMATIVE DEFENSES

By way of further answer and affirmative defenses, Applicant alleges as follows:

FIRST AFFIRMATIVE DEFENSE
No Cognizable Injury

1. No damage or injury has resulted, will result, or can result to Opposer from registration of Applicant's mark.

SECOND AFFIRMATIVE DEFENSE
Applicant's Products and Opposer's Products Are Not Competitive or Even Related

2. Applicant's products are not competitive with or related to the products Opposer allegedly offers under its star mark, which alone prevents any likelihood of confusion.

THIRD AFFIRMATIVE DEFENSE
Applicant's Products and Opposer's Products Travel in Different Channels of Trade

3. No confusion is likely between Opposer's mark and Applicant's mark because the goods as defined in Opposer's Notice of Opposition travel in distinct channels of trade. On information and belief, Applicant believes Opposer's products are offered, if at all, through mail order or through church organizations that provide and support Opposer's ministerial services. Thus, on information and belief the products travel in completely different channels of trade, which alone precludes any likelihood of confusion claim.

FOURTH AFFIRMATIVE DEFENSE
Opposer's Registration is Weak

4. Opposer's mark allegedly consists of "a star design." Where, as here, there is extensive third party usage of a mark, the mark is weak and entitled to narrow protection, which alone precludes any likelihood of confusion. For example, third parties that use star marks include, among others, Rockstar Energy Drink, Converse Inc. and the All-Star Division of Ampac Enterprises, Inc.

FIFTH AFFIRMATIVE DEFENSE
Opposer's Mark is Not Well-Known or Widely Used

5. Opposer's mark, on information and belief, is not well known and has, at most, been subject to limited advertising or promotion, which limits its consumer recognition and precludes any likelihood of confusion claim.

SIXTH AFFIRMATIVE DEFENSE
Opposer Does Not Properly Allege Use

6. Opposer only alleges that has used its "star design" in the past on goods that Opposer alleges are competitive with the products Applicant offers or plans to offer

under its mark ("such various goods have included..."). On its face this does not suffice to demonstrate current use of the mark by Opposer on the allegedly related products or harm to Opposer and alone precludes a likelihood of confusion claim.

Dated: January 2, 2008

MORGAN, LEWIS & BOCKIUS LLP

By: _____
Leigha E. Wilbur
Attorney for Applicant

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PROOF OF SERVICE

I declare:

I am and was at the time of the service mentioned in this declaration, employed in the County of San Francisco, California. I am over the age of 18 years and not a party to this cause. My business address is Spear Street Tower, One Market, San Francisco, California 94105.

On **January 2, 2009**, I served a copy(ies) of the following document(s)

ANSWER TO NOTICE OF OPPOSITION (Opposition No. 91,183,180)

☐ by transmitting via facsimile the document(s) listed above to the fax number(s) set forth below on this date before 5:00 p.m.

☒ by placing the document(s) listed above in a sealed envelope with postage thereon fully prepaid, in the United States mail at San Francisco, California addressed as set forth below. I am readily familiar with the firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with the U.S. Postal Service on that same day with postage thereon fully prepaid in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after date of deposit for mailing in affidavit.

☐ by causing the document(s) listed above to be personally delivered at to the person(s) at the address(es) set forth below.

☐ by transmitting via electronic mail the document(s) listed above to each of the person(s) as set forth below.

Richard M. Moose
Dority & Manning, P.A.
P.O. Box 1449
Greenville, SC 29602
email: rmm@dority-manning.com

I declare under penalty of perjury under the laws of the State of California and the United States of America that the foregoing is true and correct, and that this declaration was executed on **January 2, 2009**, at San Francisco, California.

Yelena Lolua