

ESTTA Tracking number: **ESTTA900777**

Filing date: **06/04/2018**

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

| | |
|------------------------|---|
| Proceeding | 91240810 |
| Party | Defendant Our Life 2.5 LLC |
| Correspondence Address | GREGORY OZGA WARN PARTNERS PC 691 N. SQUIRREL RD, SUITE 140 AUBURN HILLS, MI 48326 Email: ozga@warnpartners.com, info@warnpartners.com, tbrown@warnpartners.com, greggozga@gmail.com |
| Submission | Answer and Counterclaim |
| Filer's Name | Rebecca L. Wilson |
| Filer's email | tmmail@patentco.com, bwilson@patentco.com, bwhitten@patentco.com |
| Signature | /Rebecca L. Wilson/ |
| Date | 06/04/2018 |
| Attachments | AnswerToNoticeOfOpposition_2108_001USOPP.pdf(28772 bytes) |

Registration Subject to the filing

| | | | |
|------------------|---|-------------------|------------|
| Registration No. | 5226141 | Registration date | 06/20/2017 |
| Registrant | Askov Holdings, LLC 200 North 1st Street Minneapolis, MN 55401 UNITED STATES | | |

Goods/Services Subject to the filing

Class 025. First Use: 2013/09/01 First Use In Commerce: 2013/09/01

All goods and services in the class are requested, namely: clothing, namely, hats, caps, knitted caps, shirts, sweatshirts, and t-shirts

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| | | |
|---------------------|---|-------------------------|
| Askov Holdings, LLC |) | |
| |) | |
| |) | Opposition No. 91240810 |
| Opposer |) | |
| -v- |) | Serial No. 87/458,572 |
| |) | |
| Our Life 2.5 LLC |) | Mark: NORTH 10 |
| |) | |
| Applicant |) | |
| <hr/> | | |

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

ANSWER TO NOTICE OF OPPOSITION

Applicant, Our Life 2.5 LLC, by and through its attorneys, answers the Notice of Opposition filed by Askov Holdings, LLC as follows:

1. The allegations of Paragraph 1 are admitted.
2. The allegations of Paragraph 2 are admitted.
3. The allegations of Paragraph 3 are admitted.
4. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the averments in paragraph 4 of the Notice and therefore denies the same.
5. The allegations of Paragraph 5 are facts on the record; therefor admitted as far as the accuracy of the record.
6. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the averments in paragraph 6.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the averments in paragraph 7 of the Notice and therefore denies the same.

8. The allegations of Paragraph 8 are facts on the record; therefor admitted as far as the accuracy of the record.

9. The allegations of Paragraph 9 are facts on the record; therefor admitted as far as the accuracy of the record.

10. The allegations of Paragraph 10 are facts on the record; therefor admitted as far as the accuracy of the record.

11. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the averments in paragraph 11 of the Notice, specifically the assertion of any common law rights for any alleged marks and therefore denies the same.

12. The allegations of Paragraph 12 are facts on the record; therefor admitted as far as the accuracy of the record

13. The allegations of Paragraph 13 are facts on the record; therefor admitted as far as the accuracy of the record.

14. The allegations of Paragraph 14 are denied.

15. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the averments in paragraph 15 of the Notice and therefore denies the same.

16. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the averments in paragraph 16 of the Notice and therefore denies the same.

17. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the averments in paragraph 17 of the Notice and therefore denies the same.

18. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the averments in paragraph 18 of the Notice and therefore denies the same.

19. The allegations of Paragraph 19 are denied.

20. The allegations of Paragraph 20 are denied.

21. The allegations of Paragraph 21 are denied.

22. The allegations of Paragraph 22 are denied.

23. The allegations of Paragraph 23 are denied.

24. The allegations of Paragraph 24 are denied.

25. The allegations of Paragraph 25 are denied.

26. The allegations of Paragraph 26 are denied.

27. The allegations of Paragraph 27 are denied.

28. The allegations of Paragraph 28 are denied.

29. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the averments in paragraph 29 of the Notice and therefore denies the same.

30. The allegations of Paragraph 30 are denied.

31. The allegations of Paragraph 31 are denied.

AFFIRMATIVE DEFENSE NO. 1

32. Notice of Opposition fails to state a claim upon which relief can be granted, and in particular, fails to state legally sufficient grounds for sustaining the Opposition.

AFFIRMATIVE DEFENSE NO. 2

33. There is no likelihood of confusion because, inter alia, the Mark and the alleged trademarks of Opposer are not confusingly similar.

AFFIRMATIVE DEFENSE NO. 3

34. Opposer is barred from any relief by its unclean hands.

AFFIRMATIVE DEFENSE NO. 4

35. Alternatively, any similarity between the Mark and Opposer's alleged trademark(s) is restricted to that portion of the Mark consisting of the word "North," which is not distinctive as used by the Opposer.

AFFIRMATIVE DEFENSE NO. 5

36. Opposer's rights in and to the portion of its alleged "North" mark are generic at best, or in the alternative, merely geographically descriptive of the goods or services offered under the mark. Opposer's alleged word mark for the word "North" as well as other asserted marks only using the word "North" with limited design features, is therefore inherently unprotectable absent acquired distinctiveness which most of their marks lack.

AFFIRMATIVE DEFENSE NO. 6

37. The trademark office has already decided this fact in inferred within the decision to allow the Applicant's mark to proceed to publication. There was no finding of confusion in the record and therefore this prior decision should be given weight in this proceeding.

COUNTERCLAIM TO CANCEL REGISTRATION

38. Applicant repeats and realleges each and every allegation set forth in the foregoing paragraphs as if fully set forth herein.

39. Applicant hereby seeks cancellation of Opposer's Registration, specifically Registration No. 5226141, issued June 20, 2017 for the mark "NORTH" in International Class 25 for the Application filed April 15, 2016.

40. The term “North” is not unique to the Opposer. Rather, as used in the word format, this term is geographically descriptive.

41. Since the Opposer’s primary mark is descriptive as it relates to the goods offered under the mark given the location of the Opposer, the mark should be cancelled.

42. Opposer’s alleged “NORTH” mark in the word format, as well as a few of the logo formats, is therefore not distinctive.

43. Opposer’s alleged “NORTH” mark in the word format, as well as a few of the logo formats, has no secondary meaning, and therefore has not acquired distinctiveness required for a descriptive trademark.

44. As a result, Opposer’s alleged “NORTH” mark in the word format, as well as a few of the logo formats, has no secondary meaning and cannot function as a trademark.

45. Opposer’s use of the word mark “NORTH” fails to function as a trademark. As can be evidenced on their website, it is merely ornamental.

46. Opposer’s registration of the word mark for “NORTH” as well as the pending applications for the same, are not inherently unique. Again, the mark itself is descriptive and based on the abundance of marks containing the word “NORTH” for the same items, this would impede others use of their respective marks.

WHEREFORE, for the reasons stated above, Applicant prays that the Board will find that Opposer has no grounds to oppose the registration of Applicant’s mark and respectfully requests that the Opposition be dismissed with prejudice, and that a registration be issued to Applicant as applied for in application serial no. 87/458,572.

Applicant also respectfully asks that the Board grant the petition to cancel Registration No. 5226141 based on the grounds presented.

Respectfully submitted,

The Dobrusin Law Firm, P.C.

Date: June 4, 2018

By: /Rebecca L. Wilson/
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ATTORNEYS FOR APPLICANT

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and complete copy of the foregoing APPLICANT'S ANSWER TO THE NOTICE OF OPPOSITION/AFFIRMATIVE DEFENSES has been served by mailing said true and complete copy on June 4, 2018, via First Class Mail, postage prepaid, to:

Stephen Baird
Winthrop & Weinstine PA
225 South 6th Street, Capella Tower, Suite 3500
Minneapolis, MN 55402

And also via email to: sbaird@winthrop.com, dweseman@winthrop.com, jbriley@winthrop.com, trademark@winthrop.com with delivery receipt and read receipt requested.

Date: June 4, 2018

By: /Rebecca L. Wilson/
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