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

Proceeding	91249384
Party	Defendant Next Step Group, Inc.
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Submission	Answer
Filer's Name	Martin W. Schiffmiller
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Date	08/19/2019
Attachments	COVER GIRL - Answer to Notice of Opposition.pdf(314469 bytes)

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

In the Matter of Application Serial No. 88-158,015
For the Mark: COVER GIRL
Published in the Official Gazette on March 12, 2019

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Noxell Corporation, :
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 Opposer, :
:
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v. : Opposition No. 91249384
:
Next Step Group, Inc., :
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 Applicant. :
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:
-----X

APPLICANT’S ANSWER TO NOTICE OF OPPOSITION

Applicant Next Step Group, Inc. (“Applicant”), for its Answer to the Notice of Opposition, alleges as follows:

1. Applicant denies having knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 1 of the Notice of Opposition, but affirmatively avers that substantially all of Opposer’s alleged trademarks have been used and are registered in the USPTO as the single word, COVERGIRL, not as two words as shown throughout the Notice of Opposition.
2. Applicant denies having knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 2 of the Notice of Opposition.

3. Applicant denies having knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 3 of the Notice of Opposition.

4. Applicant denies having knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 4 of the Notice of Opposition.

5. Applicant denies having knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 5 of the Notice of Opposition.

6. Applicant denies having knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 6 of the Notice of Opposition, but affirmatively avers that Opposer's COVERGIRL marks have been used and registered almost exclusively in connection with cosmetics products and accessories for the same or services related to the same.

7. Applicant denies having knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 7 of the Notice of Opposition, but affirmatively avers that Opposer's COVERGIRL marks have been used and registered almost exclusively in connection with cosmetics products, accessories for the same, or services related to the same.

8. Applicant admits the allegations set forth in paragraph 8 of the Notice of Opposition.

9. Applicant admits the allegations set forth in paragraph 9 of the Notice of Opposition.

10. Applicant admits the allegations set forth in paragraph 10 of the Notice of Opposition.

11. Applicant admits the allegations set forth in paragraph 11 of the Notice of Opposition.

12. Applicant admits the allegations set forth in paragraph 12 of the Notice of Opposition.

13. Applicant admits the allegations set forth in paragraph 13 of the Notice of Opposition.

14. Applicant admits the allegations set forth in paragraph 14 of the Notice of Opposition.

15. Applicant admits the allegations set forth in paragraph 15 of the Notice of Opposition.

16. Applicant denies the allegations set forth in paragraph 16 of the Notice of Opposition.

17. Applicant denies the allegations set forth in paragraph 17 of the Notice of Opposition.

18. Applicant denies the allegations set forth in paragraph 18 of the Notice of Opposition.

19. With respect to the allegations incorporated by reference in paragraph 19 of the Notice of Opposition, Applicant responds to said allegations in the same manner set forth hereinabove.

20. Applicant admits the allegations set forth in paragraph 20 of the Notice of Opposition.

21. Applicant admits the allegations set forth in paragraph 21 of the Notice of Opposition.

22. Applicant denies the allegations set forth in paragraph 22 of the Notice of Opposition, and affirmatively avers that the only overlapping Class 18 goods between those identified in the Opposed COVER GIRL Application and the Prior Application are travel bags. The remaining Class 18 goods in the Opposed COVER GIRL Application are different from and

not encompassed by the identification of goods in the Prior Application. Moreover, at the time the opposition to the Prior Application was filed by Opposer, Applicant owned an active registration for the mark COVER GIRL, Reg. No. 3352770, that covered handbags and wallets in Class 18 (also included in the presently Opposed COVER GIRL Application). Thus, the opposition against the Prior Application could not have encompassed handbags and wallets.

23. Applicant admits the allegations set forth in paragraph 23 of the Notice of Opposition, but affirmatively avers that the only Class 18 goods in the Opposed COVER GIRL Application for which an opposition was previously sustained are travel bags.

24. Applicant denies the allegations set forth in paragraph 24 of the Notice of Opposition.

25. With respect to the allegations incorporated by reference in paragraph 25 of the Notice of Opposition, Applicant responds to said allegations in the same manner set forth hereinabove.

26. Applicant denies the allegations set forth in the first sentence of paragraph 26 of the Notice of Opposition, and denies having knowledge or information sufficient to form a belief as to the truth of the allegations in the second sentence of said paragraph.

27. Applicant denies having knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 27 of the Notice of Opposition.

28. Applicant denies the allegations set forth in paragraph 28 of the Notice of Opposition.

29. Applicant denies the allegations set forth in paragraph 29 of the Notice of Opposition.

30. Applicant denies the allegations set forth in paragraph 30 of the Notice of Opposition.

31. Applicant denies the allegations set forth in paragraph 31 of the Notice of Opposition.

32. Applicant denies the allegations set forth in paragraph 32 of the Notice of Opposition.

33. Applicant denies the allegations set forth in paragraph 33 of the Notice of Opposition.

34. Applicant denies the allegations set forth in paragraph 34 of the Notice of Opposition.

35. Applicant denies the allegations set forth in paragraph 35 of the Notice of Opposition.

36. Applicant denies the allegations set forth in paragraph 36 of the Notice of Opposition.

37. Applicant denies the allegations set forth in paragraph 37 of the Notice of Opposition.

38. Applicant denies the allegations set forth in paragraph 38 of the Notice of Opposition.

39. Applicant denies the allegations set forth in paragraph 39 of the Notice of Opposition.

40. With respect to the allegations incorporated by reference in paragraph 40 of the Notice of Opposition, Applicant responds to said allegations in the same manner set forth

hereinabove.

41. Applicant admits the allegations set forth in paragraph 41 of the Notice of Opposition.

42. Applicant denies the allegations set forth in paragraph 42 of the Notice of Opposition.

43. Applicant denies the allegations set forth in paragraph 43 of the Notice of Opposition.

44. Applicant denies the allegations set forth in paragraph 44 of the Notice of Opposition.

45. Applicant denies the allegations set forth in paragraph 45 of the Notice of Opposition.

46. Applicant denies the allegations set forth in paragraph 46 of the Notice of Opposition.

AS AND FOR AFFIRMATIVE DEFENSES, APPLICANT ALLEGES THAT:

A. Applicant's Bona Fide Use and/or Intention to Use
Its COVER GIRL Mark in Commerce on the Subject Goods

47. Applicant and its predecessors-in-interest have engaged for many years in selling and licensing the sale of goods under COVER GIRL trademarks. For example, Applicant and/or its predecessors-in-interest have sold women's shoes and other footwear products under the mark COVER GIRL since 1957. Applicant has sold or licensed the sale of apparel products under the COVER GIRL trademark since 2004.

48. Applicant is engaged in an active licensing program under which licenses have already been issued for the marketing of various categories of goods, including goods identified in the Opposed COVER GIRL Application. Applicant's license agreements and proposed agreements pertaining to its COVER GIRL trademark state that all uses of such mark by the licensees inure to Applicant's benefit.

49. Applicant and its predecessors-in-interest have filed a total of 15 applications to register the trademark COVER GIRL in the United States Patent and Trademark Office. Nine of these applications have proceeded to registration, seven of which registrations are still active. Three of Applicant's registrations of the mark COVER GIRL, Reg. Nos. 1188714, 2933436 and 4129195, are incontestable. The Opposed COVER GIRL Application is the only application still pending.

50. Applicant had a bona fide intention at the time each of its applications to register COVER GIRL was filed to use the mark shown in the application in U.S. commerce in connection with the goods identified therein and/or to license the mark for use in U.S. commerce in connection with such goods, with the licensees' use of the mark inuring to Applicant's benefit.

51. Applicant has not engaged in any warehousing of trademarks, nor has it manipulated the USPTO's intent-to-use application process.

B. Absence of Actual Confusion in the Marketplace

52. During all the years that Applicant and its predecessors-in-interest have sold and/or licensed for sale in the United States products under the COVER GIRL trademark, no incident has come to the attention of Applicant, its predecessors-in-interest or its licensees involving confusion, mistake or deception of any consumer, customer or potential customer as to any

association of source or sponsorship between Applicant's COVER GIRL trademark or products and Opposer's COVERGIRL trademark or products. Furthermore, Opposer has never brought any alleged instance of such confusion, mistake or deception to Applicant's attention. This absence of actual confusion in the marketplace is evidence that there is no likelihood of confusion between Applicant's COVER GIRL mark and Opposer's COVERGIRL mark as used by the parties on their respective goods.

WHEREFORE, Applicant prays that the opposition be dismissed.

Respectfully submitted,

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By 

Martin W. Schiffmiller

Dated: New York, New York
August 19, 2019

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Answer to Notice of Opposition was served on Opposer's counsel by first class mail, postage prepaid, in an envelope addressed to:

Lisa Pearson, Esq.
Kilpatrick Townsend & Stockton LLP
1114 Avenue of the Americas, 21st Floor
New York, New York 10036

this 19th day of August, 2019.



Deborah A. Egan