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

|                        |  |
|------------------------|--|
| Proceeding no.         | 91295794   |
| Party                  | Defendant<br>Jake, Jessika   |
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| Submission             | Answer   |
| Filer's name           | Alan Kendrick  |
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| Date                   | 01/17/2025   |
| Attachments            | Mathlibs Answer to Oppoiton.pdf(307105 bytes )   |

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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|                          |   |                          |
|--------------------------|---|--------------------------|
| Penguin Random House LLC | ) | Opposition No.: 91295794 |
| Opposer,                 | ) |                          |
| vs.                      | ) | <b>MARK: MATHLIBS</b>    |
| Jessika Jake             | ) |                          |
| Applicant                | ) | Serial No. 98242543      |
|                          | ) |                          |
|                          | ) |                          |
|                          | ) |                          |
|                          | ) |                          |

**APPLICANT’S ANSWER TO NOTICE OF OPPOSITION**

**AND AFFIRMATIVE DEFENSES**

Applicant, Jessika Jake, owner of the Federal Trademark Application Serial No. 98242543 for the mark MATHLIBS (hereinafter the “Applicant’s Mark”, by its attorney, hereby submits its Answer to the Notice of Opposition filed by Opposer, Penguin Random House LLC, as follows, with the following numbered Paragraphs corresponding to the Numbers of the Paragraphs of the Notice of Opposition under the headings used in the Notice of Opposition:

1. Applicant is without knowledge or information sufficient to form a belief as to the allegations in Paragraph 1 and therefore denies the same.
2. Upon information and belief, the Opposer began using its MAD LIBS mark in relation to children's books, books featuring word games, and children's activity books at or about 2020, which is years after the Applicant had been using her MATHLIBS mark exclusively in children’s education since at least 01/01/2004.

3. Applicant is without knowledge or information sufficient to form a belief as to the allegations in Paragraph 3 and therefore denies the same.

4. Applicant is without knowledge or information sufficient to form a belief as to the allegations in Paragraph 4 and therefore denies the same.

5. Applicant admits that Opposer owns the seven listed MAD LIBS marks and registrations.

6. Applicant admits that Opposer's seven listed MAD LIBS marks and registrations are valid.

7. Applicant confirms that Jessika Jake is an individual residing at 6012 Ranch Mission Road, Unit 312, San Diego, California 92108.

8. Applicant confirms she filed an Application to register the mark MATHLIBS in IC 009 for "Downloadable educational course materials in the field of mathematics for students from elementary to junior high" et al., and in IC 016 for "Printed instructional and teaching materials in the field of mathematics" et al.

9. Applicant admits the allegations in paragraph 9.

10. The Applicant denies the allegations in paragraph 10.

11. Applicant admits the allegations in paragraph 11; Applicant denies that this notice amounts to violating the Opposer's prior rights in its MAD LIBS mark.

12. The Applicant denies the allegations in paragraph 12.

13. The Applicant denies the allegations in paragraph 13; the Opposer does not own the term LIBS as this term has been used throughout the field of education for decades, and carries different meanings in the field of education.

### **AFFIRMATIVE DEFENSES**

#### **First Affirmative Defense**

As a result of Applicant's continuous use of the Mark since the adoption thereof and at least as early as 01/01/2004, the Mark has developed significant goodwill among the consuming public and consumer acceptance of the goods and services offered by Applicant in conjunction with the mark. The Mark has developed significant goodwill among educators and educational institutions and the acceptance by educators and educational institutions of the goods and services offered by Applicant in conjunction with the mark. Such goodwill and widespread usage have caused the Mark to acquire distinctiveness with respect to the Applicant, and caused the Mark to become a valuable asset of Applicant.

### **Second Affirmative Defense**

Purchasers of goods sold along with the relevant marks are careful and sophisticated, thus making any confusion or mistake amongst potential overlapping consumers highly unlikely. Ordinary Consumers would not confuse or conclude that the parties' products share a common source or affiliation or connection.

Applicant reserves the right to amend this Answer to assert any additional affirmative defenses arising from any applicable facts or law that may be revealed during discovery.

**FURTHERMORE,** Applicant sets forth the following in support of its position:

14. Applicant's mark is unique and distinctive.
15. The wording in the Applicant's mark and Opposer's marks are different and distinct.
16. Applicant's mark and Opposer's Marks are different in spelling.
17. Applicant's mark and Opposer's Marks are different in appearance.
18. Applicant's mark and Opposer's Marks are phonetically different.
19. Opposer's mark contains the word element "MAD" which is not present in the Applicant's mark.
20. Applicant's mark contains the word element "MATH" which is not present in the

Opposer's mark.

21. The dissimilar elements of these marks, MATH vs MAD, are not nearly identical in either sight (TH in MATH vs D in MAD), nor in sound (a soft TH in MATH vs a hard D in MAD).

22. Applicant also owns the Federal Trademark Registration Serial No. 85309226 for the mark MATHLIBS.ORG and has been using said mark in children's education continuously in commerce for more than 20 years without objections from the Opposer.

23. Opposer's goods under the MAD LIBS JUNIOR mark (children's books, books featuring word games, and children's activity books), are related to the goods Applicant offers under the MATHLIBS mark, but the Applicant has been using the MATHLIBS mark in association with children's educational goods and services long before any MAD LIBS mark use or registration in association with children's education.

24. There are no goods or services descriptions in any of the MAD LIBS marks that include the term "education" or "educational", or any indication that the goods or services serve an educational purpose for children.

23. Applicant's mark and Opposer's mark do not create the same mental or commercial impression: MATH creates a mental impression of mathematics and the MATHLIBS mark creates a mental impression that the goods or services sold under this mark are associated with mathematics. MAD creates a mental impression of madness or craziness or, as the Opposer has stated "to allude to the zany". The MAD LIBS mark similarly creates a mental impression that the goods sold under these marks are associated with fun and games and mad-zany times. This creates two completely different commercial impressions.

24. The word element "LIBS" has been used in the field of education for several decades.

25. The word element "LIBS" is used in commerce by third parties as part of

numerous trademarks for education related goods and services that are not owned by the Opposer.

26. Applicant's goods are marketed exclusively towards educational institutions, teachers or directly to students.

27. Opposer's goods are marketed towards the consumer public in general and in particular consumer's seeking games and game type activities.

28. Applicant's goods and Opposer's goods are therefore not marketed through the same channels of trade.

29. During the examination of Applicant's application for registration, the trademark examining attorney searched the USPTO database of registered and pending marks and found no conflicting marks that would bar registration under Trademark Act Section 2(d). 15 U.S.C. §1052(d); TMEP §704.02.

30. Applicant's mark and Opposer's marks are not likely to cause confusion, mistake or deception to purchasers as to the source of Opposer's goods.

31. Applicant's mark and Opposer's marks are not likely to disparage or falsely suggest a trade connection between Opposer and Applicant.

Applicant hereby appoints Alan J. Kendrick, a member of the Bar of the State of California, at the firm of:

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to act as attorney in the matter of the opposition identified above, to prosecute said opposition, to transact all business in the Patent and Trademark Office, and in the United States courts

connected with the opposition, to sign its name to all papers which are hereinafter to be filed in connection therewith, and to receive all communication rejecting to the same.

**Relief Requested**

**WHEREFORE**, the Applicant asks that the Trademark Trial and Appeal Board deny the Opposition and permit registration of the Applicant's proposed mark in Application Serial Number 98242543 in the United States Patent and Trademark Office.

By: Alan Kendrick

Alan Jefferson Kendrick, Esq.

California Bar No. 197688

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Dated: 17 January 2025

# AKIP LEGAL



## INTELLECTUAL PROPERTY LAW

| Patent Research | Trademarks | Copyrights | Trade Secrets | Unfair Competition

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Friday, January 17, 2025

I hereby certify that a true and complete copy of the foregoing Answer to Notice of Opposition No. 91295794 has been served on Craig S. Mende of Fross Zelnick representing Opposer Penguin Random House LLC, by forwarding said copy on January 17, 2025, via e-mail to [cmende@fziz.com](mailto:cmende@fziz.com).



Alan J. Kendrick, Attorney

January 17, 2025

| AKIP Legal | Alan Kendrick Attorney-at-Law |

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