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March 13, 2006

VIA FIRST CLASS MAIL
United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Re: Notice of Opposition
of United States Trademark
Application No.: 78/541,146
Applicant: ZoneChefs LLC
Mark: FROZONE
Classes 29, 30

Dear Madam:

The following documents are submitted in connection with U.S. Application Serial No. 78/541,146, filed by ZoneChefs LLC, for the mark FROZONE in International Classes 29 and 30on the Principal Register:

1. Opposer Barry D. Sears, Ph.D.'s Opposition to Applicant ZoneChefs, LLC's Motion to Dismiss Pursuant to Fed. R. Civ. P. Rule 12(b)(6), with Exhibit 1 (Amended Notice of Opposition with Exhibits 1-9);

2. Certificate of Mailing dated March 13, 2006;

3. Certificate of Service dated March 13, 2006; and

4. Return postcard.

Sincerely,

Amy B. Spagnole

Enclosures

cc: Deborah L. Benson (w/o Encl.)

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03-15-2006
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #30

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

BARRY D. SEARS Ph.D.,	)	
Opposer,	)	
v.	)	**Opposition No. 91168573**
ZONECHEFS, LLC,	)	**Mark:** **FROZONE** **Serial No.:** **78/541,146**
Applicant.	)	**Classes:** **29, 30**

OPPOSER BARRY D. SEARS PH.D.'S OPPOSITION TO APPLICANT ZONECHEFS LLC'S MOTION TO DISMISS PURSUANT TO FED. R. CIV P. RULE 12(b)(6)

Opposer Barry D. Sears Ph.D. ("Opposer" or "Dr. Sears"), hereby submits this Opposition to Applicant ZoneChefs LLC's ("Applicant" or "ZoneChefs") Motion to Dismiss For Failure to State A Claim And, In The Alternative, Motion for a More Definite Statement ("Applicant's Motion"). Although Applicant's Motion is entitled "Motion to Dismiss for Failure to State A Claim," this title is misleading in that Applicant's Motion is **not** a motion to dismiss the **entire** Notice of Opposition but, rather, a **partial** motion to dismiss only with regard to certain of Opposer's trademark applications as listed in "Table A" of the Applicant's Motion, which applications were filed after the filing date of the subject application. Applicant claims that the Notice of Opposition must be dismissed as to these applications because such applications do not have priority over the application for FROZONE that is the subject of this opposition. Applicant's partial motion to dismiss must be denied because Opposer has properly pled facts sufficient to allege that Opposer is the owner of a family of ZONE marks and, thus, is

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not required to allege that each and every member of the family has a priority date that precedes the filing date of the subject application of FROZONE.

I. Applicant's Motion for Partial Dismissal Should Be Denied Because Opposer Has Alleged Sufficient Facts To State A Claim Upon Which Relief May Be Granted

A motion to dismiss pursuant to Fed. R. Civ. P. 12(b)(6) is well taken only when the plaintiff has failed to state a claim upon which relief may be granted. Fed. R. Civ. P. 12(b)(6). Such motion to dismiss is a test solely of the legal sufficiency of the complaint. Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd., 22 U.S.P.Q.2d 1994 (T.T.A.B. 1992). In order to withstand such a motion, a pleading need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought therein. Lipton Industries, Inc. v. Ralston Purina Company, 670 F.2d 1024, 213 U.S.P.Q. 185 (C.C.P.A. 1982). In considering Applicant's Motion the Board must accept as true the factual allegations of the Notice of Opposition [and] construe all reasonable inferences therefrom in favor of the Opposer. Baroid Drilling Fluids Inc. v. Sun Drilling Products, 24 U.S.P.Q.2d 1048 (T.T.A.B. 1992). In reviewing a Notice of Opposition in connection with a motion to dismiss, the Board construes the allegations therein liberally, as required by Fed. R. Civ. P. 8(f). See TBMP 503.02.

Viewing the Notice of Opposition in the light most favorable to Dr. Sears as the plaintiff, and resolving every doubt in his favor, it is abundantly clear that Dr. Sears has sufficiently asserted a claim upon which relief may be granted. Opposer has properly pled facts sufficient to allege that Opposer is the owner of a family of ZONE marks and, thus, is not required to allege, as Applicant contends, that each and every member of the family has a priority date that precedes the filing date of the subject application of FROZONE.

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A party opposing registration of a trademark pursuant to Lanham Act's Section 13, 15 U.S.C. 1063, must demonstrate both standing and a statutory ground which negates applicant's entitlement to registration, and, at pleading stage, opposer must allege facts in support of both. 37 C.F.R. § 2.104(a) ("The opposition must set forth a short and plain statement showing why the opposer believes it would be damaged by the registration of the opposed mark and state the grounds for opposition."). Applicant's motion to dismiss does not dispute Opposer's standing to maintain the proceeding. The motion charges only that Opposer has not pled facts which, if proved, would establish grounds for refusing registration to Applicant.

In particular, Applicant claims that Opposer has failed to establish valid grounds for denying the registration sought with regard to "many of the alleged "ZONE Marks" that have been pled by Opposer" because applications for such marks -- those specifically listed in "Table A" of Applicant's Motion -- were filed subsequent to January 3, 2005, the filing date of the subject application of FROZONE, and Opposer has not filed a Statement of Use or Amendment to Allege Use alleging a date of first use that precedes January 3, 2005 in connection with such applications and, therefore, Applicant is entitled to partial dismissal of the Notice of Opposition on the grounds that the Opposer does not have priority with respect to these specific marks. See Applicant's Motion to Dismiss for Failure to State a Claim, and, In the Alternative, Motion for a More Definite Statement, p. 7-8.

Applicant's argument is misplaced, as Opposer has sufficiently pleaded in his Notice of Opposition that he is the owner of a family of marks all containing the common distinctive element ZONE and that, prior to Applicant's filing of the subject application for registration of FROZONE, many of the marks containing the claimed family feature ZONE were used and

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promoted together by Opposer in such a manner as to create public recognition with and an association of common origin predicated on the family feature. J&J Snack Foods Corp. v. McDonald's Corp., 18 U.S.P.Q.2d 1889 (C.A.F.C. 1991). Specifically, the Notice of Opposition provides:

> 2. Since 1995, Opposer has used the trademark ZONE and composite marks, all incorporating ZONE as the dominant portion thereof, such as ZONE LABS, ZONENET, ZONE CAFÉ, ZONE CUISINE, ZONE SKIN CARE, ZONERX, and DR. SEARS ZONE, in connection with a wide variety of branded health and nutrition products and services, including print and electronic publications, educational and counseling services, meal delivery services, prepared foods, vitamins and supplements, meal replacements bars and drinks, skin care products and restaurant and café services. Such use has been ongoing and continuous. (Notice of Opposition ¶ 2)
>
> 9. Since creation of his hormonal control/insulin balanced program, Dr. Sears has provided a wide array of health and nutrition products and services that are compliant with this program under the trademark ZONE and composite trademarks all containing ZONE as the dominant portion thereof, including, but not limited to, ZONE, ZONE CUISINE, ZONE CAFÉ, ZONE SKIN CARE, ZONERX, ZONE LABS, ZONENET and ZONE SHAKES (the "ZONE Marks"). (Notice of Opposition ¶ 9)
>
> 10. Dr. Sears is well known as the source of ZONE branded products and services. (Notice of Opposition ¶ 10)
>
> 16. In addition to his ZONE branded books, Dr. Sears and his ZONE branded health and nutrition products and services are widely known from his numerous and frequent live and taped appearances, including seminars, conferences, radio shows, and network television interviews, throughout the country. (Notice of Opposition ¶ 16)
>
> 17. In promoting his ZONE branded health and nutrition products and services, Dr. Sears has appeared on nationally-broadcast television shows, including *The Today Show* in 1996 and again in January 2005, *20/20* in 1999, *Good Morning America* on June 9, 2000, June 15, 2000 and again in May 2002, *Dateline* in July 2002, *CBS Evening News* on May 21, 2003, *The Montel Williams Show* on April 1, 2004 and *Live With Regis and Kelly* on February 2, 2005. (Notice of Opposition ¶ 17)
>
> 18. Additionally, each year since 1998, Dr. Sears has conducted a week long ZONE branded seminar aboard a cruise ship, providing a series of presentations and demonstrations on mastering his hormonal and insulin control program. (Notice of Opposition ¶ 18)

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