

Amy B. Spagnole, Esq.
aspagnole@haslaw.com
Direct (617) 378-4204

Boston, MA 02108-1110
TEL: 617.345.9000
FAX: 617.345.9020
www.haslaw.com

April 11, 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.: 78/655,807
Applicant: ZoneChefs LLC
Mark: KOSHER ZONECHEFS
Class: 39

Dear Madam:

The following documents are submitted in connection with U.S. Application Serial No. 78/655,807, filed by ZoneChefs LLC, for the mark KOSHER ZONECHEFS in International Class 39 on 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 April 11, 2006;
3. Certificate of Service dated April 11, 2006; and
4. Return postcard.

Sincerely,



Amy B. Spagnole

Enclosures

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



04-17-2006

U.S. Patent & TMO/TM Mail Rpt Dt. #3:

577660

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

BARRY D. SEARS Ph.D.,

Opposer,

v.

ZONECHEFS, LLC,

Applicant.

Opposition No. 91169269

Mark: KOSHER ZONECHEFS

Serial No.: 78/655,807

Class: 39

**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 KOSHER ZONECHEFS 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 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 KOSHER ZONECHEFS.

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 KOSHER ZONECHEFS.

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 June 22, 2005, the filing date of the subject application of KOSHER ZONECHEFS, and Opposer has not filed a Statement of Use or Amendment to Allege Use alleging a date of first use that precedes June 22, 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. 6.

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 KOSHER ZONECHEFS, many of the marks containing the claimed family feature ZONE were

used and 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)

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.