



12-10-01 TTAB TM

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

In the Matter of Trademark Application Serial No. 75/378,779
Filed on October 24, 1997, by Iomega Corporation
Published July 3, 2001, for the trademark "ZIP"



12-05-2001

U.S. Patent & TMOfo/TM Mail Ropt. Dt. #40

C.H. OSTFELD S.A.S.
DI OSTFELD CLAUDE HERBERT,

Opposer,

v.

IOMEGA CORPORATION,

Applicant.

Opposition No. 124,176

ANSWER

ANSWER

Applicant, Iomega Corporation ("Iomega"), by and through counsel, hereby answers the Notice of Opposition of C.H. Ostfeld S.A.S. Di Ostfled Claude Herbert ("Opposer"), as follows:

1. Iomega denies that paragraph 1 sets forth the description of goods as originally stated in the application, but admits that paragraph 1 sets forth the description of goods as amended, and admits the remaining allegations in paragraph 1.

2. Iomega is without sufficient information to form a belief as to the allegations of paragraph 2, and therefore denies the same.

3. Iomega is without sufficient information to form a belief as to the allegations of paragraph 3, and therefore denies the same.

4. Iomega is without sufficient information to form a belief as to whether "many" other parties use the word "zip" in commerce on and in connection with computer software for

performing data compression on files and similar types of computer software, and therefore denies the same. Iomega admits that it is aware of a computer software file extension named “.zip” (dot zip) and that this file extension is associated with computer software files that are associated with compressed data files. Iomega also admits that it is aware of some entities that use the word “zip” only in combination with another term as a unitary mark used in commerce on and in connection with computer software for performing data compression on files. Iomega is without sufficient information to form a belief as to whether other parties use the word “zip” in commerce on and in connection with computer software that is similar to computer software used for performing data compression on files, and therefore denies the same.

5. The allegation in paragraph 5 is a legal conclusion to which no response is required. To the extent that a response is required, Iomega denies the same.

6. The allegation in paragraph 6 is a legal conclusion to which no response is required. To the extent that a response is required, Iomega denies the same.

7. Iomega denies paragraph 7.

8. Iomega denies the allegation in paragraph 8 that by grant of a registration for the mark “ZIP”, Iomega will obtain at least *prima facie* the exclusive right to use this mark on computer software and affirmatively asserts that by the grant of registration for Iomega’s application for the mark “ZIP” (U.S. App. Ser. No. 75/378,779), Iomega’s rights in that mark will extend to the identification of goods as provided in its application as duly amended. Iomega is without sufficient information to form a belief as to whether registration of the mark “ZIP” will be a source of injury to Opposer, and therefore denies the same.

9. To the extent not specifically admitted above, all allegations in Opposer’s Opposition are denied.

AFFIRMATIVE DEFENSES

1. Opposer's Opposition was not timely filed and is therefore void.
2. Opposer lacks standing to challenge the Applicant's registration of the mark.
3. Opposer has failed to state a claim upon which relief may be granted
4. Applicant's rights in and to the mark ZIP are superior to any rights of Opposer.
5. Opposer's claims are barred by the equitable defenses of acquiescence and laches.
6. Opposer's claims are barred by the equitable doctrine of unclean hands.
7. Opposer's claims are barred by the doctrines of estoppel and waiver

WHEREFORE having fully answered Opposer's Opposition, Iomega hereby prays the Opposition be dismissed with prejudice.

DATED this 5th day of December, 2001.

PARSONS BEHLE & LATIMER

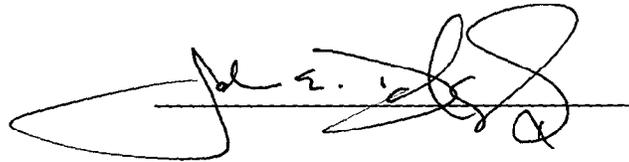


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CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service, postage prepaid, as U.S. Express Mail in an envelope addressed to: Assistant Commissioner of Trademarks, 2900 Crystal Drive, Arlington, VA 22202, on this date December 5th, 2001, Express Mail Label No. EL 900104464 US.

I hereby certify that this Answer to Opposition No. 124,176 is being deposited with the United States Postal Service, first class mail, postage prepaid, in an envelope addressed to: Frank P. Presta, Esq. NIXON & VANDERHYE P.C., 1100 North Glebe Road, 8th Floor, Arlington, VA 200201-4714, on this date December 5th, 2001.

A handwritten signature in black ink, appearing to be "Frank P. Presta", written over a horizontal line. The signature is stylized and cursive.