

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

MAXIMUS, INC.

Opposer,

v.

WILLIAM K. DABAGHI,

Applicant.

Opposition No. 91157646



01-26-2004

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #78

Commissioner for Trademarks
BOX TTAB
2900 Crystal Drive
Arlington, Virginia 22202-3513

WILLIAM K. DABAGHI'S ANSWER TO NOTICE OF OPPOSITION

Honorable Commissioner:

In response to the Notice of Opposition identified above, WILLIAM K. DABAGHI, by his attorneys, answers as follows:

WILLIAM K. DABAGHI denies that Opposer is being damaged, or will be damaged, by issuance of a registration to U.S. App. Ser. No. 76/382,915 MAXIMUS INTERNATIONAL for "business consulting services for others in the fields of multilateral trade policy, international trade, World Trade Organization negotiations, and imports and exports, all excluding the design, installation and maintenance of information technology and computer systems."

With respect to Opposer's asserted and enumerated grounds:

1. WILLIAM K. DABAGHI admits the allegations of Paragraph 2, with the exception that the services for U.S. App. Ser. No. 76/382,915 were not correctly specified by Opposer. The correct services for U.S. App. Ser. No. 76/382,915 are "business consulting services for others in the fields of multilateral trade policy, international trade, World Trade Organization negotiations, and imports and exports, all excluding the design, installation and maintenance of information technology and computer systems."

2. WILLIAM K. DABAGHI is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 2, and therefore denies the same.

3. WILLIAM K. DABAGHI is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 3, and therefore denies the same.

4. WILLIAM K. DABAGHI is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 4, and therefore denies the same.

5. WILLIAM K. DABAGHI is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 5, and therefore denies the same.

6. WILLIAM K. DABAGHI denies the allegations in Paragraph 6.

7. WILLIAM K. DABAGHI denies the allegations in Paragraph 7.

8. Any matters not expressly admitted are hereby denied.

AFFIRMATIVE DEFENSES

In further answer and response to the Notice of Opposition WILLIAM K. DABAGHI, by his attorneys, asserts:

9. The marks asserted by Opposer are weak and dilute. There are a considerable number of trademarks and designations used and registered and/or applied for in the United

States by third parties which include "MAXIMUS" as part thereof. As a result of the widespread proliferation of such third party usage, the public has become accustomed to co-existing, simultaneous uses of this common word. If Opposer has any rights in the common word MAXIMUS, the scope of protection of those rights is extremely limited and narrow. Upon information and belief, the public, upon simply hearing or seeing the common word, does not identify it with Opposer.

10. There is room on the Principal Register, already crowded with co-existing marks containing the dilute word MAXIMUS, for the addition and inclusion of Applicant's mark, without any likelihood of confusion with the alleged marks asserted by Opposer.¹

11. Applicant's "business consulting services for others in the fields of multilateral trade policy, international trade, World Trade Organization negotiations, and imports and exports, all excluding the design, installation and maintenance of information technology and computer systems" are not closely related to any services provided by Opposer under any mark. Opposer's rights in connection with MAXIMUS, if any, do not extend *in gross* to a monopoly on *all* services.

12. Upon information and belief, the respective parties sell very expensive services to small niche groups of highly sophisticated and educated purchasers.

13. Upon information and belief, the respective marks of the parties do not travel in the same channels of trade.

¹ PTO Examining Attorneys have particular expertise and closely scrutinize applications. Therefore, the PTO Examining Attorneys' prior findings of no likelihood of confusion here with any of Opposer's trademarks is particularly significant. See, e.g., Miss Universe, Inc. v. Little Miss USA, Inc., 212 USPA 425, 427 n.6 (N.D. Ga. 1981).

14. Opposer is prevented by the equitable defense of estoppel from opposing U.S. App. Ser. No. 76/382,915.

15. Opposer is prevented by the equitable defense of acquiescence from opposing U.S. App. Ser. No. 76/382,915.

16. Opposer is prevented by the equitable defense of laches from opposing U.S. App. Ser. No. 76/382,915.

17. Opposer waived any rights to oppose U.S. App. Ser. No. 76/382,915.

WHEREFORE, WILLIAM K. DABAGHI respectfully requests that the claims made against him in this opposition proceeding be DISMISSED, with prejudice.

POWER OF ATTORNEY

WILLIAM K. DABAGHI hereby appoints PETER J. RIEBLING, ESQ., ROGER P. FUREY, ESQ., COURTNEY BAILEY, ESQ., REBECCA E. McDOUGALL, ESQ. and SYLVIA D. DAVIS, ESQ. of KATTEN MUCHIN ZAVIS ROSENMAN, located at 1025 Thomas Jefferson Street, N.W., Seventh Floor, Washington, D.C. 20007, as its attorneys with full powers of substitution and revocation, to file this Answer, to receive all related communications, to transact all business in the U.S. Patent and Trademark Office and/or Trademark Trial and Appeal Board in connection therewith, and to represent it in all proceedings and appeals that may arise in the U.S. Patent and Trademark Office or the courts concerning this proceeding.

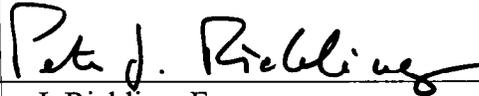
Please address all correspondence in this matter to:

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Respectfully submitted,

WILLIAM K. DABAGHI

By:



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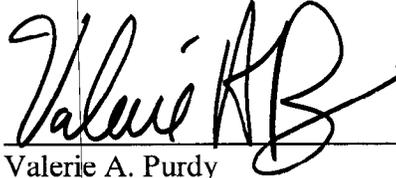
Dated: January 26, 2004

Attorneys for Applicant

CERTIFICATE OF HAND-DELIVERY

I hereby certify that the foregoing **Answer to Notice of Opposition No. 91157646** filed on behalf of Applicant, William K. Dabaghi, was hand-delivered to the following address, this 26th day of January, 2004:

Commissioner for Trademarks
U.S. Patent and Trademark Office
2900 Crystal Drive
Arlington, Virginia 22202-3514
MAIL STOP BOX TTAB - NO FEE



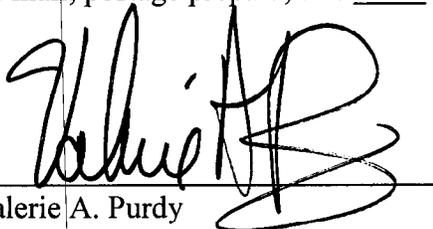
Valerie A. Purdy
Trademark Paralegal
KATTEN MUCHIN ZAVIS ROSENMAN

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **Answer to Notice of Opposition No. 91157646** filed on behalf of Applicant, William K. Dabaghi, was served on:

Linda K. McLeod, Esq.
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
1300 I Street, N.W.
Washington, D.C. 20005-3315

Opposer's counsel, via first-class mail, postage prepaid, this 26th day of January, 2004.



Valerie A. Purdy
Trademark Paralegal
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VIA HAND DELIVERY

MAIL STOP BOX TTAB – NO FEE

RE: Opposer: Maximus, Inc.
Applicant: William K. Dabaghi
Opposition No.: 91157646
Our Reference: 330504-00001



01-26-2004
U.S. Patent & TMO/TM Mail RcptDt. #78

Dear Sir:

Submitted herewith are the following:

1. William K. Dabaghi's Answer to Notice of Opposition (5 Pages);
2. Certificate of Hand Delivery with Certificate of Service (1 Page); and
3. A receipt to be date stamped with the filing date (1 Pink sheet).

The Commissioner is hereby authorized to charge any necessary fees associated with the filing of this Answer to Notice of Opposition to the Deposit Account of Katten Muchin Zavis Rosenman, Account No. 50-1877.

Please direct all inquiries and correspondence in this matter to Peter J. Riebling, Esq., at the address on this letterhead or by telephone at (202) 625-3598.

Respectfully submitted,

Valerie A. Purdy
Trademark Paralegal

Date: January 26, 2004

Enclosures

cc: William K. Dabaghi
Peter J. Riebling, Esq.