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

Proceeding	91188179
Party	Defendant A. Hamid Andalib
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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ZUMBA FITNESS, LLC,

Opposer,

v.

Opposition No. 91188179

A. HAMID ANDALIB,

Applicant.

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ANSWER AND DEFENSES

A. Hamid Andalib (“Applicant”) hereby responds to the Amended Notice of Opposition (“Notice”) of Zumba Fitness, LLC (“Opposer”) as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 1 of the Notice, and therefore denies the same. Applicant also objects to Opposer including any assertions in an unnumbered, introductory paragraph or preamble for which it is not clear whether Opposer is making averments and how and to what extent, if any, Applicant should respond to such assertions. Applicant denies any and all such averments and assertions. Additionally, Applicant denies that Opposer will be damaged in any legally cognizable respect or in any other respect whatsoever by registration of Applicant’s YOUZOOMBA, UZOOMBA, UZUMBA, and YOUZUMBA marks (“Applicant’s Marks”) of Application Serial Nos. 77371281, 77371229, 77371247, and 77371302 (“Applicant’s Applications”) on the Principal Register of the U.S. Patent and Trademark Office (“USPTO”).

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 2 of the Notice and therefore denies the same.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 3 of the Notice and therefore denies the same.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 4 of the Notice and therefore denies the same.

5. Applicant, A. Hamid Andalib, admits the allegation of paragraph 5 that he is an individual. However, Mr. Andalib's principal place of residence is currently 2225 Johnson Ferry Road, Marietta, Georgia 30062.

6. Applicant admits the allegations of paragraph 6 of the Notice.

7. Applicant admits the allegations of paragraph 7 of the Notice.

8. Applicant denies the allegations of paragraph 8 of the Notice.

9. Applicant incorporates its preceding responses to the allegations of the Notice as if fully set forth herein.

10. Applicant denies the allegations of paragraph 10 of the Notice.

11. Applicant denies the allegations of paragraph 11 of the Notice.

12. Applicant incorporates its preceding responses to the allegations of the Notice as if fully set forth herein.

13. Applicant denies the allegations of paragraph 13 of the Notice.

14. Applicant denies the allegations of paragraph 14 of the Notice.

15. Applicant incorporates its preceding responses to the allegations of the Notice as if fully set forth herein.

16. Applicant denies the allegations of paragraph 16 of the Notice.

17. Applicant denies the allegations of paragraph 17 of the Notice.

18. Applicant admits the allegations of paragraph 18 of the Notice.
19. Applicant denies the allegations of paragraph 19 of the Notice.
20. Applicant denies the allegations of paragraph 20 of the Notice.

All allegations in the Notice not specifically admitted or denied are hereby denied.

AFFIRMATIVE AND OTHER DEFENSES

1. The Notice fails to state a claim upon which relief can be granted.
2. The Notice is barred by laches.
3. The Notice is barred by acquiescence.
4. The Notice is barred by unclean hands.
5. The Notice is barred by estoppel.
6. The Notice is barred by res judicata.
7. The Notice is barred by collateral estoppel.
8. The Notice fails by reason of the fact that Opposer's registrations are unenforceable and/or invalid due to fraud on the USPTO. Opposer's alleged predecessor-in-interest, Zumba Productions, made material, knowingly false or misleading statements or omissions during prosecution of the application to register the ZUMBA mark, U.S. Application Serial No. 76/327,278, filed on October 19, 2001, and also during post-registration activities pertaining to enforcement and/or maintenance of the registration issuing therefrom. In particular, during prosecution of the '278 application, the Examining Attorney requested that "the applicant must indicate whether ZUMBA has any significance in the relevant trade, any

geographical significance or any meaning in a foreign language,” in accordance with 37 C.F.R. §2.61(b). In response, Opposer stated “the word ZUMBA does not have any significance in the relevant trade, except for possible significance as applicant’s mark, any geographical significance, or any meaning in a foreign language.” In reliance on the truth of this statement, the USPTO granted Opposer a registration for its mark. However, Opposer omitted an explanation of the geographic significance or foreign language meaning, when it knew full well that its statements and/or omissions of information made during prosecution was false or at least misleading in that the English translation of the Spanish term “zumba” in Opposer’s mark was said by Opposer in later prosecution and advertising material to mean “move fast” or “fast.”

Additionally, on September 30, 2004, Opposer’s alleged predecessor Zumba Productions filed a Statement of Use in connection with the ‘278 application. In its Statement of Use, Zumba Productions declared under oath, being warned that willful false statements, and the like, may jeopardize the validity of the application, that the ZUMBA mark was being used for all of the following goods and services: video recordings in the field of exercise and physical fitness, pre-recorded video cassettes in the field of physical fitness and exercise in international class 9; clothing namely, hats, caps, shirts, pants, shorts, socks, shoes, athletic shoes, pullovers, jackets, sweatshirts, sweat pants, leotards, exercise clothing, namely, shirts, shorts, pants, leotards, sweatshirts, jackets, socks, shoes, caps and hats in international class 25; and entertainment services, namely, a series of television programs in the field of physical fitness and exercise in international class 41. Upon information and belief, this was a “willful false statement” or “the like” because, among other things, the mark ZUMBA was not being used for all of the goods

and/or services identified in the Statement of Use as alleged in Zumba's Statement of Use. Upon information and belief, Zumba's Statement of Use containing false or misleading material information, statements, or omissions was filed in bad faith with knowledge or reason to know of its falseness and of its misleading character and in an attempt to perpetrate a fraud upon the USPTO because Zumba Productions knew or should have known that it was not using the mark ZUMBA for all of the goods sworn to in the Statement of Use when it filed the same in the USPTO, and to induce the USPTO by fraudulent or misleading statements or omissions of material fact to issue a registration for the mark covering all these goods and services.

Relying on these materially false statements or misleading statements in the Amendment and Statement of Use, the USPTO approved the '278 application, which issued as U.S. Trademark Registration No. 3,046,534 on January 17, 2006. Registration No. 3,046,534 is the first registration underlying Opposer's asserted registrations for its ZUMBA marks, all of which include a claim to ownership of the genesis U.S. Trademark Registration No. 3,046,534 and were all therefor deliberately established by Opposer to have a direct dependency relationship relating back to the original genesis '534 registration and to be a family of directly related marks/registrations originating with the '534 registration.

Further, Opposer made material, knowingly false statements and/or omissions during the prosecution underlying the application to register the ZUMBAWEAR mark, U.S. Application Serial No. 77/165,007, filed on April 25, 2007. When Opposer filed the '007 application, Opposer declared under oath, being warned that willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, that the ZUMBAWEAR

mark was being used for all of the goods listed in the '007 application. Upon information and belief, Opposer was not using the mark ZUMBAWEAR on all of the goods identified in the '007 application when it filed the '007 application. Opposer's declaration in the '007 application was made in bad faith and in an attempt to perpetrate a fraud upon the USPTO because Opposer knew or should have known that it was not using the mark ZUMBAWEAR in connection with all of the goods identified in the '007 application when it filed the '007 application.

In view of at least the above material, false statements and/or omissions, at least U.S. Trademark Registration Nos. 3,046,534 and 3,359,366 are invalid and unenforceable and any/all other registrations and applications which relate thereto, derive therefrom, rely thereon, or are dependent thereon in any material respect, and/or include claims to ownership thereof are and should be declared to be invalid and unenforceable due to Opposer's fraud on the U.S. Patent and Trademark Office in procuring the '534 and '366 registrations, and cancelled from the Principal Register.

9. The Notice fails by reason of the fact that Opposer's alleged marks are unenforceable and/or abandoned due to naked licensing.

10. The Notice fails by reason of the fact that use of Applicant's Marks of Applicant's Applications for the services stated therein is not likely to cause confusion, mistake, or deception with regard to the source of the services vis-a-vis the source of any goods and services provided under any ZUMBA or other mark to which Opposer is allowed to rely upon herein, or to otherwise cause any damage to any cognizable right or interest of Opposer.

11. The Notice fails by reason of the fact that extensive third party use and/or registration of similar marks and names containing the term “zumba” or any phonetic or literal similar term as a primary or dominant component thereof for many years for or in connection with goods and/or services at least as similar to any goods or services for which Opposer or any other entity has made any use of its alleged ZUMBA marks as the services for which Applicant has applied to register Applicant’s Marks shows that Opposer’s ZUMBA Marks do not have sufficient strength, fame, or distinctiveness in regard to services of the type for which Applicant has applied to register Applicant’s Marks to allow Opposer to have an alleged “family” of ZUMBA marks or to cause use of Applicant’s marks to be deemed to be likely to cause confusion, mistake, or deception as to the source of Applicant’s services vis-a-vis the goods and/or services provided under any ZUMBA mark of Opposer or to otherwise cause any cognizable damage to Opposer, and such third party use is sufficiently pervasive to prevent Applicant’s use of Applicant’s Marks of Applicant’s Applications for the services stated therein from being deemed to be likely to lessen or diminish any distinctive value or other quality of any of Opposer’s ZUMBA Marks or in any way damage any rights or interests of Opposer in regard to the same.

12. Applicant reserves the right to assert such other and further defenses including, but not limited to, affirmative defenses, as it may become aware of in the course of this proceeding.

WHEREFORE, Applicant A. Hamid Andalib prays that the Board deny all relief requested by Opposer in its Amended Notice of Opposition, that the Board dismiss the

Opposition Proceeding with prejudice against Opposer, and that the Board grant Applicant such other and further relief as it deems just.

Respectfully Submitted,

LUEDEKA, NEELY & GRAHAM, P.C.

Dated: May 20, 2009

By: s/Mark S. Graham  
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Certificate of Service

This is to certify that a true and correct copy of the foregoing is being served on counsel of record, by first class mail, postage prepaid, addressed as follows:

Michael B. Chesal  
Paul L. Kobak  
PERETZ CHESAL & HERRMANN, PL  
201 S. Biscayne Blvd., 17<sup>th</sup> Floor  
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Date: May 20, 2009

s/Mark S. Graham

Mark S. Graham