

ESTTA Tracking number: **ESTTA264094**

Filing date: **02/02/2009**

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

Proceeding	91188179
Party	Defendant Andalib, A. Hamid
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Date	02/02/2009
Attachments	6386199-pleadings-20090202-answer to notice of opposition and counterclaims.pdf (12 pages)(26180 bytes)

Registrations Subject to the filing

Registration No	3046534	Registration date	01/17/2006
Registrant	ZUMBA FITNESS, LLC 3801 North 29th Avenue Hollywood, FL 33020 UNITED STATES		

Goods/Services Subject to the filing

<p>Class 025. First Use: 2002/10/01 First Use In Commerce: 2002/10/01 All goods and services in the class are requested, namely: 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</p>
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Registration No	3359366	Registration date	12/25/2007
Registrant	Zumba Fitness, LLC. 1688 NE 205 Terrace Miami, FL 33179 UNITED STATES		

Goods/Services Subject to the filing

<p>Class 025. First Use: 2003/02/15 First Use In Commerce: 2003/02/15 All goods and services in the class are requested, namely: 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</p>

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

ZUMBA FITNESS, LLC,

Opposer,

v.

Opposition No. 91188179

A. HAMID ANDALIB,

Applicant.

ANSWER, DEFENSES, AND COUNTERCLAIM

A. Hamid Andalib (“Applicant”) hereby responds to the 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 the preamble of the Notice and of paragraph 1 thereof, and therefore denies the same. Applicant also objects to Opposer including any assertions in an unnumbered, introductory paragraph for which it is not clear whether, how, and to what extent, Applicant should respond to such 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 admits the allegations of paragraph 4 of the Notice.

5. Applicant admits the allegations of paragraph 5 of the Notice.

6. Applicant denies any/all characterizations and other assertions in paragraph 6 including, but not limited to, description of Applicant's Marks collectively as "U.S. Trademarks." Otherwise, Applicant admits the allegations of paragraph 6 of the Notice.

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

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

9. Applicant denies the allegations of paragraph 9 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 invalid due to fraud on the USPTO. In this regard, Zumba Productions, Opposer's alleged predecessor-in-interest, is believed to have made and to be continuing to make material, knowingly false statements during the prosecution underlying the application to register the ZUMBA mark, U.S. Application Serial No. 76/327,278, filed on October 19, 2001, and with regard to post-registration activities pertaining to the registration issuing therefrom. In particular, during prosecution of the '278 application, the Examining Attorney made a request 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" and, on the basis of this statement, Opposer was granted a registration for its mark. However, Opposer failed to elaborate as to the geographic significance or foreign language meaning when it knew or should have known that its statement made during prosecution was false or at least misleading in that the English translation of the Spanish term "zumba" in Opposer's mark is "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 was done 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 issuing on January 17, 2006. Registration No. 3,046,534 is the first registration underlying Opposer’s alleged family of registrations for its ZUMBA marks, all of which are said to include a claim to ownership of U.S. Trademark Registration No. 3,046,534.

Further, Opposer made material, knowingly false statements 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, 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 or rely thereon in any respect, and/or include claims to ownership thereof are invalid and unenforceable due to Opposer's fraud on the U.S. Patent and Trademark Office in procuring the '534 and '366 registrations.

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 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 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 significant strength or fame 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 any goods or services provided under any ZUMBA mark of 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.

COUNTERCLAIM

Applicant hereby incorporates by reference all of Applicant's averments, responses, and defenses set forth above. Applicant believes it will be damaged by continued registration of the marks of U.S. Trademark Registration Nos. 3,046,534 and 3,359,366 and hereby petitions to cancel the same. As grounds for this petition, Applicant asserts as follows:

1. On information and belief, Opposer's alleged predecessor-in-interest, Zumba Productions, LLC, filed an intent to use application with the United States Patent and Trademark Office ("USPTO") to register ZUMBA for use with "dietary food supplements, dietary supplements, meal replacement and dietary supplement drink mixes, meal replacement drinks in international class 5; video recordings in the field of exercise and physical fitness in international class 9; clothing; clothing namely, hats, caps, shirts, pants, shorts, socks, shoes, athletic shoes, pullovers, jackets, sweatshirts, sweat pants, leotards, exercise clothing in international class 25; wheat germ, chocolate food beverages not being dairy-based or vegetable based, herbal food beverages, tea-based beverages with fruit flavoring in international class 30; fruit drinks, fruit-based soft drinks flavored with tea, fruit-flavored drinks, isotonic drinks, sports drinks, smoothies in international class 32; and entertainment services; entertainment services, namely, a series of television programs and prerecorded video cassettes in the field of physical fitness and exercise in international class 41" on October 19, 2001. This application was assigned Serial Number 76/327,278 ("the '278 application").

2. The USPTO issued an Office Action against the '278 application on January 11, 2002, wherein the Examining Attorney made a request 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).

3. In an Amendment filed in response to the Office Action on February 1, 2002, Zumba Productions 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.”

4. On information and belief, the English translation of the Spanish term “zumba” is “move fast” or “fast.”

5. On information and belief, Zumba Production’s statement in its February 1, 2002, Amendment was made in bad faith and in an attempt to perpetrate a fraud upon the USPTO because Zumba Productions knew or should have known that the word ZUMBA did have a meaning in a foreign language when it made the statement.

6. Reasonably relying on the truth of such materially false statement in the February 1, 2002, Amendment, the USPTO eventually approved the ‘278 application for publication, which resulted in Registration No. 3,046,534 issuing on January 17, 2006.

7. On September 30, 2004, Zumba Productions filed a Statement of Use in connection with the ‘278 application using the USPTO’s electronic filing system. In the 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.

8. Upon information and belief, Zumba Productions was not using the mark ZUMBA on all of the goods and services identified in the Statement of Use when it filed the Statement of Use on September 30, 2004.

9. Upon information and belief, Zumba Production's declaration in its statement of use was made in bad faith 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 in connection with all of the goods identified in the Statement of Use when it filed the Statement of Use.

10. Reasonably relying on the truth of such materially false statement in the Statement of Use, the USPTO eventually approved the '278 application, which resulted in Registration No. 3,046,534 issuing on January 17, 2006.

11. The conduct of Zumba Productions constitutes fraud on the USPTO and therefore Reg. No. 3,046,534 should be cancelled.

12. On information and belief, Opposer filed an application with the United States Patent and Trademark Office ("USPTO") to register ZUMBAWEAR for use with "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 025 on April 25, 2007. This application was assigned Serial Number 77/165,007 (“the ‘007 application”).

13. When Opposer filed the ‘007 application, on April 25, 2007, 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.

14. 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 on April 25, 2007.

15. Upon information and belief, 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.

16. Reasonably relying on the truth of such materially false statement in the application, the USPTO eventually approved the ‘007 application, which resulted in Registration No. 3,359,366 issuing on December 25, 2007.

17. The conduct of Opposer constitutes fraud on the USPTO and therefore Reg. No. 3,359,366 should be cancelled.

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

Proceeding with prejudice against Opposer, that the Board cancel U.S. Trademark Registration Nos. 3,046,534 and 3,359,366 pleaded by Opposer in its Notice of Opposition, and that the Board grant Applicant such other and further relief as it deems just.

Respectfully Submitted,

LUEDEKA, NEELY & GRAHAM, P.C.

Dated: February 2, 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
KLUGER, PERETZ, KAPLAN & BERLIN, P.L.
201 S. Biscayne Blvd., 17th Floor
Miami, Florida 33131

Date: February 2, 2009

s/Mark S. Graham

Mark S. Graham