

3. Commencing long prior to September 18, 2003 (the filing date of Applicant's Application Serial No. 78/301,935), Opposer engaged in the development, distribution, sale, advertising and promotion, in interstate commerce, of food products, vitamins and mineral supplements, electronic and printed publications, on-line and retail services, clothing, meal delivery services, educational services, and counseling services under its ZONE PERFECT, ZONE UNIVERSITY, and ZONE TRAINER trademark and service marks (the "ZONE Marks").

4. Opposer has made substantial sales of merchandise and services in the United States under the ZONE Marks.

5. Opposer is the owner of the following United States trademark and service mark registrations for the ZONE Marks:

<u>Mark</u>	<u>Reg. No.</u>	<u>Reg. Date</u>	<u>Class(es)</u>	<u>Goods/Services</u>
ZONE PERFECT (stylized)	2645665	11/5/2002	5, 9, 16, 25, 29, 30, 35, 39, 41, 44	Vitamins and nutritional supplements, dietary supplements in the form of nutritional bars and nutritional drinks; downloadable electronic publications, namely, magazines in the field of diet, health and fitness; video and audio cassettes and multimedia software recorded on CD-ROM dealing with diet, health and fitness; printed publications, namely, magazines, newsletters and pamphlets in the field of health, nutrition and fitness; prepared entrees, side dishes and meals consisting primarily of vegetables, meat, fish and poultry; potato chips; mixes for making bakery goods, pancake mixes, pudding mixes, macaroni and cheese, shakes; soy-based snack chips; on-line and mail order retail services featuring vitamins, nutritional supplements, food, clothing, computer software and publications in the field of health, nutrition and fitness; meal delivery services; educational services, namely, conducting seminars and classes in the field of diet, health and fitness; physical fitness consultation; counseling services in the field of health, nutritional and fitness.

<u>Mark</u>	<u>Reg. No.</u>	<u>Reg. Date</u>	<u>Class(es)</u>	<u>Goods/Services</u>
ZONE PERFECT	2294807	11/23/1999	5, 16, 29, 35	Vitamins and nutritional supplements; publications, namely, newsletters, books, pamphlets, guides and brochures in the field of diet, health, nutrition and fitness; prepared entrees, side dishes and meals consisting primarily of vegetables, meat, fish and poultry; catalog and mail order services featuring vitamins, nutritional supplements, health foods, clothing, computer software and publications in the field of diet, health, nutrition and fitness
ZONE PERFECT	2269790	8/10/1999	25	Clothing, namely, shoes, leotards, sweatshirts, T-shirts, sweatpants, hats, shorts and sneakers
ZONE PERFECT	2492467	9/25/2001	39	Meal delivery services
ZONE PERFECT	2408977	11/28/2000	41, 42	Education and entertainment services, namely, seminars, classes and television programs dealing with diet, health, nutrition and fitness; restaurant services; counseling in the field of diet, health, nutrition and fitness
ZONE UNIVERSITY	2487942	9/11/2001	41	Educational services, namely, conducting classes, seminars, conferences and workshops in the field of diet, nutrition, health and fitness
ZONE TRAINER	2466823	7/10/2001	42	Counseling in the fields of nutrition, health and fitness

6. By reason of these registrations on the Principal Register, Opposer's ZONE Marks, as used by Opposer in connection with its goods and services, are presumed to constitute distinctive marks, which serve uniquely to identify Opposer as the source of its goods and services.

7. Since its initial use of the ZONE Marks, Opposer has made a substantial investment in advertising and promoting its goods and services under its ZONE Marks. Opposer has extensively used, advertised, promoted and offered for sale to the public, through various channels of trade and commerce, Opposer's goods and services in

association with the ZONE Marks, with the result that Opposer's customers and the public in general have come to know and recognize Opposer's ZONE Marks and associate the same with Opposer and/or the goods and services sold and provided by Opposer. Opposer has built up extensive goodwill in connection with the sale and provision of goods and services under its ZONE Marks. Moreover, as a result of Opposer's extensive use and promotion of the ZONE Marks, and its extensive sales and provision of goods and services under the ZONE Marks, the ZONE Marks have become famous.

8. Notwithstanding Opposer's prior rights in and to its ZONE Marks, on or about September 18, 2003, Applicant filed its application for registration of the mark DR. SEARS ZONE LABS, Application Serial No. 78/301,935. That mark was published for opposition in the Official Gazette on June 15, 2004, Page TM 168. Opposer sought and secured an extension of time to oppose the above-described application up to and including September 13, 2004.

9. Applicant's registration application identifies its products as "non-medicated skin care preparations and cosmetics" in International Class 3, and "vitamins, nutritional supplements, and nutritional food bars for use as a nutritional supplement or meal replacement; medicated cosmetics" in International Class 5.

10. Upon information and belief, Applicant's registration application was made with knowledge of Opposer's prior use of and rights in the famous ZONE Marks on and with the same or similar or related goods and services.

GROUND I – LIKELIHOOD OF CONFUSION

11. Opposer hereby incorporates by reference the allegations of Paragraphs 1 through 10 hereof as if fully set forth herein.

12. Applicant's DR. SEARS ZONE LABS mark, when used in connection with the products identified in Applicant's registration application, is likely to cause confusion, deception, and mistake with Opposer's ZONE Marks because Applicant's DR. SEARS ZONE LABS mark would be used on and with products that are the same as or similar or related to the goods and services sold and provided by Opposer under its ZONE Marks. Moreover, the goods and services provided by the parties in connection with their respective marks are likely both to be offered in the same and/or similar channels of trade, and to the same and/or similar customers.

13. Registration by Applicant of the mark DR. SEARS ZONE LABS would seriously damage Opposer and should be refused because use and/or registration of the DR. SEARS ZONE LABS mark is likely to cause confusion in the minds of the public and deceive purchasers. The public, upon seeing Applicant's mark in connection with Applicant's products, would believe that such products originate with, or have some connection with, the Opposer, and Opposer avers that Applicant's use of said mark interferes with Opposer's use of its ZONE Marks and will and does impede Opposer in the free use of said marks; and registration of the DR. SEARS ZONE LABS mark by Applicant will seriously damage the Opposer under 15 U.S.C. § 1052(d).

14. Registration of DR. SEARS ZONE LABS would be prima facie evidence of rights of Applicant under 15 U.S.C. § 1057(b), to the detriment of Opposer's rights in its ZONE Marks.

15. Pursuant to 15 U.S.C. § 1063(a), as amended, Opposer believes it will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the infringing use of its DR. SEARS ZONE LABS mark sought to be

registered, and will give colorable exclusive statutory rights to Applicant in violation and derogation of prior and superior statutory and common law rights of Opposer.

GROUND II – DILUTION

16. Opposer hereby incorporates by reference the allegations of Paragraphs 1 through 15 hereof as if fully set forth herein.

17. Because of the high degree of distinctiveness of Opposer's ZONE Marks, the length of time and extent to which Opposer has used its ZONE Marks, the extensive advertising and publicity Opposer's ZONE Marks have received, the nationwide trading area in which the Opposer's ZONE Marks are used, and the high degree of customer recognition of the Opposer's ZONE Marks, Opposer's ZONE Marks are famous trademarks and service marks pursuant to 15 U.S.C. § 1125(c)(1).

18. Registration of Applicant's DR. SEARS ZONE LABS mark for the products identified in its registration application would lessen the capacity of Opposer's famous ZONE Marks to identify and distinguish Opposer's products and services sold and provided thereunder and, as such, would cause dilution of the ZONE Marks in violation of 15 U.S.C. §§ 1125(c) and 1127.

19. Pursuant to 15 U.S.C. § 1063(a), as amended, Opposer believes it will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the infringing and diluting use of its DR. SEARS ZONE LABS mark sought to be registered, and will give colorable exclusive statutory rights to Applicant in violation and derogation of prior and superior statutory and common law rights of Opposer.

20. For the reasons set forth herein, pursuant to 15 U.S.C. § 1063(a), as amended, Opposer believes that registration by Applicant of the mark DR. SEARS ZONE LABS

would seriously damage Opposer and should be refused because use and/or registration of Applicant's DR. SEARS ZONE LABS mark is likely to cause dilution of Opposer's famous ZONE Marks and customer confusion as to source, origin, affiliation, or sponsorship between Applicant and Opposer and/or their respective goods and services.


WHEREFORE, Opposer, ZonePerfect Nutrition Company, believes and avers that it will be damaged by said registration and prays that registration of the DR. SEARS ZONE LABS mark shown in Application Serial No. 78/301,935, filed by Applicant, be refused, and that this Opposition be sustained.

The filing fee for this Notice of Opposition in the amount of \$600.00 is enclosed, as are the original and one copy of this Notice of Opposition.

Please recognize as attorneys for Opposer in this proceeding Daniel L. Goldberg, David O. Johanson, Joshua M. Dalton and Shaun E. Ryan (members of the Bar of the Commonwealth of Massachusetts) and the firm of Bingham McCutchen LLP, 150 Federal Street, Boston, Massachusetts 02110.

All correspondence should be addressed to David O. Johanson, Esq., of Bingham
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Respectfully submitted,



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Dated: October 12, 2004

Attorneys for Opposer,
ZonePerfect Nutrition Company

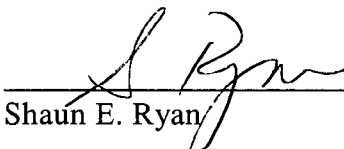
CERTIFICATE OF EXPRESS MAIL

Express Mail Label Number: EL 982734019 US

Date: October 12, 2004

By my signature below, I hereby certify that this Notice of Opposition is being deposited (in duplicate) with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above, addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.

Respectfully submitted,



Shaun E. Ryan

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October 12, 2004

TTAB

VIA EXPRESS MAIL

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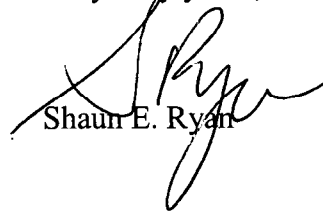
Re: Application Serial No.: 78/301,935
Published: June 15, 2004
Mark: DR. SEARS ZONE LABS
Our Ref.: ZONEP-004

Dear Sir/Madam:

Enclosed for filing are:

1. A Notice of Opposition (in Duplicate).
2. A check in the amount of \$600.00, payable to the Commissioner of Trademarks, in payment of the filing fee required by 37 C.F.R. §2.61. Please charge any additional fees to Deposit Account No. **500927**. An extra copy of this letter is attached for that purpose.
3. A self-addressed, stamped return acknowledgement postcard.

Very truly yours,


Shaun E. Ryan

SER/ems
Enclosures

cc: David O. Johanson, Esq.
Joshua M. Dalton, Esq.