

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

In re Application Serial No. 78/301,669)	
Published in the Official Gazette of July 6, 2004)	
Mark: ZONE LABS)	Opposition No. _____
Application Filing Date: September 17, 2003)	
ZonePerfect Nutrition Company,)	
)	
Opposer,)	
)	
v.)	
Barry D. Sears,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer, ZonePerfect Nutrition Company (“Opposer”), believes that it will be damaged by the issuance of a registration for the mark ZONE LABS, with respect to the goods in international class 5, as applied for in Application Serial No. 78/301,669, as filed by Barry D. Sears (“Applicant”), and hereby opposes the same.

As grounds for this Opposition, Opposer alleges as follows:

1. Opposer, ZonePerfect Nutrition Company, is a corporation organized and existing under the laws of the State of Delaware, with a principal place of business at 100 Cummings Center, Beverly, Massachusetts 01915.
2. Applicant, Barry D. Sears, is an individual with a principal place of business at 222 Rosewood Drive, Suite 500, Danvers, Massachusetts 01923.

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3. Commencing long prior to September 17, 2003 (the filing date of Applicant's Application Serial No. 78/301,669), 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>
ONE 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.
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

<u>Mark</u>	<u>Reg. No.</u>	<u>Reg. Date</u>	<u>Class(es)</u>	<u>Goods/Services</u>
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 17, 2003, Applicant filed its application for registration of the mark ZONE LABS, Application Serial No. 78/301,669. That mark was published for opposition in the Official Gazette on July 6, 2004, Page TM 160. Opposer sought and secured an extension of time to oppose the above-described application up to and including November 3, 2004.

9. Applicant's registration application identifies its products as "non-medicated skin care preparations and cosmetics," in International Class 3 (the "Class 3 Products"); and "vitamins, nutritional supplements, and nutritional food bars; medicated cosmetics" in International Class 5 (the "Class 5 Products").

10. Upon information and belief, Applicant's registration application, including the Class 5 Products, 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 ZONE LABS mark, when used in connection with the Class 5 Products identified in Applicant's registration application, is likely to cause confusion, deception, and mistake with Opposer's ZONE Marks because Applicant's 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 ZONE LABS for the Class 5 Products would seriously damage Opposer and should be refused because use and/or registration of the 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 Class 5 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 ZONE LABS mark by Applicant for the Class 5 Products will seriously damage the Opposer under 15 U.S.C. § 1052(d).

14. Registration of ZONE LABS for the Class 5 Products 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 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 ZONE LABS mark for the Class 5 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 for the Class 5 Products because such registration will support and assist Applicant in the infringing and diluting use of its 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 ZONE LABS for the Class 5 Products would seriously damage Opposer and should be refused because use and/or registration of Applicant's 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 ZONE LABS mark for the Class 5 Products shown in Application Serial No. 78/301,669, filed by Applicant, be refused, and that this Opposition be sustained.

The filing fee for this Notice of Opposition in the amount of \$300.00 is enclosed, for Opposers's opposition to registration of the ZONE LABS mark for the Class 5 Products. Also enclosed are the original and one copy of this Notice of Opposition.

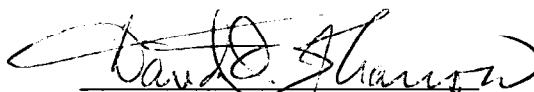
Please recognize as attorneys for Opposer in this proceeding Daniel L. Goldberg, David O. Johanson and Joshua M. Dalton (members of the Bar of the Commonwealth of Massachusetts) and the firm of Bingham McCutchen LLP, 150 Federal Street, Boston, Massachusetts 02110.

Opposer notes that it has filed oppositions against registration applications of applicant for similar marks, as follows:

<u>Mark</u>	<u>Serial No.</u>	<u>Opposition No.</u>	<u>Opposition Date</u>
DR. SEARS ZONE LABS	78/301,935	91162721	October 12, 2004
DR. SEARS ZONE LABS	78/301,937	91162722	October 12, 2004
ZONE CAFÉ	78/251,008	(not yet received)	July 14, 2004
ZONE LABS	78/301,931	(not yet received)	October 12, 2004
ZONE ICE CREAM	78/301,941	(not yet received)	October 13, 2004

All correspondence should be addressed to David O. Johanson, Esq., of Bingham
McCutchen LLP, 150 Federal Street, Boston, Massachusetts 02110.

Respectfully submitted,



Daniel L. Goldberg
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Joshua M. Dalton
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Dated: November 2, 2004

Attorneys for Opposer,
ZonePerfect Nutrition Company

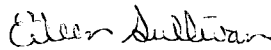
CERTIFICATE OF EXPRESS MAIL

Express Mail Label Number: EL 982734040 US

Date: November 2, 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, P.O. Box 1451, Alexandria Virginia 22313-1451.

Respectfully submitted,



Eileen M. Sullivan
Trademark Paralegal

David O. Johanson, Esq.
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TTAB

November 2, 2004

VIA EXPRESS MAIL

Commissioner for Trademarks
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02110-1726

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Re: Application Serial No.: 78/301,669
Published: July 6, 2004
Mark: ZONE LABS
Our Ref.: ZONEP-002

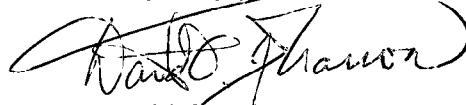
bingham.com

Dear Sir/Madam:

Enclosed for filing are:

1. A Notice of Opposition (in Duplicate).
2. A check in the amount of \$300.00, payable to the Commissioner of Trademarks, in payment of the filing fee required by 37 C.F.R. §2.61 for the opposition in one class (class 5). 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,


David O. Johanson

DOJ/ems
Enclosures

cc: Joshua M. Dalton, Esq.



11-03-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #70