

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

In the matter of Service Mark Application Serial No. 76/654,393
for the trademark "GO-ZOOM" published in the Official Gazette on January 9, 2007.

Zoom Telephonics, Inc.) Opposition No.: 91177379
)
Opposer,) ANSWER TO NOTICE OF OPPOSITION
)
vs.)
)
Ron Hay)
)
Applicant.)

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451



06-30-2007
U.S. Patent & TMO/TTA Mail Rcpt Dt. #72

ANSWER TO NOTICE OF OPPOSITION

COMES NOW THE Applicant, Ron Hay, an individual, (hereafter "Applicant"),
by and through its attorney and pursuant to Rule 2.114 of the Trademark Rules of
Practice and Rule 8(b) of the Fed. R. Civ. P., and for its Answer to the Notice for
Opposition (hereafter the "Opposition"), filed by Zoom Telephonics, Inc. Corporation of
America (hereafter "Opposer") seeking to oppose the issuance of United States Service
Mark Application Serial No. 76/654,393 for "GO-ZOOM", and answers the Opposition
as follows:

1. Answering Paragraph 1 of the Opposition, Applicant admits that it seeks to
register the mark "GO-ZOOM" under Application Serial No. 76/654,393 for the services
listed in Paragraph 1 of the Opposition. Applicant admits the remaining statements set

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forth in Paragraph 1 of the Opposition.

2. Answering Paragraph 2 of the Opposition, Applicant has insufficient information and belief to admit or deny the allegations contained therein and basing its denial on that ground, denies each and every, all and singular, the allegations of said Paragraph 2 of the Opposition.

3. Answering Paragraph 3 of the Opposition, Applicant has insufficient information and belief to admit or deny the allegations contained therein and basing its denial on that ground, denies each and every, all and singular, the allegations of said Paragraph 3 of the Opposition.

4. Answering Paragraph 4 of the Opposition, Applicant has insufficient information and belief to admit or deny the allegations contained therein and basing its denial on that ground, denies each and every, all and singular, the allegations of said Paragraph 4 of the Opposition.

5. Answering Paragraph 5 of the Opposition, Applicant has insufficient information and belief to admit or deny the allegations contained therein and basing its denial on that ground, denies each and every, all and singular, the allegations of said Paragraph 5 of the Opposition.

6. Answering Paragraph 6 of the Opposition, Applicant denies each and every, all and singular, the allegations of said Paragraph 6 of the Opposition.

7. Answering Paragraph 7 of the Opposition, Applicant denies each and every, all and singular, the allegations of said Paragraph 7 of the Opposition.

9. Answering Paragraph 9 of the Opposition (there is no Paragraph 8), Applicant has insufficient information and belief to admit or deny the allegations contained therein and basing its denial on that ground, denies each and every, all and singular, the

1 allegations of said Paragraph 9 of the Opposition.

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3 10. Answering Paragraph 10 of the Opposition, Applicant denies each and every,
4 all and singular, the allegations of said Paragraph 10 of the Opposition.

5 11. Answering Paragraph 11 of the Opposition, Applicant denies each and every,
6 all and singular, the allegations of said Paragraph 11 of the Opposition.

7 AFFIRMATIVE DEFENSES

8 FIRST AFFIRMATIVE DEFENSE

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10 12. As a first, separate and distinct affirmative defense, Applicant alleges that for
11 purposes of determining likelihood of confusion, a trademark must be considered in its
12 entirety and not dissected into two component parts. Estate of P.D. Beckwith, Inc. v.
13 Comm'n of Patents, 252 U.S. 538 (1920); In re Bed & Breakfast Registry, 791 F.2d 157,
14 229 U.S.P.Q. 818 (Fed. Cir. 1986). Applicant alleges that Opposer has violated the well
15 known trademark "anti-dissection" rule by dissecting Applicant's trademark into
16 component parts and arguing that one part is more dominant than the other to allege a
17 likelihood of confusion. Applicant's mark is "GO-ZOOM". The Opposer's family of
18 related marks includes "ZOOM COMSTAR, ZOOMAIR, ZOOM FAXMODEM,
19 ZOOM.COM, ZOOM GUARD, ZOOMCAM, ZOOMLINK, ZOOM/HOMELAN,
20 ZOOM/VIDEO and ZOOMIT (hereafter "Opposer's Marks"). The fact that Applicant's
21 marks and Opposer's marks contain in part the word "ZOOM" does not make them
22 confusingly similar.
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25 SECOND AFFIRMATIVE DEFENSE

26 13. As a second, separate and distinct affirmative defense, Applicant alleges that
27 under the overall impression analysis, there is no rule that an applicant cannot register a
28 trademark which contains in part the whole of a prior registered mark. In re

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Merchandising Motivation, Inc., 184 U.S.P.Q. 364 (T.T.A.B. 1974). In Merchandising Motivation the Examiner stated that "no one has the right to incorporate the mark of another" and refused registration of mark "MMI MENSWEAR" over prior registration of mark "MEN'S WEAR". The Board reversed the Examiner's refusal because "the legal proposition put forth by the [E]xaminer [wa]s not absolute." Id., at 365.

In fact, the prior decision clearly indicates that there is no rule that confusion is automatically likely when an applicant's trademark contains in part the whole of a prior registered trademark. *See, e.g.*, S.C. Johnson & Sons, Inc. v. Johnson, 266 F.2d 129, 121 U.S.P.Q. 63 (6th Cir. 1959), *cert. denied*, 361 U.S. 820, 80 S. Ct. 65, 4 L. Ed.2d 65, 123 U.S.P.Q. 590 (1959); Clayton Mark & Co. v. Westinghouse Elec. Corp., 356 F.2d 943, 53 C.C.P.A. 951, 148 U.S.P.Q. 672 (C.C.P.A. 1964); Colgate-Palmolive Co. v. Carter-Wallace, Inc., 432 F.2d 1400, 58 C.C.P.A. 735, 167 U.S.P.Q. 529 (C.C.P.A. 1970); Lever Bros. Co. v. Barcolene Co., 463 F.2d 1167, 59 C.C.P.A. 1162, 174 U.S.P.Q. 392 (C.C.P.A. 1972); Application of Ferrero, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A. 1973); Conde Nast Publications, Inc. v. Miss Quality, Inc., 5076 F.2d 1404, 184 U.S.P.Q. 422 (C.C.P.A. 1975); Plus Prod. v. General Mills, Inc., 188 U.S.P.Q. 520 (T.T.A.B. 1975); Lever Bros. Co. v. American Bakeries Co., 693 F.2d 251, 216 U.S.P.Q. 177 (2nd Cir. 1982). In the above cited cases, the following registration of applicant's trademarks are granted over prior registered trademarks which were respectively incorporated entirely into the applicants' trademarks:

<u>Applicant's Trademark</u>	<u>Prior Registered Trademark</u>
MARK 75	MARK
JOHNSON MOP	JOHNSON
PEAK PERIOD	PEAK

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ALL CLEAR	ALL
TIC TAC TOE	TIC TAC
COUNTRY VOGUES	VOGUE
PROTEIN PLUS	PLUS
AUTUMN GRAIN	AUTUMN

It is noted that in the above cited cases, no likelihood of confusion was found, when the prior marks incorporated were found to be suggestive, or alternatively, conveyed a different meaning as used alone.

THIRD AFFIRMATIVE DEFENSE

14. As a third, separate and distinct affirmative defense, Applicant alleges that when the Opposer's mark "ZOOM" and the Applicant's mark "GO-ZOOM" are compared in their entireties, the Applicant's mark and the Opposer's mark are not confusingly similar in overall sight, sound and meaning. The overall impression created by Applicant's mark is totally different in overall impression created by Opposer's mark.

FOURTH AFFIRMATIVE DEFENSE

15. As a fourth, separate and distinct affirmative defense, Applicant alleges that Applicant's products and Opposer's products are sold to totally different consumers in totally different channels of trade which would therefore result in no likelihood of confusion whatsoever between the two marks.

FIFTH AFFIRMATIVE DEFENSE

16. As an fifth, separate and distinct affirmative defense, Applicant alleges that the Opposition and each and every paragraph stated therein fails to state a cause of action against the Applicant.

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SIXTH AFFIRMATIVE DEFENSE

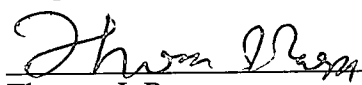
17. As a sixth, separate and distinct affirmative defense, Applicant alleges that Opposer has sustained no damage, injury or prejudice as a result of Applicant's Service Mark Application sought to be registered for "GO-ZOOM".

WHEREFORE, Applicant requests that the Opposition to Service Mark Application Serial No. 76/654,393 be denied and that Opposer take nothing by way of its Petition.

If there is any charge required for the filing of this Answer to Notice of Opposition, the Commissioner of Patents and Trademarks is hereby authorized to charge my Deposit Account No. 18-2222 for the appropriate fee.

Please send all correspondence concerning this Opposition to Thomas I. Rozsa, at the address listed below.

Date: June 29, 2000

Respectfully submitted,

Thomas I. Rozsa
Registration No. 29,210

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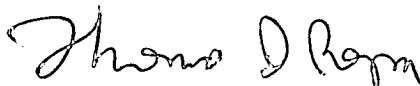
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CERTIFICATE OF MAILING

I hereby certify that the ANSWER TO NOTICE OF OPPOSITION, CERTIFICATE OF SERVICE, and CERTIFICATE OF MAILING are being deposited with the United States Postal Service with sufficient postage as Express Mail, Mail Label No. EM 077435114 US, in an envelope addressed to:

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

Dated: June 29, 2007



Thomas I. Rozsa
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the document entitled ANSWER TO NOTICE OF
OPPOSITION was sent on June 29, 2007 via first class mail, postage prepaid, to the attorneys
for the Opposer at the following address:

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Dated: June 29, 2007



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