

IN THE UNITED STATES PATENT AND TRADEMAR

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of the Service Mark Application Serial No. 76/654,387 for "ZOOMIT"  
published in the Official Gazette on February 20, 2007

Zoom Telephonics, Inc.,	)	Opposition No.: 91178057
	)	
Opposer,	)	ANSWER TO NOTICE OF OPPOSITION
	)	
vs.	)	
	)	
Ron Hay	)	
	)	
Applicant.	)	
_____	)	

Commissioner for Trademarks  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

ANSWER TO NOTICE OF OPPOSITION

COMES NOW the Applicant, Ron Hay, (hereafter "Applicant"), by and through his 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 his Answer to the Notice for Opposition (hereafter the "Opposition"), filed by Zoom Telephonics, Inc. (hereafter "Opposer") seeking to oppose the issuance of United States Trademark Application Serial No. 76/654,387, for "ZOOMIT", and answers the Opposition as follows:

1. Answering Paragraph 1 of the Opposition, Applicant admits the allegations of said Paragraph 1 of the Opposition.
2. Answering Paragraph 2 of the Opposition, Applicant has insufficient



ROZSA LAW GROUP LC  
ATTORNEYS AT LAW  
18757 BURBANK BOULEVARD, SUITE 220  
TARZANA, CALIFORNIA 91356-3346  
TELEPHONE (818) 783-0990

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

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

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

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

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

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

22           8.       Please note that there is no Paragraph 8 to the Opposition.

23           9.       Answering Paragraph 9 of the Opposition, Applicant has insufficient  
24 information and belief to admit or deny the allegations contained therein and basing its  
25 denial on that ground, denies each and every, all and singular, the allegations of said  
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ROZSA LAW GROUP LC  
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18757 BURBANK BOULEVARD, SUITE 220  
TARZANA, CALIFORNIA 91356-3346  
TELEPHONE (818) 783-0990

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Paragraph 9 of the Opposition.

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

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

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

12. As a first, separate and distinct affirmative defense, Applicant alleges that its service mark "ZOOMIT" is not confusingly similar with any of the Opposer's registrations for "ZOOM". Applicant alleges that when considered in its entirety, the service mark "ZOOMIT" is not pronounced the same as and is not confusingly similar with any of Opposer's marks for "ZOOM".

SECOND AFFIRMATIVE DEFENSE

13. As a second, separate and distinct affirmative defense, Applicant alleges that the only registration that Opposer has for "ZOOMIT" is for web acceleration services, namely providing higher speed access to the world wide web and this has nothing whatsoever to do with the Applicant's services. Therefore, Applicant's services for "ZOOMIT" are totally different services, sold to totally different consumers in totally different channels of trade. Therefore, there would be absolutely and totally no confusion between Applicant's use of "ZOOMIT" and the Opposer's use of "ZOOMIT".

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3 THIRD AFFIRMATIVE DEFENSE

4 14. As a third, separate and distinct affirmative defense, Applicant alleges that  
5 under the overall impression analysis, there is no rule that an applicant cannot register a  
6 trademark which contains in part the whole of a prior registered mark. In re  
7 Merchandising Motivation, Inc., 184 U.S.P.Q. 364 (T.T.A.B. 1974). In Merchandising  
8 Motivation the Examiner stated that "no one has the right to incorporate the mark of  
9 another" and refused registration of mark "MMI MENSWEAR" over prior registration of  
10 mark "MEN'S WEAR". The Board reversed the Examiner's refusal because "the legal  
11 proposition put forth by the [E]xaminer [wa]s not absolute." Id., at 365.

12  
13 In fact, the prior decision clearly indicates that there is no rule that confusion is  
14 automatically likely when an applicant's trademark contains in part the whole of a prior  
15 registered trademark. *See, e.g., S.C. Johnson & Sons, Inc. v. Johnson*, 266 F.2d 129, 121  
16 U.S.P.Q. 63 (6th Cir. 1959), *cert. denied*, 361 U.S. 820, 80 S. Ct. 65, 4 L. Ed.2d 65, 123  
17 U.S.P.Q. 590 (1959); Clayton Mark & Co. v. Westinghouse Elec. Corp., 356 F.2d 943, 53  
18 C.C.P.A. 951, 148 U.S.P.Q. 672 (C.C.P.A. 1964); Colgate-Palmolive Co. v. Carter-  
19 Wallace, Inc., 432 F.2d 1400, 58 C.C.P.A. 735, 167 U.S.P.Q. 529 (C.C.P.A. 1970); Lever  
20 Bros. Co. v. Barcolene Co., 463 F.2d 1167, 59 C.C.P.A. 1162, 174 U.S.P.Q. 392  
21 (C.C.P.A. 1972); Application of Ferrero, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A.  
22 1973); Conde Nast Publications, Inc. v. Miss Quality, Inc., 5076 F.2d 1404, 184 U.S.P.Q.  
23 422 (C.C.P.A. 1975); Plus Prod. v. General Mills, Inc., 188 U.S.P.Q. 520 (T.T.A.B.  
24 1975); Lever Bros. Co. v. American Bakeries Co., 693 F.2d 251, 216 U.S.P.Q. 177 (2nd  
25 Cir. 1982). In the above cited cases, the following registration of applicant's trademarks  
26 are granted over prior registered trademarks which were respectively incorporated entirely  
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3 into the applicant's trademarks:

<u>Applicant's Trademark</u>	<u>Prior Registered Trademark</u>
MARK 75	MARK
JOHNSON MOP	JOHNSON
PEAK PERIOD	PEAK
ALL CLEAR	ALL
TIC TAC TOE	TIC TAC
COUNTRY VOGUES	VOGUE
PROTEIN PLUS	PLUS
AUTUMN GRAIN	AUTUMN

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

18 **FOURTH AFFIRMATIVE DEFENSE**

19 15. As a fourth, separate and distinct affirmative defense, Applicant alleges that  
20 the Opposer's marks which are for "ZOOM" have a totally different meaning from the  
21 Applicant's mark "ZOOMIT" and have a totally different visual impression and no one  
22 would confuse the marks as emanating from the same source since they are totally  
23 different marks having totally different commercial impressions and totally different  
24 meanings in the marketplace.

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26 **FIFTH AFFIRMATIVE DEFENSE**

27 16. As a fifth, separate and distinct affirmative defense, Applicant alleges that  
28 when the Opposer's marks and Applicant's mark are compared in their entireties, the

ROZSA LAW GROUP LC  
ATTORNEYS AT LAW  
18757 BURBANK BOULEVARD, SUITE 220  
TARZANA, CALIFORNIA 91356-3346  
TELEPHONE (818) 783-0990

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Applicant's mark for "ZOOMIT" and the Opposer's marks for "ZOOM" are not confusingly similar in overall sight, sound and meaning. The overall impression created by Applicant's mark is totally different from the overall impression created by Opposer's mark.

**SIXTH AFFIRMATIVE DEFENSE**

17. As a sixth, 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.

**SEVENTH AFFIRMATIVE DEFENSE**

18. As a seventh, separate and distinct affirmative defense, Applicant alleges that the Opposer has sustained no damage, injury or prejudice as a result of the Applicant's service mark application for "ZOOMIT".

WHEREFORE, Applicant requests that the Opposition to Trademark Application Serial No. 76/654,387 be denied and that Opposer take nothing by way of its Opposition.

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.

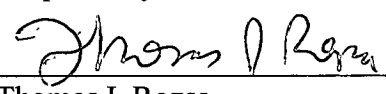
ROZSA LAW GROUP LC  
ATTORNEYS AT LAW  
18757 BURBANK BOULEVARD, SUITE 220  
TARZANA, CALIFORNIA 91356-3346  
TELEPHONE (818) 783-0990

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

Date: July 19, 2007

Respectfully submitted,



Thomas I. Rozsa  
Registration No. 29,210  
Attorney for Applicant  
Ron Hay  
18757 Burbank Boulevard, Suite 220  
Tarzana, California 91356-3346  
Telephone: (818) 783-0990  
Telecopier: (818) 783-0992

ROZSA LAW GROUP LC  
ATTORNEYS AT LAW  
18157 BURBANK BOULEVARD, SUITE 220  
TARZANA, CALIFORNIA 91356-3346  
TELEPHONE (818) 783-0990

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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 077736975 US an envelope addressed to:

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

Dated: July 19, 2007



Thomas I. Rozsa  
Registration No. 29,210  
Attorney For Applicant

In Re Opposition No. 91178057

ROZSA LAW GROUP LC  
ATTORNEYS AT LAW  
18757 BURBANK BOULEVARD, SUITE 220  
TARZANA, CALIFORNIA 91356-3346  
TELEPHONE (818) 783-0990

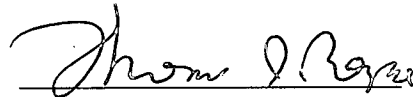
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the document entitled ANSWER TO NOTICE OF OPPOSITION was sent on July 19, 2007 via first class mail, postage prepaid, to the attorneys for the Opposer at the following address:

Sumedha A. Bahri  
Hamilton, Brook, Smith & Reynolds, P.C.  
530 Virginia Road  
P.O. Box 9133  
Concord, Massachusetts 01742-9133

Dated: July 19, 2007



Thomas I. Rozsa  
Registration No. 29,210

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