

ESTTA Tracking number: **ESTTA944252**

Filing date: **12/28/2018**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Zoom Telephonics, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	99 High Street Boston, MA 02110 UNITED STATES		

Correspondence information	Patrick A. Quinlan HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 Virginia Road Concord, MA 01742 UNITED STATES John.Dupre@hbsr.com, Patrick.Quinlan@hbsr.com, Christopher.Jensen@hbsr.com, trademarks@hbsr.com 978-341-0036
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**Applicant Information**

Application No	87808716	Publication date	12/04/2018
Opposition Filing Date	12/28/2018	Opposition Period Ends	01/03/2019
Applicant	D&S Direct LLC PO Box 370614 Montara, CA 94037 UNITED STATES		

**Goods/Services Affected by Opposition**

<p>Class 009. First Use: 2018/01/08 First Use In Commerce: 2018/01/08 All goods and services in the class are opposed, namely: Portable handheld digital electronic devices for recording, storage, transmission or reproduction of photographic, video and multimedia content; Mobile device wireless chargers and wireless charger pads; Mobile device and mobile phone camera lenses; camera lenses; spherical photo and video capture cameras; cameras for producing 360 degree views; panoramic cameras; central array boards in the nature of computer hardware for operating spherical photo and video capture cameras; selfie sticks, namely, hand-held monopods for cameras, handheld digital electronic devices, namely, cell phones; camera and mobile device fixing bands, namely, head bands, straps, shoulder bands, and chest bands for cameras, mobile phones, personal digital assistants, tablet computers, and laptop computers; mounting brackets specially adapted for cameras and mobile devices, namely, mobile phones, personal digital assistants, tablet computers, and laptop computers; wireless charging bases for cameras and mobile devices, namely, mobile phones, personal digital assistants, tablet computers, and laptop computers; mounting clamps specially adapted for cameras and mobile devices, namely, mobile phones, personal digital assistants, tablet computers, and laptop computers; floats specially adapted for cameras and mobile devices, namely, mobile phones, personal digital assistants, tablet computers, and laptop computers; floatable</p>
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hand grips specially adapted for cameras and mobile devices, namely, mobile phones, personal digital assistants, tablet computers, and laptop computers; storage bags specially adapted for cameras and mobile devices, namely, mobile phones, personal digital assistants, tablet computers, and laptop computers; protective lens covers for cameras and mobile devices, namely, mobile phones, personal digital assistants, tablet computers, and laptop computers; protective films adapted for camera screens and mobile devices, namely, mobile phones, personal digital assistants, tablet computers, and laptop computers; filters for photographic equipment; wall chargers in the nature of battery chargers that plug into a wall outlet; car-mounted battery chargers; audio and loudspeakers; smart audio speakers; touch screens for wireless smart watches; all the foregoing to exclude cases and housings for mobile devices, stands for consumer electronics, computers, cell phones, PDSs, electronic tablet computers and media players, cables for electronic devices, computer software, computer software and hardware for transmitting and receiving data, and computer software and hardware for voice over IP communications and telecommunications, communications hardware for enabling voice over IP communications, communications hardware for enabling voice communications over data networks, VoIP adapters that include one or more Ethernet ports and one or more telephone ports, broadband VoIP adapters that include a broadband modem, such as a DSL or cable modem, and one or more telephone ports

## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
No use of mark in commerce before application or amendment to allege use was filed	Trademark Act Sections 1(a) and (c)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Other	Trademark Act Section 43(a)


## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1892967	Application Date	06/08/1993
Registration Date	05/09/1995	Foreign Priority Date	NONE
Word Mark	ZOOM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1977/00/00 First Use In Commerce: 1977/00/00 telecommunications and personal computer peripheral products; namely, modems, faxmodems, voice/fax modems, dialers, communications processors, and, voice storage and playback apparatus		

U.S. Registration No.	2675838	Application Date	04/14/1999
Registration Date	01/21/2003	Foreign Priority Date	NONE
Word Mark	ZOOM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1995/08/00 First Use In Commerce: 1995/08/00 COMPUTER HARDWARE AND SOFTWARE FOR TRANSMITTING AND RECEIVING DATA OVER A WIRELESS NETWORK; VOLTAGE SURGE PROTECTORS, LIGHTNING PROTECTORS AND STATIC PROTECTORS FOR COMMUNICATIONS EQUIPMENT SOLD AS A COMPONENT OF COMMUNIC-		

	<p>ATIONS COMPUTER HARDWARE; COMPUTER HARDWARE AND SOFTWARE FOR CREATING NETWORKS OF ELECTRONIC DEVICES IN THE HOME, NAMELY, LOCAL AREA NETWORK DRIVERS, NETWORK INTERFACE CARDS, EXTERNAL INTERFACE DEVICE UNITS, PLUGS AND CONNECTORS, AND RELATED SOFTWARE FOR CREATING NETWORKS OF ELECTRONIC DEVICES; COMPUTER PERIPHERALS, [ NAMELY, VIDEO CAMERAS; COMPUTER PERIPHERALS, ] NAMELY, MODEMS, [ SPEAKERS, MICROPHONES, ] AND COMPUTER HARDWARE, AND COMPUTER OPERATING SOFTWARE FOR USE IN CONNECTION WITH SUCH PERIPHERALS; AND LOCAL AREA NETWORK PRODUCTS, namely, HARDWARE NETWORK INTERFACE CARDS, AND COMPUTER SOFTWARE FOR TRANSMITTING AND RECEIVING DATA OVER A WIRELESS NETWORK</p> <p>Class 042. First use: First Use: 1983/00/00 First Use In Commerce: 1983/00/00 TECHNICAL SUPPORT SERVICES, NAMELY PROVIDING TECHNICAL ADVICE AND CONSULTATION REGARDING INSTALLING, USE, MAINTENANCE AND TROUBLE SHOOTING OF COMPUTER COMMUNICATIONS SOFTWARE AND HARDWARE PROBLEMS, VIA TELEPHONE AND E-MAIL</p>
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U.S. Registration No.	2891467	Application Date	04/20/1999
Registration Date	10/05/2004	Foreign Priority Date	NONE
Word Mark	ZOOM		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1983/00/00 First Use In Commerce: 1983/00/00 Telecommunications and Computer Peripheral Products, namely, Wide Area Network communication receivers and transmitters, DSL modems, Cable modems [ , and satellite data transmitters and receivers ]</p> <p>Class 038. First use: First Use: 2004/05/12 First Use In Commerce: 2004/05/12 [ Provision of telecommunication connections to a global computer network ]</p>		

U.S. Registration No.	4362068	Application Date	01/17/2012
Registration Date	07/02/2013	Foreign Priority Date	NONE
Word Mark	ZOOMGUARD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2013/01/04 First Use In Commerce: 2013/01/04 Home automation systems comprising wireless and wired controllers, controlled		

	devices, and software for lighting, HVAC, security, safety and other home and monitoring and control applications via cellular telephones and the Internet
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Attachments	85518145#TMSN.png( bytes ) Notice of Opposition.pdf(149181 bytes )
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Signature	/Patrick A. Quinlan/
Name	Patrick A. Quinlan
Date	12/28/2018

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

Zoom Telephonics, Inc.,

Opposer,

v.

D&S Direct LLC,

Applicant.



Mark: iZOOM

Serial No.: 87/808,716

Filed: February 23, 2018

Published: December 4, 2018

Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

In the matter of an application for registration of the mark, iZOOM & Design, Serial No. 87/808,716 (the “Application”), filed February 23, 2018 by D&S Direct LLC, PO Box 370614, Montara, California 94037, and published for Opposition in the Official Gazette of December 4, 2018.

Zoom Telephonics, Inc., a Delaware corporation, having its principal place of business at 99 High Street, Boston, Massachusetts 02110, believes that it would be damaged by registration of the mark as sought in the foregoing application and hereby opposes the same.

The grounds for opposition are as follows:

1. By the Application herein opposed, Applicant seeks to register iZOOM & Design as a trademark for “Portable handheld digital electronic devices for recording, storage, transmission or reproduction of photographic, video and multimedia content; Mobile device wireless chargers and wireless charger pads; Mobile device and mobile phone camera lenses; camera lenses; spherical photo and video capture cameras; cameras for producing 360 degree

views; panoramic cameras; central array boards in the nature of computer hardware for operating spherical photo and video capture cameras; selfie sticks, namely, hand-held monopods for cameras, handheld digital electronic devices, namely, cell phones; camera and mobile device fixing bands, namely, head bands, straps, shoulder bands, and chest bands for cameras, mobile phones, personal digital assistants, tablet computers, and laptop computers; mounting brackets specially adapted for cameras and mobile devices, namely, mobile phones, personal digital assistants, tablet computers, and laptop computers; wireless charging bases for cameras and mobile devices, namely, mobile phones, personal digital assistants, tablet computers, and laptop computers; mounting clamps specially adapted for cameras and mobile devices, namely, mobile phones, personal digital assistants, tablet computers, and laptop computers; floats specially adapted for cameras and mobile devices, namely, mobile phones, personal digital assistants, tablet computers, and laptop computers; floatable hand grips specially adapted for cameras and mobile devices, namely, mobile phones, personal digital assistants, tablet computers, and laptop computers; storage bags specially adapted for cameras and mobile devices, namely, mobile phones, personal digital assistants, tablet computers, and laptop computers; protective lens covers for cameras and mobile devices, namely, mobile phones, personal digital assistants, tablet computers, and laptop computers; protective films adapted for camera screens and mobile devices, namely, mobile phones, personal digital assistants, tablet computers, and laptop computers; filters for photographic equipment; wall chargers in the nature of battery chargers that plug into a wall outlet; car-mounted battery chargers; audio and loudspeakers; smart audio speakers; touch screens for wireless smart watches; all the foregoing to exclude cases and housings for mobile devices, stands for consumer electronics, computers, cell phones, PDSs, electronic tablet computers and media players, cables for electronic devices, computer software,

computer software and hardware for transmitting and receiving data, and computer software and hardware for voice over IP communications and telecommunications, communications hardware for enabling voice over IP communications, communications hardware for enabling voice communications over data networks, VoIP adapters that include one or more Ethernet ports and one or more telephone ports, broadband VoIP adapters that include a broadband modem, such as a DSL or cable modem, and one or more telephone ports” (“Applicant’s Goods”). This Opposition opposes registration of such mark.

2. Opposer is the owner of all right, title, and interest in its ZOOM mark and family of ZOOM marks for use in connection with a wide variety of telecommunications products and services.

3. Opposer’s ZOOM mark was first adopted and has been used continuously by Opposer in connection with its telecommunications products and services since as early as 1977.

4. Opposer’s ZOOM mark and family of ZOOM marks are of significant value to Opposer as an identification of source in connection with the promotion and offering of its goods and services. Opposer’s ZOOM mark and family of ZOOM marks distinguish its goods and services from the goods and services of others, and the marks have acquired substantial secondary meaning in the minds of consumers.

5. Opposer has registered the ZOOM mark on the Principal Register as Reg. Nos. 1,892,967, 2,675,838, and 2,891,467, all of which are currently in force. In addition to the ZOOM mark, Opposer owns and uses a family of related marks in connection with its products and services. Among these marks is ZOOMGUARD, registered on the Principal Register as Reg. No. 4,362,068. The ZOOM mark is used in connection with telecommunications and personal computer peripheral products; namely, modems, faxmodems, voice/fax modems,

dialers, communications processors, and voice storage and playback apparatus. The ZOOM mark is also used in connection with computer hardware and software for transmitting and receiving data over a wireless network; voltage surge protectors, lightning protectors and static protectors for communications equipment sold as a component of communications computer hardware; computer hardware and software for creating networks of electronic devices in the home, namely, local area network drivers, network interface cards, external interface device units, plugs and connectors, and related software for creating networks of electronic devices; computer peripherals, namely, modems and computer hardware, and computer operating software for use in connection with such peripherals; and local area network products, namely, hardware network interface cards, and computer software for transmitting and receiving data over a wireless network. The ZOOM mark is also used in connection with telecommunications and computer peripheral products, namely wide area network communication receivers and transmitters, DSL modems, and cable modems.

6. Through the use and promotion of Opposer's ZOOM mark in connection with its goods and services for over forty years, purchasers and prospective purchasers of such goods and services, and of goods and services in the same general class, and customers and prospective customers of Opposer have come to associate the ZOOM mark with the goods, services, and business of Opposer.

COUNT I  
(Lack of Use In Commerce)  
15 U.S.C. § 1051(a)

7. Opposer repeats and realleges paragraphs 1 through 6 of this Notice of Opposition as if they were fully set forth.

8. Upon information and belief, at the time Applicant filed the Application, Applicant did not make bona fide use in commerce of the iZOOM & Design mark with each of Applicant's Goods.

9. Applicant's mark should not be registered because it was not filed based on Applicant's actual use as a trademark with each and every one of Applicant's Goods.

COUNT II  
(Likelihood of Confusion)  
15 U.S.C. § 1052(d)

10. Opposer repeats and realleges paragraphs 1 through 9 of this Notice of Opposition as if they were fully set forth.

11. Applicant's Goods are related to the goods and services that Opposer provides under the ZOOM mark and family of ZOOM marks.

12. The ZOOM mark and family of ZOOM marks as used by Opposer and the iZOOM & Design mark as sought to be registered by Applicant are confusingly similar.

13. Upon information and belief, Applicant is or will be marketing goods under the iZOOM & Design mark to customers or potential customers of Opposer, such that customers and others in the trade are likely to be confused into believing that there is some connection between Applicant's goods marketed under the iZOOM & Design mark and the well-known and well-recognized goods and services of Opposer.

14. Use of the iZOOM & Design mark by Applicant would so resemble Opposer's ZOOM mark and family of ZOOM marks as to be likely, when used on or in connection with Applicant's Goods, to cause confusion, or to cause mistake, or to deceive.

COUNT III  
(False Affiliation, Connection, Association, Sponsorship, or Approval)  
15 U.S.C. § 1125(a)

15. Opposer repeats and realleges paragraphs 1 through 14 of this Notice of Opposition as if they were fully set forth.

16. Purchasers and customers, as well as prospective purchasers and customers, familiar with Opposer's business identified by the ZOOM mark and family of ZOOM marks are likely to be misled into believing, contrary to fact, that Applicant's goods provided under the iZOOM & Design mark opposed herein, emanate from or are in some way affiliated with, connected to, associated with, sponsored by, or approved by Opposer, all to Opposer's irreparable damage.

COUNT IV  
(Dilution)  
15 U.S.C. § 1125(c)

17. Opposer repeats and realleges paragraphs 1 through 16 of this Notice of Opposition as if they were fully set forth.

18. Opposer's ZOOM mark is famous as it is widely recognized by the general consuming public of the United States as a designation of source of the goods of Opposer.

19. The iZOOM & Design mark as sought to be registered by Applicant would cause an association, arising from the similarity between Applicant's mark and Opposer's marks, that would impair the distinctiveness of Opposer's ZOOM mark and family of ZOOM marks.

20. Applicant's iZOOM & Design mark is likely to dilute the distinctive quality of Opposer's ZOOM mark and family of ZOOM marks.

21. Grant of registration of the iZOOM & Design mark as sought by Applicant, through the Application herein opposed, would place Applicant in a position to harass and cause

annoyance to Opposer and its customers, to the damage of Opposer. Such registration would inhibit Opposer in its use of its ZOOM mark and family of ZOOM marks in promoting its business, which would manifest damage upon Opposer. Finally, such registration would constitute *prima facie evidence* of an exclusive right of Applicant to use the iZOOM & Design mark for the goods identified in the Application herein opposed and for all confusingly similar uses, thereby enabling Applicant to occupy a position in the trade that would further compound confusion on the part of the purchasing public all to the damage of Opposer.

WHEREFORE, Opposer prays that application Serial No. 87/808,716, filed February 23, 2018, for registration of iZOOM & Design be refused and that this Opposition be sustained.

Respectfully submitted,

/Patrick A. Quinlan/  
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Dated: December 28, 2018