

From: Duong, Sui

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Subject: U.S. TRADEMARK APPLICATION NO. 78521891 - IPOD - N/A - SU - Request for Reconsideration
Denied - Return to TTAB

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 78521891

MARK: IPOD



CORRESPONDENT ADDRESS:

JASON CODY

APPLE INC

1 INFINITE LOOP MS:169-3IPL

CUPERTINO, CA 95014

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

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APPLICANT: APPLE INC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

trademarkdocket@apple.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 3/15/2015

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated herein. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). Refusal to register applicant's mark under Sections 1, 2, and 45 of the Trademark Act because

applicant's goods are not goods in trade, which was made final in the Office action dated August 19, 2014, is maintained and continues to be final. See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request does not raise a new issue or provide any new or compelling evidence with regard to the outstanding issues in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues.

As previously discussed in the final Office action of August 19, 2014, when considering the relevant factors regarding whether applicant's goods are "goods in trade," proper analysis requires registration of applicant's mark to be refused.

Applicant's goods are so inextricably tied to and associated with applicant's principal goods, i.e., its digital media devices, as to have no viable existence apart from them. Applicant asserts in its Request for Reconsideration that "the complexity of instructions in a manual as a determinant for specimen validity is completely irrelevant and arbitrary, and unsupported by the Trademark Rules," and that "the refusal based on lack of complexity is unfounded and should be withdrawn." These statements, however, obscure the factor for consideration: Applicant's goods, as shown in its specimen of record, are so inextricably tied to and associated with applicant's principal goods as to have no viable existence apart from them. For the reasons already discussed in the final Office action of August 19, 2014, analysis of this factor favors refusal under Sections 1, 2, and 45 of the Trademark Act.

Regarding whether applicant's goods are sold separately from its digital media devices, applicant's goods are not, in fact, sold separately from its digital media devices. While applicant discusses instances where owner's manuals and operations manuals unrelated to the instant application are sold individually, applicant in fact makes no assertion that its goods are sold separately from its digital media devices.

Lastly, as discussed in the final Office action of August 19, 2014, the substitute specimens of July 18, 2014 of third-party publications displaying applicant's mark are not used to provide source identifying information. These third-party publications are provided by Yamaha and Sony for use with select International Class 009 goods, themselves also provided by Yamaha and Sony. Display of applicant's applied-for mark references subject matter in the nature of compatibility. "IPOD" is not, however, displayed to designate the source of the printed materials.

Accordingly, applicant's Request for Reconsideration is denied.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) overcome the outstanding final refusal, and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

/Sui Q. Duong/

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