

ESTTA Tracking number: **ESTTA187621**

Filing date: **01/18/2008**

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	Apple Inc.
Granted to Date of previous extension	01/20/2008
Address	1 Infinite Loop Cupertino, CA 95014 UNITED STATES

Attorney information	Jennifer D. Arkowitz Townsend and Townsend and Crew LLP Two Embarcadero Center, 8th Floor San Francisco, CA 94111 UNITED STATES jda@townsend.com, mcm@townsend.com, d1h@townsend.com, v1t@townsend.com, litdocketing@townsend.com Phone:415-576-0200
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Applicant Information

Application No	77095264	Publication date	07/24/2007
Opposition Filing Date	01/18/2008	Opposition Period Ends	01/20/2008
Applicant	MEMBRAIN, LLC 450 N. ROXBURY DR., 8TH FL BEVERLY HILLS, CA 90210 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: Digital audio players
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Applicant Information

Application No	77095262	Publication date	07/24/2007
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Applicant	MEMBRAIN, LLC 450 N. ROXBURY DR., 8TH FL BEVERLY HILLS, CA 90210 UNITED STATES		

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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2835698	Application Date	10/18/2001
Registration Date	04/27/2004	Foreign Priority Date	08/31/2001
Word Mark	IPOD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2001/10/23 First Use In Commerce: 2001/10/23 portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing audio files; computer software for use in organizing, transmitting, manipulating, and reviewing audio files on portable and handheld digital electronic devices		

U.S. Registration No.	3089360	Application Date	10/18/2001
Registration Date	05/09/2006	Foreign Priority Date	08/31/2001
Word Mark	IPOD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2001/10/23 First Use In Commerce: 2001/10/23 Portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, and audio files; computer software for use in organizing, transmitting, manipulating, and reviewing text, data, and audio files on portable and handheld digital electronic devices		

U.S. Registration No.	3341191	Application Date	06/18/2005
Registration Date	11/20/2007	Foreign Priority Date	NONE
Word Mark	IPOD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2001/10/23 First Use In Commerce: 2001/10/23 full line of electronic and mechanical parts and fittings for portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, audio and video files; electronic docking stations; stands specially designed for holding portable and handheld digital electronic devices; battery chargers; battery packs; electrical connectors, wires, cables, and adaptors; wired and wireless remote controls for portable and handheld digital electronic devices; headphones and earphones; stereo amplifier and speaker base stations; automobile stereo adaptors; audio recorders; radio		

	receivers; radio transmitters; video viewers, namely video monitors for portable and handheld digital electronic devices; and computer software for portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, audio, image, and video files; computer application software for recording and organizing calendars and schedules, to-do lists, and contact information; computer game software; and, computer software for clock and alarm clock functionality; carrying cases, all for use with portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, audio, image, and video files
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U.S. Application No.	78459101	Application Date	07/29/2004
Registration Date	NONE	Foreign Priority Date	01/30/2004
Word Mark	POD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing audio files, and peripherals for use therewith; computer software for use in organizing, transmitting, manipulating, and reviewing audio files on portable and handheld digital electronic devices		

Related Proceedings	Opposition No. 91171199
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Attachments	78653661#TMSN.jpeg (1 page)(bytes) 78459101#TMSN.jpeg (1 page)(bytes) Consolidated Notice of Opposition to IDOP and DOP.txt.pdf (13 pages)(360369 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jennifer D. Arkowitz/
Name	Jennifer D. Arkowitz
Date	01/18/2008

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

In re Application No. 77/095,264
Filed: January 31, 2007
Published: July 24, 2007 in the Official Gazette
For: **IDOP**

In re Application No. 77/095,262
Filed: January 31, 2007
Published: July 24, 2007 in the Official Gazette
For: **DOP**

APPLE INC.,

Opposer,

vs.

MEMBRAIN, LLC

Applicant.

Opposition No. _____

**CONSOLIDATED NOTICE OF
OPPOSITION**

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

Dear Madam:

APPLE INC. ("Apple"), a California corporation, located and doing business at 1 Infinite Loop, Cupertino, California 95014, believes that it will be damaged by registration in International Class 9 of the mark **IDOP** shown in Application Serial No. 77/095,264 and the mark **DOP** shown in Application Serial No. 77/095,262, filed by MEMBRAIN, LLC ("Applicant"), a California limited liability company, with a mailing address at 450 N. Roxbury Dr., 8th floor, Beverly Hills, California 90210, and published in the Official Gazette of July 24, 2007, and hereby opposes registration thereof.

As grounds for opposition, Apple alleges:

1. Apple is the owner of Registration No. 2,835,698 for **IPOD** for "portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing audio files; computer software for use in organizing, transmitting, manipulating, and reviewing audio files on portable and handheld digital electronic devices" in International Class 9. Apple's application for said registration was filed on October 18, 2001, and matured to registration on April 27, 2004. Apple's registration has a Convention priority date of August 31, 2001. Apple has used the mark **IPOD** on and in connection with the sale of the aforementioned goods since at least as early as October 2001. A copy of Apple's Certificate of Registration for Registration No. 2,835,698 is attached hereto as Exhibit A.

2. Apple is the owner of U.S. Registration No. 3,089,360 for **IPOD** for "portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, and audio files; computer software for use in organizing, transmitting, manipulating, and reviewing text, data, and audio files on portable and handheld digital electronic devices" in International Class 9. Apple's application for said registration was filed on October 18, 2001, and matured to registration on May 9, 2006. Apple's registration has a Convention priority date of August 31, 2001 under § 44(d) of the Lanham Act, 15 U.S.C. § 1126(d). A copy of Apple's Certificate of Registration for Registration No. 3,089,360 is attached hereto as Exhibit B.

3. Apple is the owner of U.S. Registration No. 3,341,191 for **IPOD** for "a full line of electronic and mechanical parts and fittings for portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, audio and video files..." in International Class 9. Apple's application for said registration was filed on June 18,

2005, and matured to registration on November 20, 2007, with first use in commerce claimed as of October 23, 2001. A copy of Apple's Certificate of Registration for Registration No. 3,341,191 is attached hereto as Exhibit C.

4. Apple is the owner of U.S. Trademark Application No. 78/459,101 for **POD** for "portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing audio files, and peripherals for use therewith; computer software for use in organizing, transmitting, manipulating, and reviewing audio files on portable and handheld digital electronic devices" in International Class 9. Apple's application was filed on July 29, 2004 and has a Convention priority date of January 30, 2004 under § 44(d) of the Lanham Act, 15 U.S.C. § 1126(d).

5. Consumers have adopted and have used in the marketplace the term "POD" as an abbreviation for Apple's **IPOD** mark to refer to Apple's **IPOD** products.

6. The marks referred to hereinabove will be hereafter collectively referred to as "Apple's Marks."

7. As a result of Apple's extensive advertising, sales, and marketing, Apple's **IPOD** mark is famous and well known to purchasers.

8. By virtue of Apple's extensive use and promotion of Apple's Marks, Apple has established valuable goodwill in the marks, and the public has come to associate Apple's Marks with Apple. As such, the public has come to know Apple's Marks as an indication of goods/services that originate from Apple.

9. Applicant filed U.S. Trademark Application Serial No. 77/095,264 for the mark **IDOP** and U.S. Trademark Application Serial No. 77/095,262 for the mark **DOP** in connection with "digital audio players" in International Class 9 on January 31, 2007 (the "Applications"),

which are the subject of this opposition, based on an intent to use the marks. Applicant is using the **IDOP** and **DOP** marks (or variants) in connection with portable and handheld digital audio players.

10. Applicant's **IDOP** and **DOP** portable and handheld digital audio players are in part identical and otherwise highly related (as well as technologically inferior) to the goods/services identified in Apple's registrations and applications for Apple's Marks, and with which Apple has been using its **IPOD** mark for many years.

11. Apple began use of its **IPOD** mark in connection with its goods/services at least as early as October 2001, which is well prior to the Applicant's filing date for the Applications of January 31, 2007. The August 31, 2001 Convention priority date of Apple's registrations similarly pre-dates the Applications' January 31, 2007 filing date.

12. Applicant's **IDOP** mark, which contains Apple's **IPOD** and **POD** marks entirely, and Applicant's **DOP** mark, which contains a substantial portion of Apple's **IPOD** mark and its **POD** mark entirely, are extremely similar to Apple's Marks. Indeed, Applicant's **IDOP** and **DOP** marks merely flip the letters "d" and "p" in Apple's **IPOD** and **POD** marks, which are themselves highly similar letters.

13. As a result of the similarity between Apple's Marks and Applicant's **IDOP** and **DOP** marks, and the identical and highly related nature of the parties' goods/services, Applicant's Marks are likely to cause confusion, mistake or deception in the trade and among purchasers as to the source, origin or sponsorship of the parties' respective goods/services.

14. Moreover, on information and belief, Applicant has been adopting a family of **POD**-formative marks that are extremely similar to Apple's **IPOD** and **POD** marks for goods/services that are related to those of Apple, including **PODIBLE** (U.S. Serial No.

78/590,316) for "promoting the services of others through the distribution of audio and visual contents..." in Class 35, which is subject to pending Opposition Proceeding Number 91,171,199 instituted by Apple. Apple intends to file a Motion to Consolidate this opposition with the pending Opposition Proceeding Number 91,171,199.

15. Registration of the marks in the Applications and use of Applicant's Marks are likely to dilute Apple's famous **IPOD** mark.

16. Registration of Applicant's Marks shown in the opposed Applications will result in damage to Apple under the provisions of § 2(d) of the Lanham Act, 15 U.S.C. § 1052(d) and § 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), pursuant to the allegations stated above.

17. If the Applications are permitted to register, the registrations would presumptively entitle Applicant to *prima facie* exclusive ownership and rights to the **IDOP** and **DOP** marks. Such registrations would cause confusion among consumers as to the separate and distinct sources of Applicant's goods and Apple's goods/services and the relationship of Apple to Applicant, thereby damaging Apple's goodwill in Apple's Marks, diluting the value thereof, and resulting in irreparable harm to Apple's business and reputation, all to the detriment of Apple who has expended considerable sums and effort in promoting Apple's Marks.

WHEREFORE, Apple prays that this Opposition be sustained and that registration of U.S. Trademark Application Serial Nos. 77/095,264 and 77/095,262 be denied.

Please charge any necessary fee regarding this Opposition to the Deposit Account of Townsend and Townsend and Crew, LLP, 20-1430, and credit any overpayment to such deposit account.

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Please direct all notices, pleadings and process regarding this matter to:

Margaret C. McHugh, Esq.
Jennifer D. Arkowitz, Esq.
TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111-3834
Telephone: (415) 576-0200
Facsimile: (415) 576-0300
Email: jdarkowitz@townsend.com

Respectfully submitted,

TOWNSEND *and* TOWNSEND *and* CREW LLP

Dated: January 18, 2008

By Jennifer D. Arkowitz
Margaret C. McHugh
Jennifer D. Arkowitz
Attorneys for Opposer

Two Embarcadero Center, 8th Floor
San Francisco, CA 94111-3834
Telephone: (415) 576-0200
Facsimile: (415) 576-0300
Email: jdarkowitz@townsend.com

CERTIFICATE OF SERVICE

I, *Dena Hong-Yee*, declare:

1. I am employed in the City and County of San Francisco, California in the office of a member of the bar of this court at whose direction this service was made. I am over the age of eighteen and not a party to this action. My business address is Townsend and Townsend and Crew LLP, Two Embarcadero Center, Eighth Floor, San Francisco, California, 94111.

2. On January 18, 2008, I served the following documents exactly entitled:

CONSOLIDATED NOTICE OF OPPOSITION

on the interested party(ies) in this action by placing a true and correct copy thereof, on the above date, enclosed in a sealed envelope, following the ordinary business practice of Townsend and Townsend and Crew LLP, as follows:

U.S. Mail: I am personally and readily familiar with the business practice of Townsend and Townsend and Crew LLP for collection and processing of correspondence for mailing with the United States Postal Service, pursuant to which mail placed for collection at designated stations in the ordinary course of business is deposited the same day, proper postage prepaid, with the United States Postal Service. I caused such document[s] to be sent via U.S. Mail according to the practices above.

Allen B. Grodsky
Grodsky & Olecki LLP
2001 Wilshire Boulevard
Suite 210
Santa Monica, CA 90403

I declare under penalty of perjury under the laws of the state of California that the foregoing is true and correct, and that this declaration was executed on January 18, 2008, at San Francisco, California.



Dena Hong-Yee

61257348 v1

EXHIBIT A

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

United States Patent and Trademark Office

Reg. No. 2,835,698

Registered Apr. 27, 2004

**TRADEMARK
PRINCIPAL REGISTER**

IPOD

APPLE COMPUTER, INC. (CALIFORNIA CORPORATION)
1 INFINITE LOOP
CUPERTINO, CA 95014

FILES ON PORTABLE AND HANDHELD DIGITAL ELECTRONIC DEVICES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FOR: PORTABLE AND HANDHELD DIGITAL ELECTRONIC DEVICES FOR RECORDING, ORGANIZING, TRANSMITTING, MANIPULATING, AND REVIEWING AUDIO FILES; COMPUTER SOFTWARE FOR USE IN ORGANIZING, TRANSMITTING, MANIPULATING, AND REVIEWING AUDIO

FIRST USE 10-23-2001; IN COMMERCE 10-23-2001.

SER. NO. 75-982,871, FILED 10-18-2001.

DEZMONA MIZELLE, EXAMINING ATTORNEY

EXHIBIT B

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

United States Patent and Trademark Office

Reg. No. 3,089,360

Registered May 9, 2006

**TRADEMARK
PRINCIPAL REGISTER**

IPOD

APPLE COMPUTER, INC. (CALIFORNIA CORPORATION)
1 INFINITE LOOP
CUPERTINO, CA 95014

FOR: PORTABLE AND HANDHELD DIGITAL ELECTRONIC DEVICES FOR RECORDING, ORGANIZING, TRANSMITTING, MANIPULATING, AND REVIEWING TEXT, DATA, AND AUDIO FILES; COMPUTER SOFTWARE FOR USE IN ORGANIZING, TRANSMITTING, MANIPULATING, AND REVIEWING TEXT, DATA, AND AUDIO FILES ON PORTABLE AND HANDHELD DIGITAL ELECTRO-

NIC DEVICES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 10-23-2001; IN COMMERCE 10-23-2001.

PRIORITY CLAIMED UNDER SEC. 44(D) ON SWITZERLAND APPLICATION NO. 086122001, FILED 8-31-2001.

SER. NO. 78-089,144, FILED 10-18-2001.

DEZMONA MIZELLE, EXAMINING ATTORNEY

EXHIBIT C

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

Reg. No. 3,341,191

United States Patent and Trademark Office

Registered Nov. 20, 2007

**TRADEMARK
PRINCIPAL REGISTER**

IPOD

APPLE INC. (CALIFORNIA CORPORATION)
1 INFINITE LOOP
CUPERTINO, CA 95014

FOR: FULL LINE OF ELECTRONIC AND MECHANICAL PARTS AND FITTINGS FOR PORTABLE AND HANDHELD DIGITAL ELECTRONIC DEVICES FOR RECORDING, ORGANIZING, TRANSMITTING, MANIPULATING, AND REVIEWING TEXT, DATA, AUDIO AND VIDEO FILES; ELECTRONIC DOCKING STATIONS; STANDS SPECIALLY DESIGNED FOR HOLDING PORTABLE AND HANDHELD DIGITAL ELECTRONIC DEVICES; BATTERY CHARGERS; BATTERY PACKS; ELECTRICAL CONNECTORS, WIRES, CABLES, AND ADAPTORS; WIRED AND WIRELESS REMOTE CONTROLS FOR PORTABLE AND HANDHELD DIGITAL ELECTRONIC DEVICES; HEADPHONES AND EARPHONES; STEREO AMPLIFIER AND SPEAKER BASE STATIONS; AUTOMOBILE STEREO ADAPTERS; AUDIO RECORDERS; RADIO RECEIVERS; RADIO TRANSMITTERS; VIDEO VIEWERS, NAMELY VIDEO MONITORS FOR PORTABLE AND HANDHELD DIGITAL ELECTRONIC DEVICES; AND COMPUTER SOFTWARE FOR PORTABLE AND HANDHELD DIGITAL ELECTRONIC DEVICES FOR RECORDING, ORGANIZING, TRANSMITTING,

MANIPULATING, AND REVIEWING TEXT, DATA, AUDIO, IMAGE, AND VIDEO FILES; COMPUTER APPLICATION SOFTWARE FOR RECORDING AND ORGANIZING CALENDARS AND SCHEDULES, TO-DO LISTS, AND CONTACT INFORMATION; COMPUTER GAME SOFTWARE; AND, COMPUTER SOFTWARE FOR CLOCK AND ALARM CLOCK FUNCTIONALITY; CARRYING CASES, ALL FOR USE WITH PORTABLE AND HANDHELD DIGITAL ELECTRONIC DEVICES FOR RECORDING, ORGANIZING, TRANSMITTING, MANIPULATING, AND REVIEWING TEXT, DATA, AUDIO, IMAGE, AND VIDEO FILES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 10-23-2001; IN COMMERCE 10-23-2001.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 2,781,793 AND 2,835,698.

SN 78-653,661, FILED 6-18-2005.

CAROLINE WOOD, EXAMINING ATTORNEY