

ESTTA Tracking number: **ESTTA549590**

Filing date: **07/21/2013**

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

Proceeding	91211077
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Date	07/21/2013
Attachments	Reponse to opposition 91211077.pdf(66750 bytes)

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

In the matter of application Serial No. 85/806,667
For the Trademark ICOMMANDROID
Published in the Official Gazette on May 14, 2013
Opposition No. 91211077

GOOGLE INC.,)
)
 Opposer,)
)
 v.)
)
 FARNSWORTH, BOULTER, BURKE & STAMPER, LLC,)
)
)
 Applicant.)
 _____)

Farnsworth, Boulter, Burke & Stamper, LLC, a company with a listed address of P.O. Box 66, La Salle, Colorado 80645 (“Applicant”), hereby responds to the Notice of Opposition filed by Opposer Google Inc. (“Google”), a Delaware corporation having its principal place of business at 1600 Amphitheatre Parkway, Mountain View, California, 94043, on June 12, 2013.

Applicant rejects opposer’s statements and affirms its intention to pursue the trademark “iCommandroid”.

In response telepresence the opposer’s assertions, applicant responds:

1. Founded in 1998 with the introduction of breakthrough technology to search and organize the vast quantities of information available on the internet, Google operates one of the world’s most popular search engines. Since its inception, Google has grown rapidly to become a

leading technology company which now offers a wide variety of products and services. Among its innovative products, Google offers a software platform under the mark ANDROID (the “ANDROID Mark”). The Android platform is open source software and may be installed on a diverse range of devices from many different manufacturers, including mobile devices. Third-party developers have created applications for the Android platform for a variety of computing environments, including mobile environments.

Applicant does not have any problem with the above statement, although questions its relevance to the current opposition.

2. Development of the Android platform began several years before Google acquired the original developer, Android, Inc., in 2005. Google continued to develop the software, ultimately announcing the Android platform in 2007. Since launching the Android platform, Google has introduced successive updates to the software, continually improving its performance and adding new features. The Android platform has enjoyed resounding success in the marketplace and has quickly increased its share of the mobile device market. In February 2010, there were approximately 60,000 daily activations of Android devices. Today, that number has grown exponentially to more than 1.5 million daily Android activations. As of today there are more than 900 million Android devices in use around the world. According to comScore, as of February 2013, the Android platform is installed on 53.7% of all active smartphones in the United States, more than any other mobile operating system. (Exhibit A.)

Applicant does not have any problem with the above statement, although again questions its relevance to the current opposition.

3. As the popularity of the Android platform has grown among device manufacturers, the number of applications available for Android has increased dramatically. As of February 2011, more than 150,000 applications were available on the Android platform. That number continues to grow exponentially; by May 28, 2013, more than 975,000 applications were available through

Google for Android devices. These applications offer users a vast array of functionality and enhance the utility and value to users of their mobile devices.

Applicant does not have any problem with the above statement, although again questions its relevance to the current opposition. A recitation of what a successful company Google is has no bearing on this opposition.

4. Google is the owner of U.S. trademark application No. 77/318,565, filed October 31, 2007, for the ANDROID Mark. The application covers “mobile phones; operating system software, software for use in developing, executing and running other software on mobile devices, computers, computer networks, and global communication networks; computer software development tools; computer software for use in transmitting and receiving data over computer networks and global communication networks; computer software for managing communications and data exchange among and between mobile devices and desktop computers; computer middleware, namely, software that mediates between the operating systems and a mobile device and the application software of a mobile device; computer application software for mobile phones” (the “ANDROID Application”) (emphasis added). Google also has common law rights in the ANDROID Mark based on its use of the mark in commerce.

Applicant does not dispute the facts stated above. Applicant points out that

- (a) the ANDROD mark is still in the application stage after seven years;
- (b) the ANDROID mark has not been granted because of litigation over possible confusion created by the mark;
- (c) the ANDROID mark appears to be in conflict with a previously registered mark, “ANDROID DATA” registered on July 30, 2002 as number 2639556;
- (d) the list provided by Opposer includes standard items from class 038, including computer software and other items. It does not mention telepresence services, which is the category of goods and services for which applicant seeks the mark “iCommandroid”;

- (e) the word “android” is a common word that can be found in any modern dictionary;
- (f) the word “android” appears in U.S. patents as early as 1863 in reference to miniature human-like toy automatons, and thus is at least 150 years old, and
- (g) by the 1970s, the term “android” had become so common that the Star Wars films abbreviated the term to “droid”.

In short, the word “android” is a common word that Google chose to adopt for its products and services. Doing so does not give Google, no matter how big it is, the right to remove the word from the lexicon and claim exclusive rights to it. If it wished to have exclusive rights, it had the option to invent a trademark, as indeed it did with “Google”. Ironically, by doing so, Google may have added a word to the lexicon. It is fighting this in at least one country. Apparently Google does not mind taking words out of the dictionary, it just has a problem with donating words to the dictionary.

Applicant points out that the mark for which he applied is “iCommandroid”. This mark includes the common dictionary word “android”. It also includes “I” and “Command”. The intent was to convey the meaning “I Command [the] android”. As applied in the telepresence category, it means that a person is controlling an android (in the dictionary sense of a human-like robotic device) remotely. Opposer claims that this may cause confusion with its as-yet unregistered mark.

Applicant defers to the opinion of the examiner at the U.S. Patent and Trademark Office. The Examiner did not see that there would be confusion. Applicant expects that the Examiner’s first

duty is to protect the consumer, and would therefore be more likely to err on the side of caution if he or she thought that there was a possibility of confusion. Had the Examiner ruled otherwise, Applicant would not have continued to pursue this mark. The question is not whether Google feels that there is confusion between the mark for which it has applied for and the mark for which Applicant has applied. The issue is whether the consumer would think there is confusion. The Examiner, representing the consumer, has given a clear answer to this question.

5. Google has expended enormous effort and devoted substantial resources, both in the United States and internationally, promoting the ANDROID Mark and its software platform offered in connection with the ANDROID Mark. The ANDROID Mark embodies the substantial and valuable reputation and goodwill that Google has earned in the marketplace for its high quality software and related services.

Applicant is not disputing Google's claim to the ANDROID mark. Applicant is disputing that its mark contains Google's mark, when in fact it contains a merging of words found in the dictionary.

6. In addition to Google's own advertising efforts, the Android software has been the subject of thousands of unsolicited stories in the media, highlighting Google's innovative and successful open source software platform.

Applicant does not dispute the above statement but considers it not relevant.

7. As a result of Google's widespread use of the ANDROID Mark worldwide, extensive advertising and promotion and continuous and unsolicited media coverage, as well as the high degree of consumer recognition of the ANDROID Mark, and the strong and loyal base of Android users, among other factors, the ANDROID Mark is famous within the meaning of Section 43(c) of the United States Trademark Act, 15 U.S.C. §1125(c).

Applicant does not dispute the above statement but considers it not relevant.

APPLICANT AND ITS PENDING APPLICATION

8. Applicant seeks to register the word mark ICOMMANDROID in connection with “telepresence services” in International Class 38. Applicant filed its application claiming intent to use the ICOMMANDROID Mark in commerce.

Applicant wishes to point out that it seeks to register “iCommandroid”, and to do so in “telepresence services”, a sub-class not mentioned in Google’s on-going application.

9. Upon information and belief, Applicant selected the ICOMMANDROID Mark with knowledge of the ANDROID Mark.

Applicant is aware that Google uses the ANDROID mark and has some common law rights in that mark. Applicant is also aware that Google has been trying for seven years without success to obtain Federal registration for that mark.

10. On information and belief, Applicant selected the ANDROID portion of the ICOMMANDROID Mark with intent to call to mind Google’s ANDROID Mark and trade off the goodwill that Google has developed. Google is not the source of Applicant’s intended goods or services, nor has Google endorsed or sponsored Applicant or its services.

Applicant denies that the ANDROID portion of the mark is intended to call to mind Google’s ANDROID mark. Applicant has no intent or desire to call to mind Google or its mark. Applicant agrees that Google is not the source of Applicant’s intended goods or services. Therefore Applicant has no incentive to suggest a connection with Google. Applicant agrees that Google has not endorsed or sponsored Applicant or its services, nor does applicant seek or desire any such endorsement.

11. Google has priority over Applicant based on Google’s use of the ANDROID Mark in commerce and based on the filing dates of its trademark application, well prior to the December 19, 2012 filing date of the application for the ICOMMANDROID Mark.

Google has priority over applicants filing in the categories it listed in its ongoing application only for the ANDROID mark. That does not extend to other classes and categories, nor to marks other than ANDROID. Google itself is asserting rights to a mark for which another party already has federally registered rights.

FIRST GROUND FOR OPPOSITION

LIKELIHOOD OF CONFUSION

12. Google incorporates by reference paragraphs 1 through 11, inclusive, as if fully set forth here.

Applicant incorporates by reference responses to paragraphs 1 through 11 of the opposition as if fully set forth here.

13. The ICOMMANDROID Mark is substantially similar to the ANDROID Mark, and incorporates Google's ANDROID Mark in its entirety.

The iCommandroid mark is not "substantially" similar and incorporates the word "android" along with "I" and "command". Use of the word "android" is not the exclusive prerogative of Google.

14. The high degree of similarity between Google's ANDROID Mark and Applicant's ICOMMANDROID Mark and the use and planned use of the respective marks is likely to cause confusion, mistake, or deception as to the source, origin, sponsorship or approval of Applicant's services, and is likely to suggest an affiliation, connection or association between Google and Applicant and their respective goods and services.

Applicant denies the allegation that there is a high degree of similarity. The iCommandroid mark is not yet in use in commerce, therefore Google cannot allege that the use of the mark is likely to cause confusion. Applicant has not yet filed a Statement of Use in Commerce for the mark, and therefore not even Google can know what applicant plans to do with the mark, unless Google has been reading applicant's email. Applicant does not agree that the mark is likely to cause confusion and does not wish or intend to be associated in any way.

15. Applicant's Services, described in the Application as "telepresence services" are competitive with and related to the mobile phones and operating system software for mobile devices with which Google uses the ANDROID Mark.

Google has exerted serious pressure on a small company in order to try to persuade Applicant to divulge its plans. Applicant has declined to disclose its plans for obvious reasons. Google has no idea what telepresence services will be offered by Applicant, so its allegations in paragraph 15 are no more than speculation. Without divulging its plans in this document, again for obvious reasons, Applicant states that it is not in the business of mobile phones or operating systems.

16. Registration of Applicant's Mark will injure Google by causing the public to be confused or misled into believing that the services provided by Applicant are endorsed or sponsored by Google. Google has no control over the nature and quality of the goods and services offered or to be offered by Applicant under the ICOMMANDROID Mark, and Google's reputation and goodwill will be damaged and the value of the ANDROID Mark jeopardized, all to Google's detriment. Any defect, objection or fault found with Applicant's goods or services marketed under the ICOMMANDROID name would necessarily reflect upon and injure the reputation that Google has established in connection with the ANDROID Mark.

Again, Applicant defers to the decision of the USPTO Examiner who decided to publish the mark for opposition after finding no basis for confusion. Applicant neither intends nor desires that its products and

services be connected with Google. Applicant is of the opinion that any such connection with Google would damage the reputation of the Applicant.

17. Registration of the mark herein opposed will damage Google because Applicant's mark is likely, when used on or in connection with the goods and services described in the opposed application, to cause confusion, or to cause mistake or to deceive. Thus, Applicant's ICOMMANDROID Mark is unregistrable under 15 U.S.C. §§1052 and 1125, and should be refused registration.

Again, Applicant defers to the opinion of the Examiner, and this opinion directly contradicts paragraph 17 of the opposition.

SECOND GROUND FOR OPPOSITION

DILUTION OF A FAMOUS MARK

18. Google incorporates by reference paragraphs 1 through 11, inclusive, as if fully set forth here.

Applicant incorporates by reference responses to paragraphs 1 through 11 of the opposition as if fully set forth here.

19. The ANDROID Mark is highly distinctive of Google's products.

Applicant does not deny this. However, there is a possibility that Google's seven year battle to register its mark may end in failure because of a previously registered mark.

20. Google has broadly promoted the ANDROID Mark, and Google's products and services offered under the ANDROID Mark have enjoyed extensive media attention.

Applicant feels that it is not appropriate to comment on Google's decision to heavily promote a mark which it may be unable to register.

21. As a result of the considerable publicity afforded the ANDROID Mark, and the strong and loyal base of users that Google enjoys for the ANDROID platform, the ANDROID Mark has a high degree of consumer recognition.

Applicant does not deny that the Android mark has a high degree of recognition. That does not give Google the right to claim anything beyond that recognition and suppress all marks that contain similar combinations of letters.

22. Google enjoys substantially exclusive use of the ANDROID Mark.

Applicant is not opposing Google's use of the mark. The reality is that Google has exerted pressure on the Applicant, and has the resources to make very difficult the continued pursuit of a mark which it does not like. It would be unwise of any small business or individual to register a mark which challenges the use of the ANDROID mark. Applicant is not objecting to or challenging the use of the ANDROID mark, exclusive or otherwise, by Google.

23. The ANDROID Mark is famous.

Applicant does not deny this. Therefore the possibility that the Examiner was unaware of the ANDROID mark is close to zero. With knowledge of Google's use of the ANDROID mark, the Examiner still did not see the possibility of confusion. Applicant respects the decision of the Examiner.

24. The ANDROID Mark became famous before Applicant filed his application for the ICOMMANDROID Mark.

Applicant does not deny this.

25. The ICOMMANDROID Mark is substantially similar to, subsumes the entirety of, and is likely to cause dilution of the famous ANDROID Mark, all to Google's detriment.

Applicant denies this assertion and again defers to the opinion of the Examiner who disagrees with Google's position.

26. Registration of the mark herein opposed is likely to dilute Google's famous ANDROID Mark by creating an association between the ANDROID Mark and the ICOMMANDROID Mark that impairs the distinctiveness of the ANDROID Mark. Thus, Applicant's ICOMMANDROID Mark is unregistrable under 15 U.S.C. §§1052 and 1125.

At the risk of being repetitive, Applicant points out that the Examiner does not agree with this, otherwise the iCommandroid mark would never have reached the stage of being published for opposition.

27. Wherefore, Google prays that this Opposition be sustained, and that Application Serial No. 85/806,667 be refused.

To not grant Applicant's trademark application because of this Opposition would amount to a failure to protect small businesses against predatory giant corporations who believe that their financial resources allow them to bend the law to their will.

Applicant therefore prays that the Opposition be dismissed, the opinion of the Examiner respected, and the Application Serial No. 85.806, 667 be granted.

Respectfully submitted

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Date: July 21, 2013