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

Proceeding	91163437
Party	Defendant Apple Computer, Inc. Apple Computer, Inc. 1 Infinite Loop Cupertino, CA 95014
Correspondence Address	JOHN DONALD APPLE COMPUTER, INC. MS 3-TM 1 INFINITE LOOP CUPERTINO, CA 95014
Submission	Answer and Counterclaim
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Date	01/24/2005
Attachments	Tiger_Answer.pdf (6 pages)

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

In re the Matter of Application Serial No. 78/269,988
For: TIGER
Date of Publication: 08/17/2004

TIGER DIRECT, INC.

Opposer,

vs.

APPLE COMPUTER, INC.

Applicant.

Opposition No. 91163437

**ANSWER TO NOTICE OF OPPOSITION
AND COUNTERCLAIMS FOR CANCELLATION**

Applicant, Apple Computer Inc. (“Apple Computer” or “Applicant”), by and through its attorneys, hereby answers the Notice of Opposition of Tiger Direct, Inc. (“Opposer”), the paragraph numbers hereof corresponding to those of the Notice of Opposition.

Introductory paragraph. Apple Computer denies Opposer’s allegation that it will be damaged by the registration of U.S. Trademark Application Serial No. 78/269,988.

1. Apple Computer is without knowledge or information sufficient to form a belief as to the truth of the allegations of this paragraph and, therefore, denies the same.

2. Apple Computer is without knowledge or information sufficient to form a belief as to the truth of the allegations of this paragraph and, therefore, denies the same.

3. Apple Computer is without knowledge or information sufficient to form a belief as to the truth of the allegations of this paragraph and, therefore, denies the same.

4. Apple Computer is without knowledge or information sufficient to form a belief as to the truth of the allegations of this paragraph and, therefore, denies the same.

5. Apple Computer is without knowledge or information sufficient to form a belief as to the truth of the allegations of this paragraph and, therefore, denies the same.

6. Apple Computer denies the allegations in this paragraph.

7. Apple Computer admits the allegations in this paragraph.

8. Apple Computer denies the allegations in this paragraph.

9. Apple Computer denies the allegations in this paragraph.

10. Apple Computer repeats its responses to the allegations of Paragraphs 1-9 of the Notice of Opposition.

11. Apple Computer denies the allegations of this paragraph.

12. Apple Computer denies the allegations of this paragraph.

13. Apple Computer denies the allegations of this paragraph.

14. Apple Computer repeats its responses to the allegations of Paragraphs 1-9 and 11-13 of the Notice of Opposition.

15. Apple Computer denies the allegations of this paragraph.

16. Apple Computer denies the allegations of this paragraph.

AFFIRMATIVE DEFENSES

1. Apple's TIGER trademark, when used on the goods recited in the instant application, namely, "computer operating system software," is not likely to cause confusion with Opposer's alleged marks.

2. Apple's TIGER trademark does not tend to cause mistake, to deceive, or to suggest falsely a connection with Opposer or any of Opposer's activities or goods.

3. The developers, consumers and retailers who purchase or use the parties' respective goods are not likely to believe there is any relationship between these easily distinguished products; e.g., the relevant products are not impulse purchases.

4. The goods Apple sells or will sell under the TIGER trademark, namely, "computer operating system software," are only for use by consumers who are likely to put significant thought and effort into the associated buying decisions. These consumers are readily able to distinguish the source of goods sold by Apple under the subject mark and those allegedly offered by Opposer.

5. Opposer is asserting and seeking to obtain broad exclusive rights in the use and registration of the designation or root word TIGER, alone and/or in combination with other terms or names. Opposer is not entitled to such broad exclusive rights, particularly in the computer field, in which the root term TIGER and combinations of that term with other words are and have long been commonly used by others.

6. Numerous trademarks containing the designation or word TIGER have been registered and used by third parties on or in connection with goods in International Class 9 and in related classes, with the knowledge and acquiescence of Opposer. Because of such uses and registrations, the alleged marks asserted by Opposer in the Notice of Opposition are entitled to only a limited scope of protection that does not extend to Apple's goods. Therefore, Opposer cannot be injured or damaged by registration of the mark herein opposed.

7. Opposer owns no rights in the designation or word TIGER that are enforceable against the mark TIGER used on the goods recited in the instant application.

8. Apple's use of the TIGER term is a continuation and extension of its use of "large cats" marks; e.g., PANTHER, for its computer operating system software. Apple currently plans

to market its TIGER computer operating system accordingly. As a result, consumers can and will be able to readily associate the TIGER operating system with Apple, not Opposer.

9. Opposer does not use the “TIGER” term alone on its products or services; rather, the product names include other words; e.g., “TIGERDIRECT,” and “TIGERTV.COM.” These uses evidence Opposer’s recognition that it cannot distinguish its products or services from those of third parties with the use of the “TIGER” name alone.

10. Opposer has not used or has abandoned use of one or more of the cited trademarks identified in paragraph 2 of its Notice of Opposition; as a result, Opposer is not entitled to rely on those abandoned trademarks in opposition to Applicant’s TIGER mark.

COUNTERCLAIM FOR CANCELLATION OF REGISTRATIONS

Counterclaim Petitioner Apple Computer, Inc. is a corporation organized and existing under the laws of the State of California with a place of business at 1 Infinite Loop, Cupertino, California 95014. Apple Computer believes that U.S. Trademark Registration Nos. 1,641,257 and 2,526,739 are causing it damage, and hereby petitions to cancel the same, upon knowledge with respect to itself and its own acts and upon information and belief as to all other matters.

As grounds for this Petition, Apple alleges the following:

1. Opposer and Counterclaim Respondent TigerDirect, Inc. (“TigerDirect”), is a New York corporation located at 7795 West Flagler St., Suite 35, Miami, FL 33144. TigerDirect is the owner of record of Registration Nos. 1,641,257 and 2,526,739.

2. TigerDirect has not used, is not using, and/or has abandoned the alleged TIGERSOFTWARE mark that is the subject of the challenged Registration No. 1,641,257, and

has no intent to resume use of the alleged TIGERSOFTWARE mark. Moreover, the challenged mark has lost all capacity as a source indicator for registrant's goods or services.

3. TigerDirect also has not used, is not using, and/or has abandoned the alleged TIGER mark that is the subject of the challenged Registration No. 2,526,739, and has no intent to resume use of the alleged TIGER mark. Moreover, the challenged mark has lost all capacity as a source indicator for registrant's goods or services.

4. Apple Computer is likely to be damaged by continuance of the two aforesaid registrations and Apple Computer's use of the TIGER mark opposed by TigerDirect will be impaired by the continued registration of said abandoned marks owned by TigerDirect.

5. Please charge the filing fee of \$600.00 and any other fees associated with these counterclaims to Deposit Account 11-0600.

WHEREFORE, Apple Computer respectfully requests that (a) the Opposition be dismissed and denied, and that U.S. Trademark Application Serial No. 78/269,988 be issued to registration; and (b) Registration Nos. 1,641,257 and 2,526,739 for the alleged TIGERSOFTWARE and TIGER marks be cancelled and that the aforesaid counterclaims for cancellation be sustained in favor of Apple.

Date: January 24, 2005

/Allen J. Baden/
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Attorneys for Applicant
Apple Computer, Inc.

Certificate of Mailing

Date of Deposit: January 24, 2005

I hereby certify that an original and one copy of the foregoing ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM FOR CANCELLATION was filed electronically, addressed to the Commissioner for Trademarks, via the link at <http://esta.uspto.gov>.

/Allen J. Baden/

Certificate of Service

I hereby certify that on this date, a copy of the foregoing ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM FOR CANCELLATION was served by first-class mail, postage prepaid, and by electronic copy sent via email to counsel of record for Opposer:

Laura E. Goldbard, Esq.
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Dated: January 24, 2005

/Allen J. Baden/