UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

DUNN
Mailed: May 10, 2007

Opposition No. 91173003

Apple Computer, Inc.

v.

Podfitness, Inc.

Elizabeth A. Dunn, Attorney:

This case comes before the Board on opposer's motion, filed December 2, 2006, to suspend proceedings pending the disposition of civil litigation between the parties. Applicant opposes the motion.

Specifically, opposer moves to suspend pending the disposition of *Apple Computer, Inc. v. Podfitness, Inc. and DOES 1-100*, C:06-65805 SBA, now pending in the United States District Court for the Northern District of California, San Francisco Div. According to the pleadings attached to opposer's motion, Apple Computer alleges, *inter alia*:

On information and belief, consumers and industry publications have adopted and have used in the marketplace

the term "POD" as slang for the mark IPOD, to refer to Apple's IPOD player. (Complaint ¶11).

Defendant's unauthorized use of the term "POD" as a key component of its Infringing Marks falsely indicates to consumers that Defendant's goods and/or services are in some manner connected with, sponsored by, affiliated with, or related to Apple, and/or the products and services of Apple. (Complaint ¶76).

Among the remedies listed, opposer seeks an order from the district court precluding the U. S. Patent and Trademark Office from issuing as registrations the four applications (for PODWORKOUT, PODPOCKET, PODFITNESS, and PODFITNESS.COM) subject to this combined opposition.

In opposition to suspension, applicant alleges that opposer has opposed more than 100 marks employing the term POD, that having opposer's rights to the term POD decided in two fora risks inconsistent action, and that applicant intends to seek a stay of the district court decision pending the Board's disposition of this opposition.[1]

It is the policy of the Board to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case. *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22

[1] Applicant also contends that opposer's motion to suspend should be denied because applicant's motion is too short. Opposer provided the information necessary to the Board's decision – the request, the relevant rule, and the factual support in the form of the attached pleading - and no more. The Board disagrees that brevity alone is a basis for denial.

USPQ2d 1933 (TTAB 1992). Judicial economy lies in the suspension of Board proceedings because, *inter alia*, the Board has limited jurisdiction involving the issue of registrability only; the Board decision is advisory to the Court, while a Court decision may bind a party in an administrative Board proceeding [see Vol. 5, J. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §32:49 (4th ed.)]; and the Board decision is appealable to the U.S. District Court. *See Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir. 1988); *E. & J. Gallo Winery v. F. & P. S.p.A.*, 899 F. Supp 465, 35 USPQ2d 1857 (ED CA 1994) and *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F Supp 563, 2 USPQ2d 1208 (DC MN 1986). *See also* Sections 17 and 37 of the Trademark Act.

The Board does not disagree that if the other oppositions involve the same issue before the court, the cases should be handled consistently. If the district court stays proceedings because it wishes the Board to go forward, of course the Board will do so. However, inasmuch as the district court has jurisdiction to decide a wider range of issues than those before the Board, and its decision would be binding upon the Board, the Board declines to anticipate such a stay. Opposer's motion to suspend is granted, and proceedings herein are suspended

pending the final disposition of the civil action between these parties.

Opposer is ordered to promptly advise the Board of any related cases on an ongoing basis throughout the pendency of this case. Specifically, so that the Board may consider whether suspension is appropriate, opposer must promptly inform the Board of any opposition in which opposer also has brought allegations similar to those made in the action pending before the district court, namely that consumers associate the term POD with opposer and are thus likely to be confused by the use of marks employing the term POD by applicant.

Within twenty days after the final determination of the civil action, the interested party should notify the Board so that this case may be called up for appropriate action.

During the suspension period the Board should be notified of any address changes for the parties or their attorneys.

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