

ESTTA Tracking number: **ESTTA129150**

Filing date: **03/09/2007**

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 parties oppose registration of the indicated application.

Opposers Information

Name	Apple Inc.		
Entity	Corporation	Citizenship	California
Address	1 Infinte Loop Cupertino, CA 95014 UNITED STATES		

Name	Apple Inc.
Granted to Date of previous extension	03/21/2007
Address	1 Infinte Loop Cupertino, CA 95014 UNITED STATES
Party who filed Extension of time to oppose	Apple Computer, Inc.
Relationship to party who filed Extension of time to oppose	Apple Inc. was formerly Apple Computer, Inc. by corporate name change.

Attorney information	Jennifer D. Arkowitz Townsend and Townsend and Crew LLP Two Embarcadero Center, 8th Floor San Francisco, CA 94111-3834 UNITED STATES jda@townsend.com, bsw@townsend.com, d1h@townsend.com, v1t@townsend.com, litdocketing@townsend.com Phone:415-576-0200
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Applicant Information

Application No	78727860	Publication date	02/27/2007
Opposition Filing Date	03/09/2007	Opposition Period Ends	03/29/2007
Applicant	ISYS AUTOMATION, INC. 8705 Covina Circle San Diego, CA 92126 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. All goods and seVICES in the class are opposed, namely: Computer programs for remote monitoring and control of network data and equipment via any handheld microprocessor based device, namely a
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cellphone or pda

Applicant Information

Application No	78866801	Publication date	11/21/2006
Opposition Filing Date	03/09/2007	Opposition Period Ends	03/21/2007
Applicant	isys automation, inc. 8705 Covina Circle San Diego, CA 92126 UNITED STATES		

Goods/Services Affected by Opposition

Class 009.

All goods and services in the class are opposed, namely: Computer programs for remote monitoring and control of network data and equipment via any handheld microprocessor based device, namely a cellphone or pda

Applicant Information

Application No	78867126	Publication date	11/28/2006
Opposition Filing Date	03/09/2007	Opposition Period Ends	
Applicant	iSYS Automation, Inc. 8705 Covina Circle San Diego, CA 92126 UNITED STATES		

Goods/Services Affected by Opposition

Class 009.

All goods and services in the class are opposed, namely: Computer programs for remote monitoring and control of network data and equipment via any handheld microprocessor based device, namely a cellphone or pda

Applicant Information

Application No	78873569	Publication date	11/28/2006
Opposition Filing Date	03/09/2007	Opposition Period Ends	
Applicant	iSYS Automation, Inc. 8705 Covina Circle San Diego, CA 92126 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. First Use: 2005/08/23 First Use In Commerce: 2005/08/23

All goods and services in the class are opposed, namely: Computer programs for remote monitoring and control of network data and equipment via any handheld microprocessor based device, namely a cellphone or pda

Attachments	iSYS Automation's Applications, Consolidated Notice of Opposition.pdf (6 pages)(255627 bytes)
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Signature	/Jennifer D. Arkowitz/
Name	Jennifer D. Arkowitz
Date	03/09/2007

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

In re Application No. 78/727,860
Filed: October 6, 2005
Published: February 27, 2007 in the Official Gazette
For: **LONPOD**

In re Application No. 78/866,801
Filed: April 21, 2006
Published: November 21, 2006 in the Official Gazette
For: **CONTROLPOD**

In re Application No. 78/867,126
Filed: April 21, 2006
Published: November 28, 2006 in the Official Gazette
For: **BACPOD**

In re Application No. 78/873,569
Filed: May 1, 2006
Published: November 28, 2006 in the Official Gazette
For: **ISYS LONPOD**

APPLE INC.,

Opposer,

vs.

ISYS AUTOMATION, INC.

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 the registrations in

International Class 9 of the mark **LONPOD** shown in Application Serial No. 78/727,860, the mark **CONTROLPOD** shown in Application Serial No. 78/866,801, the mark **BACPOD** shown in Application Serial No. 78/867,126, and the mark **ISYS LONPOD** shown in Application Serial No. 78/873,569, filed by ISYS AUTOMATION, INC. (“Applicant”), a California Corporation, with a mailing address at 8705 Covina Circle, San Diego, California 92126, and published in the Official Gazettes of November 21, 2006, November 28, 2006, and February 27, 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.

2. Apple is also 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).

3. Apple is the owner of the U.S. Trademark Application No. 78/653,661 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” and “a full line of computer software for portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, audio, image, and video files” in International Class 9. Apple’s application was filed on June 18, 2005, and a Notice of Allowance was issued on March 6, 2007.

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. Apple’s marks referred to hereinabove will be 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 and services that originate from Apple.

9. On October 6, 2005, Applicant filed U.S. Trademark Application Serial No. 78/727,860, based on its intent to use the mark **LONPOD** in connection with “computer programs for remote monitoring and control of network data and equipment via any handheld microprocessor based device, namely a cellphone or pda” in International Class 9.

10. On April 21, 2006, Applicant filed U.S. Trademark Application Serial No. 78/866,801, based on its intent to use the mark **CONTROLPOD** in connection with “computer programs for remote monitoring and control of network data and equipment via any handheld microprocessor based device, namely a cellphone or pda” in International Class 9.

11. On April 21, 2006, Applicant filed U.S. Trademark Application Serial No. 78/867,126, based on its intent to use the mark **BACPOD** in connection with “computer programs for remote monitoring and control of network data and equipment via any handheld microprocessor based device, namely a cellphone or pda” in International Class 9.

12. On May 1, 2006, Applicant filed U.S. Trademark Application Serial No. 78/873,569 for the mark **ISYS LONPOD** in connection with “computer programs for remote monitoring and control of network data and equipment via any handheld microprocessor based device, namely a cellphone or pda” in International Class 9 with first use claimed as of September 23, 2005.

13. Applicant’s marks referred to hereinabove will be referred to collectively as “Applicant’s Marks” or “the Applications.”

14. Applicant’s goods as described in the Application are highly related to the goods and services identified in Apple’s registrations and applications for its **IPOD** mark, and with which Apple has been using its **IPOD** mark for many years.

15. Apple began use of its **IPOD** mark in connection with its goods and services at least as early as October 2001, which is well prior to Applicant’s October 6, 2005, April 21,

2006, and May 1, 2006 filing dates, as well as the September 23, 2005 claimed date of first use in U.S. Trademark Application Serial No. 78/873,569. The August 31, 2001 Convention priority date of Apple's registration and pending applications similarly pre-dates the Applications' October 6, 2005, April 21, 2006, and May 1, 2006 filing dates, as well as the September 23, 2005 claimed date of first use in U.S. Trademark Application Serial No. 78/873,569.

16. Applicant's **LONPOD, CONTROLPOD, BACPOD, and ISYS LONPOD** marks, consisting in part of a significant portion of Apple's **IPOD** mark, and the entirety of Apple's **POD** mark, are extremely similar to Apple's Marks.

17. As a result of the similarity between Apple's Marks and Applicant's Marks and the highly related nature of the goods and services of the parties' marks, 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 and services.

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

19. 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.

20. If the Applications are permitted to register, the registrations would presumptively entitle Applicant to *prima facie* exclusive ownership and rights to the **LONPOD, CONTROLPOD, BACPOD, and ISYS LONPOD** marks. Such registrations would cause confusion among consumers as to the separate and distinct sources of Applicant's goods and services and Apple's goods and 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. 78/727,860, 78/866,801, 78/867,126, and 78/873,569 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.

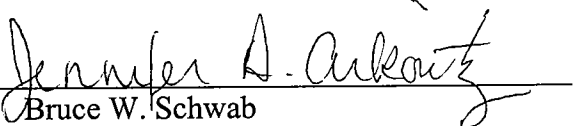
Please direct all notices, pleadings and process regarding this matter to:

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San Francisco, CA 94111-3834
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Respectfully submitted,

TOWNSEND *and* TOWNSEND *and* CREW LLP

Dated: March 9, 2007

By 
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Attorneys for Opposer

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