

ESTTA Tracking number: **ESTTA200060**

Filing date: **03/21/2008**

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

Proceeding	91176107
Party	Plaintiff Apple Computer, Inc., Apple Inc.
Correspondence Address	Jennifer D. Arkowitz Townsend and Townsend and Crew LLP Two Embarcadero Center, 8th Floor San Francisco, CA 94111-3834 UNITED STATES jda@townsend.com, mcm@townsend.com, v1t@townsend.com, d1h@townsend.com, litdocketing@townsend.com
Submission	Other Motions/Papers
Filer's Name	Jennifer D. Arkowitz, Esq.
Filer's e-mail	jda@townsend.com, mcm@townsend.com, v1t@townsend.com, d1h@townsend.com, litdocketinginbox@townsend.com
Signature	/jennifer d. arkowitz/
Date	03/21/2008
Attachments	Motion to Suspend.pdf (18 pages)(508065 bytes)

**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. 91176107

**MOTION TO SUSPEND
PENDING CONSOLIDATION ORDER
UNDER 37 C.F.R. §2.117(a)**

On March 11, 2008, Opposer Apple Inc. filed a Notice of Opposition to ISYS Automation's application for **VAVPOD** (Opposition No. 91182911), and the Answer is due on April 20, 2008. Opposer intends to file a Motion to Consolidate the Opposition to **VAVPOD** with the Consolidated Opposition to **LONPOD, CONTROLPOD, BACPOD, and ISYS**

LONPOD but is unable to do so until Applicant files an Answer to the **VAVPOD** Opposition proceeding. See Fed. R. Civ. P. 42(a) and T.B.M.P. 511. Accordingly, Opposer hereby requests suspension of the captioned Opposition proceeding pursuant to 37 C.F.R. § 2.117(a) and T.B.M.P. § 510.02(a) due to the pending Opposition to **VAVPOD**. A copy of the Notice of Opposition to **VAVPOD** is enclosed herewith.

Opposer believes that all of the requirements for suspension have been met and the captioned Opposition should be suspended pending the consolidation of the two Opposition proceedings discussed above. Action toward that end is earnestly solicited.

Respectfully submitted,

TOWNSEND *and* TOWNSEND *and* CREW LLP

Date: March 31, 2008

By: Jennifer D. Arkowitz
Margaret C. McHugh
Jennifer D. Arkowitz
Attorneys for Opposer
APPLE INC.

Two Embarcadero Center, 8th Floor
San Francisco, CA 94111-3834
Tel: 415-376-0200
Fax: 415-576-0300

61318576 v1

CERTIFICATE OF SERVICE

I hereby certify that on March 21, 2008, I caused the foregoing **MOTION TO SUSPEND PENDING CONSOLIDATION ORDER UNDER 37 C.F.R. §2.117(a)** to be served by United States mail, postage prepaid, in an envelope addressed to:

Barry F. Soalt
Procopio, Cory, Hargreaves & Savitch LLP
530 B Street, Suite 2100
San Diego, CA 92101
Attorney for Applicant



Dena Hong-Yee

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

In re Application No. 77/092,749
Filed: January 26, 2007
Published: November 13, 2007 in the Official Gazette
For: **VAVPOD**

APPLE INC.,

Opposer,

vs.

ISYS AUTOMATION, INC.

Applicant.

Opposition No. _____

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 registration in International Class 9 of the mark **VAVPOD** shown in Application Serial No. 77/092,749 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 January 26, 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 also the owner of U.S. Registration No. 3,341,191 for a variety of goods, including "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 for said registration was filed on June 18, 2005, matured to registration on November 20, 2007, and claims first use in commerce 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. 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 January 26, 2007, Applicant filed U.S. Trademark Application Serial No. 77/092,749 based on its intent to use the mark **VAVPOD** in connection with "computer software for remote monitoring, configuration and control of network data for variable air volume controllers and equipment via any handheld microprocessor based device, namely a cellphone for pda" in International Class 9.

10. 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.

11. Applicant's **VAVPOD** mark, consisting in part of a significant portion of Apple's **IPOD** mark, and the entirety of Apple's **POD** mark, is extremely similar to Apple's Marks.

12. 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 January 26, 2007 filing date. The August 31, 2001 Convention priority date of Apple's registrations and pending applications similarly pre-dates the Application's January 26, 2007 filing date.

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

14. Registration of the mark in the Application and use of Applicant's Mark is likely to dilute Apple's famous **IPOD** mark.

15. Registration of Applicant's Mark shown in the opposed Application 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.

16. If the Application is permitted to register, the registration would presumptively entitle Applicant to *prima facie* exclusive ownership and rights to the **VAVPOD** mark. Such registration would cause confusion among consumers as to the separate and distinct sources of Applicant's goods 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 No. 77/092,749 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.

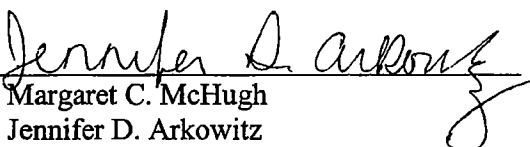
Please direct all notices, pleadings and process regarding this matter to:

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: March 11, 2008

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

Two Embarcadero Center, 8th Floor
San Francisco, CA 94111-3834
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EXHIBIT A

Int. Cl.: 9

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

Reg. No. 2,835,698

United States Patent and Trademark Office

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

Reg. No. 3,089,360

United States Patent and Trademark Office

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

CERTIFICATE OF SERVICE

On March 11, 2008, I served the foregoing **NOTICE OF OPPOSITION** on the party(ies) in said action by depositing a true copy thereof with the United States Postal Service as first class mail, postage prepaid, at San Francisco, California, enclosed in a sealed envelope addressed as follows:

Barry F. Soalt, Esq.
Procopio, Cory, Hargreaves & Savitch, LLP
530 B Street, Suite 2100
San Diego, CA 92101



Dena T. Hong-Yee

Hong-Yee, Dena R.T.

From: estta-server@uspto.gov
Sent: Tuesday, March 11, 2008 11:06 AM
To: Arkowitz, Jennifer D.; McHugh, Margaret C. ; Hong-Yee, Dena R.T.; Tom, Victor; litdocketing@townsend.com
Subject: ESTTA. Notice of Opposition. confirmation receipt ID: ESTTA197529

Notice of Opposition.

Tracking No: ESTTA197529

ELECTRONIC SYSTEM FOR TRADEMARK TRIALS AND APPEALS Filing Receipt

We have received your Notice of Opposition. submitted through the Trademark Trial and Appeal Board's ESTTA electronic filing system. This is the only receipt which will be sent for this paper. If the Board later determines that your submission is inappropriate and should not have been accepted through ESTTA, you will receive notification and appropriate action will be taken.

Please note:

Unless your submission fails to meet the minimum legal requirements for filing, the Board will not cancel the filing or refund any fee paid.

If you have a technical question, comment or concern about your ESTTA submission, call 571-272-8500 during business hours or e-mail at estta@uspto.gov.

The status of any Board proceeding may be checked using TTABVUE which is available at <http://ttabvue.uspto.gov> Complete information on Board proceedings is not available through the TESS or TARR databases. Please allow a minimum of 2 business days for TTABVUE to be updated with information on your submission.

The Board will consider and take appropriate action on your filing in due course.

Printable version of your request is attached to this e-mail

ESTTA server at <http://estta.uspto.gov>

ESTTA Tracking number: ESTTA197529
Filing date: 03/11/2008

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

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Name: Apple Inc.
Granted to Date of previous extension: 03/12/2008
Address: 1 Infinite Loop
Cupertino, CA 95014
UNITED STATES

Attorney information:
Jennifer D. Arkowitz
Townsend and Townsend and Crew LLP
2 Embarcadero Center 8th Floor
San Francisco, CA 95014
UNITED STATES
jda@townsend.com, mcm@townsend.com, d1h@townsend.com, v1t@townsend.com, litdocketing@townsend.com
Phone:415-576-0200

Applicant Information:
Application Serial No: 77092749
Publication date: 11/13/2007
Opposition Filing Date:
Opposition Period Ends: 03/12/2008
Applicant: iSYS Automation, Inc.
Address: 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 software for remote monitoring, configuration and control of network data for variable air volume controllers and equipment via any handheld microprocessor based device, namely a cellphone or pda
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
Word Mark: IPOD

Goods/Services:

Class 009 First Use: 20011023 First Use In Commerce: 20011023

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
Word Mark: IPOD

Goods/Services:

Class 009 First Use: 20011023 First Use In Commerce: 20011023

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
Word Mark: IPOD

Goods/Services:

Class 009 First Use: 20011023 First Use In Commerce: 20011023

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

U.S. Application No.: 78459101

Application Date: 07/29/2004

Word Mark: POD

Goods/Services:

Class 009

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: Opposer instituted Opposition No. 91176107 against the Applicant with respect to its applications for LONPOD, CONTROLPOD, BACPOD, and ISYS LONPOD, and intends to file a Motion to Consolidate the two proceedings.

Attachments:

78653661#TMSN.jpeg (1 page)

78459101#TMSN.jpeg (1 page)

VAVPOD Notice of Oppostion.pdf (12 pages)

Certificate of Service

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

Jennifer D. Arkowitz

/Jennifer D. Arkowitz/

03/11/2008