Docket No. 10684-6001.501

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application No. 78/876,218
Filed: May 4, 2006
Published: January 16, 2007, in the *Official Gazette*
For: **VPOD**

APPLE INC.,

Opposer,

vs.

SCHERING-PLOUGH ANIMAL HEALTH CORPORATION,

Applicant.

Opposition No. To Be Assigned

NOTICE OF OPPOSITION

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

Dear Madam:

Apple Inc. ("Opposer"), a California corporation, located and doing business at 1 Infinite Loop, Cupertino, California 95014, believes that it will be damaged by the registration of the mark **VPOD** shown in Application Serial No. 78/876,218 owned by Schering-Plough Animal Health Corporation ("Applicant"), a Delaware corporation, with a mailing address of 556 Morris Avenue, Summit, New Jersey 07901, published in the *Official Gazette* of January 16, 2007, and hereby opposes registration thereof.

As grounds for opposition, Opposer alleges:

1. Opposer 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. Opposer's application for said registration was filed on October 18, 2001, and matured to registration on April 27, 2004. Opposer's registration has a Convention priority date of August 31, 2001 under § 44(d) of the Lanham Act, 15 U.S.C. § 1126(d). Opposer 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. Opposer is also the owner of 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. Opposer's application for said registration was filed on October 18, 2001, and matured to registration on May 9, 2006. Opposer's registration has a Convention priority date of August 31, 2001. Opposer has used the mark **IPOD** on and in connection with the sale of the aforementioned goods since at least as early as October 2001.

3. Opposer is also the owner of the following pending applications for the mark **IPOD:**

- Serial No. 78/521,796 – filed November 23, 2004, with a Convention priority filing date of July 28, 2004, for "retail store services and retail store services provided via communications networks featuring computers, computer software, computer peripherals and consumer electronics, and pre-recorded music, audio-visual and music-related products; product demonstrations provided in-store and via communications networks; information and consultation in connection with all of the foregoing" in International Class 35 and "computerized data storage and retrieval services for digital

music, photographs, and audio-visual and text works; information and consultation in connection therewith" in International Class 39;

- Serial No. 78/653,661 – filed June 18, 2005 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; image scanners; video viewers, namely video monitors for portable and handheld digital electronic devices; and, electronic memory card readers; 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; 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, sacks, and bags, 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 International Class 9;

- Serial No. 78/521,891 – filed November 23, 2004, with a Convention priority filing date of July 28, 2004, for "printed materials and publications, namely, books, magazines, newsletters, brochures, booklets, pamphlets, manuals, journals, leaflets, greeting cards, and catalogues all relating to computer software, computer hardware, consumer electronics, digital technology, telecommunications, on-line retailing, entertainment, music, movies and video, and multimedia apparatus and instruments; pens and pencils, clipboards, posters, memo pads, binders" in International Class 16;

- Serial No. 78/532,252 – filed December 14, 2004, with a Convention priority filing date of July 28, 2004, for "educational services in the nature of classes and training services offered in-person and over computer networks in the fields of K-12 education, university-level subjects, topics of general interest, and computer hardware and software applications; entertainment services in the nature of musical, video, audio-video, and textual materials, namely books, plays, pamphlets, brochures, newsletters, journals, and magazines, on the subjects of sporting and cultural activities and a wide range of topics of general interest offered in-person and distributed over computer networks; providing electronic publications for browsing and downloading over computer networks, namely books, pamphlets, brochures, newsletters, journals, and magazines, on the subjects of computer hardware and software applications and a wide range of topics of general interest; editing of audio-tapes; editing of video-tapes; editing of written text; editing of photographic images; videotape editing; digital imaging services; providing information, advice and consultation services relating to all the aforesaid" in International Class 41; and

- Serial No. 77/013,000 – filed October 3, 2006, with a Convention priority filing date of April 3, 2006, for, *inter alia*,

"portable and handheld digital electronic devices for recording, organizing, transmitting, receiving, manipulating, playing and reviewing text, data, image, audio and video files; computer software for use in organizing, transmitting, receiving, manipulating, playing and reviewing text, data, image, audio, and video files on portable and handheld digital electronic devices; a full line of electronic and mechanical parts and fittings for portable and handheld digital electronic devices for recording, organizing, transmitting, receiving, manipulating, playing and reviewing text, data, image, 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; image scanners; video viewers, namely video monitors for portable and handheld digital electronic devices; electronic memory card readers; a full line of computer software for portable and handheld digital electronic devices for recording, organizing, transmitting, receiving, manipulating, playing 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; computer software for clock and alarm clock functionality; carrying cases, sacks, and bags, all for use with portable and handheld digital electronic devices; a full line of holders, straps, armbands, and clips for portable and handheld digital electronic. computers, computer peripherals, hand held computers, computer terminals, personal digital assistants, electronic organizers, electronic notepads, apparatus for recording, transmission and reproduction of text, data, image, audio, and video; blank magnetic data carriers; microprocessors, memory boards, computer and video monitors, liquid crystal displays, keyboards, electrical cables, modems, printers, digital disk drives; cameras; computer software and prerecorded computer programs for personal information management, database management software, electronic mail and messaging software; paging software; database synchronization software, computer programs for accessing, browsing and searching online databases; computer software and firmware for operating system programs; data synchronization programs; computer software application development tool programs; adapters, computer card adapters, cable and electric connectors and computer hard drives; blank random access electronic memory, read only electronic memory; solid state electronic memory; user manuals in electronically readable, machine readable or computer readable form for use with, and sold as a unit with, all the aforementioned goods; downloadable electronic publications in the nature of books, magazines, pamphlets, brochures, newsletters, journals and magazines in the fields of sporting and cultural events, computer hardware and software applications, K-12 education and university-level subjects, and a wide range of topics of general interest" in Class 09;

"Printed materials and publications, namely, books, magazines, newsletters, brochures, booklets, pamphlets, manuals, journals, leaflets, greeting cards, and catalogues all relating to computer software, computer hardware, consumer electronics, digital technology,

telecommunications, on-line retailing, entertainment, music, movies and video, and multimedia apparatus and instruments; pens and pencils, clipboards, posters, memo pads, binders" in International Class 16;

"Hand-held unit for playing electronic games" in International Class 28;

"Retail store services and retail store services provided via communications networks featuring computers, computer software, computer peripherals and consumer electronics, and pre-recorded music, audio-visual and music-related products; product demonstrations provided in-store and via communications networks; information and consultation in connection with all of the foregoing" in International Class 35;

"Telecommunication access services; communication by computer; transmission of data and of information by electronic means, broadcasting or transmission of radio and television programs; provision of telecommunications connections to computer databases and the Internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; web casting services; delivery of messages by electronic transmission; provision of telecommunications connections to electronic communications networks, for transmission or reception of audio, video or multimedia content; streaming of video content, streaming and subscription audio broadcasting of spoken word, music, concerts, and radio programs, broadcasting prerecorded videos featuring music and entertainment, television programs, motion pictures, news, sports, games, cultural events, and entertainment-related programs of all kinds, via computer and other communications networks; providing on-line bulletin boards for the transmission of messages among computer users concerning entertainment in the nature of music, concerts, videos, radio, television, film, news, sports, games and cultural events; communication services namely, matching users for the transfer of music, video and audio recordings via communication networks provision of information, consultancy and advisory services for all the aforesaid services" in International Class 38;

"Computerized data storage and retrieval services for digital text, data, image, audio, and video works; information and consultation in connection therewith" in International Class 39;

"Educational services in the nature of classes and training services offered in-person and over computer networks in the fields of K-12 education, university-level subjects, topics of general interest, and computer hardware and software applications; entertainment services in the nature of providing on-line, non-downloadable musical, video, audio-video, and textual materials, namely books, plays, pamphlets, brochures, newsletters, journals, and magazines, on the subjects of sporting and cultural activities and a wide range of topics of general interest via computer networks; entertainment services, namely, providing a website and database featuring music, musical performances and concerts, videos, films and film clips, book reviews, games, sports information and other related multimedia material; providing on-line non-downloadable publications for browsing over computer networks, namely books, pamphlets, brochures, newsletters, journals, and magazines, on

the subjects of computer hardware and software applications and a wide range of topics of general interest; editing of audio-tapes; editing of video-tapes; editing of written text; editing of photographic images; videotape editing; digital imaging services; providing information, advice and consultation services relating to all the aforesaid" in International Class 41; and

"Design and development of computer hardware and software; computer hardware and software consulting services; multimedia and audio-visual software consulting services; computer programming; technical support and consultation services for developing computer systems, databases and applications; information relating to computer hardware or software provided on-line from a global computer network or the Internet; creating and maintaining web-sites for others; providing search engines for obtaining data via communications networks; providing temporary use of on-line non-downloadable software to enable users to program audio, video, text and other multimedia content, including music, concerts, videos, radio, television, news, sports, games, cultural events, and entertainment-related programs; providing on-line facilities, via a global computer network, to enable users to program audio, video, text and other multimedia content, including music, concerts, videos, radio, television, news, sports, games, cultural events, and entertainment-related programs; providing search engines for obtaining data on a global computer network; computer services, namely, creating indexes of information, sites and other resources available on global computer networks for others; providing customized on-line web pages featuring user-defined information for the purpose of identifying, locating, grouping, distributing, and managing data and links to third-party computer servers, computer processors and computer users; customized searching, browsing, organizing and retrieving services, namely, providing specific information, sites, and other resources available on global computer networks according to user preferences as requested by customers via the global computer networks; information, advisory and consultancy services relating to all the aforesaid" in International Class 42

4. Opposer is also the owner of U.S. Trademark Application Serial No. 78/459,101 for the mark **POD**, filed July 29, 2004, with a Convention priority filing date of January 30, 2004, 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.

5. Opposer is also the owner of U.S. Trademark Application Serial No. 78/706,746 for the mark **IPODCAST**, filed September 4, 2005, with a Convention priority filing date of

March 22, 2005, for "telecommunication access services; communication by computer; transmission of data and of information by electronic means, broadcasting or transmission of radio and television programs; provision of telecommunications connections to computer databases and the Internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; web casting services; delivery of messages by electronic transmission; provision of telecommunications connections to electronic communications networks, for transmission or reception of audio, video or multimedia content; streaming of video content, streaming and subscription audio broadcasting of spoken word, music, concerts, and radio programs, broadcasting prerecorded videos featuring music and entertainment, television programs, motion pictures, news, sports, games, cultural events, and entertainment-related programs of all kinds, via computer and other communications networks; providing on-line bulletin boards for the transmission of messages among computer users concerning entertainment in the nature of music, concerts, videos, radio, television, film, news, sports, games and cultural events; communication services namely, matching users for the transfer of music, video and audio recordings via communication networks provision of information, consultancy and advisory services for all the aforesaid services," in International Class 38.

6. Consumers have adopted and have used in the marketplace the term "POD" as an abbreviation for Opposer's **IPOD** mark to refer to Opposer's **IPOD** products.

7. The marks of Opposer referred to hereinabove will be hereafter collectively referred to as Opposer's Marks.

8. By virtue of Opposer's extensive use and promotion of Opposer's Marks, Opposer has established valuable goodwill in the marks, and the public has come to associate the **IPOD**

and **POD** marks with Opposer. As such, the public has come to know **IPOD** and **POD** as an indication of products and services that originate from Opposer.

9. As a result of Opposer's extensive advertising, sales, and marketing, Opposer's **IPOD** mark is famous and well known to purchasers.

10. Applicant filed U.S. Trademark Application Serial No. 78/876,218 (the "Application"), which is the subject of this Opposition, on May 4, 2006, based on its alleged bona fide intent to use the mark **VPOD**, in connection with "animal tracking device consisting of a microchip for implantation and an electronic wireless reader," in International Class 9; and "veterinary services," in International Class 44.

11. The "electronic wireless reader" described in the Application is highly related to the goods and services identified in Opposer's registrations and applications for Opposer's Marks and with which Opposer uses Opposer's Marks. Further, Applicant has disclosed to Opposer that the electronic wireless reader intended to be sold under the VPOD mark is a handheld electronic device. This shows that Applicant's mark is an attempt to trade off the IPOD and POD marks that have come to be associated with Opposer and that Opposer has established through extensive advertising sales, and marketing.

12. Because it is Opposer's understanding that Applicant intends to use the VPOD handheld electronic devices in close association with veterinary services, Opposer believes there would be confusion with respect to veterinary services as well.

13. Opposer 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 the Applicant's filing date of May 4, 2006, for the mark **VPOD**. The August 31, 2001, Convention priority date of Opposer's registrations

and the filing dates of Opposer's pending applications for Opposer's Marks similarly pre-date the Application's May 4, 2006 filing date.

14. On information and belief, Applicant has not yet commenced use of the mark **VPOD**.

15. Applicant's **VPOD** mark is extremely similar to Opposer's Marks, the most prominent element of Applicant's Mark, "**POD**," being identical to Opposer's prior-filed **POD** mark and the most prominent element of Opposer's **IPOD** and **IPODCAST** marks. Furthermore, Applicant's use of the single letter "V" before the word POD is derivative of and similar to Opposer's famous **IPOD** mark. As a result of the similarity between Opposer's Marks and Applicant's **VPOD** mark and the related nature of the goods and services associated with each party's respective mark, 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.

16. The **IPOD** mark was famous at the time Applicant filed the Application for the **VPOD** mark.

17. Registration of the mark shown in the Application and use of Applicant's mark are likely to dilute Opposer's famous **IPOD** mark.

18. Registration of Applicant's mark shown in the opposed Application will result in damage to Opposer 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.

19. If the Application is permitted to register, the registration would presumptively entitle Applicant to *prima facie* exclusive ownership and rights to the **VPOD** mark. Such registration would cause confusion among consumers as to the separate and distinct sources of

Applicant's goods and services and Opposer's goods and services and the relationship of Opposer to Applicant, thereby damaging Opposer's goodwill in Opposer's Marks, diluting the value thereof, and resulting in irreparable harm to Opposer's business and reputation, all to the detriment of Opposer, who has expended considerable sums and effort in promoting Opposer's Marks.

WHEREFORE, Opposer prays that this Opposition be sustained and that registration of U.S. Trademark Application Serial No. 78/876,218 be denied.

Please charge any necessary fee regarding this Opposition to **Deposit Account 03-1952 (Reference 10684-6001501)**, and credit any overpayment to such deposit account. A duplicate copy of this document is being provided for that purpose.

Respectfully submitted,

Dated: July 16, 2007 By: _____

Rosemary S. Tarlton
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TRADEMARK
Docket No. 42528-24002.31

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

In re Application No. 78/876,218
Filed: May 4, 2006
Published: January 16, 2007, in the *Official Gazette*
For: **VPOD**

Opposition No.: TO BE ASSIGNED

Apple, Inc.,

Opposer,

vs.

Schering-Plough Animal Health Corporation

Applicant.

CERTIFICATE OF MAILING BY EXPRESS MAIL

TRADEMARK TRIAL AND APPEAL BOARD
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Commissioner:

Express Mail Label No.: EV968742898US

Date of Deposit: July 16, 2007

I hereby certify that the attached Transmittal + copy, Notice of Opposition (in triplicate); and receipt verification postcard are being deposited with the United States Postal Service Express Mail delivery as "Express Mail Post Office to Addressee" service under 37 C.F.R § 1.10 on the date indicated above, and is addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

Respectfully submitted,

By: _____
Jerome Lewis

sf-2355085

7-18-07

TM

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PATENT & TRADEMARK OFFICE

July 16, 2007

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TRADEMARK TRIAL AND APPEAL BOARD
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Re: *Apple, Inc., v. Schering-Plough Animal Health Corporation*
Opposition No.: To Be Assigned
Mark: VPOD
Serial No. 78/876,218
Our Reference No.: 10684-6001.501

Dear Commissioner:

Enclosed for filing is a Notice of Opposition (in triplicate), and a receipt verification postcard in the above-referenced matter.

The Commissioner is hereby authorized to charge $600.00 for the opposition to classes 9 and 44 identified in the above-referenced application, and any additional fees which may be required, or to credit any overpayment, to **Deposit Account No. 03-1952 (our reference no. 106846001501)**. A duplicate copy of this letter is enclosed for this purpose.

Very truly yours,

Rosemary S. Tarlton

Enclosures

07-16-2007
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #34

sf-2355073