

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

In the Matter of Application Serial Nos. 77/179,942 and 77/179,968



(77/179,942)



(77/179,968)

nyc.gov/planyc2030

For the marks:  
Filed: May 14, 2007  
Published: September 18, 2007

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APPLE INC.,  
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Opposer,  
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v.  
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NYC & COMPANY, INC.,  
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:  
Applicant.  
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Opposition No.  
**CONSOLIDATED NOTICE OF  
OPPOSITION**

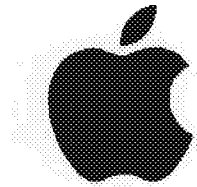
APPLE INC. ("Opposer"), a corporation organized and existing under the laws of California with a principal place of business at 1 Infinite Loop, Cupertino, California 95014, believes that it will be damaged by the issuance of registrations for the trademarks shown in Application Serial Nos. 77/179,942 and 77/179,968 and hereby opposes same.

As grounds for its opposition, Opposer alleges as follows, with knowledge concerning its own acts, and on information and belief as to all other matters:

1. Opposer is the world-famous computer company, and Opposer's APPLE brand is one of the best known brands in the world. Opposer designs, manufactures and/or markets in interstate and international commerce, among other things, computers, computer software, computer peripherals, business services and education services and offers a broad array of other

goods and services, including but by no means limited to publications, provision of information through various forms of media, advertising, clothing, glassware and dishes.

2. Since at least as early as 1977, Opposer has extensively promoted, marketed, advertised, distributed and sold goods and services in connection with a family of trademarks consisting, in whole or in part, of the word APPLE and a visual equivalent of the word, to wit a logo depicting a stylized apple, as shown below:



(the “Apple Logo”).

3. Opposer’s family of APPLE-based word marks and its Apple Logo (collectively, the “APPLE Marks”) have achieved an extraordinary level of fame and consumer recognition. As a result of Opposer’s extensive advertising, promotion and use of its APPLE Marks in connection with a variety of goods and services, Opposer’s APPLE Marks have acquired enormous goodwill, and have come to be immediately identified with Opposer as the source of goods and services.

4. The APPLE Marks are famous under the Lanham Act, specifically 15 U.S.C. § 1125 *et seq.*, and are among the most valuable trademarks in the world. The extraordinary level of fame and consumer recognition that the APPLE Marks currently enjoy cannot be seriously disputed. As a result of Opposer’s extensive advertising and use of the APPLE Marks, the APPLE Marks have acquired extensive goodwill and have come to be immediately identified with Opposer.

5. For many years, Apple's APPLE brand (including the Apple Logo) has consistently been recognized as one of the top brands in the United States and throughout the world. For example, Harris Interactive Inc., one of the world's largest market research firms, found Apple's APPLE brand to be one of the 10 most recognized brands in the United States in its 2006 and 2007 *Harris Polls* of "best brands," which are based upon consumer responses. Attached as Exhibit 1 is a printout of *The Harris Poll #71, July 17, 2007* of "Best Brands." As another example, in the yearly surveys of Brandchannel.com (an online affiliate of Interbrand Corporation ("Interbrand"), the leading brand assessment company), Apple's APPLE brand has consistently been found by the public to be one of the top two brands in the world. Attached as Exhibit 2 are true and correct copies of representative articles from Brandchannel.com.

6. In addition, Interbrand, using different criteria than Brandchannel.com, has consistently recognized Apple's APPLE brand as belonging in the top 50 brands worldwide.<sup>1</sup> Attached as Exhibit 3 are copies of the rankings of Apple's APPLE brand, in reverse chronological order from 2007 through 2001, as compiled by Interbrand. Interbrand has given the APPLE brand the following rankings and U.S. dollar values over the past six years:

- i. 2007: valuing the APPLE brand as the 33<sup>rd</sup> most valuable brand in the entire world, with an estimated brand worth of U.S. \$11.037 billion.
- ii. 2006: valuing the APPLE brand as the 39<sup>th</sup> most valuable brand in the entire world, with an estimated brand worth of U.S. \$9.130 billion.
- iii. 2005: valuing the APPLE brand as the 41<sup>st</sup> most valuable brand in the entire world, with an estimated brand worth of U.S. \$7.985 billion.
- iv. 2004: valuing the APPLE brand as the 43<sup>rd</sup> most valuable brand in the entire world, with an estimated brand worth of U.S. \$6.871 billion.
- v. 2003: valuing the APPLE brand as the 50<sup>th</sup> most valuable brand in the entire

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<sup>1</sup> Interbrand's rankings depend in part on market capitalization, and therefore, to that extent, penalize Apple because Apple's market capitalization is smaller than many of the companies that appear in Interbrand's rankings.


world, with an estimated brand worth of U.S. \$5.55 billion.

- vi. 2002: valuing the APPLE brand as the 50<sup>th</sup> most valuable brand in the entire world, with an estimated brand worth of U.S. \$5.32 billion.
- vii. 2001: valuing the APPLE brand as the 49th most valuable brand in the entire world, with an estimated brand worth of U.S. \$5.46 billion.

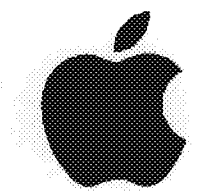
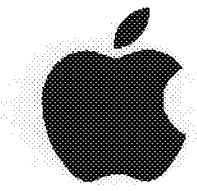
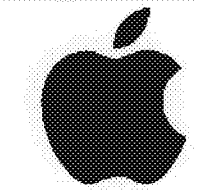
7. Opposer is the owner of numerous United States Registrations on the Principal


Register for its APPLE Marks, including, without limitation, the following registrations:

TRADEMARK	REG. NO.	FILING DATE/ REG. DATE	GOODS/SERVICES
APPLE	1,078,312	March 25, 1977 November 29, 1977	Class 9: Computers and computer programs recorded on paper and tape.
	1,114,431	March 20, 1978 March 6, 1979	Class 9: Computers and computer programs recorded on paper and tape.
APPLE	1,144,147	January 29, 1979 December 23, 1980	Class 16: Magazines for the personal computer field.
	1,401,237	November 4, 1985 July 15, 1986	Class 21: Mugs, dishes, drinking glasses, [beer steins] and wine glasses.
	2,657,931	August 24, 2000 December 10, 2002	Class 16: Printed materials and publications, namely, user manuals, series of books, booklets, brochures, data sheets, white papers, newsletters, catalogs, pamphlets, periodicals and magazines, all in the fields of business, creative design, computers, information technology, word processing, database management, multimedia, entertainment, electronic commerce and telecommunications; stationery, pens and pencils, clipboards, posters, memo pads, binders.

TRADEMARK	REG. NO.	FILING DATE/ REG. DATE	GOODS/SERVICES
	2,715,578	July 1, 2002  May 13, 2003	Class 9: Computers hardware; computer hardware, namely, server, desktop, laptop, notebook and subnotebook computers; hand held and mobile computers; computer terminals and monitors; personal digital assistants; portable digital audio players; electronic organizers; computer keyboards, cables, modems; audio speakers; computer video control devices, namely, computer mice, trackballs, joysticks and gamepads; a full line of computer software for business, home, education, and developer use; computer programs for personal information management; database management software; character recognition software; telephony management software; electronic mail and messaging software; telecommunications software, namely for paging; database synchronization software; computer programs for accessing, browsing and searching online databases; operating system software; application development tool programs; blank computer storage media; fonts, typefaces, type designs and symbols recorded on magnetic media; computer software for use in providing multiple user access to a global computer information network for searching, retrieving, transferring, manipulating and disseminating a wide range of information; computer software for use as a programming interface; computer software for use in network server sharing; local and wide area networking software; computer software for matching, correction, and reproduction of color; computer software for use in digital video and audio editing; computer software for use in enhancing text and graphics; computer software for use in font justification and font quality; computer software for use to navigate and search a global

TRADEMARK	REG. NO.	FILING DATE/ REG. DATE	GOODS/SERVICES
			<p>computer information network, as well as to organize and summarize the information retrieved; computer software for use in word processing and database management. word processing software incorporating text, spreadsheets, still and moving images, sounds and clip art; computer software for use in authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, playing, storing and organizing audio, video, still images and other digital data; computer software for analyzing and troubleshooting other computer software; children's educational software; computer game software; Computer graphics software; Computer search engine software; Web site development software; computer program which provides remote viewing, remote control, communications and software distribution within personal computer systems and across computer network; computer programs for file maintenance and data recovery; computer peripherals; instructional manuals packaged in association with the above.</p>
APPLESEED	2,882,805	January 25, 2001 September 7, 2004	<p>Class 35: providing market research services, namely, conducting and analyzing consumer surveys in relation to computer software, hardware and Internet services; collecting consumer data and providing consumer reports concerning computer software, hardware, Internet services, consumer products and consumer behavior; conducting and analyzing population and product trend studies in relation to computer software, hardware and Internet services; and collecting and analyzing demographic information and statistics in relation to computer software, hardware and Internet services; and providing statistical reports therefor.</p>

TRADEMARK	REG. NO.	FILING DATE/ REG. DATE	GOODS/SERVICES
	2,926,853	August 16, 2002 February 15, 2005	Class 35: analysis and consultation in the field of business information management, namely, the selection, adoption and operation of computers and computer information management systems; providing information in the fields of business and commerce over computer networks and global communication networks; business services, namely, providing computer databases regarding the purchase and sale of a wide variety of products and services of others; business services, namely, dissemination of advertising for others via computer networks and global communication networks; retail store services featuring computers, computer software, computer peripherals and consumer electronics, and demonstration of products relating thereto; online retail store services provided via computer networks and global communication networks featuring computers, computer software, computer peripherals and consumer electronics, and demonstration of products relating thereto.
	3,070,035	August 22, 2002 March 21, 2006	Class 25: Footwear; headwear; shirts, t-shirts, sweatshirts, jogging suits, trousers, pants, shorts, tank tops, rainwear, cloth bibs, skirts, blouses; dresses, suspenders, sweaters, jackets, coats, raincoats, snow suits, ties, robes, hats, caps, sun-visors, belts, scarves, sleepwear, pajamas, lingerie, underwear, boots, shoes, sneakers, sandals, booties, slipper socks, swimwear and masquerade and Halloween costumes.
	3,108,652	April 27, 2004 June 27, 2006	Class 45: providing a selection of on-line electronic greeting cards; (Based on 44(e)) computer dating services; providing a selection on-line electronic greeting cards.
APPLE	3,226,289	August 24, 2000	Class 16: Printed materials and publications, namely, user manuals, brochures, data sheets, white papers,

TRADEMARK	REG. NO.	FILING DATE/ REG. DATE	GOODS/SERVICES
		November 11, 2003	newsletters, catalogs, pamphlets, periodicals and magazines, all in the fields of business, creative design, computers, information technology, word processing, database management, multimedia, entertainment, electronic commerce and telecommunications; stationery, pens and pencils, clipboards, posters, memo pads, binders.
	3,298,028	August 2, 2006 September 25, 2007	<p>Class 35: Arranging and conducting trade shows, and trade show expositions and exhibitions in the fields of computers, computer software, online services, information technology, and consumer electronics.</p> <p>Class 41: Education and training services, namely, conducting classes, workshops, conferences and seminars in the field of computers, computer software, online services, information technology, internet website design, video products and consumer electronics; arranging of exhibitions, seminars and conferences; arranging professional workshop and training courses; computer education training services; training in the use and operation of computers and computer software; providing a website for the uploading, sharing, viewing and posting of photographs, digital images, movies, videos, online journals, namely web blogs in general interest fields, and other related multimedia entertainment materials over a global computer network; providing fitness and exercise facilities; physical fitness consultation and instruction; providing on-line publications in the nature of newsletters in the field of computers and education; providing information in the field of education via the internet; providing information in the field of entertainment via the Internet concerning movies, music, videos, television, celebrities, sports, news, history, science, politics, comedy, children's entertainment, animation, culture, current events.</p>



Copies of the above-identified registrations are annexed as Exhibit 4.

8. The above-identified registrations are valid and in full force and effect. Indeed, affidavits have been filed and accepted pursuant to sections 8 and 15 of the Lanham Act for Registration Nos. 1,078,312, 1,114,431, 1,144,147 and 1,401,237 rendering such registrations incontestable.

9. Additionally, since 2002, Apple has opened three high-profile, flagship, APPLE retail locations in Manhattan, all of which have garnered unprecedented press and public attention. Attached as Exhibit 5 is a true and correct copy of a December 27, 2007 article from the *New York Times* commenting on the phenomenon of Apple's Manhattan retail locations. As observed in the article, "[t]hese [APPLE] stores are going to become iconic places that people go to see when they come to New York...Rockefeller Center, Radio City Music Hall and Apple's great glass cube on Fifth Avenue." Indeed, as recently as last week, an article in the *New York Times* referred to Apple's Fifth Avenue retail location as a "popular tourist destination." See Charles V. Bagli and Terry Pristin, *Harry Macklowe's \$6.4 Billion Bill*, N.Y. Times, January 6, 2008.

10. Notwithstanding Opposer's prior rights, on May 14, 2007, applicant NYC & Company, Inc. ("Applicant") filed:

- (i) Application Serial No. 77,179,942 for “Publications, namely, brochures, booklets, and teaching materials in the field of promoting business, tourism, economic development and education on environmentally friendly policies and practices of the City of New York” in International Class 16, “sweat shirts; t-shirts; caps” in International Class 25, “beverage glassware; thermal insulated containers for food or beverage; glass beverage ware; dishes and plates” in International Class 21, “promoting the economic development in the City of New York” in International Class 35 and “education services, namely, providing public service announcements on policies and practices of the City of New York in the field of environmentally sustainable growth” in International Class 45 for the mark depicted below (the “NYC Mark”):



and

- (ii) Application Serial No. 77/179,968 for “Publications, namely, brochures, booklets, and teaching materials in the field of promoting business, tourism, economic development and education on environmentally friendly policies and practices of the City of New York” in International Class 16, “sweat shirts; t-shirts; caps” in International Class 25, “beverage glassware; thermal insulated containers for food or beverage; glass beverage ware; dishes and plates” in International Class 21, “promoting the economic development in the City of New York” in International Class 35 and “education services, namely, providing public service announcements on policies and practices of the City of New York in the field of environmentally sustainable growth” in International Class 45 for the mark depicted below (the “NYC.GOV Mark,” collectively with the NYC Mark the “Applicant’s Marks”):



[nyc.gov/planyc2030](http://nyc.gov/planyc2030)

11. Opposer obtained extensions of time to oppose the instant applications and is timely filing this Consolidated Notice of Opposition within such extended periods.

12. Applicant’s Marks are very similar to Opposer’s APPLE Marks in appearance and commercial impression. Applicant’s Marks consist of an apple with a stylized detached and

convex leaf element angled upwards. Similarly, Opposer's APPLE Marks famously evoke an apple and Opposer's APPLE Logo consists of an apple shaped logo with a stylized detached and convex leaf element angled upwards.

13. Certain of the goods and services cited by Applicant under Applicant's marks are identical, or highly related, to goods and services Opposer has long offered in connection with its APPLE Marks.

14. Accordingly, Applicant's Marks so closely resemble Opposer's APPLE Marks that Applicant's use of Applicant's Marks is likely to cause confusion, mistake or deception in the minds of consumers as to the origin or source of Applicant's goods and services in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), with consequent injury to Opposer and the public.

15. Additionally, registration of Applicant's Marks is likely to cause dilution of the distinctiveness of Opposer's APPLE Marks by eroding consumers' exclusive identification of Opposer's APPLE Marks with Opposer, and otherwise lessening the capacity of Opposer's APPLE Marks to identify and distinguish the goods and services of Opposer, in violation of Section 43(c)(1) of the Lanham Act, 15 U.S.C. § 1125(c)(1).

16. If Applicant is permitted to register Applicant's Marks, as specified in the applications herein opposed, consumer confusion resulting in damage and injury to Opposer would be caused and would result by reason of the similarity between Applicant's Marks and Opposer's APPLE Marks. Persons familiar with Opposer's APPLE Marks would be likely to purchase Applicant's goods and services as and for goods and services associated with Opposer. Furthermore, any defect, objection or fault found with Applicant's goods and services marketed

under Applicant's Marks would necessarily reflect upon and seriously injure the reputation which the Opposer has established for its goods and services.

17. There is no issue as to priority. Opposer began using its APPLE Marks in commerce since at least as early as 1977, well prior to the May 14, 2007 filing date of Applicant's intent-to-use based applications.

18. If Applicant is granted the registrations herein opposed, it would thereby obtain a *prima facie* exclusive right to the use of Applicant's Marks. Such registrations would be a source of damage and injury to Opposer.

**WHEREFORE**, Opposer requests that this opposition be sustained and that the registration of Application Serial Nos. 77/179,942 and 77/179,968 be denied.

The opposition fee in the amount of \$3,000.00 for an opposition in ten classes is filed herewith. If for any reason this amount is insufficient, it is requested that Opposer's attorneys' Deposit Account No. 11-0860 be charged with any deficiency. This paper is filed electronically.

Dated: New York, New York  
January 16, 2008

Respectfully submitted,

**KILPATRICK STOCKTON LLP**

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Christopher Lick

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*Attorneys for Opposer Apple Inc.*