

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

In the Matter of Application Serial No. 77/525,433

For the mark: APP STORE

Filed: July 17, 2008

Published: January 5, 2010

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MICROSOFT CORPORATION,	:	
	:	Opposition No. 91195582
Opposer,	:	
	:	ANSWER TO NOTICE OF
	:	OPPOSITION
v.	:	
	:	
APPLE INC.,	:	
	:	
Applicant.	:	

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APPLE INC. (“Applicant”), a corporation organized and existing under the laws of California with a principal place of business at 1 Infinite Loop, Cupertino, California 95014, answers the Notice of Opposition filed by Microsoft Corporation (“Opposer”) as follows:

Applicant admits that it owns Application Serial No. 77/525,433 for the APP STORE mark, which was published for opposition in the *Official Gazette* on January 5, 2010, and for which Opposer filed and was granted extensions of time to oppose. Applicant denies the remainder of the allegations in Opposer’s first unnumbered paragraph.

1. Applicant admits that Opposer develops and markets computer software programs and products relating thereto. Applicant lacks information sufficient to form a belief as to the truth or falsity of the remaining allegations contained in Opposer’s first numbered paragraph and therefore denies same.

2. Applicant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Opposer’s second numbered paragraph and therefore denies same.

3. Applicant admits that the word “applications” in the context of computer programming refers to computer software designed to allow users of that software to perform specific tasks. Applicant denies the remainder of the allegations in Opposer’s third numbered paragraph because such allegations lack context and are too vague to permit Apple to fully and adequately respond thereto.

4. Applicant denies the allegations in Opposer’s fourth numbered paragraph except Applicant admits that in certain contexts individuals have used the word “app” as a short-hand reference to “applications.”

5. Applicant admits that Exhibits 1 and 2 attached to Opposer’s Notice of Opposition reflect pages from Applicant’s website located at Apple.com and denies the remainder of the allegations in Opposer’s fifth numbered paragraph. Applicant further states that its APP STORE mark, as a result of the hundreds of thousands of programs offered on Apple’s APP STORE service, the millions of users that have accessed the service, and the billions of downloads obtained by such users through the service, has become one of the most famous marks in the field of online computer software and information services.

6. Applicant admits that Exhibit 3 attached to Opposer’s Notice of Opposition purports to reflect dictionary definitions for the words “app” and “application.” Applicant admits that Exhibit 4 attached to Opposer’s Notice of Opposition purports to reflect a dictionary definition for the word “app.” Applicant admits that Exhibit 5 attached to Opposer’s Notice of Opposition purports to reflect a dictionary definition for the word “app.” Applicant denies the remainder of the allegations in Opposer’s sixth numbered paragraph.

7. Applicant admits that Exhibits 6 and 7 attached to Opposer’s Notice of Opposition reflect dictionary definitions for the word “store.” Applicant denies the remainder of

the allegations in Opposer's seventh numbered paragraph and specifically denies that the word "STORE" is generic when used in connection with services outside of sales of physical goods through traditional brick and mortar retail establishments.

8. Applicant admits the allegations in Opposer's eighth numbered paragraph, but notes that a disclaimer of the term "store" is not an admission that the term is generic.

9. Applicant denies the allegations in Opposer's ninth numbered paragraph. Applicant further specifically states that its APP STORE mark is, as evidenced by the enormous reputation, goodwill and fame the mark has developed, clearly capable of identifying and distinguishing Apple as the source of the services offered under the mark.

10. Applicant denies the allegations contained in Opposer's tenth numbered paragraph and further states that any unauthorized use of the APP STORE mark by retailers is an attempt to trade on the goodwill associated with Applicant's well-known APP STORE mark in violation of Applicant's rights in the APP STORE mark.

11. Applicant denies the allegations contained in Opposer's eleventh numbered paragraph and further states that such vernacular uses of the APP STORE mark by trade press are not inconsistent with Apple's rights in its APP STORE mark. Applicant further asserts that the vastly predominant usage of the expression "app store" in trade press is as a reference to Apple's extraordinarily well-known APP STORE mark and the services rendered by Apple thereunder.

12. Applicant denies the allegations contained in Opposer's twelfth numbered paragraph and further states that such vernacular uses of the APP STORE mark by the general press are not inconsistent with Apple's rights in its APP STORE mark. Applicant further asserts that the vastly predominant usage of the expression "app store" in general press is as a reference

to Apple's extraordinarily well-known APP STORE mark and the services rendered by Apple thereunder.

13. Applicant denies the allegations in Opposer's thirteenth numbered paragraph.

14. Applicant admits that Application Serial No. 77/525,433 for the APP STORE mark covers "Retail store services featuring computer software provided via the internet and other computer and electronic communication networks; Retail store services featuring computer software for use on handheld mobile digital electronic devices and other consumer electronics" in Class 35. Applicant denies the remainder of the allegations in Applicant's fourteenth numbered paragraph.

15. Applicant admits that Application Serial No. 77/525,433 for the APP STORE mark covers "Electronic transmission of data via the internet, global computer networks, wireless networks and electronic communication networks; Providing access to global computer networks, wireless networks and electronic communications networks for transmission or receipt of data" in Class 38 and "Maintenance, repair and updating of computer software; Providing a website featuring technical information relating to computer software provided; Providing computer software consulting services; technical support services, namely, troubleshooting in the nature of diagnosing and repairing computer software problems; computer services, namely, providing search engines for obtaining data via electronic communications networks; Providing temporary use of non-downloadable computer software to enable users to program, organize and access audio, video, text, multimedia content and third-party computer software programs; Internet services, namely, creating indexes of information, sites, and other resources available on global computer networks for others; Searching and retrieving information, sites, and other resources available on global computer networks and other electronic communication networks

for others" in Class 42. Applicant denies the remainder of the allegations in Opposer's fifteenth numbered paragraph.

16. Applicant denies the allegations in Opposer's sixteenth numbered paragraph.
17. Applicant denies the allegations in Opposer's seventeenth numbered paragraph.
18. Applicant denies the allegations in Opposer's eighteenth numbered paragraph.
19. Applicant denies the allegations in Opposer's nineteenth numbered paragraph.

FIRST AFFIRMATIVE DEFENSE

Opposer's Notice of Opposition fails to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

Applicant reserves the right to amend its answer to add additional or other affirmative defenses as may become necessary after a reasonable opportunity for appropriate discovery.

WHEREFORE, Applicant requests dismissal of the Notice of Opposition and the issuance of a registration of its Application Serial No. 77/525,433 and such other and further relief as may be just and proper.

Dated: August 16, 2010

Respectfully submitted,

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Attorneys for Opposer Apple Inc.

CERTIFICATE OF TRANSMITTAL

I hereby certify that a true copy of the foregoing ANSWER TO NOTICE OF OPPOSITION is being filed electronically with the TTAB via ESTTA on this day, August 16, 2010.

/s/ Joseph Petersen
Attorney for Applicant Apple Inc.