

ESTTA Tracking number: **ESTTA496938**

Filing date: **09/27/2012**

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

Proceeding	91199897
Party	Defendant Apple Inc.
Correspondence Address	GLEN A GUNDERSEN DECHERT LLP CIRA CENTRE, 2929 ARCH STREET PHILADELPHIA, PA 19104-2808 UNITED STATES glenn.gundersen@dechert.com, christine.hernandez@dechert.com, trademarks@dechert.com
Submission	Response to Board Order/Inquiry
Filer's Name	Glenn A. Gundersen
Filer's e-mail	trademarks@dechert.com, glenn.gundersen@dechert.com, christine.hernandez@dechert.com
Signature	/Glenn A. Gundersen/
Date	09/27/2012
Attachments	91199897 Final.pdf (26 pages)(3223946 bytes)

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

In re the matter of Application Serial No: 85/041,463

Mark:



Published in the *Official Gazette* on April 19, 2011

SAMSUNG ELECTRONICS, LTD.

Opposer,

v.

APPLE INC.

Applicant.

Opposition No. 91199897

RESPONSE TO BOARD INQUIRY

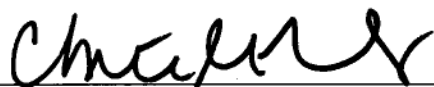
In response to the Board's August 28, 2012 Order, Applicant, Apple Inc., submits this update on the status of the federal court litigation involving the parties and respectfully requests that the Board resume the present proceeding.

In its August 25, 2011 order, the Board suspended this Opposition pending the resolution of Applicant's then-pending claims against Opposer and Opposer's affiliates, Samsung Electronics America, Inc. and Samsung Telecommunications America, LLC, in the U.S. District Court for the Northern District of California (the "District Court Litigation"). As noted by the Board, in the District Court Litigation Apple asserted that Samsung infringed Apple's trade dress rights in its iPhone, iPad and iPod touch devices, including the purple eighth-note icon that is at issue in this proceeding (the "iTunes Icon"). In its answer and counterclaims, Samsung asserted that the iTunes Icon, among other elements, was not protectable and sought a declaration that the application at issue was invalid. *See* Dkt. No. 13.

However, in the ultimate trial, Apple did not present its claims concerning Samsung's infringement of the iTunes Icon to the jury. As a result, Samsung's counterclaims concerning the iTunes Icon were mooted and were not tried to the jury. *See* Ex. A (Amended Verdict Form). Given the narrowing of the parties' claims in the District Court Litigation, that proceeding no longer has any bearing on this Opposition. The jury's decision does not address whether the iTunes Icon is distinctive and protectable or Opposer's contention that the iTunes Icon does not function as a trademark, and will not be at issue in any subsequent appeal. While the parties in the District Court Litigation are conducting additional briefing on certain non-jury claims, that briefing is limited to various equitable issues and again does not implicate the iTunes Icon. *See* Ex. B (Order Granting in Part Apple's Motion Regarding Schedule for Briefing of Non-Jury Claims). Accordingly, pursuant to TBMP 501.02, Applicant respectfully requests that the Board resume this proceeding.

Date: September 27, 2012

By:



Glenn A. Gundersen
Christine M. Hernandez
Dechert LLP
Cira Centre, 2929 Arch Street
Philadelphia, PA 19104-2808
Telephone: 215-994-2183

Attorneys for Applicant
APPLE INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Response to Board Inquiry has been duly served by mailing such copy first class, postage prepaid to Michael T. Zeller, Quinn Emanuel Urquhart & Sullivan, LLP, 856 South Figueroa Street, 10th Floor, Los Angeles, CA 90017-2543, on September 27, 2012.


Christine M. Hernandez

EXHIBIT A

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

APPLE INC., a California corporation,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD.,

a Korean corporation;

SAMSUNG ELECTRONICS AMERICA, INC.,

a New York corporation;

SAMSUNG TELECOMMUNICATIONS

AMERICA, LLC,

a Delaware limited liability company,

Defendants.

Case No.: 11-CV-01846-LHK

AMENDED
VERDICT FORM

SAMSUNG ELECTRONICS CO., LTD.,

a Korean corporation;

SAMSUNG ELECTRONICS AMERICA, INC.,

a New York corporation;

SAMSUNG TELECOMMUNICATIONS

AMERICA, LLC,

a Delaware limited liability company,

Counterclaim-Plaintiffs,

v.

APPLE INC., a California corporation,

Counterclaim-Defendant.

We, the jury, unanimously agree to the answers to the following questions and return them under the instructions of this Court as our verdict in this case.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.