

# Intellectual Property Alert

## March 2010

### Apple's iPod does not stop dop*i*

Apple Inc has failed in a bid to stop registration of the trade mark dop*i* (ipod in reverse) and the notoriety of the iPod trade mark was a factor that worked against Apple in this case.

Apple Inc., the owner of the iPod products and trade mark, has failed to stop another company's registration of the trade mark dop*i* (ipod in reverse), including for goods used with iPod products. While the iPod products and trade mark are very well known, this reputation in itself was a factor which worked against Apple in this [case](#).

#### Facts

Apple has numerous Australian trade mark registrations consisting of, or containing, the word IPOD, including in respect of computers, computer related devices, music playing devices, mobile phones and accessories (**IPOD Marks**). One of its most successful products since 2001 is its IPOD portable music player (**IPOD Player**).

The company Wholesale Central Pty Ltd applied to register the following trade mark in Australia:

(dop*i* Mark)



for goods including carry bags and accessories for laptop and personal computers, portable sound devices, mobile phones and accessories.

Wholesale Central marketed goods specifically designed for use with Apple's goods, including covers and cases for the IPOD Player, iPhone mobile phones and Macbook laptops.

IP Australia (**IPA**) accepted the dop*i* Mark for registration but Apple opposed registration and the opposition proceeded to a hearing by IPA.

Apple argued against the registration of the dop*i* Mark under the *Trade Marks Act, 1995 (Act)*, relying on grounds that:

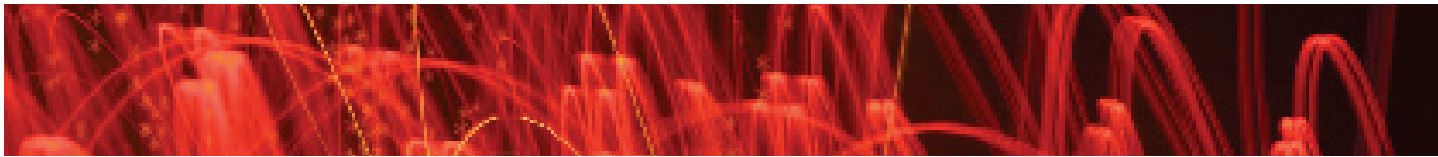
- The dop*i* Mark was deceptively similar to the earlier IPOD Marks and covered similar goods (**Similar Mark Ground**); and
- There was a reputation in the trade mark IPOD at the date that the dop*i* Mark was lodged and, as a result of that reputation, the use of the dop*i* Mark would be likely to deceive or cause confusion (**Reputation Ground**).

#### IPA's Decision

In respect of the Similar Marks Ground, IPA accepted that the dop*i* Mark covered similar goods to the goods of the IPOD Marks. However, as discussed below, this ground of opposition failed in relation to the deceptive similarity requirement.

Apple uses various "i" prefix marks like iPod, iMac and iTunes and argued that Wholesale Central was trying to "piggy-back on the fame of the ipod trade mark and the association implicit in the use of the lower case "i" in the industry", presumably being with Apple products.

However, the hearing officer found that various other parties had registered "i" prefix trade marks (**i Marks**), such as, iSoft and iSkin, in respect of the relevant goods and had used i Marks, including in respect of accessories for the IPOD Player. Apple could not claim a monopoly in such marks.



Ultimately, the hearing officer was not satisfied that “the person of ordinary intelligence and memory would be caused to wonder” whether Wholesale Central’s goods came from Apple merely because the dop*i*Mark ended with the letter “i”, nor because it consisted of the letters “ipod” in reverse. There was no evidence of confusion between the parties’ respective trade marks, which were both in use, and the hearing officer was influenced by “the ubiquitous nature of the IPOD mark” in finding that the dop*i*Mark was not deceptively similar to it. That is, the IPOD trade mark was so well known that this tended to lessen the risk of deception or confusion among consumers arising from the use of the dop*i*Mark.

In respect of the Reputation Ground, the hearing officer accepted that the IPOD trade mark was very well known in Australia at the relevant date. However, he found that the use of the dop*i*Mark was not likely to deceive or cause confusion. This was because of the obvious differences between the dop*i*Mark and the IPOD trade mark when compared as wholes, the fact that other traders used “i” Marks in respect of relevant goods and the absence of evidence of actual confusion in the market.

well known. In fact, the notoriety of a trade mark may ultimately work against it in a trade mark opposition or other dispute. In this case, the fact that consumers knew the IPOD trade mark so well, tended to militate against them confusing dop*i* goods with IPOD goods, in the view of the hearing officer. While Apple uses various i Marks in respect of its goods, it could not claim a monopoly in marks of this kind.

**Catherine Chant**  
Special Counsel

### Comment

There is no general rule against the registration in reverse order of a word mark which is already registered, even where, as in this case, the earlier registered mark is

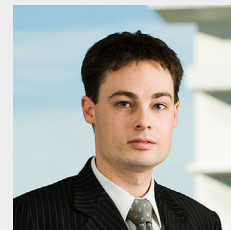
## For further information please contact:



**Peter Le Guay**  
Partner  
+61 2 8248 3424  
peter.leguay@thomsonplayfordcutlers.com.au



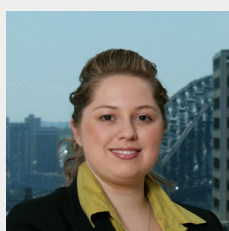
**Catherine Chant**  
Special Counsel  
+61 2 8248 3427  
catherine.chant@thomsonplayfordcutlers.com.au



**Matthew Prescott**  
Senior Associate  
+61 8 8236 1147  
matthew.prescott@thomsonplayfordcutlers.com.au



**Andrew Roff**  
Lawyer  
+61 8 8236 1149  
andrew.roff@thomsonplayfordcutlers.com.au



**Katarina Smolic**  
Lawyer  
+61 2 8248 3439  
katarina.smolic@thomsonplayfordcutlers.com.au