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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
OAKLAND DIVISION

APPLE COMPUTER, INC.,  
  
Plaintiff,  
  
v.  
  
PODFITNESS, INC., and DOES 1-100,  
Inclusive,  
  
Defendants.

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PODFITNESS, INC.,  
  
Counterclaim Plaintiff,  
  
v.  
  
APPLE COMPUTER, INC.,  
  
Counterclaim Defendants.

Case No. C 06-05805 SBA  
  
**[PROPOSED] ORDER GRANTING  
DEFENDANT'S MOTION FOR  
PARTIAL SUMMARY JUDGMENT**

1 The matter comes before the Court on defendant Podfitness, Inc.'s Motion for Partial  
2 Summary Judgment [Docket No. 102]. Having read and considered the arguments presented by  
3 the parties in the papers submitted to the Court, and for the reasons articulated below, the Court  
4 hereby GRANTS defendant's motion.

5 **I. BACKGROUND**

6 **A. APPLE**

7 **1. Overview**

8 Apple is a manufacturer of home computers and other electronic devices, including the  
9 iPod, a portable handheld digital media player (sometimes referred to as an "MP3" player) which  
10 is offered and sold under the trademark "IPOD." (See First Amended Complaint ("FAC") ¶ 2.)  
11 Apple introduced the iPod with the IPOD mark on or about October 23, 2001. (See FAC ¶ 9).  
12 Apple's iPod products are marketed through, among other things, certain department stores,  
13 member-only warehouse stores, large retail chains, and specialty retail stores, as well as through  
14 the channels for Apple's Mac products, and also through its website and online store  
15 (www.apple.com/store). (See Declaration of Gregory Wayment ("Wayment Decl.") ¶ 3, Ex. 1  
16 and 2). Apple does not market any products under the "POD" mark.

17 **2. Registration of the IPOD Mark**

18 Apple holds three federal trademark registrations for the IPOD mark. Two of them cover  
19 "portable and handheld digital electronic devices ... (and) computer software for use ... on  
20 portable and handheld digital electronic devices," and the other pertains to "public Internet kiosk  
21 enclosure containing computer hardware." (See FAC ¶¶ 15-17). Apple also has applied to  
22 register nine additional IPOD-related marks. (See FAC ¶¶ 18-19, 21-27).

23 Apple submitted its first trademark applications to the U.S. Patent and Trademark Office  
24 ("PTO") in October 2001. (FAC ¶ 15-16.) These applications were rejected by the PTO. (See  
25 Wayment Decl. ¶ 5, Ex. 3). In its Office Action denying Application No. 75/982,871 ("871  
26 Application"), dated October 21, 2001, the PTO indicated that while there were no similar  
27 registered marks, there were six similar applications that had been filed *prior* to the '871  
28 Application, and that "(t)here may be a likelihood of confusion between the applicant's mark and

1 the marks in the above-noted applications . . . .” (Id. ¶ 5, Ex. 3 at 1.) Notably, of the six prior  
2 registrations, three were for the exact same “IPOD” mark, two were for “POD”, and one was for  
3 “IPODZ.” (Wayment Decl. ¶ 5, Ex. 3 at 1 and 4-10.)

4 To assuage the PTO’s concerns and ultimately convince the PTO to approve its  
5 applications, Apple expressly represented that there was “*no likelihood of confusion between*  
6 *Applicant’s mark and the prior-filed marks*” because (among other things) the “IPOD” was  
7 different in appearance and sound from the “POD” mark. (Id. ¶ 6, Ex. 4 at 2 and 3-10 (emphasis  
8 added)). Citing the multi-factor test of In Re E.I. DuPont de Nemours & Co., 426 F. 2d 1357,  
9 1361-62 (U.S.C.C. Pa. 1973), Apple first argued its goods were unrelated to the goods/services  
10 sold under the prior marks, and that they were marketed to different consumers. (See Wayment  
11 Decl. ¶ 6, Ex. 4 at 3-6.) Particularly germane here, Apple vigorously argued that POD and  
12 IPODZ were “*clearly different*” from IPOD in “appearance, pronunciation, meaning, and  
13 commercial impression” thus making “confusion *unlikely*.” (Id. ¶ 6, Ex. 4 at 5, (emphasis  
14 added)).

15 Apple also emphasized to the PTO that potential customers would exercise sufficient care  
16 that they would not be confused. Specifically, Apple claimed that “(c)onsumers are likely to use  
17 care in purchasing expensive goods. DuPont, 426 F. 2d at 1361-62. Apple’s IPOD product sells  
18 for about \$400-\$500.... Individual consumers of prestige personal electronics devices such as  
19 Apple’s IPOD player are also mindful of brand sources. These two consumer groups – distinct  
20 from each other but both focused on distinguishing product source – *are not likely to mistakenly*  
21 *believe that Apple’s IPOD and the various applied-for goods are related with respect to source.*”  
22 (Id. ¶ 6, Ex. 4 at 6 (emphasis added)).

23 Finally, Apple argued that any possible confusion with the prior marks was further  
24 reduced because Apple’s goods were sold in entirely distinct sales channels than the prior  
25 applicant’s products and services. As a result, Apple claimed that there was no “interface”  
26 between Apple and the prior applicants. (Id. ¶ 6, Ex. 4 at 7.) Apple later reiterated its position  
27 “that the well-known Apple IPOD music player *could not be confused as to source* with the  
28 unrelated goods in the referenced applications.” (Id. ¶ 7, Ex. 5 (emphasis added)).

1 Relying on Apple’s detailed representations and explanation as to why their IPOD  
2 registration would not be confusing given the preexisting registrations, the PTO approved  
3 Apple’s trademark application on April 27, 2004, and issued Trademark Registration No.  
4 2,835,698. (See FAC ¶ 16 and Ex. B thereto).

5 **3. Apple Does Not Own Any Rights to “POD”**

6 On July 29, 2004, Apple filed United States Trademark Application Serial No.  
7 78/459,101 for the “POD” mark. (See FAC ¶ 28). However, Apple’s application is based upon  
8 an *intent to use*, rather than on actual past use. Apple has no *registration* for “POD”, and the  
9 registration has been opposed and challenged by a number of parties.

10 **B. PODFITNESS**

11 **1. Podfitness’ Business is Limited to Exercise and Fitness**

12 Podfitness is an Internet-based company that markets an innovative customized audio  
13 personal training *service*. Subscribers to Podfitness’ service can create individually-tailored  
14 downloadable fitness workouts that can be downloaded to and played through the user’s portable  
15 digital media player, such as Microsoft’s Zune player, an iPod, or virtually any other MP3 music  
16 player. Each user is able to select from a multitude workout regimes designed by a wide array of  
17 well known fitness trainers. The workout is tailored specifically to each user’s fitness profile,  
18 personal goals and available equipment. (See Declaration of Jeff Hays (“Hays Decl.”) ¶¶ 8, 10-  
19 12, 14 and Ex. B). According to Podfitness, one of the unique features of their service is that it  
20 allows the user to combine the custom workouts with music tracks on the subscriber’s portable  
21 digital media player to create a dynamic and unique workout experience.

22 Podfitness does not sell iPods, MP3 players or any other type of portable digital media  
23 device nor does it sell music. In its website, Podfitness makes it clear that is not affiliated with  
24 Apple. And although Podfitness’ website indicates that its service is compatible with the iPod,  
25 Podfitness also emphasizes but may be used on any number of digital media players, such as the  
26 competing Microsoft Zune. (*Id.* ¶¶ 15-16, 18-21 and Ex. B). Likewise, Podfitness’ sites and  
27 advertising include an unequivocal disclaimer, stating that “iPod is a registered trademark of  
28 Apple, Inc. Podfitness is *not affiliated with or endorsed or supported by Apple, Inc.*” (See *id.*

1 ¶ 25 and Ex. B, passim (emphasis added)).<sup>1</sup>

## 2                   **2.       The Podfitness Name**

3               The name Podfitness was chosen partly in response to the increasing popularity of the  
4 term “podcast” or “podcasting,” but also because it was a domain name still available to  
5 purchase. At the time, because of the media and other discussion about the popularity of  
6 podcasts, the word “pod” had a number of meanings, including primarily reference to the generic  
7 category of MP3 players, the “pod” in “podcast,” “portable on demand,” a small thing connected  
8 to a larger thing, and the iPod product. (Hays Decl. ¶¶ 2-4, 26 and Ex. D at 65-68, 100, 212).  
9 The word “podcast” (which was named “word of the year” for 2005 by the New Oxford  
10 American Dictionary) is a generic term meaning a digital recording made available on the  
11 Internet for downloading to a personal audio player or computer. (See Hays Decl. ¶ 3 and Ex.  
12 A). Podfitness sells fitness podcasts, except that unlike traditional podcasts, the Podfitness  
13 product is individually created and customized for the consumer. (See Hays Decl. ¶ 4).

## 14                   **C.       PROCEDURAL SUMMARY**

15               On September 21, 2006, Apple filed a Complaint in this Court against Podfitness alleging  
16 eight claims for relief against Podfitness. On August 1, 2007, Apple filed its First Amended  
17 Complaint, adding two additional claims (for a total of ten claims) for relief. Seven of Apple’s  
18 ten claims for relief are premised upon a theory that defendant’s use of its “Podfitness”  
19 trademark infringes Apple’s IPOD trademark and otherwise violates the federal Lanham Act and  
20 California law.<sup>2</sup> Podfitness now moves for summary judgment on these claims, specifically  
21 Apple’s first, second, fourth, fifth, sixth, seventh and eighth claims for relief.

## 22                   **II.       LEGAL STANDARD**

23               Summary judgment is appropriate if no genuine issue of material fact exists and the  
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25 <sup>1</sup> In fact, the first version of Podfitness was not compatible with Apple’s Mac product, and could  
26 only be used through the Microsoft Windows platform. (See Hays Decl. ¶ 26 and Ex. D at 293-  
27 294). Today, the Podfitness homepage prominently states that “Podfitness is now allied with  
28 Microsoft Health Vault,” and prominently displays Microsoft, a rival of Apple, as the first of  
Podfitness’ corporate partners. (See Hays Decl. ¶ 12 and Ex. B).

<sup>2</sup> This order does not address Apple’s remaining claims based upon trade dress infringement,  
breach of contract and cyber squatting.

1 moving party is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c); Celotex Corp.  
2 v. Catrett, 477 U.S. 317, 322-23 (1986). The party moving for summary judgment must  
3 demonstrate there are no genuine issues of material fact. See Horphag v. Research Ltd. v. Garcia,  
4 475 F.3d 1029, 1035 (9th Cir.2007). A factual dispute is genuine only if the non-moving party  
5 can offer “concrete evidence” such that a reasonable jury could return a verdict in its favor. See  
6 Anderson v. Liberty Lobby, 477 U.S. 242, 256 (1986). The burden on the moving party may be  
7 discharged by identifying to the court “that there is an absence of evidence to support the non-  
8 moving party’s case.” See Celotex, 477 U.S. at 325.

9 This Court has recognized that summary judgment on trademark infringement issues such  
10 as likelihood of confusion is appropriate where “there are no facts in dispute and the issue of  
11 confusing similarity is based solely upon a comparison of the marks in the context of extrinsic  
12 facts.” JouJou Designs, Inc. v. JOJO Ligne Internationale, Inc., 821 F. Supp. 1347, 1352 (N.D.  
13 Cal. 1992).

### 14 **III. ANALYSIS**

#### 15 **A. LIKELIHOOD OF CONFUSION**

16 To prevail on its trademark claim, Apple must plead and prove that Podfitness is likely to  
17 confuse its customers into believing that they are dealing with Apple. Instant Media, Inc. v.  
18 Microsoft Corp., 2007 WL 2318948 at \*6 (N.D. Cal. 2007). “The test for likelihood of  
19 confusion is whether a reasonably prudent consumer in the marketplace is likely to be confused  
20 as to the origin of the good or service bearing one of the marks.” Dreamwerks Prod. Group, Inc.  
21 v. SKG Studio, 142 F.3d 1127, 1129 (9th Cir. 1998) (internal quotation marks and citation  
22 omitted). Confusion must be “probable, not simply a possibility.” Cohn v. Petsmart, Inc., 281  
23 F.3d 837, 842 (9th Cir. 2002) (per curiam) (internal quotation marks omitted)

24 To assess the likelihood of confusion, the court generally considers the eight non-  
25 exclusive factors articulated in AMF Inc. v. Sleekcraft Boats, 599 F. 2d 341, 348-49 (9th Cir.  
26 1979). The Speedcraft factors are: (1) strength of the mark; (2) proximity or relatedness of the  
27 goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used;  
28 (6) type of goods and the degree of care likely to be exercised by the purchaser; (7) likelihood of

1 expansion of the product lines; and (8) defendant’s intent in selecting the mark (“Sleekcraft  
2 factors”).

3 Where the Internet is involved, “the three most important Sleekcraft factors in evaluating  
4 a likelihood of confusion are (1) the similarity of the marks, (2) the relatedness of the goods and  
5 services, and (3) the parties’ simultaneous use of the Web as a marketing channel.” Interstellar  
6 Starship Servs. Ltd. v. Epix, Inc., 304 F. 3d 936, 942 (9th Cir. 2002). This analysis, commonly  
7 referred to as the “controlling troika” or “Internet trinity,” id., applies here since it there is no  
8 dispute Podfitness’ primary business is through the Internet.

9 **B. SIMILARITY OF THE MARKS**

10 **1. Apple is Estopped from Claiming a Likelihood of Confusion**

11 Podfitness argues that Apple is estopped from claiming a likelihood of confusion in light  
12 of its prior representations to the PTO. The Court agrees. It is well settled that a party cannot  
13 seek to enforce its trademark rights by taking a position contrary to statement it made to the PTO  
14 in obtaining approval of its trademark application. See Instant Media, 2007 WL 2318948, at \*8-  
15 9, 10-11, 13; Freedom Card, Inc. v. JP Morgan Chase & Co., 432 F. 3d 463, 476 (3d Cir. 2005);  
16 accord Top Tobacco, L.P. v. North Atlantic Ops. Co., 509 F. 3d 380 (7th Cir. 2007); Petro  
17 Stopping Ctrs., L.P. v. James River Petroleum, Inc., 130 F. 3d 88, 94 (4th Cir. 1997); Lampi  
18 Corp. v. American Power Products, Inc., 1995 WL 723764 at \*3 (N.D. Ill. Dec. 5, 1995).

19 Here, in an effort to overcome the PTO’s rejection of its trademark applications, Apple  
20 expressly represented to the PTO that there was no likelihood of confusion between IPOD and  
21 POD (or POD formative marks). As noted, the PTO initially rejected Apple’s application for the  
22 IPOD mark based upon a perceived likelihood of confusion between “IPOD” and *prior*  
23 applications for the marks “POD,” “IPOD,” and “IPODZ.” Apple convinced the PTO to  
24 reconsider its rejection by arguing that the sight, sound and meaning of its proposed IPOD mark  
25 and the POD and IPODZ marks were so dissimilar that no confusion was likely. For example,  
26 Apple asserted to the PTO that its IPOD mark was “*clearly different in appearance and sound*”  
27 from the POD and IPODZ marks. (See Wayment Decl. ¶ 6, Ex. 4 at 6 (emphasis added)).  
28 Significantly, Apple emphasized – *not* the “pod” portion of its mark, but rather *the use of the “i”*

1 *in the mark*, which Apple claimed distinguished the IPOD mark from the others. (See *id.* ¶ 6, Ex.  
2 4 at 6.)

3 Whether viewed “as judicial estoppel, an admission, waiver, or simply hoisting [Apple]  
4 by its own petard,” Apple’s prior statements that IPOD would not be confused with POD  
5 forecloses their present claim regarding the likelihood of confusion. Card, Inc. v. JPMorgan  
6 Chase & Co., 432 F.3d 463, 476 (3rd Cir. 2005); Instant Media, 2007 WL 2318948 at \*8. The  
7 Court thus agrees that Apple is judicially estopped from now arguing that its mark is similar to  
8 PODFITNESS, that “pod”-formative marks (i.e., anything without the crucial “i”) are similar to  
9 its IPOD trademark, and from asserting any rights based upon “pod.” Apple’s sight, sound and  
10 meaning disclaimers to the PTO call for the application of the rule of Instant Media, Lampi, and  
11 Freedom Card.

## 12 2. No Likelihood of Confusion

13 Estoppel aside, the Court finds that there is an insufficient similarity to establish the  
14 requisite likelihood of confusion. Similarity of marks “has always been considered a critical  
15 question in the likelihood-of-confusion analysis.” GoTo.com, Inc. v. Walt Disney Co., 202 F. 3d  
16 1199, 1205 (9th Cir. 2000). To assess similarity, the court must compare the sight, sound and  
17 meaning of the marks. Surfvivor Media, 406 F. 3d at 631. A comparison of the IPOD and  
18 PODFITNESS marks shows they are dissimilar in sight, sound and meaning, and confusion is  
19 unlikely as a matter of law.

20 First, the terms IPOD and PODFITNESS are strikingly different in *appearance*:

21 The image shows two logos side-by-side. On the left is the logo for Podfitness.com, where 'Pod' is in a light green color, 'fitness' is in a medium green color, and '.com' is in a dark green color. On the right is the logo for iPod, where 'i' is in a light grey color and 'Pod' is in a dark grey color.

22  
23  
24 (See Hays Decl. ¶ 7). “Podfitness” has ten letters while “IPOD” only has four letters. The only  
25 common sequential letters, “pod,” appear at the end of the IPOD mark, while it appears at the  
26 beginning of the “Podfitness” mark. Further, PODFITNESS is typically written in green  
27 lettering, with light green for the “pod” portion, medium green for the “fitness” portion, and dark  
28 green for the “.com” portion of the mark. In contrast, the IPOD mark is typically in grey text,



1 with no differentiation in color. PODFITNESS also begins with a capital letter, while IPOD  
2 begins with the lower-case “i” – which particularly is significant given Apple’s stated emphasis  
3 that the “i” is what distinguishes its products. In addition, the visual comparison of the marks  
4 shows that they are plainly dissimilar. Finally, the Apple and Podfitness websites are strikingly  
5 different and, as noted below, call for completely different types of customer interaction. (See  
6 Hays Decl. ¶¶ 8-12, 15, 17-18, 23-24 and Ex. B); (See Wayment Decl. ¶ 3 and Ex. 1).

7 Second, the marks *sound* entirely dissimilar when spoken. IPOD has just two syllables  
8 and begins with a hard “i” sound, with the phonetic emphasis on the “I,” while PODFITNESS  
9 has three syllables, begins with the “pod” sound, with the phonetic emphasis on “fitness.”

10 Third, while the term “IPOD” appears to have no particular *meaning*, the word “fitness”  
11 in “Podfitness” invokes health and exercise, concepts clearly not embodied in “IPOD.”  
12 Moreover, in the *context* in which they are used, there is no likelihood of confusion as the  
13 Podfitness website is completely different from the Apple site, includes disclaimers of any  
14 association with Apple on virtually every page, and prominently states, including on its home  
15 page, that Podfitness is a partner with Apple’s chief rival, Microsoft. (See Hays Decl. ¶ 12, 25,  
16 26 and Ex. B).

17 The mere fact that both IPOD and PODFITNESS use the word “pod” does not change the  
18 fact that these two marks, *as a whole and in context*, are plainly different. Aside from Apple’s  
19 successful argument to the PTO that the term “POD” is dissimilar and not confusing to its IPOD  
20 mark, the “anti-dissection” rule demands that the marks be compared *in their entirety*, and even  
21 the inclusion of a common elements, words or string of letters, does not make the marks  
22 confusingly similar. See Instant Media, 2007 WL 2318948 at \*8 (marks not similar “simply  
23 because they contain an identical or nearly identical word”).<sup>3</sup>

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24  
25 <sup>3</sup> This principle is uniformly accepted in federal case law. Moose Creek, Inc. v. Abercrombie &  
26 Fitch Co., 331 F. Supp. 2d 1214, 1229 (C.D. Cal. 2004) (concluding that “Moose” was not  
27 confusingly similar to “Moose Creek” because “on the whole they sound different because (one)  
28 contains an additional word”); Gruner + Jahr USA Publ’n v. Meredith Corp., 991 F. 2d 1072,  
1078 (2d Cir. 1993) (dissimilar elements distinguished marks, and “Parent’s Digest” did not  
infringe upon “Parents” magazine, despite common word “parents”); see also Top Tobacco, L.P.  
v. North Atlantic Operating Co., Inc., 2007 WL 4234454, at \*2 (C.A. 7 (Ill.) (noting that there

1           Moreover, the use of “Pod”, pod-formative, and even i-formative marks on the Internet is  
2 ubiquitous, and “POD” is used (among other things) more broadly and as a generic term for mp3  
3 players, podcasts, etc. (See Wayment Decl. ¶ 11, Ex. 9; ¶ 12, Ex. 10; ¶ 13, Ex. 11; ¶ 15, Ex.13;  
4 ¶¶ 16 and 17, Exs. 14-15; ¶ 19, Ex. 8. In addition, Apple holds no rights to POD – POD is not a  
5 registered mark belonging to Apple, and Apple has *never* used POD in commerce, let alone prior  
6 to the Podfitness mark.<sup>4</sup> See, e.g., Brookfield Communications, Inc. v. West Coast  
7 Entertainment Corp., 174 F. 3d 1036 (9th Cir. 1999) (“(A)n intent to use a mark creates no  
8 rights a competitor is bound to respect.”) (quoting Zazu Designs v. L’Oreal, S.A., 979 F. 2d 499,  
9 504 (7th Cir. 1992)).

10           Consequently, the Court concludes that the respective marks are not similar in sight,  
11 sound, or meaning and that there is no likelihood of confusion. See Alladin Plastics, 362 F. 2d at  
12 534 (summary judgment proper because there was no likelihood of confusion upon “simple  
13 comparison of the sound, appearance, and meaning of the two marks.”); Freedom Card, Inc. v.  
14 JPMorgan Chase & Co., 432 F. 3d 463, 482 (3rd Cir. 2005) (affirming summary judgment where  
15 there was no likelihood of confusion between “Chase Freedom” card and “Freedom Card”).

### 16           **C.       RELATEDNESS OF GOODS AND SERVICES**

17           The second factor of the “Internet trinity” pertains to the relatedness of the goods and  
18 services at issue. “The standard for deciding whether the parties’ goods or services are ‘related’  
19 is whether customers are ‘likely to associate’ the two product lines.” Survivor Media, Inc. v.  
20 Survivor Prods., 406 F. 3d 625, 633 (9th Cir. 2005). In that regard, the court considers “whether  
21 the buying public could reasonably conclude that the products came from the same source.” Id.  
22 Setting aside the fact that Apple previously represented goods or services bearing the POD mark  
23 are “unrelated” and are “not likely to be confused” with IPOD, the Court concludes that this  
24 factor weighs in favor of Podfitness.

25  
26           “is no doubt that ‘top’ is commonly used in the tobacco business”).

27  
28           <sup>4</sup> Apple has filed an “*intent to use*” application with the PTO for the POD mark, a *de facto*  
admission that Apple has never *used* “POD” in commerce, and thus will always be junior to the  
existing Podfitness mark. Apple’s application faces several oppositions.

1 It is undisputed that Podfitness does not sell iPods, mp3 players or any other portable  
2 digital media player device. Rather, Podfitness sells, on a subscription basis, customized,  
3 downloadable audio exercise workout routines conducted by celebrity trainers that can be played  
4 on any number of portable media players. Podfitness service is markedly different from Apple’s  
5 IPOD products, which consist of portable handheld digital electronic devices for recording,  
6 transmitting, manipulating and reviewing text, data, and audio files. In other words, the  
7 PODFITNESS mark identifies a *service* while the term “IPOD” describes a tangible, physical  
8 *product*, i.e., a portable media player. And though Podfitness’ services are compatible with and  
9 marketed to mp3 users generally, which includes iPod users, the services are marketed only to a  
10 limited segment of that market – mp3 users who are also interested in fitness and exercise. A  
11 user interested in music *but not fitness* has no need for Podfitness.

12 The Court also notes that Podfitness’ workouts programs and Apple’s iPod are not used  
13 for the same purpose, not reasonably interchangeable by consumers, and are not marketed to the  
14 same consumer class. In short, “the products ... are extraordinarily different within the context  
15 of the internet.” Instant Media, 2007 WL 2318948 at \*12. Confusion between the IPOD and  
16 PODFITNESS marks is unlikely and summary judgment is proper. See, e.g., Murray v. Cable  
17 Nat’l Broad. Co., 86 F. 3d 858, 861 (9th Cir. 1996) (affirming summary judgment for defendant  
18 where plaintiff’s consumer survey services offered were unrelated to television programming  
19 and related polling services); see also M2 Software, Inc. v. Madacy, 421 F. 3d 1073, 1082 (9th  
20 Cir. 2005) (finding that “sports related music” was “very significantly different” from music  
21 CDs).

#### 22 **D. MARKETING CHANNELS**

23 Both Apple and Podfitness sell products through the Internet. But, Apple indisputably  
24 advertises its products more widely and through different channels. Apple also sells IPOD  
25 products through brick and mortar stores, and widely advertises its iPod products on television.  
26 The average consumer is therefore unlikely to confuse the products even though both are  
27 presented on the Internet. See Instant Media, 2007 WL 2318948 at \*10 (sophistication of  
28 modern consumers requires comparing products on their merits, rather than lumped under

1 “general rubric of ‘Internet-related services’”).

2 **IV. REMAINING SLEEKCRAFT FACTORS**

3 The Court agrees that the Internet trinity of Sleekcraft factors alone are sufficient to  
4 justify summary judgment for Podfitness, and that the remaining factors “are relatively  
5 unimportant to the likelihood of confusion analysis in Internet-related cases.” Instant Media,  
6 2007 WL 2318948 at \*14. That said, the Court finds that consideration of those factors actually  
7 underscores that there is no likelihood of confusion.

8 **A. STRENGTH OF THE MARK**

9 The Court finds that the strength of the IPOD mark favors Podfitness. During discovery,  
10 Podfitness sought documents from Apple regarding its decision to select that name, but Apple  
11 refused to produce any such documents, claiming that they were irrelevant. (See Wayment Decl.  
12 ¶ 21, Ex. 19 at 1). Having taken that position, Apple is precluded from making any argument  
13 based on the strength of the mark. See Republic Tobacco, L.P. v. North Atlantic Trading Co.,  
14 Inc., 254 F. Supp.2d 985, 993 (N.D. Ill. 2002) (precluding argument of infringement in  
15 trademark case, and granting summary judgment, where party had refused to produce discovery  
16 on same issue); c.f., Zhang v. American Gem Seafoods, Inc., 339 F. 3d 1020, 1028 (9th Cir.  
17 2003) (affirming district court’s exclusion of evidence not produced during discovery).

18 Even if Apple were not foreclosed from arguing this factor, the Court finds Apple’s  
19 argument unconvincing. As Podfitness correctly points out, the word “pod” is ubiquitous and  
20 preexisted the iPod or even Apple as a company. The word “pod” also has multiple meanings  
21 and is separate and distinct in meaning from IPOD. Thus, assuming that IPOD is a strong mark,  
22 it is not based upon “pod,” as a stand-alone word.

23 Indeed, as Apple represented the PTO, it is the “i” in IPOD, not “pod” that identifies the  
24 product, as evidenced by Apple’s has a series of “i-formative” marks (i.e., iPhone, iMac, iTunes,  
25 etc.). The strength of the IPOD mark is inapt given Apple’s emphasis on the “i” in IPOD which  
26 appears nowhere in “Podfitness.” See Surfvivor Media, 406 F. 3d at 631-32 (minimal protection  
27 for arbitrary or fanciful marks “that have no connection with the actual product”). In contrast,  
28 the term “POD” lies in an extremely “crowded field, rendering it “weak as a matter of law.” See

1 Instant Media, 2007 WL 2318948 at \*12 (quoting PostX Corp. v. docSpace Co., Inc., 80 F.  
2 Supp, 2d 1056, 1061 (N.D. Cal. 1999)); accord Petro Stopping Centers, 130 F. 3d at 92.<sup>5</sup>

3 **B. INTENT TO INFRINGE**

4 The next Sleekcraft factor, intent to infringe, also favors Podfitness. There is no evidence  
5 that Podfitness intended to deceive the public into believing that it was Apple. Podfitness  
6 expressly disclaims any such connection with Apple, and it is evident from the patent  
7 dissimilarity of the parties' respective marks that Podfitness had no intent to confuse consumers.  
8 See, e.g., Instant Media, 2007 WL 2318948, at \*16 (Microsoft's use of different color scheme,  
9 case, font and stylization elements was evidence of no unlawful intent). To the contrary, the  
10 record shows that it would be *detrimental* to Podfitness' business to confuse consumers into  
11 believing its business was *limited* to only iPod or iTunes users. (See Hays Decl. ¶ 15, 18, 25, 26  
12 and Ex. D at 169, 291, 293-295).

13 **C. EVIDENCE OF ACTUAL CONFUSION**

14 The evidence of actual confusion virtually is non-existent and consists only of a single  
15 email. (See Wayment Decl. ¶ 19, Ex. 17). The only relevant document cited Apple preexisted  
16 Podfitness' website and launch, and did not involve Podfitness' current website or advertising.  
17 (See Hays Decl ¶ 26 and Ex. D at 270-272). These two examples, in the context of thousands if  
18 not millions of consumers, are *de minimis*. Thus, rather than establishing likely confusion, the  
19 evidence establishes the converse. Microsoft, 126 F. Supp. 2d at 1217 (agreeing with Apple's  
20 contention that isolated incidents of actual confusion were insufficient to establish a genuine  
21 issue of material fact as to the likelihood of confusion).

22 **D. NO EVIDENCE OF A LIKELIHOOD OF EXPANSION**

23 Plans by either party to a trademark dispute to expand into directly competing areas *may*  
24 weigh in favor of confusion. Instant Media, 2007 WL 2318948, at \*16. Vague assertions of  
25 expansion, however, are insufficient. Id. Here, it is undisputed that Podfitness does not make or  
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27 <sup>5</sup> The Court notes that the PTO database reveals a plethora of POD-formative marks, and i-  
28 formative and even iPod-formative marks are ubiquitous on the Internet. (See Wayment Decl. ¶¶  
15-17 and Exs. 13, 14, and 15).

1 sell portable media players, nor does it plan to enter the portable media player market. (Hays  
2 Decl. ¶ 9).

3 **E. DEGREE OF CARE**

4 The next factor is the degree of care that a consumer is likely to exercise, from the  
5 standpoint of “typical buyer exercising ordinary caution.” Sleekcraft, 599 F. 2d at 353. ““When  
6 the goods are expensive, the buyer can be expected to exercise greater care in his purchases.””  
7 Instant Media, 2007 WL 2318948, at \*16 (citation omitted); Savin Corp. v. Savin Group., 391 F.  
8 3d 439, 461 (2d Cir. 2004) (assuming that purchasers of costlier trademarked products will be  
9 “more discriminating”). The Court finds that this factor favors Podfitness for several reasons.

10 First, due to their nature and cost of the products sold under the IPOD and PODFITNESS  
11 marks, consumers necessarily will exercise a high degree of care. Apple has acknowledged that  
12 “(c)onsumers are likely to use care in purchasing expensive goods. Apple’s IPOD product sells  
13 for about \$400 to \$500 . . .” (Wayment Decl. ¶ 6, Ex. 4 at 8). Similarly, Podfitness’ subscription  
14 service is relatively expensive, \$59.95 per quarter, or about \$240.00/year. (See Hays Decl. ¶ 22).

15 Second, unlike the purchase of a tangible good, a Podfitness subscription demands an  
16 ongoing and very high degree of care and commitment. To use Podfitness, the consumer must  
17 be interested in investing time and money on a workout or fitness program, and desire physical  
18 and time consuming interaction with the product. (See Hays Decl. ¶¶ 23-24 and Exs. B and C).  
19 Use of the Podfitness product and website requires the consumer’s active and thoughtful  
20 participation. Specifically, a user must customize the product for their personal needs, including  
21 by making numerous specific decisions which could involved hundreds (or thousands) of  
22 different possible combinations of decisions, and interacting with multiple screens and options –  
23 hardly a process promoting inadvertence or mistake. Some of the steps, including the *choice*  
24 between Microsoft’s Zune or Apple’s iTunes software, are reflected in a document sometimes  
25 called “Podfitness101,” which is available to users through the Podfitness webpage (See Hays  
26 Decl. ¶ 24 and Ex. C).

27 Third, as Apple told the PTO, “[i]ndividual consumers of prestige personal electronics  
28 devices such as Apple’s IPOD player are also mindful of brand sources.” (Wayment Decl. ¶ 6,

1 Ex. 4 at 7 [APD000051] (emphasis added).

2 Fourth, it takes a certain minimal level of sophistication to purchase, understand, operate,  
3 and use an iPod. A consumer must use not only the iPod but also a personal computer loaded  
4 with the iTunes software, which is necessary to manage the digital media files. The user must be  
5 computer literate and almost certainly be able to complete relatively complex transactions and  
6 procedures over the Internet.

7 Fifth, purchase and use of an iPod, or any MP3 player, is not an “impulse” purchase like  
8 a bag of nuts in the checkout line of the grocery store. Nor is the use of the Podfitness product.  
9 See, e.g., Beer Nuts, Inc. v. Clover Club Foods, Co., 805 F. 2d 920, 926 (10th Cir. 1986)  
10 (inexpensive snack foods purchased with little care).

11 Finally, and perhaps most decisively, there can be no confusion because the user of the  
12 Podfitness product must not only be sophisticated enough to understand and interact with the  
13 relatively time-consuming and complicated webpages, but as a necessary step a user must choose  
14 between using a Microsoft ZUNE format, or an Apple iTunes. (See Hays Decl. ¶ 21). In  
15 addition, in the “Getting Started” and “Frequently Asked Questions” sections of the Podfitness  
16 site, the user is told to select between the iPod, Microsoft’s Zune or *other* MP3 player.  
17 Certainly, no reasonable user would confuse Podfitness with Apple, given that Podfitness  
18 expressly provides instructions for a product manufactured by its chief rival, Microsoft.

19 In sum, Internet trilogy alone – and all of the Sleekcraft factors together – convince the  
20 Court that there is no likelihood of confusion. Therefore, Apple’s claims for trademark  
21 infringement under the Lanham Act fail as a matter of law.

22 **V. IN ANY EVENT, LIMITED USE OF THE “IPOD” MARK IS “FAIR USE”**

23 To the extent that Apple asserts claims based on Podfitness’ use of the IPOD mark in any  
24 of its advertising, such use is a “fair use” as a matter of law. See 15 U.S.C. § 1115(b)(4). Under  
25 Ninth Circuit law, “competitors may use a rival’s trademark in advertising and other channels of  
26 communication if the use is not false or misleading.” New Kids on the Block v. News America  
27 Publishing, Inc., 971 F. 2d 302, 307 (9th Cir. 1992); see also KP Permanent Make-Up, Inc. v.  
28 Lasting Impression I, Inc., 408 F. 3d 596, 607 (9th Cir. 2005).

1           The “nominative” branch of the fair use defense applies where a party uses a mark to  
2 describe the plaintiff’s product, as opposed to the defendant’s own product. See New Kids on  
3 the Block, 971 F. 2d at 308. Nominative fair use exists if: (1) the plaintiff’s product is not  
4 readily identifiable without use of the mark; (2) only so much of the mark is used as is  
5 reasonably necessary to identify the product; and (3) the defendant does nothing to suggest  
6 sponsorship or endorsement by the trademark holder. Id. Where these elements are established,  
7 summary judgment on a plaintiff’s trademark claims is appropriate. See, e.g., Rehrig Pacific  
8 CO. v. Norseman Plastics, Ltd., Inc., 2003 WL 25667625 at \*34 (C.D. Cal. 2003) (granting  
9 summary judgment on fair use defense); Gulfstream Aerospace Corp. v. Camp Systems Int’l,  
10 Inc., 428 F. Supp. 2d 1369, (S.D. Georgia 2006) (same).

11           First, it would be virtually impossible for Podfitness to inform consumers that its product  
12 was compatible with Apple’s iPod portable MP3 player without using the IPOD mark.<sup>6</sup> “Indeed,  
13 it is often *virtually impossible* to refer to a particular product for purposes of comparison,  
14 criticism, point of reference, or any other purpose without using the mark.” New Kids, 971 F. 2d  
15 at 306 (noting that “one might refer to the ‘two-time world champions’ or ‘the professional  
16 basketball team from Chicago,’ but it is far simpler (and more likely to be understood) to refer to  
17 the Chicago Bulls.”); Cairns v. Franklin Mint Co., 292 F. 3d 1139, 1152-53 (9th Cir. 2002)  
18 (explaining that “one might refer to the English Princess who died in a car crash in 1997 but it is  
19 far simpler (and more likely to be understood) to refer to Princess Diana.”). The first  
20 requirement of the fair use defense is satisfied as a matter of law. Rehrig, 2003 WL 25667625 at  
21 33 (summary judgment on fair use because defendant “had to identify the (plaintiff’s) products to  
22 ensure that its customers understood the products compatibility features.”); Gulfstream, 428 F.  
23 Supp. 2d at 1381 (summary judgment on fair use, first element established because defendant  
24 “must use the trademarked ‘Gulfstream’ name and identify each of the Gulfstream models it

25 \_\_\_\_\_  
26 <sup>6</sup> Obviously, the PODFITNESS mark does *not* use the IPOD mark. Many others make fair use  
27 of use of the latter mark, however, such as theipodaccessorystore.com; ipodcarparts.com;  
28 hipodgear.com; freeipodplayers.com; ipodhacks.com; iPodFanatic.com; allthingsipod.co.uk;  
everythingiPod.com, ipodgear.com, ipodtour.com, and ipodtraining.com. *See supra*. Thus,  
Podfitness’ reference to iPod in conjunction with its iPod-compatible product is not only fair use,  
but much less use of the IPOD mark than made by others in the iPod-accessory market.



1 services to offer a meaningful description to its customers”).

2 Second, it is axiomatic that Podfitness must inform consumers about the compatibility of  
3 the Podfitness product with the iPod, and to allow a user to choose to use Zune or iTunes  
4 software, and such references are limited to this purpose. (See Hays Decl. ¶ 18). See  
5 Gulfstream, 428 F. Supp. 2d at 1381 (summary judgment on fair use where “there is no evidence  
6 in the record from which a jury could decide that (defendant) uses the Gulfstream mark any more  
7 than necessary”).

8 Third, Podfitness does not use Apple’s IPOD mark to suggest that its products are  
9 sponsored or endorsed by Apple, and in fact advised that the Podfitness product works with iPod  
10 *or Zune or other MP3 players*. Podfitness disclaims affiliation, noting that “IPOD is a registered  
11 trademark of Apple” and “Podfitness is not affiliated with or endorsed or supported by Apple.”  
12 (See Hays Decl. ¶ 25). See Cairns, 292 F. 3d at 1154-55 (fair use, even with no disclaimer);  
13 Gulfstream, 428 F. Supp. 2d at 1381 (granting summary judgment on fair use where “there is no  
14 evidence that (defendant) suggests sponsorship” and “(defendant) includes an express disclaimer  
15 of sponsorship”). Each use of the IPOD name by Podfitness is protected fair use, as a matter of  
16 law.

17 **VI. PODFITNESS IS ENTITLED TO JUDGMENT ON ALL OTHER “LIKELIHOOD**  
18 **OF CONFUSION” AND INFRINGEMENT CLAIMS**

19 Podfitness is likewise entitled to summary judgment on Apple’s state law and other  
20 claims that turn upon a likelihood of confusion analysis, and fail for the fair use defense. See  
21 e.g. Survivor, 406 F. 3d at 635 (rejecting state law claims for no likelihood of confusion);  
22 Microware, 126 F. Supp. at 1222 (“Given their similarity with the federal claims, the Court also  
23 disposes of Plaintiff’s Iowa common law claims of infringement and unfair competition.”);  
24 JouJou Designs, 821 F. Supp. at 1353 & n.6 (likelihood of confusion principal test for federal  
25 and California state trademark infringement and unfair competition claims).

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**VII. CONCLUSION**

For the reasons stated above,

IT IS HEREBY ORDERED THAT Podfitness’ motion for partial summary judgment is GRANTED. Podfitness is entitled to summary judgment as to Apple’s first, second, fourth, fifth, sixth, seventh, and eighth claims for relief.

IT IS SO ORDERED.

DATED: \_\_\_\_\_

\_\_\_\_\_  
SAUNDRA BROWN ARMSTRONG  
United States District Court