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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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

Applicant: Apple Inc.
Serial No: 77/078,496
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Mark: **IPHONE**
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INTRODUCTION

Applicant Apple Inc. seeks to register its famous mark IPHONE for various entertainment services in Class 41 and computer services in Class 42. When Apple introduced its iPhone device in 2007, it ushered in a new era of power and sophistication never before seen in a mobile device, completely redefining what users can do on their mobile phones. With the touch of a finger, a user can make a call, check the weather, check stock prices, listen to music, purchase an e-book, play a game, surf the Internet, take a picture, retrieve information, get directions, and access many other types of information and services. Thus, from its inception, Apple's revolutionary iPhone device has been at the forefront of the phenomenon known as "technology convergence," or the unification of media, technologies and services into a single, common device and platform.

Technology convergence has blurred the line between goods and services.¹ In order to make the iPhone device function, Apple not only provides hardware and software, but is also rendering a broad range of services to its customers delivered through hardware and software under the IPHONE mark. Apple's customers have therefore come to understand and expect that when purchasing an iPhone device from Apple, they are also receiving a suite of services that are provided through the device. By the time Apple filed its Statement of Use with the USPTO—six years after the launch of IPHONE—Apple had created a new commercial reality. Consumers, due in no small part to the advent of IPHONE, now rely on their mobile devices for many aspects of their lives. Consumers do not just simply access software and perform their own operations on their devices; they also access a suite of services delivered by technology companies through mobile devices and their built-in software.

¹ See Request for Reconsideration, Exhibit A (representative articles from national publications such as *Time*, *The New York Times*, *The Chicago Tribune*, *Los Angeles Times*, and *Baltimore Sun*, which describe today's commercial context of digital electronic devices rendering services by way of their installed software).

As a result of Apple having exposed millions of consumers to the technology convergence embodied in the iPhone device, consumers now expect to receive, and understand they are receiving, certain IPHONE services—the ones at issue in this appeal—from Apple. In issuing the present specimen refusals, the USPTO neglected to consider today’s commercial context in which consumers would recognize these services from Apple’s specimens. Viewed against such context, the specimens clearly show valid use of the mark for the relevant services.

The USPTO, in its October 2014 revisions to the TMEP, acknowledged the challenges faced by Examining Attorneys in reviewing specimens for services rendered through technology.² In this instance, Apple submits that the Examining Attorney misapplied the new standards set forth in the TMEP in reviewing Apple’s specimens submitted in support of this Application and refused registration of Apple’s IPHONE mark erroneously. As the following arguments and evidence will show, Apple’s specimens adequately show service mark usage of IPHONE in connection with the applied-for services in Class 41 and 42.

I. THE USPTO’S NEW STANDARDS FOR REVIEW OF SPECIMENS FOR TECHNOLOGY-RELATED SERVICES CLEARLY COVERS THE TYPES OF USAGE SHOWN IN APPLE’S SPECIMENS

Newly-revised TMEP Section 1301.04(h)(iii) states:

Modern computer and technology-related services present special challenges because these services, and the terminology used to describe them, are continually evolving. In addition, any online activity entails the use of computer software, making it difficult to differentiate the various services provided online from the underlying technology used to provide them. As the Board has noted, “[a]lthough it may well be software that is generating the [services], in today’s commercial context if a customer goes to a company’s website and accesses the company’s software to conduct some type of business, the company may be rendering a service, even though the service utilizes software.” *In re Ancor Holdings, LLC*, 79 U.S.P.Q.2d 1218, 1221 (T.T.A.B. 2006).³

² See TMEP §§ 1301.04(h)(iii)-(iv), 1301.04(i)-(ii).

³ TMEP § 1301.04(h)(iii).

This application presents this exact same circumstance, except that rather than just software, it is a combination of Apple's hardware and software that is being utilized to render Apple's services to the user under the IPHONE mark. There is no logical reason why the bundling of hardware, software and services, rather than just the software and services at issue in *In re Ancor Holdings*, should change the result. Apple's usage of IPHONE not only relates to the hardware, but also the bundled software and services. The TMEP next states:

Thus, a primary consideration in these instances is whether the specimen indicates that the applicant is actually performing the relevant service activities for others, or, for instance, merely providing software that allows users of the software to perform those activities themselves....⁴

As Apple will show, its specimens clearly demonstrate that Apple is itself offering the applied-for services through its hardware and software, and that it is doing so under the IPHONE mark.

Additionally, in the context of software apps, new TMEP Section 1301.04(h)(iv)(D) states:

Software applications ("apps") for smartphones and computer tablets are now commonly used to provide online services. Apps are simply the interface that enables the providers of the services to reach the users and render the services, and the users to access those services. Common specimens for such apps are usually screenshots of electronic devices demonstrating the apps delivering the services. Such a specimen may not always depict proper service-mark use of the mark in connection with the identified services, but it may be acceptable if the displayed screenshot clearly and legibly shows the mark associated with the identified services as the services are rendered or performed via the app.⁵

Again, the circumstances described in this TMEP Section are directly analogous to the facts at issue in this case, except that, in this case, Applicant is offering not only the apps and the services, but also the smartphone device itself under the mark. As above, there is no reason why this should change the result. Since, as shown below, the specimens clearly demonstrate use of

⁴ *Id.*

⁵ T.M.E.P. § 1301.04(h)(iv)(D).

the IPHONE mark in association with not only Apple's hardware and software, but also the identified services, such specimens should be accepted.

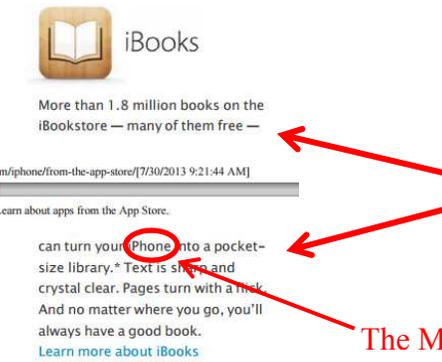
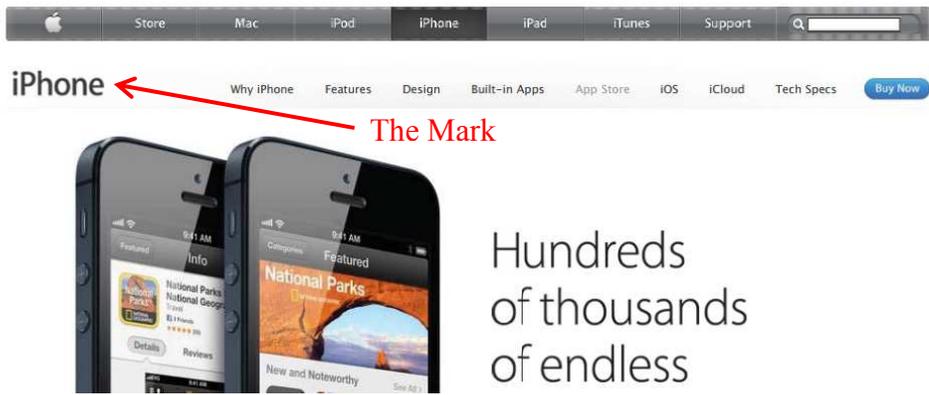
II. THE FACT THAT SOME OF APPLE'S APPLIED-FOR SERVICES ARE ALSO OFFERED UNDER THEIR OWN SOURCE IDENTIFIERS DOES NOT PRECLUDE APPLE FROM CLAIMING USE OF ITS IPHONE HOUSE MARK WITH THOSE SERVICES

The Examining Attorney erroneously maintains that because some of the recited services are offered under other Apple marks, such as "iBooks," consumers would not perceive the IPHONE mark in Apple's Class 41 specimen as a mark for the applied-for services. However, the fact that services are offered under their own source identifiers does not preclude the same services from being offered under the IPHONE mark, just as OREO cookies are offered under the OREO trademark does not preclude registration of the NABISCO house mark for cookies. *See, e.g., Weatherford/Lamb, Inc. v. C&J Energy Servs., Inc.*, 96 U.S.P.Q.2d 1834, 1840 (T.T.A.B. 2010) ("It is well settled that a party may use more than one mark to identify a product or service and thus may choose to use its housemark in conjunction with other marks."); *Textron Inc. v. Cardinal Eng'g Corp.*, 164 U.S.P.Q. 397, 399 (T.T.A.B. 1969) ("[T]here is no statutory limitation on the number of trademarks that one may use on or in connection with a particular product to indicate origin"). Similarly, Apple's use of its IPHONE mark in its specimens, discussed further below, is akin to use as a house mark, which not only relates to its device, but also for all the associated software and services shown on the specimens, notwithstanding the fact that each such item has its own individual trademark or service mark, such as IBOOKS, ILIFE, IMOVIE, IPHOTO, ICLOUD, APP STORE and others.

III. APPLE’S CLASS 41 SPECIMENS ADEQUATELY DEMONSTRATE VALID SERVICE MARK USE OF THE IPHONE MARK WITH THE APPLIED-FOR SERVICES

Apple submitted two Class 41 specimens – its original specimen submitted with its August 12, 2013 Statement of Use, consisting of “a screenshot from the Applicant's website showing use of the applied-for mark in the advertising of the applied-for services” and its supplemental specimen submitted with its October 23, 2014 Request for Reconsideration, described as “a video file containing two Apple commercials showing use of the IPHONE mark with the recited services”.

The original Class 41 specimen, as shown in the following excerpts, clearly demonstrates service mark use of IPHONE for services listed in Class 41 in the application:



The services “providing online computer databases featuring information in the field[] of ... books”.



The services “providing online computer databases featuring information in the fields of music, video, film, ... television entertainment”.

A new game or a new recipe. Something to help you stay on top of world affairs or something to help you stay on top of your finances. For all the incredible things your iPhone already does, there are thousands more, waiting for you at the App Store. [Visit the App Store](#)

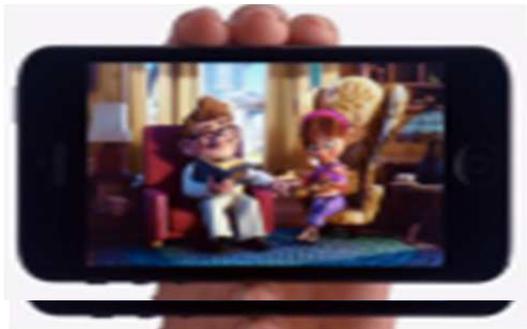
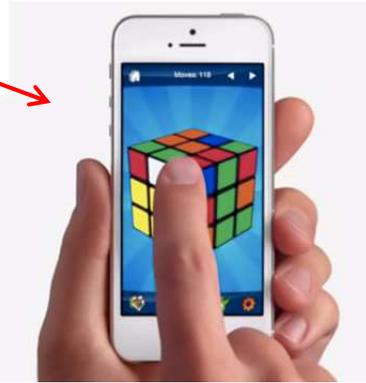
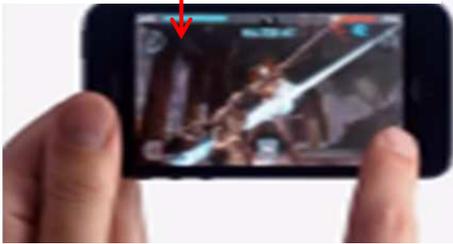
The services “providing online computer databases featuring information in the field[] of ... games”.



The Mark

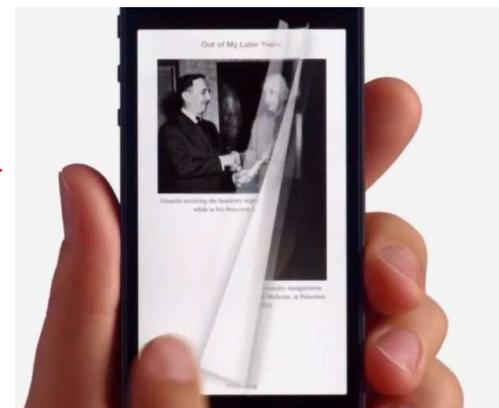
Similarly, the supplemental Class 41 specimen consisted of two television advertisements featuring successive frames showing various of the recited Class 41 services rendered through the IPHONE device. The final frame prominently depicts the IPHONE mark thereby associating the mark with the services. Representative still frames from the commercials, paired with the recited services, are depicted below.

The services “providing online computer databases featuring information in the field[] of ...games”.



The services “providing online computer databases featuring information in the fields of ... video, film”.

The services “providing online computer databases featuring information in the field[] of ... books.”





← The services “providing online computer databases featuring information in the field[] of ... music.”

Mark →



In the original specimen, as shown above, the IPHONE mark is presented in a large font at the top of the webpage and is repeated numerous times throughout the text of the page. The webpage lists many features, software apps and services that come pre-bundled with the iPhone device, including, as shown above, a number of the Class 41 services recited in the application. This specimen is very similar to the acceptable specimens shown in TMEP § 1301.04(i). Contrary to the Examining Attorney’s assertions, there is a clear mark-services association shown in the specimen due to the prominent usage of the mark at the top of the page, and due to the consistent textual use of the IPHONE mark throughout the specimen in statements describing the services.

The prominent usage at the top of the page establishes a mark-services association because “it is customary to display service marks near the top of the webpages on which the services are advertised.”⁶ There is some distance between the usage of the mark at the top of the page and the descriptions of services. However, the reason for this is that the iPhone device has an extensive set of features. The fact that the specimen first discusses other apps and services

⁶ TMEP § 1301.04(i).

before the apps and services at issue in the Application does not negate the fact that the prominent IPHONE usage at the top of the page relates to all of the goods and services described on the page, since all of the goods and services are clearly offered and rendered as features of the iPhone platform.

Moreover, the IPHONE mark is used textually throughout the specimen in statements directly describing the services. Such textual usage in close proximity to the descriptions of services reinforces and clearly establishes the mark-services association that is required for acceptable specimen usage.

Additionally, as noted above in Section II, the fact that other Apple marks, like iBooks, are also used with the recited services does not negate the fact that the IPHONE mark is also being used for the services in a manner akin to a house mark.

With respect to the supplemental specimens, Apple submits that such specimens clearly show the IPHONE mark used in rendering the services. In specimens depicting the rendering of services—as opposed to specimens advertising services—direct association is oftentimes *inferred* based on the context in which the specimens are used and the services rendered. *See In re ICE Futures U.S., Inc.*, 85 U.S.P.Q.2d 1664, 1669-70 (T.T.A.B. 2008). Consumers viewing Apple's supplemental specimens, based on their knowledge of and prior experience in receiving Apple's services, need no explicit textual reference to appreciate the services rendered. Through successive frames, the television commercials show the provision of digital media content, and at the end of the commercials, the IPHONE mark is featured prominently. Upon watching these commercials, consumers will immediately associate the IPHONE mark with the provision of databases featuring digital media content information in the fields covered under the Application (e.g., books, films, games and music). Apple's customers know that digital content does not come pre-installed. Instead, consumers are

aware and have come to expect that digital media content is obtained through online computer databases provided by Apple, such as the iTunes, iBooks, and Game Center apps. Therefore, since the commercials show successive frames of content that consumers know must be obtained from Apple's online databases, and the IPHONE mark is depicted prominently at the end of the commercials, consumers will contextually understand that the IPHONE mark is being used with the database and information services claimed under the application.

In light of the above, Apple submits that the refusal of its Class 41 specimens was erroneous and should be withdrawn.

IV. APPLE'S CLASS 42 SPECIMENS ADEQUATELY DEMONSTRATE VALID SERVICE MARK USE OF THE IPHONE MARK WITH COMPUTER SERVICES

Apple is very puzzled by the Examining Attorney's continued refusal of its Class 42 specimens, since in Apple's view, these specimens clearly and unambiguously show use of the IPHONE mark in direct association with the services. Apple submitted three Class 42 specimens – its original specimen submitted with its August 12, 2013 Statement of Use and two supplemental specimens submitted with its October 23, 2014 Request for Reconsideration. Such specimens collectively consist of three webpages, all featuring the IPHONE mark used prominently at the top of the page in the headings "IPHONE IN BUSINESS", "IPHONE ASSISTANT", and "IPHONE SUPPORT". This usage is directly placed above and in close proximity to descriptions of the Class 42 services. Moreover, the IPHONE mark is used throughout the text of all three pages in statements describing the services. Thus, the mark-services association is clearly established under the standards set forth in TMEP § 1301.04 and the examples from § 1301.04(i).

Specifically, the Class 42 services in the Application include the following items:

- “providing technical troubleshooting support for computer systems, databases and applications”
- “information relating to computer technology provided on-line from a global computer network or the Internet”
- “computer services, namely, creating indexes of information, and other resources available on global computer networks for others”

Apple submits that these services are clearly and unambiguously shown on all three Class 42 specimens, but for the sake of brevity, will focus on the IPHONE SUPPORT page, an excerpt from which is shown below. Instances of the IPHONE mark at the top of the page and throughout the text are highlighted in yellow. References to “providing technical troubleshooting support for computer systems, databases and applications” are highlighted in green.

The screenshot shows the Apple iPhone Support website, specifically the Enterprise section. The navigation bar at the top includes links for Store, Mac, iPod, iPhone, iPad, iTunes, and Support. The main header reads "iPhone Support". A left sidebar contains a menu with items like Welcome, iPhone Essentials, Phone, Messages & FaceTime, Syncing, Features, Apps & Settings, Mail, Contacts & Calendars, Wi-Fi, AirPlay & AirPrint, Accessories & Bluetooth, Enterprise (selected), Contact Support, Manuals, Tech Specs, and Communities. The main content area is titled "Enterprise" and features several sections: "iPhone in Business - IT Center" with a brief description; "iPhone Support Communities - Enterprise" with a link to discuss with other users; "AppleCare Enterprise Support Products" with a link to learn more; and "Apple Configurator" with a link to help. Below the Apple Configurator section, there are three numbered lists of links: 1. Apple Configurator: Backing up and restoring data; 2. You can use Time Machine or any other backup strategy to back up and restore Apple Configurator data including device configurations, users, apps, documents, iOS versions, and VPP redemption codes; 3. Using Volume Purchase Program (VPP) Redemption Codes; 4. Learn how to use Apple Configurator to deploy copies of paid apps using redemption codes purchased from the Volume Purchase Program (VPP); 5. Using Apple Configurator to enroll devices in Profile Manager; 6. Learn how to import Enrollment Profiles created in Profile Manager into Apple Configurator, then install the profiles onto devices.

Moreover, in addition to clearly showing use for support services, the entire page provides the recited services “information relating to computer technology provided on-line from a global computer network or the Internet” and “computer services, namely, creating indexes of information, and other resources available on global computer networks for others.” The mark-services association could not be clearer. Thus, Apple cannot understand why the Examining Attorney rejected these specimens.

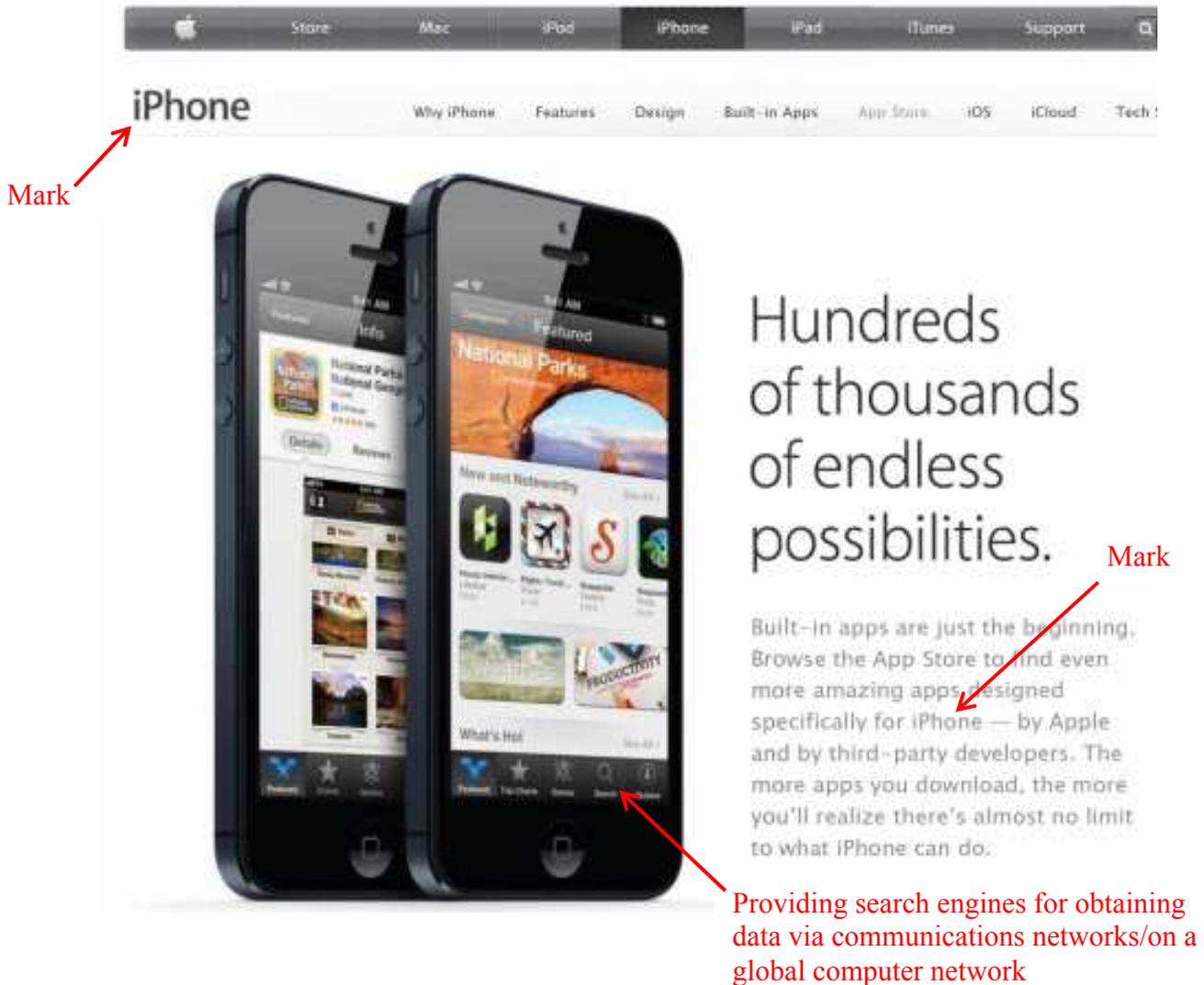
Indeed, in the three opportunities to do so (the October 1, 2013 Office Action, the April 23, 2014 Final Office Action, and the December 13, 2014 Reconsideration Letter), the Examining Attorney has never provided a clear explanation for why the Class 42 specimens are unacceptable. In the Reconsideration Letter, for example, the Examining Attorney even

conceded that these pages provide “links and information for troubleshooting issues that may arise with [Apple’s] own computer hardware,” but inexplicably concluded without justification that consumers encountering the IPHONE mark on the referenced pages would not view IPHONE as a source indicator for the identified services “because there is no association between the proposed mark and the services....”⁷

Apple respectfully disagrees. Contrary to the Examining Attorney’s contention that the Class 42 original and supplemental specimens create no association between the IPHONE mark and the applied-for services, Apple submits that the Class 42 specimens do create a clear, unambiguous and direct association between the mark and the recited services, and therefore the specimens should be approved.

Moreover, Apple notes that its original Class 41 specimen also shows use for the Class 42 services “providing search engines for obtaining data via communications networks; providing search engines for obtaining data on a global computer network”. Such usage is depicted below:

⁷ See Reconsideration Letter at 4.



This specimen clearly shows the offering of search engine services on the screen of the IPHONE in direct association with the IPHONE mark, and therefore this specimen also serves as an additional specimen in support of Class 42.

In light of the above, Apple submits that the refusal of its Class 42 specimens was erroneous and should be withdrawn.

V. THE USPTO ROUTINELY ACCEPTS SPECIMENS SHOWING USE OF DEVICE NAMES AS VALID SERVICE MARKS FOR THE SERVICES RENDERED THROUGH THE DEVICES

Finally, as asserted in Apple's previous submissions, the USPTO has routinely accepted service mark specimens that depict use of a device or software mark also as a mark for the

services rendered via its products in a manner directly analogous to the present case.⁸ The IPHONE mark is no different than ON STAR or GARMIN, for example, which are both perceived and registered as a mark for the gps navigational device *and* the gps navigational services offered via the device by the same name. As shown in Apple's evidence submitted with its Request for Reconsideration, and specifically Exhibit C thereto, the USPTO has routinely accepted specimens from the makers of ON STAR and GARMIN devices, as well as the owners of the KINDLE, NOKIA, WINDOWS PHONE, Wii, NINTENDO GAMECUBE, BLACKBERRY, and NIKEFUEL devices, to name but a few, where the specimens reflect that the applied-for services are rendered through devices and software by the same name.⁹ Apple's circumstances in the present case are no different than the circumstances of these other technology companies. In today's commercial context of technology convergence, consumers for technology products and services like the products and services of Apple and these other companies are likely to associate a device manufacturer's product mark with the services rendered by the products. Therefore, the fact that Apple's IPHONE specimens for these service classes depict or otherwise make reference to Apple's famous IPHONE device is of no import. Upon viewing the specimens, consumers will associate the IPHONE mark with the applied-for services.

VI. CONCLUSION

Apple submits that its arguments and evidence demonstrate that all of its provided specimens adequately demonstrate use of the IPHONE mark in direct association with the services recited in the Application. For the reasons set forth in this Brief, as well as in Apple's

⁸ See Request for Reconsideration at 8 and Exhibit C.

⁹ *Id.*

previously submitted papers and evidence, Apple respectfully requests that the Board reverse the refusal and allow this application to proceed to registration.

Dated: April 2, 2015

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

This is to certify that this APPEAL BRIEF was filed electronically with the Trademark Trial and Appeal Board via transmission through ESTTA on April 2, 2015.

/s/ Beth Rook

Beth Rook