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Subject: U.S. TRADEMARK APPLICATION NO. 77078496 - IPHONE - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 77078496

MARK: IPHONE



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: APPLE INC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the final refusal to register the proposed mark IPHONE in standard characters for services in International Classes 41 and 42, as amended and listed below. Registration has been refused pursuant to Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127, on the basis

that Applicant's specimens of use do not show use of the applied-for mark in connection with any of the services specified in the Statement of Use.

I. STATEMENT OF FACTS

On January 8, 2007, applicant filed the instant application under Section 1(b) of the Trademark Act to register the proposed mark IPHONE in standard characters. Following several Office actions and amendments to the original recitation of services as well as an appeal to the Board on other grounds on May 5, 2009, the proposed mark was approved for publication on May 6, 2010. On August 12, 2013, applicant filed the Statement of Use.

On October 2, 2013, registration of the proposed mark IPHONE was refused pursuant to Trademark Act 1 and 45; 15 U.S.C. §§1051, 1127 because the specimens filed with the Statement of Use do not show the applied-for mark in use in commerce in connection with any of the services specified in the Statement of Use. Applicant responded and submitted substitute specimens of use on March 24, 2014. The examining attorney issued a final refusal of applicant's specimens of use on April 23, 2014. Applicant filed a Request for Reconsideration and Notice of Appeal on October 23, 2014. The examining attorney denied Applicant's Request for Reconsideration on December 13, 2014.

II. ARGUMENT

THE SPECIMENS OF USE PROVIDED IN THE STATEMENT OF USE DO NOT SHOW USE OF THE MARK IN COMMERCE IN THE SALE, ADVERTISING OR RENDERING OF THE SERVICES IDENTIFIED IN CLASSES 41 AND 42 IN THE STATEMENT OF USE.

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each international class of services identified in the statement of use.

15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a). Specimens for services normally take the form of advertising and marketing materials, brochures, photographs of business signage and billboards, and webpages that show the mark used in the actual sale, rendering, or advertising of the services. See TMEP §1301.04(a), (h)(iv)(C).

The specimen must demonstrate the mark serving as a source indicator for the identified services. Therefore, registration must be refused if the specimen shows the mark is used only to promote goods rather than the identified services, or the mark is used as a service mark but not for the identified services (i.e., the applicant misidentified the services). See TMEP §§1301.02(a), 1301.02(e)–1301.02(f).

In this case, applicant seeks to register the proposed mark IPHONE for the following services, as amended:

- Entertainment services, namely, providing online computer databases featuring information in the fields of music, video, film, books, television entertainment, games and sports; and providing consultation services relating to all the aforesaid. (Class 41).
- Computer hardware and software consulting services; multimedia and audio-visual software consulting services; providing technical troubleshooting support for computer systems, databases and applications; providing consultation services for developing computer systems, databases and applications; information relating to computer technology provided on-line from a global computer network or the Internet; providing search engines for obtaining data via communications networks; providing search engines for obtaining data on a global computer network; computer services, namely, creating indexes of information, and other resources available on global computer networks for others; customized searching at the specific request of end users, allowing the end user to browse and retrieve information, sites, and other resources available on global computer networks; and consultation services relating to all the aforesaid. (Class 42).

For the reasons more fully set forth below, the examining attorney respectfully submits that the specimens of use filed by applicant are not acceptable because they do not show use of the proposed mark in the sale, advertising or rendering of any services identified in the Statement of Use.

A. Applicant's Specimens of Use Are Not Acceptable Specimens for Technology-Related Services.

Applicant contends that the specimens at issue in this case comply with the Office's standards of review for technology-related specimens set forth in revised TMEP §1301.04(h)(iii) and have been refused in error. Specifically, applicant indicates that the specimens are acceptable because "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 to the bundled software and services." Applicant's Brief at 3.

The examining attorney respectfully disagrees and submits that the refusal of applicant's specimens of use is supported by TMEP §1301.04(h)(iii) because the specimens consist of advertising materials for goods, which do not show use of the proposed mark in the sale, advertising, performance or rendering of any services identified in the Statement of Use. Instead, the specimens indicate that the proposed mark IPHONE is solely used as the source identifier for applicant's computer hardware, more specifically, for its specific brand of smartphone.

Applicant also relies on TMEP § 1301.04(h)(iv)(D) to argue that "applicant is not only providing 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 the IPHONE mark in association with the not only Apple's hardware and software, but also the identified services, such specimens should be accepted." Applicant's Brief at 3-4.

However, the specimens do not include a direct association or reference to the separable services that have been identified in this application in International Classes 41 and 42. In addition, the specimens do not show use of the proposed mark IPHONE in the performance or rendering of any

identified services in International Classes 41 and 42. There is no information or manner of use of the proposed mark IPHONE on the specimens, which would create the necessary mark-services association in the mind of consumers with respect to the identified services. See TMEP §1301.04(g)(i). While applicant's IPHONE computer hardware device is clearly used by consumers to access software applications, which in turn may be further used to facilitate activities of the kind identified in this application, the specimens do not show use of the proposed mark IPHONE directly as a service mark for the separable services identified in International Classes 41 and 42.¹

B. Applicant's Specimens of Use Do Not Show a Direct Association with the Identified Services

Specimens consisting of advertising or promotional materials generally must show a direct association between the mark and the services for which registration is sought. See *In re Universal Oil Prods. Co.*, 476 F.2d 653, 655, 177 USPQ 456, 457 (C.C.P.A. 1973); TMEP §1301.04(f)(ii). While the exact nature of the services does not need to be specified in the specimen, there must be something which creates in the mind of the purchaser an association between the mark and the service. *In re Adair*, 45 USPQ2d 1211, 1215 (TTAB 1997) (quoting *In re Johnson Controls Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994)).

1. The Specimens of Use for International Class 41 are Not Acceptable Specimens.

The original specimen of use for International Class 41 is featured at pages 1-6 of the August 12, 2013, Statement of Use. The specimen consists of advertising material in the nature of "a screenshot from the Applicant's website showing use of the applied-for mark in the advertising of the applied-for

¹ As indicated by the dictionary evidence from <http://searchmobilecomputing.techtarget.com/definition/iphone> and <http://www.webopedia.com/TERM/I/iPhone.html> provided with the December 13, 2014 Denial of Applicant's Request for Reconsideration at pages 2-14, the general consuming public associates "IPHONE" with a device that is "an internet enabled smartphone developed by Apple. The iPhone combines mobile phone capabilities with a wireless internet device and an iPod into one product. The iPhone also includes a 3.5-inch multi-touch screen (4 inch Retina Display on the iPhone 5) rather than a keyboard, that can be manipulated by users with two finger touches. The iPhone runs on a special version of Apple's Mac OS X operating system."

services.” According to applicant, the original specimen of use for International Class 41 clearly demonstrates service mark use of IPHONE in connection with services identified in International Class 41. To support this argument, applicant has included some excerpts from the specimen at page 6 of Applicant’s Brief.

However, a full review of the August 12, 2013, specimen indicates that the proposed mark IPHONE identifies applicant’s computer hardware only. The specimen features the proposed mark at the top of the first page in close proximity to a photograph depicting two of applicant’s computer hardware devices. The introductory paragraph next to the photograph states:

“Hundreds of thousands of endless possibilities. Built-in apps are just the beginning. Browse the App Store to find even more amazing apps designed specifically for IPHONE-by Apple and by third-party developers. The more apps you download, the more you’ll realize there’s almost no limit to what IPHONE can do.”

Additional textual information on the first page explains that consumers may access software applications specifically designed for the IPHONE device through the App Store. The third paragraph states:

“More to see. More to love. With the bigger display on iPhone 5, your built-in apps look even more stunning. Apple apps you download from the App Store have been optimized for the new iPhone 5 display. But even if an app hasn’t been updated for iPhone 5, automatic letterboxing lets you use it as you always have. And developers can easily update apps to take advantage of the larger screen. So you’ll see more, play more and get more done.”

Similar to the information above, the remaining pages of the specimen feature the proposed mark IPHONE as part of textual information solely to identify applicant’s computer hardware device. Prominent images of the computer hardware device are also featured throughout the specimen. The textual information also highlights software applications available for the device. According to the

information provided, the device features built-in software applications and additional software applications designed for applicant's computer hardware may be obtained by consumers through applicant's App Store.

Several software applications for applicant's IPHONE device are identified on the specimens by their own source indicators. For example, at page 2, the specimen advertises "iMovie," "iPhoto" and "GarageBand." Similarly, at page 3, the specimen advertises "iBooks," a software application which can "turn your iPhone into a pocket-size library," and "iTunes U," an application that allows consumers to take complete courses from universities and other schools and access the world's largest online catalog of free education content- right on your IPHONE."

The examining attorney respectfully submits that the August 12, 2013 specimen does not feature a direct association or explicit reference to any of the identified services in International Class 41 that would establish the requisite direct association between the proposed mark IPHONE and the services, namely, "entertainment services, namely, providing online computer databases featuring information in the fields of music, video, film, books, television entertainment, games and sports; and providing consultation services relating to all the aforesaid." In addition, the specimen does not show use of the proposed mark IPHONE in the actual performance or rendering of the services, contrary to applicant's arguments. While the proposed mark IPHONE appears in the textual information on the specimen, the mark is solely used to promote applicant's computer hardware device and to explain its features. The specimens make it eminently clear that a myriad of services can be utilized and accessed via the device but in no way uses the name of the device as the source identifier for any of the services.

Applicant filed the substitute specimen of use for International Class 41 with the October 23, 2014, Request for Reconsideration. The October 23, 2014, substitute specimen consists of a media file

featuring two television advertisements with successive frames depicting applicant's computer hardware device.

Applicant argues that the successive frames show services identified in Class 41 rendered through the IPHONE device and that the IPHONE mark in the final frame associates the mark with the services. To support this argument, applicant has provided excerpts from the substitute specimen of use at page 7 of the Brief. From the first television commercial, applicant relies on still frames of a user holding applicant's computer hardware and apparently playing games on the device. Applicant argues that these images show use of the proposed mark IPHONE in the rendering or performance of services in the nature of "providing online computer databases featuring information in the field of... games." From the second television commercial, applicant relies on a frame depicting animation to argue that this frame shows use of the proposed mark IPHONE in the performance or rendering of services in the nature of "providing online computer databases featuring information in the fields of video, film." Applicant also relies on a frame depicting an image of Albert Einstein from a book to argue that the proposed mark IPHONE is used in connection with "providing online computer databases featuring information in the field of...books."

However, it is clear that the proposed mark IPHONE is used in the television advertisements solely to identify and promote applicant's computer hardware device. The successive frames merely depict applicant's computer hardware device in the hand of a user, who is accessing a variety of content, provided via other trademarks, not from any 'IPHONE' service. None of the frames show use of the proposed mark in the sale, advertising, performance or rendering of any services identified in International Class 41. Consumers encountering the proposed mark on the final frame of both television advertisements would not associate the proposed mark with any separable services as the mark IPHONE is used solely to promote applicant's computer hardware device.

While the services need not be stated word for word, a “sufficient reference” to the services themselves or a general reference to the trade, industry, or field of use is required. *In re Ralph Mantia Inc.*, 54 USPQ2d 1284, 1286 (TTAB 2000) (reversing the specimen refusal since the term “design” appeared on applicant’s letterhead stationery, envelope, and business cards and stating “[i]t is not necessary that the specific field of design, i.e., commercial art, also appear [on the specimen]. If the alleged reference to the services is so vague that the services cannot be discerned, the specimen will not be acceptable. *In re Chengdu AOBI Info. Tech. Co., Ltd.*, 111 USPQ2d 2080, 2082 (TTAB 2011); See TMEP §1301.04(i). However, in this case, there is no reference at all to any of the identified services.

For specimens showing the mark used in rendering the identified services, the services need not be explicitly referenced to establish the requisite direct association. *See In re Metriplex, Inc.*, 23 USPQ2d 1315, 1316-17 (TTAB 1992) (noting that “the requirements specific to specimens which are advertising are not applicable” and finding the submitted specimens acceptable to show use of applicant’s mark in connection with data transmission services because the specimens showed “the mark as it appears on a computer terminal in the course of applicant's rendering of the service” and noting that “purchasers and users of the service would recognize [applicant’s mark], as it appears on the computer screen specimens, as a mark identifying the data transmission services which are accessed via the computer terminal”). Rather, direct association may be indicated by the context or environment in which the services are rendered, or may be inferred based on the consumer’s general knowledge of how certain services are provided or from the consumer’s prior experience in receiving the services. *Id.* In other words, the context in which the services are provided and consumer knowledge and experience create an inference of the services without an explicit textual reference to the services. *See* TMEP §1301.04(i), Example 17 (CASHFLOW UNITS).

Applicant argues that “upon watching applicant’s 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 consumers 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 in the application.” Applicant’s Brief at 9-10. Thus, in its brief, applicant has clearly acknowledged that the services in question are provided under marks OTHER than IPHONE - Apple, iTunes, iBooks and Game Center, and that consumers are well aware of this. It would thus take specimens with a very clear nexus between such services and IPHONE for consumers to view IPHONE as a source for the services rather than the accustomed brands by which such services have traditionally been offered - Apple, iTunes, iBooks and Game Center.

Further, applicant’s arguments are not supported by the television advertisements themselves since they do not feature use of the proposed mark IPHONE in the performance or rendering services in the nature of “providing online computer databases featuring information provision of online computer databases featuring information in the fields of music, video, film, books, television entertainment, games and sports or the provision of consultation services relating to all the aforesaid.” The specimens do not feature a proper nexus between the proposed mark IPHONE and the services. *See, e.g., In re Metriplex, Inc.*, 23 USPQ2d at 1316.

2. The Specimens of Use for International Class 42 are Also Not Acceptable.

The original specimen of use for International Class 42 is featured at pages 7-11 of the August 12, 2013 Statement of Use and also consists of advertising material in the nature of a screenshot from applicant's website. This specimen features the wording "iPhone in Business" at the top of the first page together with a prominent photograph of applicant's computer hardware device held in the hand of a user. For the convenience of the Board, the following outlines some of the additional textual information featured on the specimen:

- 1) Page 7- "New to using iPhone for work? Check out the resources below to get you going now. Experienced business users, dive in to learn more." (With accompanying photograph of applicant's electronic device held in the hand of a user).
- 2) Page 7- "Set Up- Putting Your iPhone to work is easy-start here with the basics of setting up email, securing your iPhone, accessing Wi-Fi networks and more." (With accompanying photographs of IPHONE electronic device).
- 3) Page 8- "IT Get Up and running. Learn about the features of iPhone and iOS to assist you with getting employees set up on corporate services whether they have a corporate-owned device or bring their own to work. Deploy fast. Learn the Options for integrating, setting up, and managing iPhone across your corporate network."
- 4) Page 8- "Start using iPhone for work by getting quick tips on a variety of apps to get you through your business day...View these how-to-videos and get inspired to boost your productivity. Subscribe to the iPhone Quick Tips podcast series in iTunes to get the latest tips." This text is accompanied by a photograph of the IPHONE electronic device and video link.
- 5) Page 10- "Get Help. Whether you're new to iPhone or an experienced user, there's plenty of support available for business professionals-online, in person, or over the phone."

As noted in the Final Office action dated April 23, 2014, applicant's original specimen of use is not acceptable because it does not show use of the proposed mark IPHONE in the sale, advertising, performance or rendering of any services identified in the application in International Class 42, namely, "computer hardware and software consulting services; multimedia and audio-visual software consulting services; providing technical troubleshooting support for computer systems, databases and applications; providing consultation services for developing computer systems, databases and applications; information relating to computer technology provided on-line from a global computer network or the Internet; providing search engines for obtaining data via communications networks; providing search engines for obtaining data on a global computer network; computer services, namely, creating indexes

of information, and other resources available on global computer networks for others; customized searching at the specific request of end users, allowing the end user to browse and retrieve information, sites, and other resources available on global computer networks; and consultation services relating to all the aforesaid.” Instead, the specimen indicates that the proposed mark IPHONE is used solely as the source indicator for applicant’s computer hardware device.

Through the October 23, 2014, Request for Reconsideration, applicant filed substitute specimens of use for International Class 42 consisting of additional pages from applicant’s website. The first page of the substitute features the wording “iPhone Assistant” at the top of the page and also includes various images of applicant’s computer hardware device with categories of information for consumers to “learn how to solve most common ‘IPHONE’ issues.” The second page features the wording “iPhone Support” at the top of the page and features categories of information with headings such as “Enterprise;” “iPhone in Business-IT Center;” “iPhone Support Communities-Enterprise;” “Apple Configurator;” “Exchange ActiveSync;” “Enterprise Networking;” “Deployment;” and “iPhone Configuration Utility.” It is clear that *Apple* offers the services in question as they relate to the IPHONE device but there is no connection between IPHONE as the source of the services. The specimens actually quite clearly show the exact opposite - the services are rendered by Apple solely in regards to the IPHONE device.

Contrary to applicant’s arguments that the specimen shows use of the proposed mark as a service mark for “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,” in International Class 42, the examining attorney submits that there is no direct association or reference to separable services identified in this application in International Class 42. In addition, the specimens do not show us of the proposed mark as a service mark in the performance or rendering of any services in International Class 42.

Applicant also argues that the original August 12, 2013 specimen of use for International Class 41 is an acceptable specimen of use for the services identified in this application as “providing search engines for obtaining data via communication networks; providing search engines for obtaining data on a global computer network” in International Class 42. To support this argument, applicant includes an excerpt of the first page of the Class 41 specimen, which depicts the two computer hardware devices together and was previously referenced above. Applicant then points to an icon depicted on the bottom portion of the screen of applicant’s computer hardware device and to the proposed mark IPHONE included in the paragraph next to the photograph and argues that “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.” *Id.* at 14. The examining attorney respectfully disagrees because the information referenced by applicant clearly shows that the proposed mark IPHONE identifies applicant’s computer hardware device rather than any separable services.

C. Past Practice and Acceptability of Specimens of Use

Applicant also argues that the specimens of record should be accepted because “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.” *Id.* at 15. However, the acceptability of a specimen is determined based on the facts and evidence of record, and viewed in the context of the relevant commercial environment. *See In re Ancor Holdings, LLC*, 79 USPQ2d at 1220 (“[W]e must base our determination of public perception of applicant's mark on the manner of use of [the mark] in the advertising which has been submitted as a specimen. Further, we must make that determination within the current commercial context, and, in doing so, we may consider any other evidence of record ‘bearing on the question of what impact applicant's use is likely to have on purchasers and potential purchasers.’” (quoting *In re Safariland Hunting Corp.*, 24 USPQ2d

1380, 1381 (TTAB 1992)). Thus, the information provided by the specimen itself, any explanations offered by the applicant clarifying the nature, content, or context of use of the specimen, and any other information in the record should be considered in the analysis. *In re DSM Pharm., Inc.*, 87 USPQ2d 1623, 1626 (TTAB 2008) (“In determining whether a specimen is acceptable evidence of service mark use, we may consider applicant's explanations as to how the specimen is used, along with any other available evidence in the record that shows how the mark is actually used.”).

When the specimens of use are viewed in the context of the relevant commercial environment and in consideration of the public perception of applicant's mark as used in the advertising which has been submitted, it is clear that consumers, encountering the proposed mark through the specimens of record, would view the proposed mark IPHONE solely as the source indicator for applicant's computer hardware device. Since the specimens of use do not show use of the proposed mark IPHONE in a manner that would be associated by consumers with any of the services identified in this application, they are not acceptable specimens.

III. CONCLUSION

Because applicant's specimens of use do not show use of the proposed mark with any services identified in the Statement of Use, registration must be refused pursuant to Trademark Act Sections 1 and 45; 15 U.S.C. §§1051, 1127. For the foregoing reasons, the examining attorney respectfully requests that the Board affirm the refusal to register the proposed mark.

Respectfully submitted,

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