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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Applicant | Apple Inc. |
| Applied for Mark | IPHONE |
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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
Filed: January 8, 2007
Mark: **IPHONE**
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APPLICANT'S REPLY BRIEF

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APPLICANT'S REPLY BRIEF

I. ARGUMENT

Applicant Apple Inc. submits the following Reply to the Examining Attorney's June 8, 2015 Appeal Brief (the "Examiner's Brief"). There are a number of points on which Apple and the Examining Attorney are in agreement. There is no dispute that the IPHONE mark is prominently displayed on the specimens. Nor is there any dispute regarding the fact that the services at issue are clearly shown on the specimens. The Examiner has even conceded with respect to Class 41 that "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 the this application"¹ and with respect to Class 42 that "[i]t is clear that Apple offers the services in question as they relate to the IPHONE device...."²

The sole point of contention in this appeal is whether there is a sufficient association between the IPHONE mark and the Class 41 and 42 services identified in the application. The Examiner, despite conceding that "[t]he specimens make it eminently clear that a myriad of services can be utilized and accessed via the [IPHONE] device,"³ comes to the unreasonably narrow conclusion that the IPHONE mark only functions as the name of the device itself and not the services rendered through the device. Apple respectfully submits that, in today's commercial context, the Examiner's distinction is an artificial one and that consumers perceive the IPHONE mark as shown in the specimens as not only the source indicator for the device but also for the suite of services that consumers receive from Apple through the device.

¹Examiner's Brief at 4.

²*Id.* at 9.

³*Id.* at 5-6.

A. APPLE’S CLASS 41 SPECIMENS SHOW A DIRECT MARK-SERVICES ASSOCIATION BETWEEN THE IPHONE SERVICE MARK AND THE APPLIED-FOR SERVICES

The Examining Attorney’s conclusion that IPHONE is merely the name of the device and is not used in association with the Class 41 services is an artificial distinction that is: (i) contradicted by the information appearing on the face of the specimens; and (ii) not supported by any evidence of record. Indeed, the original Class 41 specimen prominently shows the IPHONE mark at the top of the page, and lists a number of built-in apps that clearly render the claimed services.

The Examiner correctly observes that “[a]dditional textual information on the first page [of Apple’s specimen] explains that consumers may access software applications specifically designed for the IPHONE device through the App Store.”⁴ The Examiner then, however, draws the wrong conclusion, asserting the IPHONE mark only references the device itself. The Examiner ignores the fact that the cited portion of Apple’s specimen *specifically references the App Store service*, which is one of the services offered under the IPHONE mark that allows consumers to access the very databases for which registration is sought in Class 41 in this application. Accordingly, the Examiner’s assertion that the specimen highlights use of the mark only for the hardware and software related goods but not services is flatly contradicted by the very evidence relied upon by the Examiner for that assertion.

In sum, it is clear that Apple’s IPHONE mark serves as both a source identifier for Apple’s goods as well as the services with which those goods are now inextricably linked. The Board’s holding in *In re Ancor Holdings, LLC* is instructive on the issue of whether Apple’s IPHONE mark can serve as a mark for both goods and services.⁵ In that case, the mark

⁴*Id.* at 5.

⁵79 U.S.P.Q.2d 1218 (T.T.A.B. 2006).

INFOMINDER was used in the specimen as a reference to a “tool” or a “technology solution.” The Examiner refused registration claiming that the specimen showed use for software, but not the applied-for services. The Board overturned this refusal, stating “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.”⁶ The decision then states that since there was ambiguity as to whether the mark refers to the applicant’s software or services, a showing that consumers access the services through the branded software is sufficient to establish use of the mark for the services.

The panel in *Ancor* distinguished the Board’s earlier decision in *In re Walker Research, Inc.*,⁷ because the mark at issue in *Walker* was clearly and repeatedly “used as an adjective to modify the word ‘software.’”⁸ Therefore, since there was no ambiguity, the *Ancor* panel reasoned that consumers would view the mark in *Walker* as merely referring to the software, and not the services purportedly offered through the software.

The present case is analogous to *Ancor*, and distinguishable from *Walker*. In the original Class 41 specimen, the IPHONE mark is used ubiquitously at the top of the page and throughout the textual descriptions of the services. It is not used as an adjective to modify mobile devices or any other type of hardware (as in the *Walker* case). Similarly, in the substitute Class 41 specimens, a series of images are shown of Apple’s device rendering the Class 41 entertainment database services, and at the end of the commercial, the IPHONE mark is prominently displayed. There is no indication in any of the Class 41 specimens that IPHONE is merely the name of the device. Consequently, as in *Ancor*, a sufficient mark-services association is established because

⁶*Id.* at 1221.

⁷228 U.S.P.Q. 691 (T.T.A.B. 1986).

⁸*Ancor Holdings*, 79 U.S.P.Q.2d at 1221.

consumers are exposed to the mark when they utilize Apple's mobile device to access the services.

Further, with respect to the Class 41 substitute specimens, the Examiner states "the successive frames [of the commercials] 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.*"⁹ First, this statement is factually incorrect inasmuch as most of the content being accessed bears no other trademarks. Second, the implicit assumption that Apple is limited to identifying each of its services under only one mark is incorrect as a matter of law. *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) ("[There is no statutory limitation on the number of trademarks that one may use on or in connection with a particular product to indicate origin."). Apple is free to use multiple marks to distinguish its services and, as evidenced by the substitute specimens, does so with respect to its IPHONE mark along with the other marks noted by the Examiner.

The Examiner goes on to say "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.*"¹⁰ However, the Examiner has provided no

⁹Examiner's Brief at 6 (emphasis added).

¹⁰*Id.* at 7-8 (emphasis added).

support (nor is Apple aware of any) for the contention that, if multiple marks are used, a “very clear nexus” must be shown between the mark at issue and the services. This heightened standard is erroneous and the use of multiple marks does not change the requirements for a sufficient mark-services association.

Apple’s Class 41 specimens demonstrate valid use of the IPHONE mark for the recited services, and the specimen refusal should be withdrawn.

B. APPLE’S CLASS 42 SPECIMENS CLEARLY SHOW A DIRECT MARK-SERVICES ASSOCIATION BETWEEN IPHONE SERVICE MARK AND THE APPLIED-FOR SERVICES

The Examining Attorney’s continued maintenance of the refusal in Class 42 is without merit. As detailed in Apple’s Brief, Apple’s Class 42 original and substitute specimens clearly and unambiguously show use of the IPHONE mark in direct association with the covered services. In response, the Examiner once again takes the unreasonably narrow view that IPHONE is merely the name of the device, and therefore cannot be a service mark referencing the services. As with the class 41 services, the Examiner’s distinction is an artificial one that is unsupported in law and contradicted by Apple’s specimens.

Apple’s specimens consist of three webpages, which prominently use the IPHONE mark in the wording iPhone in Business, iPhone Assistant and iPhone Support. The pages clearly provide the computer information and support services that are covered in the Class 42 identification. The Examiner rejects the sufficiency of the specimen for the Class 42 services by claiming “[i]t 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 examiner

continues, “the specimens actually quite clearly show the exact opposite – the services are rendered by Apple solely in regards to the IPHONE device.”¹¹

The Examiner’s statement misapplies the standard for trademark use. The specimens do not need to show that IPHONE is the source of services. They need to show that *the owner of the IPHONE mark* (Apple) is the source of the services. As the Examiner has conceded in this statement, the specimens show that Apple is the source of the computer information and support services offered on the webpages. Since the IPHONE mark is clearly used in association with the rendering of such services, the refusal of the Class 42 specimens is unsupported by the record.

II. CONCLUSION

Apple’s specimens of use in Class 41 and 42 demonstrate clear 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 previously submitted papers and evidence, Apple respectfully requests the Board to reverse the refusal and allow its Application to proceed to registration.

Dated: June 26, 2015

Respectfully submitted,

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¹¹*Id.* at 9 (emphasis in original).

CERTIFICATE OF TRANSMISSION

This is to certify that this APPLICANT'S REPLY BRIEF was filed electronically with the Trademark Trial and Appeal Board via transmission through ESTTA on June 26, 2015.

/s/ Alberto Garcia

Alberto Garcia