From: Estrada, Linda

Sent: 12/13/2014 9:49:19 PM

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Subject: U.S. TRADEMARK APPLICATION NO. 77078496 - IPHONE - N/A - SU - Request for Reconsideration Denied - Return to TTAB

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Attachment Information:

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Files: whatis-1.jpg, whatis-2.jpg, whatis-3.jpg, whatis-4.jpg, whatis-5.jpg, whatis-6.jpg, whatis-7.jpg, webo-1.jpg, webo-2.jpg, aapip-1.jpg, aapip-2.jpg, aapip-3.jpg, 77078496.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 77078496 **MARK:** IPHONE	
CORRESPONDENT ADDRESS: THOMAS R. La PERLE Apple Inc. MS: 169-3IPL 1 INFINITE LOOP CUPERTINO CA 95014-2083	**GENERAL TRADEMARK INFORMATION:** http://www.uspto.gov/trademarks/index.jsp VIEW YOUR APPLICATION FILE
APPLICANT: APPLE INC.	
CORRESPONDENT'S REFERENCE/DOCKET NO: N/A **CORRESPONDENT E-MAIL ADDRESS:** trademarkdocket@apple.com	

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 12/13/2014

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated April 23, 2014 are maintained and continue to be final. *See* TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues.

Through the Request for Reconsideration, applicant argues that the specimens of use, filed with the Statement of Use, are valid specimens showing use of the proposed mark as a service mark for the services identified in this application in International Classes 41 and 42. The examining attorney respectfully disagrees and submits that the specimens consist of advertising materials, which do not show a direct association between the applied-for mark and the identified services; thus the specimens fail to show the applied-for mark in use in commerce for each international class. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a), 1301.04(f)(ii), (g)(i).

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); *In re HSB Solomon Assocs.*, 102 USPQ2d 1269, 1274 (TTAB 2012); 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)); *see In re Osmotica Holdings, Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010).

In the present case, the specimens of use filed with the August 12, 2013 Statement of Use consist of screenshots from applicant's website. The specimens constitute advertising. These advertisements do not feature a direct connection between the proposed mark and the identified services. Instead, they indicate that the proposed mark is the source indicator for applicant's IPHONE computer hardware. The specimens advertise and explain features and functions of applicant's hardware. For example, please see page 1 of the Statement of Use indicating "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."

Consumers encountering the proposed mark, through the specimens of use, would not view it as a source indicator for the services identified in the Statement of Use because the proposed mark "IPHONE" is used to identify and promote applicant's computer hardware. The specimens do not show use of the proposed mark in the sale, advertising, performance or rendering of any of the identified services. The specimens do not show use of the proposed mark on webpages through which any of the identified services are accessed, rendered, experienced and/or advertised. Despite applicant's arguments to the contrary, the specimens do not feature a direct association between the proposed mark and the services identified in International Classes 41 and 42.

With respect to various pre-bundled applications referenced in the specimens of use as well as those available for purchase and downloading from the App Store, the examining attorney respectfully submits that these applications are identified through their own source identifiers. The specimens clearly indicate that "IPHONE" is the device through which these applications can be accessed. For example, the advertisement at pages 3-4 of the August 12, 2013 Statement of Use advertises "iBooks," an application which can "turn your iPhone into a pocket-size library." This information makes clear to consumers that "IPHONE" identifies the electronic device and that one of the mobile applications, which they can use or access through the "IPHONE" device is "iBooks."

In the Request for Reconsideration, applicant cites to various articles to support applicant's argument that, in today's commercial context, digital electronic devices render services through their installed software. Applicant also argues "as a result of this commercial context, customers clearly recognize IPHONE as not only a trademark for the device itself, but also the suite of software offered on the device, and as a service mark for the suite of services offered via the device." Request for Reconsideration at page 2.

The examining attorney also encloses articles supporting the finding that consumers encountering the proposed mark would view "IPHONE" as a source indicator for applicant's computer hardware but not for the services identified in the Statement of Use. For example, please see the evidence from http://www.webopedia.com/TERM/I/iPhone.html indicating that "IPHONE" 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 by two finger touches. The iPhone runs on a special version of Apple's Mac OS X operating system."

Moreover, the services identified in this application are not suites of software applications, computer hardware devices or software as a service. Instead, the services set forth in the Statement of Use are "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 International Class 41 and "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," in International Class 42. None of the specimens of use filed by applicant, to date, show the applied-for mark in use in commerce in connection with any of these services.

Applicant also argues that the specimens of record should be accepted because "the prior practice of the USPTO reflects that it has routinely accepted analogous specimens of use submitted by other technology device manufacturers." Request for Reconsideration at page 9. To support this argument, applicant relies on copies of third-party registrations and accompanying specimens of use.

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 1218, 1220 (TTAB 2006) ("[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)).

Through the October 23, 2014 Request for Reconsideration applicant has filed substitute specimens of use. The substitute specimens of use consist of: 1) media files featuring two television commercials for applicant's "IPHONE" device and 2) pages from applicant's website featuring information for consumers "to learn how to solve most common 'IPHONE' issues." The examining attorney respectfully submits that

the substitute specimens of use also do not overcome the refusal because they do not show use of the proposed mark in the sale or advertising of any services identified in the Statement of Use.

For example, with respect to the media files featuring the television commercials submitted as substitute specimens for International Class 41, the examining attorney submits that the commercials clearly advertise applicant's computer hardware. Applicant argues that "upon watching these commercials, consumers will associate the IPHONE mark with the services advertised throughout the commercials. The services include the provision of various digital media content (e.g., books, films, games and music) and information pertaining thereto, which consumers will conclude come from online computer databases." Request for Reconsideration at 12. The examining attorney respectfully disagrees because there is no association between the proposed mark and any services identified in the Statement of Use in the commercials.

With respect to the substitute specimens of use for International Class 42, the examining attorney submits that they must also be refused. These substitute specimens consist of pages from applicant's website providing links and information for troubleshooting issues that may arise with applicant's own computer hardware. The specimen features a title that the page has information on "how to solve most common 'IPHONE' issues." Consumers encountering the proposed mark, through this specimen, would not view it as a source indicator for the identified services because there is no association between the proposed mark and the services identified in International Class 42 in the Statement of Use.

A service-mark specimen must show the mark as actually used in the sale or advertising of the services recited in the application. 37 C.F.R. §2.56(b)(2). "[B]ecause by its very nature a service mark can be used in a wide variety of ways, the types of specimens which may be submitted as evidence of use are varied." *In re Metriplex, Inc*., 23 USPQ2d 1315, 1316 (TTAB 1992). Whatever type of specimen is submitted, it must show proper use in commerce of the mark, which may be established by (1) showing the mark used or displayed as a service mark in the sale of the services, which includes use in the course of rendering or performing the services, or (2) showing the mark used or displayed in advertising the services, which encompasses marketing and promotional materials. *See On-Line Careline, Inc. v. Am. Online, Inc*., 229 F.3d 1080, 1088, 56 USPQ2d 1471, 1476-77 (Fed. Cir. 2000) (indicating that an online menu item bearing the mark ONLINE TODAY was proper service mark use in connection with "providing access to online computer services offering computer-industry news, commentary and product reviews" because, inter alia, the "menu items are the mechanisms by which users obtained access to a particular online service"); *In re Metriplex, Inc.*, 23 USPQ2d at 1316 (indicating that a specimen that does not explicitly refer to the services may be acceptable if it "show[s] use of the mark in the rendering, i.e., sale, of the services"); *In re Red Robin Enters*., 222 USPQ 911, 914 (TTAB 1984) (stating that "rendition" of services is properly viewed as an element of the "sale" of services); 37 C.F.R. §2.56(b)(2).

For specimens showing the mark used in advertising the identified services, the specimen must explicitly reference the services to establish the requisite direct association. *See In re Monograms Am., Inc*., 51 USPQ2d 1317, 1318 (TTAB 1999). 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. *See id.; 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]. Here, the word 'design' alone is sufficient to create in the minds of purchasers an association between the mark and applicant's commercial art services."); *In re Monograms Am., Inc*., 51 USPQ2d at 1318; see alsoTMEP §1301.04(h). However, 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 In re Monograms Am., Inc*., 51 USPQ2d at 1318.

Essentially, the mark must be shown "in a manner that would be perceived by potential purchasers as identifying the applicant's services and indicating their source." *In re DSM Pharm., Inc*., 87 USPQ2d 1623, 1624 (TTAB 2008); *see In re Ancor Holdings, LLC*, 79 USPQ2d 1218, 1220 (TTAB 2006) (*citing In re Walker Research, Inc*., 228 USPQ 691, 692 (TTAB 1986)).

In this case, the specimens of use filed by applicant fail to show use of the proposed mark in use in commerce for each international class. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a), 1301.04(f)(ii), (g)(i).

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).

Accordingly, the request is denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

/Linda M. Estrada/

Trademark Examining Attorney

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iPhone is a smartphone made by Apple that combines an iPod, a tablet PC, a digital camera and a cellular phone. The device includes Internet browsing and networking capabilities.

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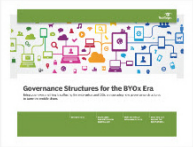

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millimeters thick) but wider and longer than many comparable devices. The display area is a 3.5-inch wide screen multi-touch interface with unusually high resolution (160 pixels per inch). Unlike most other smartphones, iPhone does not use a hardware keyboard or a stylus. To navigate, a user uses multiple taps and drags to navigate through a mobile version of Apple's OS X operating system. Like iPod, iPhone synchronizes data with a user's personal computer, using iTunes as a client software and Apple's proprietary USB port. iPhone is compatible with Microsoft's Windows operating systems, including Vista.

iPhone's networking features include:

- Automatic detection of WiFi networks.
- Support for the 802.11b and 802.11g standards.
- The use of quadband GSM and SIM cards to access cellular networks.
- EDGE support for high-speed data transfer where available.
- Bluetooth connectivity for short range networking with peripherals, other iPhones and PCs.

Apple says that iPhone carries 8 hours of life on the internal lithium-ion battery for talk or video, and up to 24 hours for music mode. The device ships with either a 4 or 8 GB hard drive, an Intel CPU and Apple's OS X operating system, modified for mobile use.

iPhone comes preloaded with a suite of media management software and communications software, including iTunes, the Safari Web browser and iPhoto. iPhoto may be used in combination with the 2 megapixel camera on the back of the device. Google's search and mapping services are fully integrated, including the ability to initiate phone calls from within Google Maps. Users can also view YouTube videos on the device, along with Microsoft Office documents and most imaging formats, including .JPEG, .GIF and .TIFF. A partnership with Yahoo allows iPhone users to send and receive rich HTML email. Other IMAP or POP3 e-mail services are integrated as well, along with webmail access in the browser.

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While iPhone was released under an exclusive two-year partnership with AT&T Wireless, it took less than three months for hackers working in concert worldwide to unlock the device for use on any GSM network, though the process involved a level of technical sophistication well beyond the consumer level.

This was first published in September 2007

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Mobile computing expert Rik Ahlberg considered the iPhone in the enterprise. Can it replace a BlackBerry?

Andrew Hickey writes that Apple's iPhone is 'gorgeous,' but not fit for the enterprise -- yet.

Apple iPad Review from TabletPCReview.com

Learn about connecting an iPhone to OWA in this tip from SearchExchange.com.

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Apple Reinvents the Phone with iPhone

MACWORLD SAN FRANCISCO—January 9, 2007—Apple® today introduced iPhone, combining three products—a revolutionary mobile phone, a widescreen iPod® with touch controls, and a breakthrough Internet communications device with desktop-class email, web browsing, searching and maps—into one small and lightweight handheld device. iPhone introduces an entirely new user interface based on a large multi-touch display and pioneering new software, letting users control iPhone with just their fingers. iPhone also ushers in an era of software power and sophistication never before seen in a mobile device, which completely redefines what users can do on their mobile phones.

"iPhone is a revolutionary and magical product that is literally five years ahead of any other mobile phone," said Steve Jobs, Apple's CEO. "We are all born with the ultimate pointing device—our fingers—and iPhone uses them to create the most revolutionary user interface since the mouse."

iPhone is a Revolutionary Mobile Phone
iPhone is a revolutionary new mobile phone that allows users to make calls by simply pointing at a name or number. iPhone syncs all of your contacts from your PC, Mac® or Internet service such as Yahoo!, so that you always have your full list of up-to-date contacts with you. In addition, you can easily construct a favorites list for your most frequently made calls, and easily merge calls together to create conference calls.

iPhone's pioneering Visual Voicemail, an industry first, lets users look at a listing of their voicemails, decide which messages to listen to, then go directly to those messages without listening to the prior messages. Just like email, iPhone's Visual Voicemail enables users to immediately randomly access those messages that interest them most.

iPhone includes an SMS application with a full QWERTY soft keyboard to easily send and receive SMS messages in multiple sessions. When users need to type, iPhone presents them with an elegant touch keyboard which is predictive to prevent and correct mistakes, making it much easier and more efficient to use than the small plastic keyboards on many smartphones. iPhone also includes a calendar application that allows calendars to be automatically synced with your PC or Mac.

iPhone features a 2 megapixel camera and a photo management application that is far beyond anything on a phone today. Users can browse their photo library, which can be easily synced from their PC or Mac, with just a flick of a finger and easily choose a photo for their wallpaper or to include in an email.

iPhone is a quad-band GSM phone which also features EDGE and Wi-Fi wireless technologies for data networking. Apple has chosen Cingular, the best and most popular carrier in the US with over 58 million subscribers, to be Apple's exclusive carrier partner for iPhone in the US.

iPhone is a Widescreen iPod
iPhone is a widescreen iPod with touch controls that lets music lovers "touch" their music by easily scrolling through entire lists of songs, artists, albums and playlists with just a flick of

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easily scrolling through entire lists of songs, artists, albums and playlists with just a flick of a finger. Album artwork is stunningly presented on iPhone's large and vibrant display.

iPhone also features Cover Flow, Apple's amazing way to browse your music library by album cover artwork, for the first time on an iPod. When navigating your music library on iPhone, you are automatically switched into Cover Flow by simply rotating iPhone into its landscape position.

iPhone's stunning 3.5-inch widescreen display offers the ultimate way to watch TV shows and movies on a pocketable device, with touch controls for play-pause, chapter forward-backward and volume. iPhone plays the same videos purchased from the online iTunes® Store that users enjoy watching on their computers and iPods, and will soon enjoy watching on their widescreen televisions using the new Apple TV™. The iTunes Store now offers over 350 television shows, over 250 feature films and over 5,000 music videos.

iPhone lets users enjoy all their iPod content, including music, audiobooks, audio podcasts, video podcasts, music videos, television shows and movies. iPhone syncs content from a user's iTunes library on their PC or Mac, and can play any music or video content they have purchased from the online iTunes store.

iPhone is a Breakthrough Internet Communications Device

iPhone features a rich HTML email client which fetches your email in the background from most POP3 or IMAP mail services and displays photos and graphics right along with the text. iPhone is fully multi-tasking, so you can be reading a web page while downloading your email in the background.

Yahoo! Mail, the world's largest email service with over 250 million users, is offering a new free "push" IMAP email service to all iPhone users that automatically pushes new email to a user's iPhone, and can be set up by simply entering your Yahoo! name and password. iPhone will also work with most industry standard IMAP and POP based email services, such as Microsoft Exchange, Apple .Mac Mail, AOL Mail, Google Gmail and most ISP mail services.

iPhone also features the most advanced and fun-to-use web browser on a portable device with a version of its award-winning Safari™ web browser for iPhone. Users can see any web page the way it was designed to be seen, and then easily zoom in to expand any section by simply tapping on iPhone's multi-touch display with their finger. Users can surf the web from just about anywhere over Wi-Fi or EDGE, and can automatically sync their bookmarks from their PC or Mac. iPhone's Safari web browser also includes built-in Google Search and Yahoo! Search so users can instantly search for information on their iPhone just like they do on their computer.

iPhone also includes Google Maps, featuring Google's groundbreaking maps service and iPhone's amazing maps application, offering the best maps experience by far on any pocket device. Users can view maps, satellite images, traffic information and get directions, all from iPhone's remarkable and easy-to-use touch interface.

iPhone's Advanced Sensors

iPhone employs advanced built-in sensors—an accelerometer, a proximity sensor and an ambient light sensor—that automatically enhance the user experience and extend battery life. iPhone's built-in accelerometer detects when the user has rotated the device from portrait to landscape, then automatically changes the contents of the display accordingly, with users immediately seeing the entire width of a web page, or a photo in its proper landscape aspect ratio.

iPhone's built-in proximity sensor detects when you lift iPhone to your ear and immediately turns off the display to save power and prevent inadvertent touches until iPhone is moved away. iPhone's built-in ambient light sensor automatically adjusts the display's brightness to the appropriate level for the current ambient light, thereby enhancing the user experience and saving power at the same time.

Pricing & Availability
iPhone will be available in the US in June 2007, Europe in late 2007, and Asia in 2008, in a 4GB model for $499 (US) and an 8GB model for $599 (US), and will work with either a PC or Mac. iPhone will be sold in the US through Apple's retail and online stores, and through Cingular's retail and online stores. Several iPhone accessories will also be available in June, including Apple's new remarkably compact Bluetooth headset.

iPhone includes support for quad-band GSM, EDGE, 802.11b/g Wi-Fi and Bluetooth 2.0 EDR wireless technologies.

iPhone requires a Mac with a USB 2.0 port, Mac OS® X v10.4.8 or later and iTunes 7; or a Windows PC with a USB 2.0 port and Windows 2000 (Service Pack 4), Windows XP Home or Professional (Service Pack 2). Internet access is required and a broadband connection is recommended. Apple and Cingular will announce service plans for iPhone before it begins shipping in June.

Learn More About iPhone
To learn more about iPhone, please visit Apple.com or watch the video of the iPhone introduction at www.apple.com/iphone/keynote.

Apple ignited the personal computer revolution in the 1970s with the Apple II and reinvented the personal computer in the 1980s with the Macintosh. Today, Apple continues to lead the industry in innovation with its award-winning desktop and notebook computers, OS X operating system, and iLife and professional applications. Apple is also spearheading the digital music revolution with its iPod portable music players and iTunes online store.

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