

Hearing:
April 20, 2011

**THIS OPINION IS NOT
A PRECEDENT OF
THE T.T.A.B.**

Mailed:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Apple Inc.

Serial No. 77219819

Glen Gunderson, Erik Bertin and Jacob Bishop of Dechert LLP, and Thomas R. La Perle, Esq. for Apple Inc.¹

April K. Roach, Trademark Examining Attorney, Law Office 115 (John T. Linconski, Managing Attorney).

Before Zervas, Taylor and Lykos, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Apple Inc. is the owner of an application (application Serial No. 77219819, filed pursuant to Trademark Act §§ 1(b) and 44(d), 15 U.S.C. §§ 1051(b) and 1126(d), for registration of the term MULTI-TOUCH (in standard character form) for International Class 9 goods ultimately identified as:

¹ Mr. Gunderson argued for applicant at the oral hearing. Except for the reply brief, Mr. La Perle signed all of the papers filed with the Office.

Handheld mobile digital electronic devices with electronic mail, digital data transmission, audio player, video player, handheld computer, personal digital assistant, electronic organizer, electronic notepad, telephone, computer gaming, and camera functions.

Applicant's identification of goods is directed to applicant's iPhone product.

The examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that applicant's proposed mark is merely descriptive of applicant's goods. Applicant then (i) filed an amendment to allege use asserting first use on January 9, 2007 and first use in commerce on June 29, 2007; (ii) amended its application to seek registration under the provisions of Trademark Act § 2(f), 15 U.S.C. § 1052(f); and (iii) submitted evidence in support of its Section 2(f) claim of acquired distinctiveness. The examining attorney was not persuaded by applicant's showing of acquired distinctiveness and issued a final Office action maintaining the Section 2(e)(1) mere descriptiveness refusal and her finding that applicant's Section 2(f) showing is insufficient.

Applicant has appealed the examining attorney's final refusal to the Board. Both applicant and the examining

attorney have filed briefs² and the Board conducted a hearing on April 20, 2011. We affirm the refusal to register.

The Federal Circuit, our primary reviewing court, has stated that "the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning." *In Re Bongrain Int'l (Am.) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1728 n.4 (Fed. Cir. 1990). The examining attorney and applicant disagree on the degree of descriptiveness of the applied-for term. Thus, we begin our analysis with a determination of the degree of descriptiveness of the term in relation to the goods identified in the application.³

The examining attorney maintains that "multi-touch" is "highly descriptive" and identifies a type of touchscreen interface which "allows a user to manipulate and control the functions of an electronic device by using more than

² Applicant submitted with its brief a copy of most, if not all, of the evidence it submitted during the prosecution of its application. The Board prefers not to have duplicates of material already submitted; it merely adds to the bulk of the record and wastes the time of Board staff in handling or scanning the papers and the time of the judges in reviewing the additional papers.

³ Applicant did not contest the Section 2(e)(1) determination in its brief, thus, applicant has waived any argument that the mark is not merely descriptive. The only issue presented in this appeal is whether the evidence of record is sufficient to support applicant's claim of acquired distinctiveness under Section 2(f).

one finger simultaneously." Brief at unnumbered p. 2.

Applicant's specimen of use explains:

Multi-Touch control.

With its large Multi-Touch display and innovative software, iPhone lets you control everything using only your fingers. Type using the predictive keyboard, glide through albums with Cover Flow, scroll through photos with a flick, or zoom in and out on a section of a web page - all courtesy of Multi-Touch.

How it works.

The Multi-Touch display layers a protective shield over a capacitive panel that senses your touch using electrical fields. It then transmits that information to the LCD screen below it. And the iPhone software enables the flick, tap and pinch.

The examining attorney relies on, inter alia, (a) a definition of "multi-touch" taken from <http://mobileburn.com> (submitted with the February 9, 2009 Office action) stating, "Multi-touch is a method of input on a touchscreen that allows two or more fingers to be used on the screen at one time"; (b) a <http://online.wsj.com> article (submitted with the July 10, 2008 office action) stating,

This interface is generally called "multitouch," and it involves using one or more fingers on a screen or touchpad to perform special gestures that manipulate lists or objects on a screen --

See TBMP § 1203.02(g) (3d ed. 2011); and *In re Gibson Guitar Corp.*, 61 USPQ2d 1948 (TTAB 2001).

without moving a mouse, pressing buttons, turning scroll wheels or striking keys;

and (c) a <http://www.popularmechanics.com> article

(submitted with the July 10, 2008 office action) stating,

A new technology called multitouch, which responds to multiple inputs by multiple fingers—even multiple users—at the same time, could transform the way we interact with computers. Why? Because simultaneous finger inputs allow more complex gestures than simple pointing and clicking, such as rotating or resizing a photo by grabbing two corners and pulling or navigating a map by pulling and twisting the image with your fingers.⁴

In addition, the examining attorney submitted the following evidence to support her contention that the mark is highly descriptive:⁵

- “Apple Sues Nexus One Maker HTC,” from <http://www.nytimes.com> (accessed March 26, 2010):

⁴ Applicant makes the point at p. 2 in its reply brief that many of the documents forming the examining attorney’s evidence were written in early 2008 and do not reflect the purchaser’s current perception of the MULTI-TOUCH mark in light of the success of the goods since the articles were written. There is ample evidence in the record post-2008. The evidence from 2008 – which was not too long ago – is probative, as is evidence with a later date. Applicant’s argument is also not well taken because applicant has not established much, if any, awareness of MULTI-TOUCH as a mark among potential purchasers (see discussion below), even as of 2010, when applicant filed its briefs.

⁵ Applicant has challenged the probative value of press releases because the average consumer would never encounter them, several articles because they merely report product rumors and previews and blogs because the examining attorney has not proven they are widely read by consumers. These challenges are not well taken; purchasers of applicant’s goods are the general public and the evidence demonstrates use of the term by the general public or directed to the general public, and may be accessed by the general public through the internet.

Since last fall, Google has been gradually **adding multitouch capabilities to phones** running Android through software updates.

- "Wee Mousie, Fear Not a Touch PC," from <http://www.nytimes.com> (accessed March 26, 2010):

The iPhone brought **multitouch** to the real world. You want to push a button? So push it. You want to turn a page? Flick the screen like a real page. Move down a map by dragging with your finger, as you would a real map. Spread two fingers on the glass to zoom into a page or a photo, as if it's printed on a sheet of rubber. Twist two fingers against the glass to rotate a photo. It's direct, it's logical, it's addictive.

But why should multitouch be confined to your phone? We should have multitouch screens on our computers, right?

Multitouch regular PCs, however, are a long way away from being usable or pleasant. Until the consistency and design problems go away, **multitouch** will only complement, not replace, the mouse.

- "Multitouch Screens Could Enliven New Devices," from the online *New York Times*, available at <http://bits.blogs.nytimes.com> (accessed March 26, 2010):

Multitouch screens have been a little slower to enter the electronics marketplace than consumers might have hoped. Since Jeff Han, a research scientist at New York University's Courant Institute of Mathematical Sciences, first presented his multitouch wall at the TED Conference in 2006, **we've seen other multitouch technologies trickle into the electronic marketplace.** The cellphone has used the technology most, starting with the iPhone, and then moving into other smartphones using Google's Android platform and Hewlett-Packard TouchSmart countertop computer. But with the exception of a few outliers and device manufacturer research

demos, we haven't really seen multitouch used in other consumer electronics yet.

As you can see from the images below, there are **lots of potential applications and devices that could use inexpensive multitouch technology.**

- "A Tablet PC That Lets The User Decide Whether to Type or Touch," from <http://www.nytimes.com> (accessed March 26, 2010):

The TX2Z from Hewlett-Packard is the **first multitouch convertible tablet PC**, which means you can turn the screen to hide the keyboard and use only your fingers on the laptop's 12-inch display.

- "Fujitsu Announces 9 New Notebooks," from *PC Magazine*, available at <http://www.lexis.com> (accessed March 26, 2010):

Fujitsu has announced several new additions to the LifeBook Series. The models run the gamut **from mini-notebooks to multi-touch tablets.**

Next up is the LifeBook UH900 Multi-Touch Mini-Notebook, that is by far the lightest in the series, being a mere 1.1 lbs with a 5.6-inch screen. Small enough to fit in a pocket, this handheld device delivers full PC functionality, while giving it the same portability as a smart phone.

- "Hands On: Dell Mini 3 and Mini 5," from *PC Magazine*, available at <http://www.lexis.com> (accessed March 26, 2010):

The Mini 5 is even more intriguing. It's a 5-inch, touchscreen Android tablet, with a wide screen, a slim body, and both HSDPA and WiFi connectivity. The Mini 5 has a 5-megapixel camera with LED flash on the back, and a smaller camera on the front. It **supports multitouch** and works with Android Market applications. While AT&T didn't announce support for the Mini 5, Dell said it would sell it both through carriers and directly at retail stores.

- "The Best of CES 2009," from *PC Magazine*, available at <http://www.lexis.com>:

PALM PRE Deemed the hottest product at CES by Editor-in-Chief Lance Ulanoff, the Pre boasts a new people-centric OS that consolidates contact information from various sources and makes it easy to connect with people in any number of ways. Add to that **a large multitouch screen**, a powerful processor, an accelerometer, a hidden QWERTY keyboard, GPS, 802.11g, and a 3.2-megapixel camera, and you've got the most innovative smartphone since the iPhone.

- "HTC Nexus One by Google," from cnet reviews, available at <http://reviews.cnet.com>:

Editors' note: In the days following this review, T-Mobile has acknowledged user complaints over 3G connectivity issues. We continue to test our phone and will update the review as needed. On February 2, 2010, Google issued an update to the Nexus One that **added multitouch capability**. We have changed this review the new feature.

- "Motorola Droid," from cnet reviews, available at <http://reviews.cnet.com> (accessed March 26, 2010):

The capacitive display's touch interface is quick and responsive and **we love the added multitouch capability**.

- "LifeBook® T900 Tablet PC," available at <http://store.shopfujitsu.com> (accessed March 26, 2010):

The unmatched 13.3-inch display with 160 degree vertical and horizontal viewing angles and **optional multi-touch screen** provides the optimal combination to efficiently interact with on-screen applications.

This evidence suggests that "multi-touch" identifies the technology used in applicant's device and in similar

devices of other manufacturers for controlling various features of the devices.⁶

Other evidence in the record indicates that multi-touch identifies how the interactive surface of the kind used on applicant's goods operates.⁷ See page from "Next Window's Multi-Touch Overview," submitted with February 8, 2009 Office action, stating:

What is Multi-Touch?

Multi-touch simply refers to a touch-sensitive device that can independently detect and optionally resolve the position of two or more touches on screen at the same time. In contrast, a traditional touch screen senses the position of a single touch and hence is not a multi-touch device.

- A single-touch touch screen allows users to interact with software by touching the screen instead of using a mouse, for example. ...
- A multi-touch touchscreen, not only provides the intuitive human-computer interface as above, but also surpasses the capability of traditional pointing devices. Multi-touch provides a much richer set of gestures. For example, you can use

⁶ Applicant states at p. 2 of its January 12, 2009 response that "touchscreen" and "capacitive" are the generic terms for applicant's input technology. At Exhibit C to the same response are internet printouts from freshpatents.com and reuters.com referring to devices using "two finger inputs" on touch screens. Despite applicant's contention and evidence, the balance of the evidence, including the dictionary definition of "multi-touch" which applicant has not challenged, persuades us that that "multi-touch" is a generally accepted term that identifies this input technology.

⁷ The definition of "multi" submitted with the February 8, 2009 Office action from the online edition of *The American Heritage Dictionary of the English Language* (4th ed. 2000) located at bartleby.com is "1. Many; much; multiple; multicolored. 2a. More than one ... b. More than two ..."

your finger and thumb in a stretching, squeezing or rotating action to manipulate an object on screen.

- Furthermore, multi-touch allows you to perform more than one action at the same time. ...

Also, from <http://elotouch.com> (submitted with February 8, 2009 Office action), is the following:

First of all, what is "multi-touch?" At its simplest, multi-touch is the ability to recognize multiple touch points simultaneously. Some touch technologies can realistically handle only two simultaneous points; others are unlimited.

And, the article submitted with the February 8, 2009 Office action entitled "[N]okia recovering, readying multi-touch phone?" at <http://electronista.com> states, "Alleged market sources tell DigiTimes today that Nokia is planning a resurgence that may hinge on multi-touch devices. ... While unconfirmed, the news would make Nokia only the second company outside of Apple to have plans for multi-finger touch controls."

Applicant has submitted evidence to show that three other manufacturers of electronic devices use particular trademarks to identify the touchscreen features of their devices. See Ex. J to applicant's brief. This evidence has limited probative value; it only demonstrates that the three manufacturers have adopted their own trademarks for the touchscreen feature of their products.

Thus, from the foregoing, we find that "multi-touch" not only identifies the technology, but also describes how a user of the goods operates the device. Based on the evidence discussed above, as well as other evidence in the record, we agree with the examining attorney that MULTI-TOUCH indeed is highly descriptive of a feature of the identified goods. We now consider whether applicant has submitted sufficient evidence to establish acquired distinctiveness of this highly descriptive term.

It is applicant's burden to establish a prima facie case of acquired distinctiveness. See *Yamaha Int'l Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). In determining whether secondary meaning has been acquired, the Board may examine copying, advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, and consumer studies (linking the name to a source).⁸ *Cicena*

⁸ See also TMEP § 1212.06 (7th ed.), stating:

Under Trademark Rule 2.41(a), 37 C.F.R. §2.41(a), an applicant may submit affidavits, declarations under 37 C.F.R. §2.20, depositions, or other appropriate evidence showing the duration, extent, and nature of the applicant's use of a mark in commerce that may lawfully be regulated by Congress, advertising expenditures in connection with such use, letters, or statements from the trade and/or public, or other appropriate evidence tending to show that the mark distinguishes the goods or services.

Ltd. v. Columbia Telecomms Group, 900 F.2d 1546, 14 USPQ2d 1401 (Fed. Cir. 1990). "On this list, no single factor is determinative." *In re Steelbuilding.com*, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. See *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (CCPA 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (CCPA 1960); and *In re Gammon Reel, Inc.*, 227 USPQ 729 (TTAB 1985). Typically, more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods or services would be unlikely to believe that it indicates source in any one entity. See, e.g., *Bongrain*, 13 USPQ2d at 1727 n. 4, citing *Yamaha Int'l*, 6 USPQ2d at 1008 ("the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning").

Applicant has used MULTI-TOUCH for a limited time period - only two and a half years. Applicant's evidence for the most part consists of Internet and Nexis articles, as well as applicant's webpages, describing the iPhone

product.⁹ This evidence establishes that the iPhone is a very successful product that has generated much interest among potential purchasers. However, as the examining attorney correctly pointed out, the applied-for mark is not IPHONE, it is MULTI-TOUCH. Thus, applicant's evidence pertaining to the success, sales volumes and, to a limited extent, advertising expenditures of the iPhone, is not helpful in establishing that the purchasing public associates the term MULTI-TOUCH with applicant. As has been stated in the past, a successful product and even high advertising expenses for the product do not necessarily translate into a mark acquiring descriptiveness. See *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately eighty-five million dollars, and annual advertising expenditures in excess of ten million dollars,

⁹ Some of the articles submitted by applicant use "multi-touch" in a trademark manner, i.e., with initial capital letters and, in some instances, the "TM" designation next to the term. On balance, these uses, although not insignificant in number, do not establish that the public has come to view MULTI-TOUCH as a source indicator. In fact, some of the articles support the examining attorney's assertion of non-trademark use. See, "iPhone taps into a new era" from *Newark Morning Ledger Co.* (January 10, 2007) accessed from www.lexis.com stating, "All functions are activated by tapping the screen with your finger, a patented technology called 'multi-touch.'"; and "It's not the iPhone, but G1 at least some competition" from *The San Francisco Chronicle* (October 17, 2008) accessed from www.lexis.com stating, "It isn't capable of the multitouch that distinguishes the iPhone, but it's sensitive."

not sufficient to establish acquired distinctiveness in view of highly descriptive nature of mark); *Braun Inc. v. Dynamics Corp.*, 975 F.2d 815, 827, 24 USPQ2d 1121, 1133 (Fed. Cir. 1992) ("[L]arge consumer demand for Braun's blender does not permit a finding the public necessarily associated the blender design with Braun."); *Bongrain*, 13 USPQ2d at 1729 (growth in sales may be indicative of popularity of product itself rather than recognition as denoting origin).

The record does not reveal that MULTI-TOUCH has been used on the goods or even on packaging for the goods. For this reason too we are not sympathetic to applicant's arguments that the success of the product sold under the IPHONE trademark translates to acquired distinctiveness of the term MULTI-TOUCH. Rather, the record reflects use by applicant of MULTI-TOUCH on webpages describing the operation of the goods. See, e.g., the specimen of use, which is a printout of one of applicant's webpages. Because such use is on a website, applicant should have introduced evidence showing how long the term was used on the website and what levels of traffic it had on the website. All we know about exposure to the website is what appears in an article from <http://nielsenbuzzmetrics.com> (Exhibit C to applicant's August 19, 2009 filing) entitled

"Unprecedented Pre-Launch Buzz Sets High Expectations for iPhone, Sales and Customers, Nielsen BuzzMetrics Reports," dated June 25, 2007, which states in relevant part that "the iPhone section of the site had 1.79+ million unique visitors in January 2007," and refers to visitors through May 2007, specifically noting that there were "more than 701,000 unique visitors a month prior to release." That article, even in combination with other evidence, only establishes exposure to applicant's webpages during a limited period in 2007; there is no indication in the record of the number of visitors to the website outside of the times mentioned in the article. Also, the webpages referred to in the Nielsen report from January 2007 are not of record so we cannot determine if MULTI-TOUCH even was featured on the website at that time.

Additionally, applicant makes several statements in its brief which are not supported by evidence. Clearly, an applicant may not make assertions of fact in its brief that are unsupported by evidence properly put into the record. *Martahus v. Video Duplication Services Inc.*, 3 F.3d 417, 27 USPQ2d 1846, 1849 (Fed. Cir. 1993) ("mere attorney arguments unsubstantiated by record evidence are suspect at best"). For example, at pp. 8 - 9 of its brief, applicant states that "[t]he continued success and sales growth of

the iPhone device means that more and more consumers have encountered the MULTI-TOUCH mark in advertising, user manuals, and in-store product demonstrations, which reinforces the fact that they view MULTI-TOUCH mark as an indicator of source for Applicant's products." The record includes no user manuals, little advertising showing MULTI-TOUCH and no evidence regarding in-store product demonstrations in which the MULTI-TOUCH term is used. Additionally, applicant states at p. 10 of its brief that its "national television commercials have demonstrated the touchscreen interface of MULTI-TOUCH devices." Again, there is no evidence in the record regarding national television commercials, including the frequency of such commercials and even if MULTI-TOUCH was mentioned or promoted as a mark in such commercials, which would be important to applicant's claim of acquired distinctiveness.

Last, applicant submitted copies of several registrations from other countries for MULTI-TOUCH. These registrations are irrelevant to our analysis because they may have issued under different standards and rules than those which we are bound to follow.

We also point out that applicant did not submit other types of evidence which the Board typically considers in determining acquired distinctiveness. Specifically, there

are no affidavits, declarations, depositions, or other appropriate evidence showing the extent and nature of the applicant's use of MULTI-TOUCH, advertising expenditures in connection with the use of MULTI-TOUCH,¹⁰ letters, or statements from the trade and/or public in the record. We know nothing about the quantity, frequency and scope of any advertising of MULTI-TOUCH. Simply put, the record contains little direct or circumstantial evidence that purchasers of applicant's goods view MULTI-TOUCH as a distinctive source indicator for applicant's goods. Clearly, MULTI-TOUCH is not the primary mark for applicant's goods, and it is not apparent from the material submitted by applicant to what extent MULTI-TOUCH has made an impression on purchasers as a source indicator for applicant's goods.

Thus, in view of the foregoing, and given the highly descriptive nature of the designation MULTI-TOUCH, we would need substantially more evidence (especially in the form of direct evidence from customers) than what applicant has submitted in order to find that the designation has become

¹⁰ Applicant's counsel states at p. 7 of its brief, without citing to any specific evidence, that applicant spent \$388 million on advertising in its fiscal year 2006, \$467 million in 2007 and \$486 million in 2008. Even if the statement was supported by the record, it is not helpful to applicant because it does not indicate how much of this advertising, if any at all, was for MULTI-TOUCH.

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distinctive of applicant's services. *In re Lens.com Inc.*, 83 USPQ2d 1444 (TTAB 2007). Again, simply because the applied-for term has been used in association with a highly successful product does not mean the term has acquired distinctiveness.

Decision: The examining attorney's finding that the Section 2(f) showing is insufficient is affirmed.