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EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77844736

MARK: OPENCL



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Apple Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

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CORRESPONDENT E-MAIL ADDRESS:

EXAMINING ATTORNEY'S APPEAL BRIEF

On November 17, 2011, the Applicant, Apple, Inc., submitted an intent-to-use application (serial No. 77616247) to register the standard character mark OPENCL for “computer software; Application programming interface computer software and language definition for uses in developing applications for execution on central processing units (CPU) or graphic processor units (GPU).” On October 8, 2011, Applicant submitted two additional companion applications for the mark OPENCL and design (serial No. 77844718 based on 1(a) and 44(d); and serial No. 77844736 based on 1(b) and 44(d)) for “Application programming interface computer software for use in developing applications for execution on central processing units (CPU) or graphic processor units (GPU).”¹ The design marks were refused because the marks were not used to identify “goods in trade” under Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051-1053, 1127. Upon submission of the statement of use, the standard character mark was refused for the same

¹ Applicant subsequently deleted the Section 44(d) basis for serial Nos. 77616247 and 77844736.

reason. For purposes of consistency, the standard character mark was reassigned to the Examining Attorney assigned to the design marks.

After Applicant responded to the initial refusal, the Examining Attorney issued new Office Actions requiring a disclaimer of the term “OPENCL” in the design marks and refusing registration for the standard character mark for mere descriptiveness under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). The Examining Attorney also refused the specimens for the use-based applications (Nos. 77616247 and 77844718) because they did not show use of the mark as a trademark for the goods identified in the applications. Applicant responded by arguing that the term OPENCL was not descriptive, submitted substitute specimens, and amended the identification of goods to its current form. The requirement for a disclaimer in the design marks and the refusal under Section 2(e)(1) for the standard character mark were then made Final. The refusal of the specimens for failure to show use of the mark as a trademark was also continued and made final for application Nos. 77616247 and 77844718. Applicant subsequently requested reconsideration in each of the applications and appealed all of the remaining issues to the Trademark Trial and Appeal Board. On September 22, 2011, Applicant submitted a motion to consolidate the appeals in the three applications for all purposes and the Board granted the request. This appeal now follows.

ARGUMENTS

I. The Term OPENCL is Merely Descriptive

- A. The Term OPENCL is Merely Descriptive Because it Identifies the Common Name of an Industry Standard.

Section 1209.01 of the Trademark Manual of Examining procedure states, “matter may be categorized along a continuum, ranging from marks that are highly distinctive to matter that is a generic name for the goods or services.” “A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services.” TMEP §1209.01(b). However, generic terms are terms that the relevant purchasing public understands primarily as the common name for the goods or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001). These terms are incapable of functioning as trademarks and denoting source. TMEP §1209.01(c).

Applicant has applied to register the term OPENCL in standard characters and with design for “Application programming interface computer software for use in developing applications for execution on central processing units (CPU) or graphic processor units (GPU), sold as an integral component of computer operating software.” The original specimen submitted for application Nos. 77616247 and 77844718 states, “OpenCL stands for Open Computing Language.” (Oct. 29, 2009, Specimen, p.3). The specimen further states, “Best of all, OpenCL is an *open standard* that’s supported by the biggest names in the industry, including AMD, Intel, and NVIDIA.” (Specimen, p.4).

The Examining Attorney refused the standard character mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), and required a disclaimer of “OPENCL” for the design marks under Section 6, 15 U.S.C. §1056, because OPENCL immediately identifies the common or generic name of an industry standard language and application programming interface. In the Office Action dated September 14, 2011, the Examining Attorney submitted twenty-nine articles from a Lexis database identifying

OPENCL as the name of an “industry standard” or “open standard”. (See end of Office Action).² The Examining Attorney also submitted several web pages referring to OPENCL as an open industry standard. (Sept. 14, 2011, Office Action, pp. 2-31). Applicant concedes that OPENCL is the name used for an “open standard for the computing industry.” Applicant’s Brief at 6. However, Applicant disputes the Examining Attorney’s conclusion that the name of an *open industry standard* is merely descriptive of the goods with which it is used and cannot also identify the source of Applicant’s goods. Brief at 11.

The determination of whether a mark is merely descriptive requires consideration of the significance that the mark would have to the average purchaser of the goods in the marketplace. *See In re Omaha Nat’l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987). In the Final Action dated February 24, 2011, the Examining Attorney attached the following references defining the term “standard”:

Standards are the technical specifications and working methods necessary for different vendors’ equipment to interoperate. Standards enhance efficiency and usability; however, they do not protect life and limb.³ (Exhibit 3, p.56).

A specification for hardware or software that is either widely used and accepted (de facto) or sanctioned by a standards organization (de jure).⁴ (p. 57).

Standards are necessary for interworking, portability, and reusability. They may be de facto standards for various communities, or officially recognized national or international standards.⁵ (p. 58).

² All references to **evidence** in the consolidated appeals refer to the page numbers and evidence in Serial No. 77616247 for the standard character mark. Evidence in each case is the same but may not be in the same order or have the same action date.

³ On-line computer glossary from WestNet learning.

⁴ Computer Desktop Encyclopedia copyright ©1981-2009 by The Computer Language Company, Inc.

⁵ Provided by FOLDOC – Free Online Dictionary of Computing (foldoc.org)

Contrary to Applicant's assertion on page 10 of its brief, the Examining Attorney has also provided multiple references defining an "open standard". For example, an on-line article from Wikipedia® describing open standards submitted with the August 2, 2010 Office Action contains several definitions of "open standard".⁶ (Aug. 2, 2010, pp. 48-57). A popular definition credited to Bruce Perens states, "Open Standards create a fair, competitive market for implementations of the standard. They do not lock the customer in to a particular vendor or group." "Open Standards are free for all to *implement*, with no royalty or fee." (p.51). The Open Source Initiative's definition further states that "[a]n 'open standard' must not prohibit conforming implementations in open source software." (p.52). The Digital Standards Organization (DIGISTAN) defines an open standard as "a published specification that is immune to vendor capture at all stages in its life-cycle." (p.53). All of the definitions provided essentially identify an open standard as a specification that can be freely implemented by all and that promotes *competition* because its use cannot be claimed by a single vendor. Similarly, one of the main reasons for not allowing protection of descriptive marks through registration is to prevent the applicant from inhibiting *competition*. *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978).

In its brief, Applicant references an article from wigglesbits.com describing how standards are necessary for every day communication. Brief at 10. The Examining Attorney provided the article as evidence because the author thoroughly describes, in simple terms, the meaning and use of standards in various fields. (Aug. 2, 2010, pp. 59-

⁶ Articles from the online Wikipedia® encyclopedia may be used to support a refusal or requirement, provided the applicant has an opportunity to rebut such evidence. *See In re IP Carrier Consulting Grp.*, 84 USPQ2d 1028, 1032 (TTAB 2007); TBMP §1208.03; TMEP §710.01(b).

62). The author compares standards to the English language as a means for communication as follows:

Languages and standards are very similar, they are the means by which people and computers communicate: people via language and computers via standards. Just like society needs a common language to communicate and grow, computers need a common language also. In that way, both the signal senders and the signal receivers will always speak the same language. And just like no one should “own” English, no one should “own” standards, the language of computing. (p. 61).

The author then distinguishes an “open standard” from a “proprietary standard” by stating, “[a]n *open standard* is a published standard that is possessed by no one and used by all. HTML is an open standard; it is managed by the World Wide Web consortium and they see to its dissemination and evolution. But they do not own it, no one does. A *proprietary standard*, on the other hand, is typically owned by a corporation. Its internals cannot be inspected.” (p.61)

The evidence in the record therefore indicates that the relevant consumers would view OPENCL as the name of an open standard in the computing industry because of the frequent use of OPENCL with the terms “open standard” and “industry standard”. The abundant use in the marketplace identifies the term as the name for an open standard for a computing language and API. Indeed, Applicant and its “licensees” promote OPENCL as an open standard in the computing industry. The multiple descriptions of “open standard” indicate that the significance of the name of an open standard to the relevant consuming public immediately describes a specification used by all for equipment from different vendors to interoperate and to maintain competition in the market.

Consequently, the significance that the proposed mark would have to the average

purchaser is that of the common name of an open industry standard or specification that is free to be used by all and will have multiple implementations.

Applicant argues that “open standards are analogous to open source software” and provides examples of registrations that Applicant contends identify open source software that have been registered by the USPTO. Brief at 11. This statement is incorrect.

Moreover, registrations for open source software are not relevant to the refusal. Based on the evidence in the record, open standards are analogous to agreed upon blueprints or protocols that must be employed to ensure that things, such as software or hardware, made by different people will work together. An open standard cannot be changed except by consensus or agreement by members of an industry consortium. If a manufacturer wants to compete in an industry, it must adopt the standards and implement the standards into its products so that they may communicate with, or work together with, products from other manufacturers. Therefore, because Applicant’s proposed mark identifies the common generic name of an open standard it cannot also indicate the source of Applicant’s goods.

B. The Term OPENCL is Merely Descriptive Because it Identifies the Common Name of a Non-Proprietary Computing Language.

The proposed mark OPENCL is also merely descriptive of the identified goods because it identifies the common name of a non-proprietary computing language.

“Because a language is not “goods” or “services” under the Act, 15 U.S.C. Section 1127 (1988), a name originated for a new language is inherently not registrable for the language.” *The Loglan Inst., Inc. v. Logical Language Group, Inc.*, 962 F.2d 1038, 1041,

22 USPQ2d 1531, 1533 (Fed. Cir. 1992). In *Loglan*, the Court upheld Trademark Trial and Appeal Board's cancellation of the term "Loglan" on the grounds that the mark was a generic designation identifying logical language. The Court stated, "a generic name of a language alone cannot function as a trademark to indicate origin of a dictionary describing that language." *Id.* The Court relied on evidence that third parties and the Registrant itself used the term in a generic fashion.

In this case, the Examining Attorney has provided evidence of third-party references to OPENCL as a common open computing language. In the Office Action dated February 24, 2011, the Examining Attorney attached twenty-five articles from a search of a Lexis database referring to OPENCL as an Open Computing Language. Most of the references do not refer to Applicant or the Khronos Group. The articles include the following:

ArcSoft's products, which are optimized with **OpenCL**, include the upscaling technology SimHD® on TotalMedia Theatre 5 and H.264 encoders across many applications such as TotalMedia ShowBiz, TotalMedia Studio, and MediaConverter 7. With OpenCL-based H.264 encoders, the encoding process takes the full capacity of the entire . . . (Document 9).

CUDA provides compilers to use **common programming languages** to write software for the GPU rather than the unique specialty **languages** previously required for graphics programming. CUDA currently supports programming in C, C, Fortran, **OpenCL**, Direct Compute, Python, Perl and Java. This list continues to grow with offerings from NVIDIA and third parties. (Document 11).

IBM has released a Linux development kit for the Open Computing **Language OpenCL**. **The language**, is seen as vendor agnostic solution to parallel coding **languages** such as Nvidia's Cuda. Even IBM claims that the language "greatly improves speed and responsiveness for a wide spectrum of applications in numerous market categories from gaming and entertainment to scientific and medical software." In IBM's case, it's less of the gaming and more towards the scientific research aspect. (Document 15).

The **OpenCL industry standard programming language** allows developers to preserve their source code investments and easily target multi-core CPUs, GPUs, and will be supported on the upcoming AMD Fusion APUs. (Document 17).

In addition to Applicant's own promotion of OPENCL as an open standard on the original specimen, Applicant's licensee, the Khrohos Group, also promotes OPENCL as an "open, royalty-free standard for cross-platform, parallel programming". (Aug. 2, 2010 Office Action, p. 8). The definitions of "open standard" in the record support the conclusion that OPENCL is the common name of a computing language used as an industry standard and is not a source-indicator for Applicant's own computer software.

Applicant has submitted several third-party registrations as evidence that the names of computer languages could function as a trademark for computer software. However, "prior decisions in 'descriptiveness' and 'capability' cases, no less decisions of Examiners rather than precedential tribunals are of little help in determining such issues in a given case with its peculiar designation and factual context." *In re Carvel Corporation*, 223 USPQ 65, 66-7 (TTAB 1984). Additionally, the records of those registrations are not of record here. Moreover, the Examining Attorney also provided evidence of third-party registrations where the generic names of the computer languages (BASIC, COBOL, FORTRAN, PASCAL, C+) have been disclaimed. (Exhibit 4, Feb. 24, 2011, pp. 62-77).

In support of registration Applicant cites the non-precedential case *In re Faculdades Catolicas*, Serial No. 77423725 (TTAB, July 10, 2010) where the Board allowed registration of the mark LUA for computer programs recorded on data media . . . for implementing computer programming languages. However, in the that case, the Board found the evidence insufficient to conclude that LUA referred to a particular "type

of programming language as opposed to a particular *proprietary* programming language.”

Id. at 12. Unlike LUA, OPENCL identifies the common name of a non-proprietary, industry standard language. Contrary to Applicant’s assertion on page 8 of its brief, the articles attached to the September 12, 2011 denial of reconsideration clearly identify OPENCL as a non-proprietary open computing language. The articles include the following:

"We are proponents of industry **standards** like **OpenCL** and Bullet Physics because they can simplify programming as well as removing barriers caused by **proprietary** technologies that can restrict developers' creativity," said Sandeep Gupte, general manager, AMD Professional Graphics. (Document 3).

The jointly developed **OpenCL** courses from AMD and Acceleware are designed to support professional software developers by providing ongoing education opportunities around **OpenCL**, the **non-proprietary industry standard** for true heterogeneous computing across platforms. (Document 12).

This effort underscores AMD's commitment to the educational community, which currently includes a number of strategic research initiatives, to enable the next generation of software developers and programmers with the knowledge needed to lead the era of heterogeneous computing. **OpenCL**, the only **non-proprietary industry standard** available today for true heterogeneous computing, helps developers to harness the full compute power of both the CPU and GPU to create innovative applications for vivid computing experiences. (Document 24).

A major difference between the approaches by Nvidia and AMD to GPU computing is that the former has developed its **proprietary** CUDA framework, while the latter says it's committed only to open **standards** like the **OpenCL** heterogeneous programming language that can work on any vendor's hardware. (Document 60).

Additionally, the abundant evidence identifying OPENCL as an “open standard” and “industry standard” supports the conclusion that OPENCL is non-proprietary based on the definitions of “open standard” discussed previously. The definition of “proprietary” from dictionary.com includes: “manufactured and sold *only* by the owner

of the patent formula, brand name, or trademark associated with the product.” (Emphasis added). (February 24, 2011, p. 88). Unlike the computing language in *In re Faculdades Catolicas*, the OPENCL open standard language is “free for all to implement” and is not provided only by Applicant. Indeed, the evidence attached to the August 2, 2011 Office Action identifies implementations of the OPENCL standard by several different independent vendors, including AMD®, Nvidia®, RapidMind®, Gallium3D, ZiiLABS, and IBM®. (Aug. 2, 2011, pp. 3-4). Most of these implementations are not software at all, and particularly, not Applicant’s software. Consequently, Applicant’s use of OPENCL with its operating system software to identify its own implementation of the language merely describes the common generic name of the industry standard and cannot function as a source identifier for software that implements the language.

Applicant argues that the computing industry recognizes OPENCL as a trademark and Applicant has submitted affidavits from two companies who are “licensees” of the proposed mark and have adopted the standard. However, the determination of whether a designation is descriptive or generic depends on how the relevant public understands the term. TMEP §1209.01(c)(i). The parties represented in the affidavits do not represent the relevant public in this case. These “licensees” are manufacturers and providers of computer and graphics processors. They provide their own implementations of the language on their processors in conformance with the standard. The relevant public, in this case, are purchasers of the software, CPU’s and GPU’s or programmers who need to write programs in the OPENCL language using one of the many implementations of the standard. And given the nature of the mark and the manner in which it is used in

commerce the term OPENCL is merely descriptive because it identifies both the name of an industry standard and a non-proprietary computing language.

II. The Specimens do not Show Use of OPENCL as a Trademark for Computer Software

A. The Term OPENCL, as Used on the Specimens, Identifies a Programming Language, and is not Used to Identify Computer Software.

The specimens of use submitted with application Serial Nos. 77616247 and 77844718 do not show use of the marks OPENCL and OPENCL and design as trademarks in connection with “application programming interface computer operating software for use in developing applications for execution on central processing units (CPU) or graphics processor units (GPU), sold as an integral component of computer operating software.” An application for registration under §1(a) of the Trademark Act or an allegation of use in an application under §1(b) of the Act must include one specimen per class showing use of the mark on or in connection with the goods. 15 U.S.C. §§1051(a)(1), 1051(c) and 1051(d)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), 2.76(b) and 2.88(b). TMEP §904.

Applicant submitted the same specimen with the statement of use for serial No. 77616247 and the application for serial No. 77844718. The specimen consists of a web page for Applicant’s OS X operating system software with the heading “New technologies in Snow Leopard”. According to the specimen, the operating system software can be purchased by clicking on a button with the wording “Buy Now” at the top of the page. The proposed mark, OPENCL, appears by scrolling down the web page.

However, a close inspection reveals that OPENCL is identified as “a C-based programming language with a structure that will be familiar to programmers who can simply use Xcode developer tools to adapt their programs to work with OpenCL.” (SOU, Oct. 29, 2009, p.5). Consequently, the specimen does not show use of the mark to identify Applicant’s software. Instead, it merely identifies the implementation of the standard programming language. Additionally, a computing language is not software. A programming language is “an artificial language” or “a set of grammatical rules” designed to express computations. (See Exhibit 1, Feb. 24, 2011, pp. 2-19).

Applicant argues that the statement on the specimen that “OpenCL automatically optimizes for the kind of graphics processor in the Mac, adjusting itself to the available processing power” is not a description of a programming language. However, this statement does not identify a function of computer software. It identifies the advantages of programming in the OpenCl language and “GPU-based programming”. Additionally, the statement on the specimen that “OpenCl makes it possible for developers to tap the vast gigaflops of computing power currently in the graphics processor” merely identifies what’s made possible for software developers by programming in OpenCl. It does not identify the function of computer software identified as OpenCl.

In its brief, Applicant provides conflicting statements that OpenCl is in fact used to identify computer software. On page 6, Applicant states, “OPENCL is a *technical framework* that Apple created in order to allow computer programmers to write software with multiple types of processors.” (Emphasis added). However, a technical framework identifies a specification for a standard or computing language but does not identify computer software. Additionally, Applicant states, “Apple has developed a computer

language and software that implements that language, and is attempting to register the name that refers to both the language and the software as a trademark *for software* that implements the language.” Brief at 8. (Emphasis in original). On the specimen, OPENCL clearly refers to the standard computing language. The software that implements the language is the Mac OS X® operating system software and the trademarks that identify it are Mac OS X® or Snow Leopard®. OPENCL does not refer to this software.

In its August 24, 2011, Request for Reconsideration for the standard character mark in serial No. 77916247, Applicant submitted a substitute specimen only identified as a “screen shot depicting an implementation of the OPENCL API.” The specimen appears to show an “example” of use of the language and does not appear to identify a particular software. Moreover, an API is also not software. An API is defined as a “set of routines, protocols and tools for building software applications” or “an interface between the operating system and application programs which includes the way the application programs communicate with the operating system, and the services the operating system makes available to the programs.” (Office Action dated Aug. 2, 2010, pp. 64-67). As such, the API is merely a communication interface, or set of rules and specifications to allow software written in OPENCL to communicate with the operating system and other software or hardware. It is an integral feature of the programming language. (See Feb. 24, 2011, Final Action, Exhibit 2, pp. 20-54).

- B. OPENCL is Used on the Specimens to Identify an Open Standard, and Therefore, Cannot also Identify the Source of Applicant’s Software.

Based on Applicant's specimens and the evidence in the record, the Examining Attorney refused registration because the specimen does not show the applied-for mark in use in commerce as a trademark. 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56; TEMP §§904, 904.07(a). The specimen, along with any other relevant evidence of record, is reviewed to determine whether an applied-for mark is being used as a trademark. *In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455 (TTAB 1998). Applicant's specimen states, "[b]est of all, OpenCL is an open standard that's supported by the biggest names in the industry, including AMD, Intel, and NVIDIA." Because of consumers' understanding of an "open standard", the use of OPENCL on the specimens does not show use of the mark as a trademark.

Applicant's own arguments contradict its position that OPENCL is used as a source indicator for the identified goods. On page 9 of its brief, Applicant states, "[d]evelopers associate the name of an open standard with the organization that *manages and evolves* the standard, and they use the name as a mark to indicate conformance with the criteria developed by that organization." (Emphasis added). Consequently, Applicant admits developers would not associate the name with Applicant, even when used on its operating system. Moreover, the process of *managing* and *evolving* a standard by a non-profit consortium does not indicate the sale or provision of a particular product.

Additionally, the use of OPENCL to indicate conformance with criteria suggests certification of particular criteria and not indication of source. Applicant argues that "when they [developers] see the mark OPENCL in connection with *an implementation* of the standard, they know the implementation has been certified to meet the specifications

promulgated by Khronos.” Brief at 9. (Emphasis added). In addition, “[m]embers of Khronos are licensed to use the mark OPENCL in connection with *implementations* of the standard that conform to the specifications, as determined by Khronos. Brief at 6. These statements indicate that there are multiple implementations of the standard in addition to Applicant’s implementation. The statements further indicate that the mark certifies conformance with the specifications of the industry standard, consistent with a certification mark.

With its Request for Reconsideration dated, August 24, 2011, Applicant submitted a copy of the “Khronos Trademark Guidelines”. (pp. 80-82). In the second paragraph of the first page the guidelines state, “Khronos may make available Certification Logos available for use on fully conformant products.” It is clear from the record in this case that the use and promotion of OPENCL will give certification significance to the mark in the marketplace and not identify the source of Applicant’s goods. See TMEP §1306.05; *See also, Ex parte Van Winkle*, 117 USPQ 450 (Comm’r Pats. 1958). A mark that functions to certify conformance with a standard cannot also be used to indicate the source of a particular product. TMEP §1306.05. Consequently, Applicant has not submitted evidence of use of the mark as a trademark for the identified goods.

CONCLUSION

The term OPENCL identifies the common generic name of a non-proprietary computing language and an open standard in the computing industry. Therefore, the refusal of the mark under Section 2(e)(1) for serial No. 77646247 and the requirement for

a disclaimer for serial Nos. 77844718 and 77844736 should be affirmed. Additionally, the specimens submitted for the applications based on use in commerce show use of the mark in connection with an open standard computing language and do not identify the goods in the application. Consequently, the refusal of the specimens for failure to show use of the mark as a trademark for the identified goods should be affirmed.

Respectfully submitted,

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