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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77844736
Applicant	Apple Inc.
Applied for Mark	OPENCL
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re Applications of :
Apple Inc. :
 :
Mark: OPENCL :
Serial No.: 77/616,247 :
Filing Date: November 17, 2008 :
 :
Mark: OPENCL & Design (black/white) :
Serial No.: 77/844,718 :
Filing Date: October 8, 2009 :
 :
Mark: OPENCL & Design (color) :
Serial No.: 77/844,736 :
Filing Date: October 8, 2009 :
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APPLICANT’S REPLY BRIEF

Applicant Apple Inc. (“Apple”) respectfully submits this brief in response to the Examining Attorney’s Appeal Brief.

In the course of the prosecution of these applications, Apple has provided extensive evidence demonstrating that (1) Apple created a technical framework to allow computer programmers to write software, (2) Apple fostered the development of an open standard to implement the creation of software under this technical framework, (3) Apple licenses the use of the mark OPENCL in connection with the implementation of the standard, (4) Apple uses OPENCL as its mark for its own application program interface software, and (5) the industry perceives OPENCL as an indicator of source and an Apple trademark.

In a highly specialized and esoteric technical field such as this, it’s appropriate for an Examining Attorney to be cautious to ensure that an applicant does not obtain trademark

registration for a term that rightly belongs in the public domain. However, at each stage in the prosecution of these applications, Apple has provided extensive information and documentation, including affidavits from third parties with unquestioned knowledge and expertise in the field, explaining how its OPENCL mark is used and why the relevant public of software developers views OPENCL as an indicator of origin.

The Examining Attorney's Appeal Brief does not rebut Apple's evidence. Instead, it posits an alternate universe, unsupported by any reliable authority, in which OPENCL is merely the "common name of an industry standard" and the "common name of a non-proprietary computing language", and therefore not eligible for registration as a mark for Apple's software.

The Examining Attorney has not presented any credible evidence to support the refusal. Specifically:

- The Examining Attorney has not provided any authority for the assertion that OPENCL "identifies the common name of an industry standard." Instead, this part of the refusal is based solely upon a single definition of "open standard" found on a website called "Building a School Web Site by Wanda Wigglebits", and the Examining Attorney's conjecture based on this single, and clearly unreliable, source.
- The Examining Attorney has not provided any authority for the assertion that OPENCL "identifies the name of a non-proprietary computing language." Instead, this part of the refusal is based upon a single sentence in two press releases from a company called AMD that refer to OPEN CL as a "non-

proprietary industry standard”, and the Examining Attorney’s conjecture about the meaning of that language.

The core of the Examining Attorney’s argument is that because OPENCL refers to an open standard, it therefore must be generic. However, as Apple has demonstrated, one does not follow from the other. The Examining Attorney fails to address the extensive evidence that Apple provided on the nature of open standards, and provides no credible evidence from an authoritative source in the information technology field for the proposition that OPENCL is the common name of an industry standard or the name of a non-proprietary computing language. There is no such evidence in the Examining Attorney’s record, because neither of these propositions is true.

Thus, for the reasons set forth in its original brief and in the discussion below, Apple is entitled to register OPENCL as a mark for its software. The fact that OPENCL also identifies an open standard and a computing language does not disqualify the mark from registration. Apple respectfully submits that there is no justification for the premise that OPENCL is descriptive or that Apple’s specimens of use are unacceptable, and respectfully requests that the refusal to register and the disclaimer requirements be reversed and the applications approved for registration.

Discussion

I. The term OPENCL is not merely descriptive for Apple’s goods.

The Examining Attorney argues that “because Applicant’s proposed mark identifies the common generic name of an open standard it cannot also indicate the source of Applicant’s

goods.” Apple has explained that OPENCL refers to an open standard for the computing industry, as well as Apple’s own implementation of the standard, which consists of application program interface (API) software. However, there is no basis for the Examining Attorney’s conclusion that OPENCL is the “common generic name” of the standard.

The Examining Attorney cites various definitions of the term “open standard” to support his position. However, none of these definitions establish that the name of an open standard is necessarily generic. In summarizing the various definitions he has cited, the Examining Attorney asserts that “[a]n open standard cannot be changed except by consensus or agreement by members of industry consortium.” In the case of OPENCL, the standard cannot be changed by “consensus”; as indicated in the affidavits set forth at Exhibit B and Exhibit C of the Request for Reconsideration on Serial No. 88/616,247, dated August 24, 2011, the OPENCL standard is determined by the Khronos Group, which administers the standard under license from Apple.

The fact that the standard is “open,” in the sense that the technology may be used by parties other than the original developer, is entirely consistent with the fact that the name of the standard is associated with a single source. When developers see the term OPENCL in reference to the standard, they know that the mark identifies a standard originated by Apple and administered by its licensee. Simply put, OPENCL is not generic, because it refers to one particular standard developed by one company, Apple, and its licensee. The Examining Attorney has not submitted any evidence to contradict this conclusion.

The Examining Attorney asserts that “all of the definitions provided essentially identify an open standard as a specification that can be freely implemented by all”, but that observation is completely consistent with how Apple’s OPENCL open standard works – the standard is “open”,

in the sense that competing developers can use it to create their own software products. That fact does not preclude trademark protection.

The Examining Attorney also contends that OPENCL is merely descriptive for Apple's goods "because it identifies the common name of a non-proprietary computer language." OPENCL does indeed identify a programming language, but that fact does not make it generic. Just as the Examining Attorney has failed to demonstrate that OPENCL is a "generic common name" for an open standard, he has also failed to show that OPENCL is a "common name" for a language.

The Examining Attorney has provided no credible evidence to support the refusal. On pages 7-8 of his brief, the Examining Attorney relies on brief quotes from material retrieved from NEXIS, but all four of these quotes are presented without attribution or context. In fact, none of them are reliable indicators of perception in the U.S. Only one of the quotes is even from a U.S. source -- Document 9 is from a source called "Vertical News". The other excerpts are from sources in India and Pakistan -- Document 11 is from Animation Xpress (described as an "Indian-focused news portal for animation, VFX, gaming, professionals, students and enthusiasts"); Document 15 is from TendersInfo, a New Delhi-based government procurement website, and Document 17 is from Right Vision News in Karachi, Pakistan. None of these sources can be assumed to have credibility, and even if they were credible, none of them stand for the Examining Attorney's proposition that OPENCL is the common name of a non-proprietary computing language.

The Examining Attorney emphasizes that "[m]ost of the references do not refer to [Apple] or the Khronos Group." This observation, of course, is entirely irrelevant. The fact that

a third-party news article refer to a brand, without mentioning the brand owner, obviously does not transform the brand into a generic term. For example, the Examining Attorney has cited the Indian article that states the following:

CUDA provides compilers to use common programming languages to write software the GPU rather than the unique specialty languages previously required for graphics programming. CUDA currently supports programming in C, Fortran, OpenCL, Direct Compute, Python, Perl, and Java.

The Examining Attorney has highlighted the term “common programming languages” in bold letters, as if to suggest that the term “common” is significant from a trademark perspective. However, the author of this article obviously uses the term “common” to make a technical distinction between languages that are geared specifically for graphics programming (“specialty”) and languages that are not geared specifically for graphics programming (“common”). There is no suggestion whatsoever that OPENCL is the “common name” of a programming language. Indeed, the article refers to OPENCL alongside other languages such as PYTHON, PERL, and JAVA—which are all registered trademarks for software.

Apple has previously noted that numerous third-party software marks are also the names of computer languages. In his appeal brief, the Examining Attorney asserts that “the records of those registrations are not of record here.” However, Apple submitted TESS records for nineteen such marks at Exhibit A of its Request for Reconsideration on Serial No. 88/616,247, dated August 24, 2011. In response, the Examining Attorney has cited a handful of registrations in which the names of computer languages were disclaimed, but these registrations do not contradict Apple’s position. Simply put, the name of a given computing language may or may not have the capacity to function as a mark for software; there is no *per se* rule against registering the name of a computer language as a trademark. Consequently, the fact that

OPENCL identifies a computer language is not determinative. The Examining Attorney has the burden to demonstrate that the name of this particular computer language, OPENCL, is descriptive for Apple's software, and has failed to meet that burden.

The Examining Attorney also cites four quotes found on NEXIS, shown on page 9 of this brief, all of which are presented without attribution or context. In fact, only one of these quotes is even from a news publication – Document 60, which apparently appeared in Computer Reseller News. The other three quotes (Documents 3, 12, and 24) are not news reporting at all, but quotes from press releases from a single company called AMD.

Two of these press releases are the Examining Attorney sole authority for the premise that the OPENCL is “non-proprietary”. The Examining Attorney follows this by citing a definition from Dictionary.com, indicating that “proprietary” means something “manufactured and sold only by the owner of the patent formula, brand name, or trademark associated with the product.” However, this cut-and-paste argument proves nothing. Wording found in a single company's press releases does not prove how the industry perceives the OPENCL standard or Apple's mark. Even if the press releases had some relevance, they don't prove the Examining Attorney's premise, because he has taken a single sentence and imbued the term “non-proprietary” with a meaning from the world of trademarks.

The question is not whether the computer language itself is categorized as “proprietary” by commentators, but whether the computing industry recognizes the name of the language as an indicator of source. It's conceivable that an information technology professional might refer to the OPENCL language as “non-proprietary” in the sense that Apple and its licensee, the Khronos Group, invite other parties to use the language in developing their own programs. In other

words, Apple does not assert ownership rights to block others from using the language.

However, that does not mean that users perceive the name of the language as a generic term.

In short, OPENCL does not identify a “type” of programming language, or a “class” of programming language; it identifies one particular programming language, originated by one particular company, and further developed by that company’s licensee. As such, OPENCL can also function as a mark for that company’s software.

II. The specimens show use of OPENCL as a trademark for Apple’s goods.

The Examining Attorney contends that Apple’s specimens do not show use of the mark on the goods covered by the application, namely, “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.” The original specimen consists of a printout of a page from Apple’s website that describes Apple’s OS X Snow Leopard computer operating system. The page describes various features and components of Snow Leopard, including OPENCL, and displays a button labeled “Buy Now” to allow consumers to order the software online. As discussed in Apple’s appeal brief, The Trademark Manual of Examining Procedure (TMEP) expressly contemplates the use of specimens of the type submitted by Apple.

In his appeal brief, the Examining Attorney offers the following summary of his basis for rejecting the specimen:

[A] close inspection [of the specimen] reveals that OPENCL is identified as “a C-based programming language....” 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.

This is a non sequitur. Apple has consistently maintained throughout the prosecution of these applications that OPENCL refers to (i) a technical standard for writing computer programs, which was conceived by Apple; (ii) a programming language that is a component of that standard; and (iii) Apple's own implementation of the standard, consisting of the application programming interface (API) software described in the identification of goods. The fact that the specimen refers to the OPENCL programming language is immaterial to whether the specimen also shows use of the mark OPENCL for software.

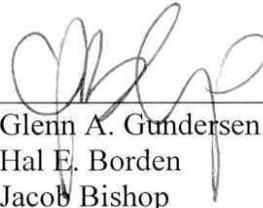
The specimen is a web page that allows consumers to order the Snow Leopard OS X operating system software, and the page prominently displays the mark OPENCL, which identifies API software that is a component of the operating system software. The fact that the specimen does not refer explicitly to OPENCL next to the word "software" is not determinative; there is no requirement of such a reference in the Trademark Office's rules. Apple seeks registration of OPENCL for software "sold as an integral component of computer operating software." The specimen is a web page that displays the mark and provides a means for ordering the computer operating software. As such, it establishes use of the mark for the goods.

Conclusion

For the foregoing reasons and the reasons set forth above in Applicant's appeal brief, Applicant respectfully requests that the mark OPENCL be approved for registration, and that the marks OPENCL and Design be approved for registration without disclaimer.

Date: February 21, 2012

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gundersen", written over a horizontal line.

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