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Subject: U.S. TRADEMARK APPLICATION NO. 77844736 - OPENCL - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 77844736

MARK: OPENCL



CORRESPONDENT ADDRESS:

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Apple Inc.

MS 169-3IPL

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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Apple Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

FACTS

Applicant has applied for registration on the Principal Registration for the mark OpenCL and design [hereinafter OpenCL] for goods described as “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.” Registration was refused pursuant to Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127, inasmuch as the applied for mark, as used on the specimen of record, merely identifies a process in the nature of an industry standard and therefore, does not function as a trademark to indicate the source of the applicant’s goods and to identify and distinguish said goods from others. Additionally, registration was refused inasmuch as the specimen does not show the applied mark in use in commerce in connection with any of the goods specified in the Statement of Use, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a). Finally, registration was refused inasmuch as the goods to which the proposed mark is applied are not “goods in trade” pursuant to Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; TMEP §1202.06(b). This appeal follows the Examining Attorney’s final refusal.¹

ARGUMENT

The issue in this case is whether an industry standard (computing language or Application Programming Interface [hereinafter API]) can function as a trademark or source-indicator for a single party’s implementation the standard. The specimen and any other evidence of record may be used to

¹ It should be noted that the instant application was previously the subject of an appeal on a different matter (consolidated case dated August 28, 2012) whereupon the Board affirmed the applicant’s failure to submit an acceptable specimen), that it was subsequently approved, published and the instant appeal follows the refusal of the applicant’s Statement of Use.

determine whether the proposed mark functions as a trademark to indicate the source of the goods.

See In re Petersen Manufacturing Co., Inc., 229 USPQ 466 (TTAB 1986).

I. OPENCL Fails to Function as a Trademark.

A. A Term Recognized as an Industry Standard Process Cannot also Function as a Trademark to Identify the Source of One Party's Goods Implementing the Standard.

The applied-for mark, OpenCL, does not function as a trademark because consumers in the industry would recognize it solely as indicating the name of an industry standard computing language and API and not as a source-indicator for Applicant's goods.

In the prior Board decision, the Board stated, "[t]he open standard-application programming interface [API] software dichotomy is analogous to the process-service dichotomy. A term that only identifies process, style method system, or the like (e.g., a computer or programming language or an *industry standard*) is not registrable as a service mark (or trademark). A system or process is only a way of doing something, not a service (or a product)." Board Decision, August 28, 2012, TTABVUE #22 at 8 (Emphasis Added), *citing In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (C.C.P.A. 1973).

A term that only identifies a process does not function as a service mark (or trademark) to indicate the source of a party's goods and distinguish them from the goods of others. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; *see In re Griffin Pollution Control Corp.*, 517 F.2d

1356, 1358-59, 186 USPQ 166, 167 (C.C.P.A. 1975); TMEP §§904.07(b), 1202. However, a term that identifies a *proprietary* process may also identify the source of the services (or goods) if used to identify and distinguish the services or goods. See, e.g., *Liqwacon Corporation v. Browning-Ferris Industries, Inc.*, 203 USPQ 305, 316 (TTAB 1979) (Board found LiqWaCon “a proprietary process” was also used as a service mark); Cf. *In re HSB Solomon Associates LLC*, 102 USPQ2d 1269, 1272-4 (TTAB 2012) (CEI refers to a “proprietary standard” or process used by applicant, but is never used to identify consulting service).

Applicant’s specimen submitted with the December 19, 2013 Statement of Use states, “OpenCL Specification Get full details on the OpenCL *standard* from the OpenCL Specification version1.2.” In the instant case, there is no doubt that the OpenCL standard computing language and API, which was jointly developed and “created by the Khronos Group with the participation of many leading companies and institutions . . .,”² is clearly a non-proprietary industry standard. As such, the industry standard OpenCL cannot also function as a trademark to indicate the source of a single party’s goods implementing the industry standard.

In this case, it is important to understand the nature of an “industry standard” process, which cannot function as a trademark, as opposed to a “proprietary standard,” which, if used as a source-indicator, can function as a trademark. In the August 28, 2012 Board Decision, the Board took judicial notice of the following definition of “open standard” from Webster’s New World Computer Dictionary.

² See Office Action, May 25, 2010, p. 7, (page from Khronos Group website).

A set of rules and specifications that describes the design or operating characteristics of a program or device, published and made freely available to the technical community and (ideally) standardized) by an independent international standards body. Open standards may contribute to rapid market growth if they encourage interoperability (the capability of a device made by one manufacturer to work with a device made by a different manufacturer) and cross-platform computing (use in a network with computers made by several different vendors and running different operating systems). **The opposite of an open standard is a proprietary standard**, which a company pushes in the hope that its standard, and not others will come to dominate the market.³

In its appeal brief, Applicant cites a Wikipedia definition for “open standard” which states,

While open standards or architectures are considered **non-proprietary** in the sense that the standard is either un-owned or owned by a collective body it can still be publicly shared and not tightly guarded. . . . Many specifications that are sometimes referred to as standards are **proprietary** and only available under restrictive contract terms (if they can be obtained at all) from the organization that owns the copyright on the specification. As such these specifications are not considered to be fully open.⁴

Applicant states that, in general, “Apple provides access to technology that allows developers to create software applications to **run on Apple devices** thereby making Apple products even more attractive to software users.” Applicant’s Brief at 10. Emphasis Added. This statement is accurate. By way of example, Applicant uses proprietary APIs,⁵ the specifications for which Applicant provides to

³ TTABVUE #22 at 6. (Emphasis added).

⁴ Applicant’s Brief at 9; TTABVUE #34 at 43; Request for Recon, March 10, 2015, p. 18. (emphasis added).

⁵ An application programming interface (API) is “a set of routines used by an application program to direct the performance of procedures by the computer’s operating system.” MICROSOFT COMPUTER DICTIONARY, p. 33 (5th ed. 2002). TTABVUE #22 at 4-5. *See also*, Office Action, Feb. 1, 2011, p. 35 (“a language and message format by an application program to communicate with the operating system or

certain software developers, which allows the developers to create software that will communicate *only* with Applicant's proprietary operating system in Applicant's products such as a Macbook® or iPad®. An API that is only used to allow others to create products to run only on Applicant's devices is a proprietary standard or process, the specifications for which Applicant can provide restrictively to whoever it wants in order to allow them to create products that work with Applicant's products. As a result of the popularity of Applicant's products, other companies desire to provide compatible products, such as software, that will work with Applicant's products. Applicant, however, must provide the specifications of its proprietary standards to those parties in order for their products to work with Apple devices.

Contrary to a proprietary standard, an open *industry* standard such as OpenCL identifies the specifications used in an industry for products from several different manufacturers to work together or communicate with each other. An industry standard such as an industry standard API allows products such as printers, scanners, VOIP phones, processers, speakers or software made by different manufacturers to work with many different computers or operating systems from different developers who also adopt the industry standard API. The Examining Attorney has provided the following definitions for "industry standard":

Generally accepted *requirements* followed by the members of an industry.⁶

some other control program to such as a database management system or communications protocol. API's are implemented by writing function calls in the program, which provide the linkage to the required subroutine for execution." PCMAG.COM Encyclopedia. *See also* Exhibit 2 at Office Action, Feb. 1, 2011, p. 21 for further information on APIs.

⁶ Office Action, Feb. 17, 2014, p. 24; Business Dictionary.com. (Emphasis added).

Established as being the *required* standard or norm in a particular area of business.⁷

A voluntary industry developed document that establishes *requirements* for products, practices, or operations.⁸

The record also includes the following definitions for a non-proprietary “standard”:

A specification for hardware or software that is either widely used and accepted (de facto) or is sanctioned by standards organization (de jure).⁹

Standards are necessary for interworking, portability, and reusability. They may be de facto standards for various communities or officially recognized national or international standards.¹⁰

A standard is a document that contains technical specifications or other criteria to be used consistently as a rule, guideline or definition of characteristics to ensure that materials, products, processes, personal services are competent and or fit for their intended purpose(s).¹¹

An agreed-upon set of specifications for hardware or software. Agreeing upon standards makes it possible for different manufacturers to create products that are compatible with each other. Standards may be set by official standards organizations, or they may be unofficial standards that are established by common use.¹²

⁷ Office Action, Feb. 17, 2014, p. 26; Collins English Dictionary

⁸ Office Action, Feb. 17, 2014, p. 31. NIST National Institute of Standards and Technology –U.S. Department of Commerce. (Emphasis added).

⁹ Office Action, Feb. 1, 2011, p. 57, The Free Dictionary by Farlex from the Computer Desktop Encyclopedia, <http://encyclopedia2.thefreedictionary.com/standard>. (Emphasis added).

¹⁰ Office Action, Feb. 1, 2011, p. 58, Article provided by FOLDOC – Free Online Dictionary of Computing (foldoc.org.).

¹¹ Office Action, Feb. 17, 2014, p. 22, NIST National Institute of Standards and Technology –U.S. Department of Commerce; <http://gsi.nist.gov/global/index.cfm/L1-5/L2-44>.

¹² Office Action, Feb 17, 2014, p. 28; Computer User Dictionary, <http://www.computeruser.com/dictionary/standard>

Unlike a proprietary standard API, it is clear from Applicant's identification of goods and the evidence of use of the mark in the industry that the OpenCL specification is a fully open *industry* standard process and is not technology for the purpose of creating software applications solely "to run on Apple devices." (Please see the web page attachments to Office Actions dated Aug. 16, 2011 and Feb. 17, 2014). The evidence in the record clearly shows that OpenCL is an open "industry standard" API and computing language "for use in developing applications for execution on central processing units (CPU) or graphic processor units (GPU)" and not a proprietary standard for use only on "Apple devices." The evidence includes the following:

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.¹³

[S]ince OpenCL is an **industry standard** programming interface, programs written in OpenCL 1.1 can be recompiled and run with any OpenCL-compliant compiler and runtime.¹⁴

OpenCL (Open Computing Language) is the first truly open and *royalty-free* programming **standard** for general-purpose computations on heterogeneous systems Developed in an open standards committee with representatives from major industry vendors, OpenCL gives users a cross-vendor, **non-proprietary** solution for accelerating their applications on their CPU and GPU cores.¹⁵

¹³ Action Denying Reconsideration, Aug. 16, 2011, p. 11. www.acceleware.com.

¹⁴ Action Denying Reconsideration, Aug. 16, 2011, p. 20. <http://community.topcoder.com/>

¹⁵ Action Denying Reconsideration, Aug. 16, 2011, p. 21. <http://community.topcoder.com/>

This *method* through which data is processed, in parallel, by both CPU and GPU has as the most widely adopted **industry standard** the OpenCL.¹⁶

The Khronos Group, an industry consortium geared towards creating open standards for authoring and acceleration of parallel computing and graphics, and a long list of vendors, including NVIDIA, have elected to make OpenCL the **industry standard**¹⁷

(Emphasis in bold added).

The August 16, 2011, Office Action includes twenty-five (25) articles from a Lexis/Nexis database (which was attached to the end of the Office Action) referring to OpenCL as an "industry standard." The articles include the following statements:

"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. (Article 3 of 119).

"Intel is a strong supporter of open **industry standards** that create developer choice and foster innovation," said Elliot Garbus, vice president Intel Software and Services Group and general manager Visual Computing Software Division. "As a contributor to the **OpenCL** 1.1 specification, Intel is encouraged by its evolution as a programming model and excited about the promise of **OpenCL** to offer developers flexibility and the power to harness future parallel processing on Intel platforms." (Article 56 of 119).

¹⁶ Office Action, Feb. 17, 2014, p. 20. <http://news.softpedia.com>.

¹⁷ Action Denying Reconsideration, Aug. 16, 2011, p. 28. www.genomeweb.com.

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. (Article 60 of 119).

Industry standards enable the seamless interoperability video professionals and developers experience today. As the developer community looks to harness the power and performance associated with heterogeneous architectures, **industry standards** are needed for developing applications capable of running on all of the available processors in a system. **OpenCL** is designed to enable developers to write vendor-neutral, cross-platforms applications capable of being accelerated by the most appropriate processors within a system, whether it is the CPU, GPU or others. This widely supported **industry standard** unlocks developers from vendor-specific implementations and gives them the freedom to choose. (Article 61 of 119).

Heavy computational workloads have traditionally been processed on a CPU but the industry is shifting to a new computing paradigm that relies more on the GPU or a combination of GPU and CPU. **OpenCL** is the widely adopted **industry standard** for running parallel tasks on CPUs and GPUs using the same code. As the only hardware provider in the industry designing and delivering both high-performance CPU and GPU technologies, AMD is the only company providing a complete **OpenCL** development platform for the entire system. (Article 75 of 119).

In the precedential decision, *In re Westlake Plastics Co.*, 79 USPQ2d 1151 (TTAB 2006), the Board recognized that, although the “industry-wide standard” FM4910 was “a relatively recent development,” prospective purchasers of the applicant’s goods would “immediately recognize FM4910 as signifying an approved class of plastic materials” and not as a source-indicator for the applicant’s goods. *In re Westlake Plastics Co.*, 79 USPQ2d. at 1155. Much like the industry-wide standard FM4910, consumers in the relevant industry will recognize the term OpenCL as an industry standard when used on products in the industry implementing the standard, including Applicant’s own product.

Applicant argues that the NIST¹⁸ definition, is inapplicable because OpenCL “is not ‘a voluntary, industry-developed document’ . . . it does it ‘establish requirements for products, practices or operations.’” Brief at 8-9. This is incorrect as Applicant’s specimen shows that only an OpenCL document (the written specifications or programming guide) describing the specifications can be accessed through its website. Additionally, Applicant refers to a definition of an “API” that states that API’s can come in the form of “a library that includes specifications for routines, data structures, object classes, and variables. . . .”¹⁹ Further, the specifications were industry developed by Applicant and others in the Khronos group, an industry consortium. See page from Khronos website at Office Action, May 25, 2010 at p. 7, and the declaration of Mr. Neil Trevett. OpenCL is a required process that is needed for goods of different vendors to be able to work together to perform a specific function.

¹⁸ According to applicant’s evidence, the mission of the NIST, a division of the Department of Commerce, is “to promote U.S. innovation and industrial competitiveness by advancing measurement science, standards, and technology. . . .” The NIST home page at www.NIST.gov indicates that the NIST works with standards in information technology. See Attached Webpages from the NIST website. In its Brief, the applicant asks the Board to dismiss the NIST’s “industry standards” definitions provided by the examining attorney as inapplicable inasmuch as NIST is a “physical science” laboratory and therefore, “has no relevance to technical computing standards in the computer industry.” Applicant’s Brief at 8-9. As shown in the attached pages from NIST’s own website, NIST in fact deals with “information technology” as well as computer-related topics and not just “physical science” as the applicant inaccurately suggests. The examining attorney asks that the Board take judicial notice of this information. The Trademark Trial and Appeal Board may take judicial notice of encyclopedia entries and standard reference works that (1) are available in a printed format, (2) are the electronic equivalent of a print reference work, or (3) have regular fixed editions. TBMP §1208.04; see *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1338 (TTAB 2009) (taking judicial notice of listing in *Computer Desktop Encyclopedia*); *In re Tokutake Indus. Co.*, 87 USPQ2d 1697, 1700 n.1 (TTAB 2008) (taking judicial notice of census data); *In re Consol. Specialty Rests. Inc.*, 71 USPQ2d 1921, 1927 (TTAB 2004) (taking judicial notice of *Merriam-Webster’s Geographical Dictionary* and *The Columbia Gazetteer of North America*); *In re Astra Merck Inc.*, 50 USPQ2d 1216, 1218-19 (TTAB 1998) (taking judicial notice of the *Physicians’ Desk Reference* and other PDR publications); see also Fed. R. Evid. 201; 37 C.F.R. §2.122(a).

¹⁹ Applicant’s Brief, 11-12, TTABVUE #34 at 12-13.

Applicant further argues that the OpenCL specifications “are not determined by general consensus or common usage, but solely by Khronos.” The Khronos Group is “an industry consortium of leading technology companies.”²⁰ The applicant’s own statement provides further evidence that consumers understand that OpenCL is an “industry developed” standard (by an industry consortium) as opposed to a proprietary standard developed by a single party for use only with its own products.

In contrast to definitions of industry standard, Section 45 of the Trademark Act, 15 U.S.C. § 1127, defines a “trademark” as any word, name, symbol, device, or any combination, used or intended to be used *to identify and distinguish the goods/services* of one seller or provider from those of others, and to indicate the source of the goods. By definition, the name of an industry standard, which identifies the *required* specifications needed for each product to compete in the industry, cannot also function to identify the source of one party’s goods implementing the standard in that same industry.

Applicant’s specimen submitted with the Statement of Use states the following regarding the “OpenCL Specification:” Get full details on the OpenCL *standard* from the OpenCL Specification version 1.2.”²¹ The bottom of the specimen states, “OpenCL is an open standard defined by the Khronos Group.” It is clear from the record that the term OpenCL is recognized in the relevant industry as an open, non-proprietary, *industry standard* computing language and API. As an industry standard, consumers would recognize OpenCL, as used by Applicant, as a *method* or *process* used throughout the industry for parallel programming on CPUs and GPUs. The definitions indicate that an industry standard

²⁰ Brief at 11.

²¹ Statement of Use, filed December 19, 2013.

process or method cannot also function as a trademark for a one party's implementation of the standard.

By definition, the only manner in which an industry standard can be used is as a certification mark to certify conformance with the specifications of the industry standard.

B. The OPENCL Design Mark does not Function as a Trademark Because Applicant is Using the Designation Through its Licensee as a Certification Mark.

The proposed mark OpenCL does not function as a trademark because it is used as a certification mark and, therefore, would not be recognized as a source-indicator for one party's goods implementing the standard. Consequently, it is not registrable as a trademark.

Section 45 of the Trademark Act defines a certification mark as a mark that is used by a person other than its owner to certify regional or other origin, material mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services. 15 U.S.C. § 1127. By definition, a certification mark is not used by the owner of the mark and does not indicate the source of goods or distinguish the goods of one party from those of another. *See* TMEP §1306.01 *et seq.* "If a designation is in fact used as a guarantee or certification symbol, it cannot be registered as a trademark." 3 McCarthy on Trademarks and Unfair Competition § 19:94 (4th ed. 2015).

Applicant states that it “began working with the Khronos Group, an industry consortium of leading technology companies, to develop this framework into an open standard for use in the computer industry.” Brief at 11. “Apple granted the Khronos Group a license to use the mark OpenCL in connection with the ongoing development of the technical specifications for the standard.” *Id.* “Members of the Khronos Group are licensed to use the mark OpenCL in connection with implementations of the standard *that conform to the specifications*, as determined by Khronos.”²² (Emphasis added). Use of the OpenCL as a certification mark by a licensee inures to the benefit of the licensor. See *Turner v. HMH Publ'g Co.*, 380 F.2d 224, 229, 154 USPQ 330, 334 (5th Cir. 1967), *cert. denied*, 389 U.S. 1006, 156 USPQ 720 (1967); *Cent. Fid. Banks, Inc. v. First Bankers Corp. of Fla.*, 225 USPQ 438, 440 (TTAB 1984).

Additionally, the evidence submitted by Applicant, namely, the declarations of Neil Trevett, President of the Khronos Group, and William Licea-Kane of Advanced Micro Devices, as well as the Khronos Trademark Guidelines, further confirms that the OpenCL is being used by the Applicant through its licensee as a certification mark and not a source-indicator for Applicant’s own implementation of the industry standard. In his declaration, Mr. Trevett states,

The specifications of the OPENCL standard . . . are determined by working groups within the Khronos Group consisting solely of Khronos members. Developers who see the mark OPENCL in connection with a member’s implementation of the standard know that the implementation meets the specifications promulgated by Khronos Group and have passed the criteria defined in Khronos’ conformance program. . . . Developers associate the name of an open standard with

²² Brief at 11; TTABVUE #34 at 12; Request for Recon at 5.

the organization managing and evolving the standard, and developers use the mark as an indication of *conformance to the criteria* defined by that organization.²³

The Khronos Trademark Guidelines state the following:

To assure that implementation of Khronos specifications meet a *consistent standard of the highest quality*, the Khronos Group maintains Adopter Programs that provide access to conformance tests for verification by Khronos that a product or implementation *conforms to the specification*.²⁴

An Adopter that has an implementation of a published specification that has been submitted to and passed the Khronos Conformance Process may use the relevant Khronos Mark in text, logo and **certification** mark form in association with the implementation, and Adopters may state that their products are *in conformant or compliant with the appropriate specifications . . .*²⁵

Mr. Trevett's own statements in his declaration that developers who see the mark on an implementation "know that the implementation meets the specifications" of the conformance program; and that "developers use the mark as an indication of conformance to the criteria" are clear indications of use by "persons other than the owner" to certify "quality or accuracy." Mr. Trevett does not state that developers consider the name of an open standard as a source indicator for a particular product. Additionally, Mr. William Licea-Kane states that "developers who see the mark in connection with a member's implementation of the standard know that the implementation meets the specifications

²³ TTABVUE #34 at 18; Request for Recon, March 10, 2015, p. 37. (Emphasis added).

²⁴ TTABVUE #34 at 20; Request for Recon, March 10, 2015, p. 39. (Emphasis added).

²⁵ TTABVUE #34 at 22 under "Conformant Products"; Request for Recon, March 10, 2015, p. 41. (Emphasis added).

promulgated by Khronos Group.”²⁶ Neither Mr. Trevett or Mr. Licea-Kane states that developers who see the mark will identify it as a source-indicator for Applicant’s goods.

In view of the evidence in the record, it is clear that Applicant is using the mark, through its licensee, as a certification mark to certify conformance with the specifications of the industry standard. Consequently, OpenCL cannot function as a trademark to identify source on Applicant’s industry standard while, at the same time, being used as a certification mark by others implementing the standard to identify conformance with the specifications of the industry standard. “Using the same mark for two contradictory purposes [source indication and certification] would result in confusion and uncertainty about the meaning of the mark and would invalidate the mark for either purpose.” TMEP § 1306.04; *see also In re Fla. Citrus Comm’n*, 16 USPQ 495, 499 (TTAB 1968).

Applicant states that “[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” while “Apple itself uses OPENCL as a mark for its own implementation of the standard.”²⁷ However, it is not legally possible for consumers to recognize Applicant’s use of OpenCL as a source indicator for Applicant’s own implementation of the industry standard while also recognizing the use of OpenCL by other members in the industry as an indicator of conformance with the specifications of the industry standard.

²⁶ TTABVUE #34 at 25; Request for Recon, March 10, 2015, p. 44.

²⁷ Brief at 11; TTABVUE #34 at 12; Request for Recon at 5.

It is therefore clear from the evidence in the record that consumers would recognize the OpenCL mark as a certification mark indicating conformance with the specifications for the industry standard and not as a trademark to identify the source of Applicant's own goods. Accordingly, as the name of an industry standard, OpenCL and design does not function as a trademark.

C. Specimen Does Not Show Use of Mark on Identified Goods.

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each class of goods and/or 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); see *In re Gulf Coast Nutritionals, Inc.*, 106 USPQ2d 1243, 1247 (TTAB 2013). For downloadable computer software, an applicant may submit a specimen that shows use of the mark on a website. Such a specimen is acceptable only if it creates an association between the mark and software and provides sufficient information to enable the user to download or purchase the software from the website. See *In re Azteca Sys., Inc.*, 102 USPQ2d 1955 (TTAB 2012). If the website simply advertises the software without providing a way to download, purchase, or order it, the specimen is considered unacceptable to show use. See *In re Dell Inc.*, 71 USPQ2d 1725, 1727 (TTAB 2004); see also *In re Osterberg*, 83 USPQ2d 1220, 1224 (TTAB 2007); TMEP § 904.03(e).

In the Statement of Use dated December 19, 2013, Applicant describes the specimen as a "screenshot depicting use of OPENCL logo in connection with software download." As indicated previously, the Applicant's goods are identified as "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.***” (Emphasis added).

The specimen submitted with the Statement of Use fails to show use of the mark in connection with any software that may be downloaded via the web page specimen. Under the heading “References, Guides, and Sample Code,” the first four items on the left side are links to documents, including a “Programming Guide” describing how to program in the OpenCL language. It fails to refer to software. Additionally, the OpenCL Specifications, which allows the user to “get full details on the OpenCL standard” merely relates to written specifications as to how a user may create its implementation of the standard API. The remaining items are merely “examples” of sample code using the OpenCL computing language. None of the items listed identifies downloadable software as described in the Statement of Use. Finally, the specimen does not identify OPENCL as software that is sold as an “integral component of computer operating software.” There is no indication of an operating system software anywhere on the specimen or that OpenCL is a component of any type of larger software.

In view of the above, Applicant has not shown use of the mark OpenCL in commerce for the goods identified in the application

D. The Mark is not used on “Goods In Trade.”

The mark OpenCL and design is not registrable as a trademark because it is not used on goods that are sold or transported in commerce under Trademark Act Sections 1, 2, and 45 15 U.S.C. §§1051-1052, 1127; TMEP § 1202.06(b). “Goods in trade” are items that an applicant sells or transports in commerce for use by others. *See Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 F.3d 1376, 1379-80, 103 USPQ2d 1672, 1675 (Fed. Cir. 2012).

The definitions of an “application programming interface” include a “set of rules and specifications,”²⁸ a “format”²⁹ or a “set of routines.”³⁰ An API is similar to a set of instructions.

Contrary to Applicant’s arguments and its identification of goods, there is no evidence in the record referring to an API as software. Applicant’s specimen only identifies OpenCL as a “framework” or “specification” for the standard. The specimen merely references the written specifications of the standard and provides “examples” of its use. It does not identify any software, nor any software that is downloadable. Additionally, according to the evidence and Applicant, the specifications for OpenCL are published as completely free and open. Applicant merely licenses the OpenCL mark. It does not license the use of the API in connection with the mark. Consequently, Applicant does not sell or transport any software in commerce under the OpenCL mark. *Id.*

Moreover, if the identified goods are so inextricably tied to and associated with other goods or services as to have no viable existence apart therefrom, the identified goods are not independent

²⁸ Office Action, Feb. 1, 2011, p. 21.

²⁹ Office Action, Feb. 1, 2011, p. 35.

³⁰ MICROSOFT COMPUTER DICTIONARY, p. 33 (5th ed. 2002). TTABVUE #22 at 4-5.

goods in trade. *Id* at 1676; *see also, In re MGA Entm't Inc.*, 84 U.S.P.Q.2d 1743, 1746-47 (T.T.A.B. 2007) (boxes used to store puzzle pieces did not constitute goods in trade because “consumers [we]re likely to regard the puzzle boxes as nothing more than point of sale containers, as opposed to separate goods in trade”).

With respect to an application programming interface, an API is so inextricably tied to the software or other goods implementing it that it has no independent value apart from the goods implementing the API. The OpenCL API, as an open industry standard, is freely implemented on software or other technology by anyone, not just members of the Khronos Group, because the specifications for the API are fully open and published. As a standard “interface through which one program can communicate with another,” the OpenCL API allows a program to use the functions of another program. In this case, it gives applications access to graphical processing units (GPUs) in addition to CPU’s.³¹ However, the API is not sold separately and has no independent value apart from the goods implementing it.

Because OpenCL is not software that is sold or transported in commerce, and the OpenCL API has no value apart from the goods implementing the API, OpenCL is not used in connection with “goods in trade.”

³¹ *See* Office Action, May 25, 2010, p. 2.

CONCLUSION

The OpenCL mark fails to function as a trademark inasmuch as it is a term recognized as an industry standard process and therefore cannot also function as a trademark to identify the source of one party's goods implementing that standard. Additionally, OpenCL and design fails to function as a trademark inasmuch as the applicant uses the designation through its licensee as a certification mark. Moreover, the specimen submitted with the Statement of Use fails to show use of the mark on the identified goods. Finally, the mark is not used on goods in trade. Consequently, the above refusals should be affirmed.

Respectfully submitted,

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