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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Applicant	Apple Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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**APPLICANT'S REPLY BRIEF**

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## APPLICANT'S REPLY BRIEF

### I. ARGUMENT

Applicant Apple Inc. submits the following Reply to the Examining Attorney's July 20, 2015 Appeal Brief (the "Examiner's Brief"). As fully articulated in its Appeal Brief, Apple believes it has demonstrated that both its original specimen of use, consisting of its IPOD Quick Start Guide, as well as its substitute specimens of use, consisting of manuals bearing the MADE FOR IPOD badge, are valid specimens of use in support of the application for the relevant goods "brochures, pamphlets, and leaflets, all relating to computer software, computer hardware, and multimedia apparatus and instruments and sold or distributed in connection with handheld mobile digital media devices."

Apple and the Examining Attorney are in agreement that the IPOD mark is prominently displayed on Apple's specimens and that Apple's specimens are transported in commerce. There is also no dispute that the technology trade routinely distributes printed publications providing operation instructions for hardware and software bearing the same marks as the corresponding hardware and software. Nor do the parties dispute that the technology trade regularly distributes such printed publications with, and often in the same box as, its hardware and software goods. Nor do the parties dispute that the USPTO widely accepts as valid Class 16 specimens copies of printed publications that describe how to operate hardware and software goods by the same name and which are distributed therewith.

The sole point of contention on appeal with respect to Apple's IPOD Quick Start Guide is whether the Guide's minimalism and allegedly "introductory" nature disqualifies it as an acceptable specimen for the goods described in the application. With respect to the Yamaha and Sony publications bearing Apple's MADE FOR IPOD mark, submitted as Apple's Substitute Specimens, the sole point of contention is whether this usage is valid licensed usage that inures

to Apple's benefit and demonstrates that Apple is a source of the goods. In both cases, Apple submits that the submitted specimens are valid goods in trade and suitable specimens. Thus, and for the reasons set forth in Apple's prior submissions as well as in this Reply, Apple submits that the PTO's specimen refusals should be reversed and Apple's application should be approved for registration.

#### **A. THE IPOD QUICK START GUIDE IS A VALID SPECIMEN**

As articulated by Apple, the "goods in trade" cases relied upon by the Examiner dealt with four categories of specimens deemed not to be valid goods in trade: packaging<sup>1</sup>, advertising material<sup>2</sup>, conduits for rendering of services<sup>3</sup>, and incidental items that an applicant uses to conduct its business (e.g. letterheads, invoices, and business forms)<sup>4</sup>. None of these prior cases are controlling as to whether Apple's IPOD Quick Start Guide represents a valid good in trade because the Guide falls within none of these four categories. Instead, the Examiner inappropriately distorted the factors set forth by the Federal Circuit in *Lens.com v. 1-800 Contacts*.<sup>5</sup> The three factors listed in *Lens.com* were "whether the [specimen]: (1) is simply the conduit or necessary tool useful only to obtain applicant's services; (2) is so inextricably tied to and associated with the service as to have no viable existence apart therefrom; and (3) is neither sold separately from nor has any independent value apart from the services."<sup>6</sup> The Examining

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<sup>1</sup> See, e.g., *In re MGA Entm't, Inc.*, 84 U.S.P.Q.2d 1743, 1747 (T.T.A.B. 2007) (holding packaging boxes for toys, games, and playthings not goods in trade where packaging boxes were not sold separately and had no independent value apart from applicant's primary goods).

<sup>2</sup> See, e.g., *Paramount Pictures Corp. v. White*, 31 U.S.P.Q.2d 1768 (T.T.A.B. 1994) (holding games not goods in trade where the games had no real function or entertainment value as games but functioned only as advertising flyers for applicant's musical group).

<sup>3</sup> See, e.g., *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 103 U.S.P.Q.2d 1672, 686 F.3d 1376 (Fed. Cir. 2012) (holding software distributed for purpose of ordering contact lenses is merely a conduit through which online services were rendered and therefore not goods in trade); *In re Ameritox Ltd.*, 101 U.S.P.Q.2d 1081, 1084 (T.T.A.B. 2011) (holding reports featuring medical laboratory results not goods in trade where applicant solely provided drug testing services, and reports were not sold separately and had no independent value apart from applicant's primary service).

<sup>4</sup> See T.M.E.P. § 1202.06.

<sup>5</sup> 103 U.S.P.Q.2d 1672 (Fed. Cir. 2012).

<sup>6</sup> *Id.* at 1382; see also *In re Thomas White Int'l, Ltd.*, 106 U.S.P.Q.2d 1158, 1161-62 (T.T.A.B. 2013) (citing the *Lens.com* factors).

Attorney has ignored the first factor and focused the analysis solely on factors 2 and 3.<sup>7</sup> The reason for such omission, obviously, is that the first factor supports Apple's position, since the IPOD Quick Start Guide is not a conduit or necessary tool. The Examining Attorney's justification for overlooking this factor is purportedly that no single factor from *Lens.com* is meant to be dispositive.<sup>8</sup> In any event, an examination of both the *Lens.com* and *Thomas White* decisions upon which the Examining Attorney relies, is that both are cases involving conduits through which services are rendered. Therefore, since the present case is not a conduit case, these decisions, and the factors relied upon in them, are irrelevant to the current case.

Moreover, in applying factors 2 and 3, the Examining Attorney has crafted a new rule, without any support or basis, that the IPOD Quick Start Guide is so inextricably tied to Apple's devices to have no viable existence apart therefrom and no independent value because (1) it is short; and (2) it provides "only basic introductory information."<sup>9</sup> Apple is aware of no prior decisions, nor has the Examining Attorney cited any, holding that the length and comprehensiveness of content, nor the duration of utility, are relevant factors in determining whether a specimen in the form of a technical guide distributed with goods is a good in trade. Such factors are completely arbitrary – How long is long enough? How comprehensive? How enduring? The fact is that the IPOD Quick Start Guide is of utility to Apple's customers, and such utility is continuing in that customers can and often do retain such guides for future reference on the features and operation of the IPOD device. In view of such utility, the Guide is a valid good in trade and an acceptable Class 16 specimen.

The Examiner's new asserted rule is contrary to the prior practice of the USPTO, as clearly established by Apple's evidence. Apple has submitted thirty-two (32) third-party

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<sup>7</sup> See Examiner's Br. at \*8.

<sup>8</sup> See *id.*

<sup>9</sup> See *id.*

registrations owned by parties in the technology trade<sup>10</sup> where the accepted specimens were, like Apple's IPOD Quick Start Guide, printed publications that provide operational information for hardware and software. Many of these examples are directly analogous to Apple's IPOD Quick Start Guide in terms of length, comprehensiveness and duration of utility. According to the Examining Attorney's newly fashioned test, neither these, nor any of the thirty-two third-party registrations should have issued at all since the publication specimens in those registrations are not goods in trade.

Rather than addressing Apple's concerns about the significant departure made from prior examination standards, the Examining Attorney advances four reasons for discounting such prior registrations: (1) some have been cancelled, (2) they purportedly differ materially in length from Apple's IPOD Quick Start Guide, (3) Apple's IPOD Quick Start Guide provides only basic introductory information about the iPod device, and (4) prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Board.<sup>11</sup> Apple addresses these arguments in turn.

That some of the referenced Class 16 registrations are no longer live registrations is irrelevant to Apple's point that the USPTO routinely finds during examination that publication specimens which explain how to operate technology goods by the same name to be acceptable specimens. Even though this point has been raised repeatedly, the Examining Attorney continues to reference the cancelled status of some of the third-party registrations without explaining its significance.

Next, the Examining Attorney erroneously distinguishes Apple's IPOD Quick Start Guide from the third-party publication specimens on the basis of their lengths and the assertion

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<sup>10</sup> The Examiner errs by stating that Apple refers to only twenty-two (22) third-party registrations in its papers. *See* Examiner's Br. at \*10. Apple has in fact provided the USPTO with thirty-two (32) third-party registrations. *See* Apple's Resp. to Office Action dated December 23, 2013, Exs. B and E; *see also* Apple's Req. for Recons., Ex. 3.

<sup>11</sup> *See* Examiner's Br. at \*9-\*10.

that the IPOD Quick Start Guide contains only introductory information.<sup>12</sup> However, these distinctions are not accurate. While it is true that three of the thirty-two registrations submitted by Apple are somewhat lengthy at 400, 135 and 45 pages, many as set forth in Apple's prior papers, are of comparable length and substance to Apple's IPOD Quick Start Guide, including:

Submitted with Request for Reconsideration, Exhibit 3:

- BAUSCH + LOMB – Reg. No. 4102774 (one-page user guide/leaflet)
- MEDICALERT – Reg. No. 3334545 (tri-fold brochure).
- SCHRODINGER- Reg. No. 2941593 (two-page product installation guide)
- TEXAS INSTRUMENTS – Reg. No. 3717043 (two-page product bulletin)

Submitted with First Response to Office Action dated December 23, 2013:

- PENTIUM – Reg. No. 2201867 (two-page product information brief)
- LTO – Reg. No. 2487985 (four-page data sheet)

Indeed, all six of these registrations remain live and in effect as of this date.

Additionally, many of the other examples submitted by Apple were specimens constituting only the first page, or only the front and back cover; such specimens were accepted in such form without inquiry into the length or content of the document. Thus, neither length nor content appears to have been a determining factor.

With respect to content, the Examining Attorney asserts that acceptable publications of this nature must provide more than “basic information” beyond an “introductory level,”<sup>13</sup> though the Examining Attorney cites to no authority for evaluating these kinds of publications in such a manner. Users of computing goods derive value from publications such as the IPOD Quick Start Guide to help guide their usage—introductory or otherwise—of the devices. Such publications are of continuing utility and may be kept and referred to for operational guidance in the future

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<sup>12</sup> See *id.* at \*9.

<sup>13</sup> See *id.* at \*7.

regardless of simple the instructions may be. Any value conferred to the consumer should suffice.

The Examining Attorney further attempts to dismiss thirty-two (32) other examiners' opinions on the acceptability of printed publications that are distributed with technology goods, and which discuss the operability of such goods, as not binding on the USPTO or the T.T.A.B.<sup>14</sup> However, prior examiners' acceptance of other specimens is probative of USPTO practice, and nonetheless, the Examining Attorney's dismissal of USPTO practice does nothing to prevent the inevitable conclusion that numerous registrants' rights in Class 16 would be potentially invalidated if the Examining Attorney's examination criteria are affirmed.

Lastly, the Examining Attorney made a number of further unsupportable statements, including repeatedly misconstruing the IPOD Quick Start Guide as advertising<sup>15</sup> (which it obviously is not), and claiming that Apple's position would enable providers of packaged bread to obtain registration for twist ties and providers of tea to obtain registration for paper labels attached to tea bags by string.<sup>16</sup> Of course, neither of these circumstances are analogous since twist ties are packaging and therefore disallowed under *In re MGA*, and paper labels for tea bags are not even separable goods and clearly have no utility separate and apart from the tea bag to which they are attached.

In view of the foregoing, Apple submits that its IPOD Quick Start Guide is a good in trade and constitutes a valid Class 16 specimen in support of the Application.

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<sup>14</sup> See *id.* at \*9-\*10.

<sup>15</sup> See *id.* at \*6 -\*7.

<sup>16</sup> See *id.*

**B. APPLE’S SUBSTITUTE SPECIMENS ARE VALID GOODS IN TRADE THAT CONSUMERS WOULD PERCEIVE AS EMANATING, IN PART, FROM APPLE**

The Examining Attorney erroneously maintains a goods in trade refusal of Apple’s Substitute Specimens on the ground that use of the IPOD mark in the MADE FOR IPOD Logo indicates subject matter in the nature of compatibility and not source.<sup>17</sup> The Examining Attorney has not contested, and therefore has conceded, that the Substitute Specimens use the IPOD mark on the goods at issue in the Application. The Examiner’s view, however, which is unsupported by any precedent, is that the Substitute Specimens are not valid goods in trade because, despite the presence of trademark licenses from Apple to Sony and Yamaha governing the use of the mark, the use is actually merely a compatibility statement and not trademark use at all. Further, the Examining Attorney appears to require, without citing to any authority on point, that an applicant’s mark must be the *only* source identifier on a trademark specimen in order to qualify as an acceptable specimen of use.

However, parties often co-brand goods and services. Just as Yankees’ merchandise can bear both the Yankees’ team logo and the Major League Baseball Properties’ MLB mark under license, and just as the use of the INTEL INSIDE badge on computers made by manufactures other than Intel can signify that both Intel and the computer maker are valid co-branding sources of the product at issue, so too can Sony and Yamaha’s printed manuals bear these companies’ marks along with Apple’s IPOD mark under license. “The marks of different entities may, of course, appear on a single product where they serve separate functions; for example, manufacturer/distributor, ingredient/product, licensor/licensee.”<sup>18</sup>

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<sup>17</sup> See *id.* at \*10 -\*11.

<sup>18</sup> 1 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:8 (4th ed. 2015) (citing *In re Polar Music Int’l AB*, 714 F.2d 1567, 1571, n.3, 221 U.S.P.Q. 315 (Fed. Cir. 1983)); see e.g., *Citigroup Inc. v. Citicair, LLC*, Opp. No. 91201920 at \*11-12 (T.T.A.B. Mar. 31, 2014) (non-precedential) (finding use of CITI

As demonstrated in Apple's prior submissions, the use of the MADE FOR IPOD Logo is branded, licensed use that is controlled by Apple, inures to the benefit of Apple, and signifies that Apple, along with Sony and Yamaha, is a source of the printed manuals. Therefore, such manuals are goods in trade and valid specimens of Class 16 usage of Apple's IPOD mark.

## II. CONCLUSION

Apple's specimens of use reflecting its IPOD mark are valid goods in trade. For the reasons set forth in this Brief, as well as in Apple's previously submitted papers and evidence, Apple respectfully requests the Board to reverse the specimen refusal and allow its Application to proceed to registration.

Dated: August 10, 2015

Respectfully submitted,

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trademark along with travel company marks on co-branded credit cards as use of CITI in the context of travel-related services).

CERTIFICATE OF TRANSMISSION

This is to certify that this APPLICANT'S REPLY BRIEF was filed electronically with the Trademark Trial and Appeal Board via transmission through ESTTA on August 10, 2015.

/s/ Alberto Garcia

Alberto Garcia