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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Apple Inc.

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Serial No. 85019762

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Lisa G. Widup, Senior Intellectual Property Counsel for Apple Inc.

Andrew Rhim, Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).

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Before Taylor, Bergsman and Lykos, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register for the mark shown below:

for the following goods identified in the application, as amended:

> Computer software for use in reviewing, storing, organizing, and playing pre-recorded audio content, sold as a feature of handheld mobile digital electronic devices comprised of digital audio and

video players, handheld computers, personal digital assistants, and electronic personal organizers, in International Class 9. [1]

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that applicant's mark is likely to cause confusion with the registered mark shown below for, *inter alia*, "providing temporary use of nondownloadable software for adding music and video profiles on the internet, for listening to MP3's and for sharing MP3's and music playlists with others," in Class 42.[2]

Preliminary Issue

Applicant attached copies of third-party registrations to its appeal brief. Trademark Rule 2.142(d), 37 CFR § 2.142(d), provides that the record in the application should be complete prior to the filing of an appeal. To the extent that the evidence attached to applicant's brief has not otherwise been made of record, it has been given no consideration. *See* the discussion regarding the strength of the mark in the cited registration below.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In*

[1] Application Serial No. 85019762 was filed on April 21, 2010, based upon use in commerce.

[2] Registration No. 3484512, issued August 12, 2008.

re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks"). These factors, and any other relevant *du Pont* factors in the proceeding now before us, will be considered in this decision.

A. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression and the strength of the registered mark.

We turn first to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). As in this case, where both marks are design marks, the similarity of the marks must be analyzed on the basis of their visual similarity. *In re Vienna Sausage Manufacturing Company*, 16 USPQ2d 2044, 2047 (TTAB 1990).

In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods and services offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). When the marks are placed side-by-

side for comparison, specific differences may become apparent. However, there is nothing in the record to indicate that these marks would be viewed together, nor has applicant argued that the marks would be viewed together. Thus, the proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). In this case, the average customer is someone who downloads music and/or has a music application on a handheld device: in other words, ordinary consumers.

Although a side-by-side comparison of the marks is not the proper test, we nevertheless, reproduce the marks below for purposes of this decision.

Applicant's Mark

Registered Mark

In comparing the marks within the above-noted legal parameters, the marks at issue are similar because they comprise a double musical note in an orange rectangle. The designs are not identical because applicant's rectangle has rounded corners, the shades of orange are different, and applicant's double musical note is ascending while note in the registered mark is descending. Nevertheless, we find that the basic similarities in the marks outweigh any specific differences that might be apparent upon a side-by-side comparison. The differences in the details of the respective depictions of the double musical notes and their background designs do not suffice to distinguish the marks in terms of their overall commercial impressions. Regardless of the

differences which might be apparent in a side-by-side comparison, both marks depict a double musical note in an orange rectangle. Thus, when the marks are viewed at different times, the recollection of the first viewed mark will be a general impression that is devoid of the details that applicant argues sets its mark apart from the registered mark. What will be remembered is a musical note in an orange rectangle. The fact that the marks are not identical is less significant to our analysis than the basic similarities arising from the fact that both marks include the depiction of a double musical note in an orange rectangle.

Applicant argues that the marks are not similar because the registered mark comprising a musical note is a weak mark entitled only to a narrow scope of protection or exclusivity of use. In its September 2, 2011 Request for Reconsideration, applicant submitted eight (8) third-party registrations for marks incorporating a musical note for "computer programs for editing images, sound and video," "audio discs featuring music" and "downloadable musical sound recordings," "downloadable computer software for accessing and posting on-line music, videos and web address," "computer software for storing, accessing and transmitting digital information, namely, music," and "computer software for playing digital music." Applicant contends that because of this evidence of extensive third-party use, consumers will be able to distinguish the marks.[3]

The third-party registrations introduced by applicant are not evidence that those marks have been used at all, let alone used so extensively that consumers have become sufficiently conditioned by their usage that they can distinguish between such marks on the bases of minute differences. The probative value of third-party trademarks depends entirely upon their usage. *E.g., Scarves by Vera, Inc. v. Todo Imports, Ltd.*, 544 F.2d 1167, 192 USPQ 289, 294 (2d Cir. 1976) ("The significance of third-party trademarks depends wholly upon their usage. Defendant

[3] Applicant's Brief, p. 11.

introduced no evidence that these trademarks were actually used by third parties, that they were well promoted or that they were recognized by consumers."). As the Court pointed out in *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (CCPA 1967), "the existence of these registrations is not evidence of what happens in the market place or that customers are familiar with their use." Where, as here, the "record includes no evidence about the *extent of [third-party] uses* … [t]he probative value of this evidence is thus minimal." *See also Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) ("As to strength of a mark, however, registration evidence may not be given *any* weight").

As indicated above, we analyze the similarity of the marks by comparing the marks in their entirety. In this regard, the marks need not be identical to be in conflict. Section 2(d) prohibits the registration of a mark "which so resembles" another mark "as to be likely … to cause confusion." While the musical notes are the dominant feature of the marks at issue, the marks are otherwise similar by virtue of displaying a double musical note in an orange rectangular background. In this regard, applicant's mark and registrant's mark are closer to each other than the marks in the third-party registrations submitted by applicant. Moreover, consumers may not recognize the differences because they do not typically set out to find them. *See Alfacell v. Anticancer Inc.*, 71 USPQ2d 1301, 1035 (TTAB 2004) (ONCASE vs. ONCONASE: "As seen and spoken, this middle portion may be missed by many of the relevant purchasers."). "Thus, when there are small differences between the marks, the differences may be insignificant in obviating the likelihood of confusion when compared to the marks' overall similarities." *Hercules, Inc. v. National Starch & Chemical Corporation*, 223 USPQ 1244, 1246 (TTAB 1984).

In view of the foregoing, we find that the marks are similar.

B. The similarity or dissimilarity and nature of the products and services described in the application and registration.

Applicant is seeking to register its mark for the goods identified below:

> Computer software for use in reviewing, storing, organizing, and playing pre-recorded audio content, sold as a feature of handheld mobile digital electronic devices comprised of digital audio and video players, handheld computers, personal digital assistants, and electronic personal organizers.

Registrant has registered its mark for "providing temporary use of nondownloadable software for adding music and video profiles on the internet, for listening to MP3's and for sharing MP3's and music playlists with others."

According to the **ENCYCLOPEDIA BRITANNICA**, an MP3 is described as follows:[4]

> [A] data compression format for encoding digital audio, most commonly music. MP3 files offer substantial fidelity compared to compact disc sources at vastly reduced file sizes.
>
> … [MP3 files] quickly became the most popular [compression standard] through the wide availability of simple computer programs for compressing the music files.
>
> … An MP3 file can be played directly on a personal computer (PC) or portable digital music player, such as Apple's iPod, or written onto a standard audio CD, although the data loss from compression is not reversible.
>
> By the early 21st century the average consumer could store millions of songs in the MP3 format on a PC or MP3 player. Online services allowed computer users to share their music files with millions of others. Yet even as musicians and consumers began posting downloadable MP3 files online as a way of directly reaching listeners, recording companies took legal action to prevent the unauthorized distribution of copyrighted recordings. Meanwhile, legitimate Internet e-commerce sites, such as Apple's iTunes Store, sprang up to serve the market, selling individual

[4] The Board may take judicial notice of information in encyclopedias. *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 n.61 (TTAB 2011).

> songs that could be downloaded in a matter of seconds and changed forever the distribution of musical recordings.[5]

See also **DICTIONARY OF COMPUTING** (2008) (MP3 files "are now one of the most popular ways for storing and distributing music over the Internet."); "MP3," **GROLIER MULTIMEDIA ENCYCLOPEDIA** (2012) ("Apple Computer gave industry a big push with the introduction of its iPod portable player and the iTunes online store.").

Applicant's software and the registrant's services (*i.e.*, providing software) perform similar functions: controlling digital music. In fact, MP3 technology may be used in applicant's digital audio and video players, handheld computers, personal digital assistants, and electronic personal organizers. MP3 files are utilized in digital handheld devices and, in fact, applicant uses MP3 technology in its iPod devices and it sells audio downloads through its iTunes Stores. The relationship between applicant's software for processing audio files and registrant's service of providing access to nondownloadable software for processing audio files is corroborated by the third-party registrations submitted by the Trademark Examining Attorney. Third-party registrations which individually cover a number of different services that are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed services are of a type which may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786; *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). The registrations listed below are the most relevant.[6]

[5] "MP3, **ENCYCLOPEDIA BRITANNICA** (2012).

[6] We have not included the entire description of goods and services for each of the registrations. Only the goods and services in both applicant's application and registrant's registration are listed.

Mark	Reg. No.	Goods
FREE YOUR MUSIC	3294370	Providing temporary use of nondownloadable software for the creation of music; computer software used to create, compose, collaborate, record, mix, manipulate and edit sound and music samples, and play back the new musical audio files; computer software for use in transmitting and receiving musical audio files in multiple sound file formats attached to electronic and wireless interactive applications
SOCOCO	3790963	Computer software for electronic communication and collaboration in virtual spaces among remote parties; computer software for real-time sharing of electronic data, audio, visual and graphic materials among multiple persons; providing temporary use of nondownloadable computer software for real-times sharing of electronic materials among multiple persons
MYMOVO	3737397	Computer groupware for use in searching for, streaming and converting audio and video files to format requested by end user; computer software for processing digital music files; providing on-line non-downloadable software for use in searching for, streaming and converting audio and video files to format requested by end user
FRIENDFEED	3571429	Software for use in uploading, posting, displaying, organizing and customizing electronic media and information in the nature of web pages, videos, music and photos; providing online non-downloadable software allowing users to uploading, posting, displaying, organizing and customizing electronic media and information in the nature of web pages, videos, music and photos

In view of the foregoing, we find that applicant's software for processing audio content is related to registrant's services of providing access to nondownloadable software for processing audio and video content.

C. The similarity or dissimilarity of likely-to-continue trade channels and classes of consumers.

The essence of this factor is whether the same classes of consumers are exposed to the marks at issue under circumstances likely to give rise to the mistaken belief that the goods and/or services emanate from the same source. *In re Binion*, 93 USPQ2d 1531, 1534-35 (TTAB 2009); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co.*, 221 USPQ2d 58, 61 (TTAB 1984). Applicant contends that registrant's services of providing software for processing audio is available only through the Internet while its software is provided in conjunction with a handheld electronic device. Assuming *arguendo* that this is true, both registrant's services and applicant's software are put in the hands of music listeners. Although there are differences in the manner in which the goods and services are sold, the same consumers may encounter both marks.

D. Conditions of Sale (*i.e.*, the degree of consumer care).

Applicant contends that consumers for both applicant's software and registrant's services of providing access to nondownloadable software will exercise a high degree of consumer, thus, minimizing potential confusion.

> A consumer seeking [applicant's] device-specific software must first purchase the device to acquire the software. The cost of high-quality, portable, handheld electronic devices, such as those made by [applicant], is not trivial, and consumers do not undertake this purchasing decision lightly. Thus, a buyer of a product on which [applicant's] claimed software is installed is exceedingly likely to be discriminating and to give the product careful consideration. …
>
> Consumers acquiring the services [registrant] offers … are also likely to exercise care. Functions of the [registrant's] software … include "adding music and video to profiles on the internet" and "sharing MP3's and music playlists with others." To perform these functions, users would necessarily need to provide some amount of personal information – and more likely, to register and create an account – so their information can be stored and shared. It is therefore unlikely that consumers use [registrant's] services without exercising some degree of care as to what company will be

> managing their person data and likely consumers would be able to distinguish that source, [registrant], from [applicant].[7]

This is simply argument by counsel; it is not supported by any evidence in the record. As such, there are problems with applicant's analysis. First, handheld devices like applicant's handheld computers, personal digital assistants, and electronic personal organizers are ubiquitous. One need only look around at any public gathering, or even just walking down the street, and you will notice many people with their handheld devices. While this group of people may include discriminating consumers, it also includes those who are not very careful. Second, consumers may acquire software applications that will become a feature of their handheld device at some time after the purchase of the handheld device. The care that went into purchasing the handheld device may not be the care used in acquiring applications. The standard of care cannot be supposed: it must be proven. Therefore, based on the record before us, the conditions of sale is a neutral factor.

E. The nature and extent of any actual confusion.

Applicant asserts that despite the "very public nature" of its use of the double musical note design mark since 2007, it is unaware of any reported instances of confusion with the registered mark. However, the absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by registrant of its mark for a significant period of time in the same markets as those served by applicant under its mark. *Citigroup Inc. v. Capital City Bank Group, Inc.,* 94 USPQ2d 1645, 1660(TTAB 2010), *aff'd,* 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.,* 23 USPQ2d 1768, 1774 (TTAB 1992). On this record, the contemporaneous use of applicant's and registrant's marks for a period of over four years without actual confusion is entitled to little

[7] Applicant's Brief, pp. 17-18.

weight. *See In re Majestic Distilling Co., Inc*., 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) ("uncorroborated statements of no known instances of actual confusion are of little evidentiary value"). *See also In re Bisset-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of applicant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). The lack of evidence of actual confusion carries little weight, *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965), especially in an *ex parte* context. The record is devoid of probative evidence relating to the extent of use of applicant's and registrant's marks and, thus, whether there have been meaningful opportunities for instances of actual confusion to have occurred in the marketplace. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000); and *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Accordingly, the *du Pont* factor of the length of time during and conditions under which there has been contemporaneous use without evidence of actual confusion is considered neutral.

F. Balancing the factors.

In view of the facts that the marks are similar, the goods and services are related and are encountered by the same classes of consumers, we find that applicant's double musical note and design for "computer software for use in reviewing, storing, organizing, and playing pre-recorded audio content, sold as a feature of handheld mobile digital electronic devices comprised of digital audio and video players, handheld computers, personal digital assistants, and electronic personal organizers" is likely to cause confusion with the registered mark comprising a double musical note and design for "providing temporary use of nondownloadable software for adding

music and video profiles on the internet, for listening to MP3's and for sharing MP3's and music playlists with others."

Decision: The refusal to register is affirmed.