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

Proceeding	91203865
Party	Plaintiff Apple Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Applications of Hewlett-Packard Development Company, L.P.



Mark:

Serial No.: 85/316,016

Published in the Official Gazette of October 18, 2011



Mark:

Serial No.: 85/315,978

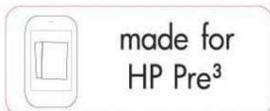
Published in the Official Gazette of October 18, 2011



Mark:

Serial No.: 85/315,880

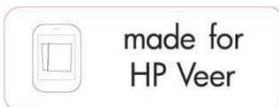
Published in the Official Gazette of October 25, 2011



Mark:

Serial No.: 85/315,996

Published in the Official Gazette of October 25, 2011



Mark:

Serial No.: 85/315,959

Published in the Official Gazette of October 25, 2011

device. Yet HP seeks wide-ranging discovery into Apple's development of the physical three-dimensional designs of the iPad and iPhone devices, into the designs used by third-party tablet and smartphone manufacturers, and into Apple's efforts to enforce its design patent and trade dress rights against competing manufacturers. HP fails to show how Apple's product design development and enforcement is relevant to the validity of Apple's two-dimensional logotypes for its "Made for" accessory licensing program. HP's effort to burden Apple with unwarranted discovery should be rejected. Similarly, HP seeks discovery concerning Apple's wholly-owned subsidiary, IP Application Development LLC ("IPAD LLC"), which is the applicant of record for Serial No. 77/913,563 for the word mark IPAD (the "IPAD Word Mark Application"). Apple has not asserted the IPAD Word Mark Application in this proceeding, and HP has failed to demonstrate that its requests may lead to relevant evidence. Accordingly, HP's Motion should be denied in its entirety.

BACKGROUND

Apple's Asserted Applications and Registrations

In this Opposition proceeding, Apple asserts that the overall design of HP's marks, including their use of "Made for" language alongside a line drawing representation of the applicable product, is likely to cause confusion with the marks that Apple uses in its "MFi" program. Through the MFi program, Apple licenses the word marks "Made for iPod", "Made for iPhone", and "Made for iPad" and accompanying two dimensional logotypes to producers of electronics accessories that are compatible with the iPod, iPhone, and iPad devices. As shown in the attached Exhibit A, Apple describes the program to potential licensees as follows:

Get the hardware connectors and components that are required to manufacture iPod, iPhone, iPad, and AirPlay audio accessories. And access the iPod Accessory protocol

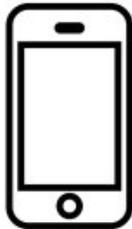
specification, the communication protocol used to interact with iPod, iPhone, and iPad.

Promote your electronic accessory with MFi logos. Made for iPod, Made for iPhone, and Made for iPad logos communicate to customers that an electronic accessory has been designed to connect specifically to iPod, iPhone, or iPad, and has been certified by the developer to meet Apple performance standards.

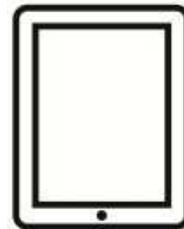
The marks asserted by Apple in this proceeding consist of two-dimensional designs used in the MFi program, with and without the phrases “Made for iPod”, “Made for iPad”, and/or “Made for iPhone”, including those examples shown below:

Ser. No. 85/040,770 (“the iPhone MFi Logo”)

Ser. No. 85/025,647 (“the iPad MFi Logo”)



Ser. No. 85/025,627



Ser. No. 85/025,637



Consistent with its use in the MFi program, Apple’s iPhone MFi Logo application does not seek to register the iPhone MFi Logo in connection with the iPhone device itself, but rather various accessories for the iPhone, such as “electronic docking stations,” “stands specially designed for holding mobile phones and portable and handheld digital electronic devices,” “headphones and earphones” and “protective cases.” Similarly, Apple seeks to register the iPad MFi Logo only in connection with various accessories for the iPad.

Applicant's Discovery Requests

Despite Apple's assertion of only two-dimensional logotype marks, more than one-half of Applicant's discovery requests seek discovery on the three-dimensional design configuration of Apple's devices:

- Requests for Production ("RFP") Nos. 3 and 4 and Request for Admission ("RFA") No. 6 seek information concerning the creation of the external design of the iPhone and iPad devices. *See* Motion Ex. A.
- RFP Nos. 15-21 and 29-36 demand documents concerning particular design features on Apple's physical products, such as the shapes of the exterior corners, the button on the face of the product and the screen. *Id.*
- RFA Nos. 7-10 and 25-32 seek comparisons between the design of Apple's devices and smartphones and tablets by other manufacturers. *Id.*
- RFP Nos. 24 and 25 call for documents concerning Apple's efforts to enforce its trade dress rights against other manufacturers.¹ *Id.*

None of the requests at issue touch on the use of two-dimensional logos in connection with accessories for mobile devices, and accordingly, Apple objected to all such requests as irrelevant. Because the requests could not lead to admissible evidence, Apple further objected to the requests as overbroad and unduly burdensome.

HP also seeks documents concerning the IPAD Word Mark Application and Apple's subsidiary IPAD LLC, including "[a]ll trademark assignments and licenses between Opposer and IP Application Development Company [sic] LLC," regardless of subject matter. *See* Motion

¹ In its Motion, HP appears to also object to Apple's response to Request for Production No. 14, which seeks discovery concerning "[a]ll unlicensed third-party packaging and advertisements that employ a rounded rectangle as a trademark, graphic element, or portion of a trademark or graphic element, for Opposer's Identified Goods." However, in subsequent correspondence, Apple agreed to produce documents with respect to trademarks that employ a rounded rectangle. *See* Motion Ex. C at 2.

Ex. A at RFP Nos. 26-28 and RFA Nos. 1-4. Apple similarly objected to such requests as irrelevant and thus overbroad and unduly burdensome.

ARGUMENT

“[T]he right to discovery is not unlimited.” *FMR Corp. v. Alliant Partners*, 51 USPQ2d 1759 (TTAB 1999). Particularly “[i]n view of the limited jurisdiction of the Board in deciding only issues of registrability,” a party must ““make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the case.”” *Pioneer Kabushiki Kaisha v. Hitachi High Techs. Am., Inc.*, 74 USPQ2d 1672 (TTAB 2005) (citation omitted). The Board may limit discovery where, as here, “the burden or expense of the proposed discovery outweighs its likely benefit, considering the needs of the case, the amount in controversy, the parties’ resources, the importance of the issues at stake in the action, and the importance of the discovery in resolving the issues.” Fed. R. Civ. P. 26(b)(2)(C); TBMP § 402.02.

I. Discovery Concerning the Trade Dress of Apple’s Devices Is Not Relevant.

HP’s Motion mischaracterizes the nature of Apple’s iPhone MFi Logo and iPad MFi Logo. As discussed above, Apple’s iPhone MFi Logo and iPad MFi Logo are used in connection with accessories produced by third parties for Apple’s devices, and signal to consumers that the accessories are produced under Apple’s technology licensing program and are compatible with Apple’s devices. The identifications of goods in Apple’s applications for these marks are limited to accessories. In its Motion, HP never mentions the goods for which Apple has applied to register the iPhone MFi Logo and iPad MFi Logo, nor even indicates that it is aware of the goods identified in the applications.

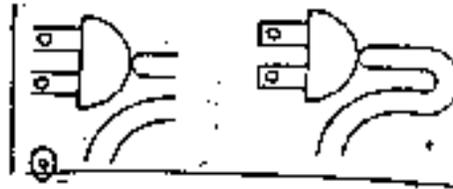
HP claims that it needs discovery to show that Apple’s iPhone MFi Logo and iPad MFi

Logo are functional, but these are two-dimensional logotypes. Functionality is a basis for refusing registration to an application for trade dress. *See* TMEP § 1202.02. HP also claims that Apple's iPhone MFi Logo and iPad MFi Logo are nondistinctive, but the distinctiveness of a mark must be evaluated vis-à-vis the goods for which registration is sought. *See* TMEP § 1209.01(b) ("The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract."); TMEP § 1209.01(c)(i) ("There is a two-part test used to determine whether a designation is generic: (1) What is the genus of goods or services at issue? and (2) Does the relevant public understand the designation primarily to refer to that genus of goods or services?").

HP does not, and cannot, convincingly explain how discovery concerning the design of the exterior of smartphones and tablets is relevant to whether Apple's two-dimensional design marks are distinctive and protectable with respect to speakers, remote controls, or any of the other peripheral accessories for which Apple seeks registration. The attenuated nature of HP's position is evident from its inability to provide a simple rationale for permitting discovery. Its argument requires several steps, starting with the false premise that functionality is at issue in this proceeding: "whether the features shown in Apple's simplified drawings are functional, rather than ornamental, directly correlates to the strength and distinctiveness of the alleged marks, and this in turn correlates directly to the validity of the marks and whether confusion is likely." Motion at 2. Reasonable discovery with respect to the two-dimensional logotypes at issue is fair game; demands for all documents related to Apple's decision-making in designing three-dimensional product trade dress are beyond the scope of this proceeding.

Numerous Board decisions confirm that a graphic design that is merely suggestive of the

relevant goods and services is distinctive and registrable. For example, in *In re General Electric Co.*, 209 USPQ 425 (TTAB 1980), the Board found that a stylized depiction of an electrical plug and cord, as shown below, were at most suggestive of rechargeable batteries.



Similarly, in *In re LRC Products Ltd.*, 223 USPQ 1250 (TTAB 1984), the Board allowed registration of the symbol below for gloves, finding that while the mark might suggest or resemble gloves, it is not “a common symbol or design used by the trade to represent gloves.”



As noted by HP, the Board has already evaluated the relevance of Apple’s three-dimensional trade dress to the registrability of the iPhone MFi Logo and iPad MFi Logo. In *Acer Inc. et al v. Apple Inc.*, Opposition No. 91198009, Samsung Electronics Co., Ltd. (“Samsung”) is challenging the iPhone MFi Logo and iPad MFi Logo on similar grounds of functionality and genericness. Samsung sought to suspend the Board proceeding pending the resolution of the recently-decided federal court litigation between Samsung and Apple, in which Apple alleged that Samsung’s devices infringed Apple’s trademark, trade dress and design patent rights.

Samsung argued that the district court litigation would address the validity of Apple’s asserted trade dress—including the same design features that HP has attempted to put at issue in this proceeding, such as curved external corners, a round button and a rectangular screen—and thus have a bearing on the registrability of the iPhone MFi Logo and iPad MFi Logo. *Compare* Opp. No. 91198009 Dkt. No. 18 *with* Motion Ex. A at RFP Nos. 15-17. The Board denied Samsung’s motion, and found that whether a product configuration is functional, nondistinctive or generic is irrelevant to whether a two-dimensional logo used on accessories is protectable:

[E]ven assuming *arguendo*, that the district court finds that applicant’s pleaded marks are functional, nondistinctive trade dress and/or generic configurations of applicant’s smart phones and/or computer tablets, such a finding would not be determinative or have a bearing on whether applicant’s marks involved herein, which are used or intended to be used in association with **accessories** for applicant’s smart phone and/or computer tablets and not for the electronic devices themselves, are functional, nondistinctive configurations of one or more of applicant’s goods or merely descriptive of the goods identified in applicant’s subject applications.

Opp. No. 91198009 Dkt. No. 22 at 11 (emphasis in original). HP does not attempt to address the import of the Board’s decision or distinguish its findings. Rather, HP misdirects attention by claiming, erroneously, that the decision was based “primarily” on other grounds, and decries the Board’s finding quoted above as mere “dicta.” Motion at 6. The Board’s reasoning, however, applies with equal force here. Evidence concerning the distinctiveness of elements of Apple’s physical devices, or comparing features of such devices to those of third-party manufacturers, has no relevance to the validity of the iPhone MFi Logo and iPad MFi Logo.

None of the cases cited by HP is to the contrary. All address functionality only in the context where the mark is merely a direct visual representation of the goods and services offered under the mark, and not where the mark is merely suggestive of the relevant goods and services.

In *Textron, Inc. v. Pilling Chain Co.*, 175 USPQ 621 (TTAB 1972), applicant attempted to

register a picture of a zipper slider for use on just that—zipper sliders. Similarly, in *In re Lighting Systems, Inc.*, 212 USPQ 313 (TTAB 1981), applicant described the mark as “a facsimile of a portable, electric flashlight” and sought to register the mark for portable electric flashlights. And in *In re Water Gremlin Co.*, 208 USPQ 89 (TTAB 1980), applicant sought to register a picture of a circular container for fishing line weights for that precise good.

Thus, evidence concerning the design of Apple’s iPhone and iPad devices can have no impact on this proceeding, and Apple respectfully submits that its objections on the grounds of irrelevance, overbreadth and undue burden should be sustained. *See, e.g., Ginena v. Alaska Airlines, Inc.*, 04-cv-01304-RCJ-CWH, 2011 WL 4749104, at *2 (D. Nev. Oct. 6, 2011) (“Production of information that is not relevant is an inherently undue burden.”).

II. Discovery Concerning Apple’s Registration of the IPAD Word Mark Is Not Relevant.

HP’s unjustified discovery attempts into Apple’s relationship with its subsidiary should also be denied. As noted above, IPAD LLC, Apple’s wholly-owned subsidiary, is the owner of record of the IPAD Word Mark Application. Apple has not asserted the IPAD Word Mark Application in this proceeding, and does not claim that HP’s applications at issue infringe upon a stand-alone word mark such as IPAD. While certain of the design marks asserted by Apple incorporate the mark IPAD, the PTO has accepted Apple’s claim that it is the parent corporation of IPAD LLC and removed the IPAD Word Mark Application as a basis for refusal of those design marks. *See* Application Serial Nos. 85/025,637, 85/028,975, 85/028,997 and 85/029,010. Accordingly, HP has not demonstrated why further discovery of IPAD LLC is warranted.

Moreover, the majority of HP’s requests concerning IPAD LLC bear no relation to the IPAD Word Mark Application and are improper for that reason alone. RFP No. 28 seeks “[a]ll

trademark assignments and licenses between Opposer and [IPAD LLC]” without limitation, while RFA Nos. 1-4 seek information concerning the existence of license agreements between IPAD LLC and Apple at various points in time, without any specification as to the subject matter of the license, and in some cases without even narrowing the request to trademark, as opposed to other types, of licenses. Such requests are impermissibly broad, and Apple’s objections thereto should be upheld.

CONCLUSION

For the foregoing reasons, Opposer respectfully requests that the Motion be denied.

Date: August 27, 2012

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APPLE INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Opposer’s Opposition to Applicant’s Motion to Compel is being sent by e-mail to James F. Struthers at jim@richardlawgroup.com, as agreed by the parties, on August 27, 2012.

/Christine M. Hernandez/
Christine M. Hernandez

EXHIBIT A

MFi Program

Join the MFi licensing program and get the hardware components, tools, documentation, technical support and certification logos needed to create AirPlay audio accessories and electronic accessories that connect to iPod, iPhone, and iPad.



Hardware Components and Documentation

Get the hardware connectors and components that are required to manufacture iPod, iPhone, iPad, and AirPlay audio accessories. And access the iPod Accessory protocol specification, the communication protocol used to interact with iPod, iPhone, and iPad.



MFi Logos

Promote your electronic accessory with MFi logos. Made for iPod, Made for iPhone, and Made for iPad logos communicate to customers that an electronic accessory has been designed to connect specifically to iPod, iPhone, or iPad, and has been certified by the developer to meet Apple performance standards.



Technical Support

Request support from our Developer Technical Support engineers and get one-on-one assistance with your specific technical issue.

What's Included

- Technical Information
- Hardware connectors and components
- Testing Tools
- Technical Support
- Product Certification
- MFi and AirPlay logos
- iPod, iPhone, and iPad compatibility icons

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