

ESTTA Tracking number: **ESTTA493407**

Filing date: **09/10/2012**

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

Proceeding	91203865
Party	Defendant Hewlett-Packard Development Company, L.P.
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Date	09/10/2012
Attachments	Reply in Support of Motion to Compel FOR FILING.pdf (8 pages)(44804 bytes)

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

In re MADE FOR HP TOUCHPAD & Design Serial No. 85/315,880 et al.

Apple, Inc.	§	
	§	
Opposer	§	
	§	
v.	§	Opposition No. 91203865
	§	
Hewlett-Packard Development Company, L.P.	§	
	§	
Applicant	§	

**APPLICANT’S REPLY IN SUPPORT OF ITS MOTION TO COMPEL
PRODUCTION OF DOCUMENTS AND TO DETERMINE SUFFICIENCY
OF OBJECTIONS AND ANSWERS TO REQUESTS FOR ADMISSION**

Applicant Hewlett-Packard Development Company, L.P. (“HPDC”) respectfully submits this Reply in Support of its Motion to Compel Production of Documents and to Determine Sufficiency of Objections and Answers to Requests for Admission (the “Motion”), which Opposer Apple Inc. (“Apple”) opposes in its Opposition to Applicant’s Motion to Compel (the “Response”), and for good cause shows the Board as follows:

SUMMARY OF THE ARGUMENT

In this opposition, Apple is asserting Application Serial No. 85/040,770, which attempts to register a highly simplified and realistic representation of a phone for phone accessories and a “full line of electronic and mechanical parts and fittings for mobile phones”; and Application Serial No. 85/025,647 which seeks to register a simplified and realistic representation of a tablet/handheld computer for handheld computer accessories and a “full line of electronic and mechanical parts and fittings for handheld computers.”

Apple is attempting to avoid *any* discovery that reaches the generic, functional or merely

descriptive nature of these alleged marks, first by mischaracterizing its identification of goods as “limited to accessories” and next by suggesting that any inquiry beyond these goods is irrelevant. The problem with Apple’s argument is that distinctiveness is not judged solely according to the precise goods listed in an ID. Descriptiveness may be found, for example, where a mark describes any “function, feature, purpose or use” of the specified goods or services. Apple’s alleged marks are clearly not entitled to registration if they merely describe the parts, fittings or accessories which Apple expressly identifies. But they are also not entitled to registration if they describe a phone or a handheld computer, since these products are the express function, feature, purpose and use of the goods specified in the ID.

Apple insists that the distinctiveness of its simplified drawings must be judged in a vacuum, without reference to the three-dimensional products Apple concedes that its alleged marks represent. However, Serial No’s 85/040,770 and 85/025,647 are *pending applications*, and they are not entitled to a presumption of validity. Previous TTAB decisions, including those relied upon by Apple, have carefully examined the correspondence of two-dimensional marks to three-dimensional products before attempting to reach a conclusion on distinctiveness. If a drawing is similar or identical in appearance to a design that is in common use in connection with goods listed in or closely related to the ID, regardless of whether the design is 2-D or 3-D, this plainly bears on distinctiveness and is fair game for discovery.

With regard to IPAD LLC, Apple’s unsupported assertion that this entity is a wholly-owned subsidiary of Apple is new, and even if true does not excuse its discovery obligations.

Finally, Apple has failed to establish that there is *any* burden associated with the requested discovery.

ARGUMENT

HPDC IS ENTITLED TO DISCOVERY AS TO WHETHER OPPOSER'S MARKS ARE MERELY DESCRIPTIVE OR FUNCTIONAL

Apple relies on two equally weak rationales for its failure to respond to HPDC's discovery on descriptiveness and functionality: (1) that because Apple's applied-for goods are "limited to accessories," HPDC cannot inquire into whether the alleged marks merely describe phones or handheld computers; and (2) that because the pending marks are 2-dimensional drawings, any inquiry into the 3-dimensional products the drawings represent is irrelevant.

As to the first point, Apple's ID is *not* limited to accessories. On the contrary, Apple seeks to register its marks for, among other things, a "full line of electronic and mechanical parts and fittings for mobile phones;" and a "full line of electronic and mechanical parts and fittings for handheld computers." The category "electronic and mechanical parts and fittings" is much broader than any fair reading of "accessories," and clearly includes all of the exterior iPad and iPhone elements represented in the alleged marks, including buttons, screens, bezels, earpieces, etc. Furthermore, nothing in the ID restricts the scope of Apple's claimed rights to Apple's alleged MFi licensees.

Even if Apple had actually limited its ID to accessories, discovery into the correlation between Apple's alleged marks and phones or tablet/handheld computers would be permissible, since it is clear from the ID's themselves, as well as Apple's brief,¹ that all of Apple's identified accessories *are for use with phones and tablets/handheld computers*. The fact that Apple's simplified drawings are two-dimensional designs, as opposed to word marks, does not alter the fundamental test of descriptiveness. Whether a mark is suggestive or merely descriptive must be

¹ Apple admits that it seeks to register the iPhone MFi Logo for "various accessories for the iPhone" and the iPad MFi Logo "only in connection with various accessories for the iPad." In addition, the ID's specifically state that various accessories are "for use with mobile phones" or "for use with handheld computers."

determined in relation to the goods or services for which registration is sought, considering “the context in which the mark is used, or intended to be used... and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace.” See Trademark Manual of Examining Procedure § 1209.01(b). Descriptiveness may be found where a mark describes any “ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services.” *Id.* (emphasis added, citations omitted). Phones and handheld/tablet computers are plainly an intended function of accessories that work with phones and handheld/tablet computers, not to mention Apple’s “full line” of parts and fittings “*for phones*” and “*for handheld computers.*”

The alleged marks in issue do not have to be affixed to the iPhone or iPad to make discovery regarding those products relevant. Matters are discoverable if they are relevant or reasonably calculated to lead to the discovery of admissible evidence. Apple has conceded that its alleged marks are “simplified drawings of mobile digital electronic communication devices.” The goods covered by Apple’s ID plainly include parts, fittings and accessories for such devices. HPDC seeks discovery that will demonstrate that the alignment of Apple’s drawings and this class of devices is one of near identity. Furthermore, HPDC seeks to show that Apple’s drawings are distilled to only the most essential and functional elements of the respective device classes, and are completely devoid of ornamentation. HPDC seeks discovery to demonstrate that these drawings look like virtually every mobile phone and tablet computer on the market, and therefore they cannot distinguish parts, fittings or other goods associated with those devices. It simply cannot be the case that the distinctiveness of these drawings must be evaluated in a vacuum, without consideration of the functionality or commonality in the industry of the products they depict, and which are expressly identified in the ID as a function, purpose and use

of the goods for which registration is sought. This would put Apple's alleged marks on equal footing with a purely arbitrary or ornamental drawing.

On pages 7-8 of its Response, Apple notes prior decisions in which the Board found that a "graphic design that is merely suggestive of relevant goods and services is distinctive and registrable." Apple then makes the leap, without any evidence or discussion, that its alleged marks are "merely suggestive." It must make this leap, because to do otherwise is to concede that the information requested is relevant.

For example, in *In re General Electric Company*, 209 USPQ 425 (TTAB 1980), the Board found the marks to be suggestive after reviewing the evidence presented. After reviewing the evidence, the Board determined that the cord and plug design was "stylized, rather than realistic in nature." The Board also evaluated other characteristics of the mark – the fact that the power cord curved in an abnormal manner and was cut off so that it was two pieces. Finally, the Board concluded that the applicant's batteries "are never 'used in connection with' an electrical cord and plug, so the cord and plug were not descriptive of the batteries. *Id.* at 426-27. HPDC's discovery goes directly to the issue of whether Apple's alleged marks are "stylized, rather than realistic." The more realistic Apple's drawings are, the less distinctive and the less likely they are to function as trademarks or lead to confusion.

Likewise, *In re LRC Products Limited*, 223 USPQ 1250 (TTAB 1984), the Board evaluated the evidence presented before determining that the mark was "sufficiently arbitrary and fanciful" so as not to be merely descriptive. Importantly, the Board stated that there is "no evidence that applicant's mark is a common symbol or design used in the trade to represent gloves. *Id.* at 1252. Thus, evidence of industry usage to determine if the marks are a common symbol or design is relevant. If rounded corners, rectangular screen, buttons and earpieces, as

well as the overall simplified design Apple seeks to register, are highly functional and commonly used in the relevant industry, then the marks are going to be weaker, if not entirely indistinctive.

In sum, to establish its various defenses, including lack of distinctiveness and the absence of any likelihood of confusion, HPDC needs to examine the source and significance of Apple's simplified drawings, the functionality and absence of ornamentation of the constituent elements, and how commonly these elements and the overall designs are used in the industry. The discovery at issue is both appropriate and narrowly tailored to the issues at hand, and HPDC's Motion should be granted.²

**HPDC'S IPAD LLC DISCOVERY IS REASONABLY CALCULATED
TO LEAD TO THE DISCOVERY OF ADMISSIBLE EVIDENCE**

In its Response, Apple states for the first time that IPAD LLC is a wholly owned subsidiary of Apple. This is new, and still unsupported, information. Apple's counsel did not mention this information in its discovery responses or in its communications while the parties were conferring prior to HPDC's filing of its Motion. Instead, counsel said "Requests for Admission 1-4 and Requests for Production 26-28 seek discovery concerning certain applications filed by IP Application Development LLC, which have not been asserted by Apple in this proceeding. Thus, Apple maintains its objections to the relevance of such requests." As discussed in HP's Motion (pp 7-8), an apparent third-party claim to the dominant feature of an asserted mark is relevant to likelihood of confusion and validity, so the discovery is entirely

² Apple's continuing reliance on the Board's denial of the Motion to Suspend in *Acer, Inc., et al v. Apple, Inc.*, Opposition No. 91198009 is misplaced. The decision does not apply to this Motion or proceeding because, among other things: HPDC is not a party to the Acer proceedings; the TTAB's decision on the Motion to Suspend is not precedential; the decision did not involve discovery; likelihood of confusion is not claimed by any party to the Acer proceedings; HPDC is not a party to Apple's civil litigation with Samsung; and Apple's simplified drawing marks were not asserted or at issue in the civil litigation with Samsung.

appropriate. HP is not required to rely on Apple's summary or conclusions regarding its relationship with this entity.

**APPLE FAILS TO ESTABLISH THE REQUESTED
DISCOVERY IS OVERLY BROAD OR UNDULY BURDENSOME**

As discussed on pages 8-9 of HPDC's Motion, Apple – as the party resisting discovery – has the burden to prove overbreadth and undue burden. It failed to make such a showing, such as by declaration testimony setting forth the burden in producing the documents or answering the admissions. Instead, Apple views these objections as synonymous with its relevance objections. It apparently concedes that if the Board finds the discovery to be relevant, there are no other bases to withhold the information and documents. Accordingly, for the reasons discussed above, the relevance objections should be overruled and Apple ordered to produce the discovery and answer the requests for admission within 30 days of the Board's Order.

CONCLUSION

Based on the arguments and authorities presented by HPDC in its Motion and this Reply, HPDC respectfully requests that the Board grant its Motion to Compel and Motion to Determine the Sufficiency of Objections and Answers to Requests for Admission.

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CERTIFICATE OF SERVICE

I certify that on September 10, 2012, a true and correct copy of this Reply in Support of Its Motion to Compel Production of Documents and To Determine the Sufficiency of Objections and Answers to Requests for Admission was served on Glenn Gundersen and Christine Hernandez, Dechert LLP, via email to glenn.gundersen@dechert.com, christine.hernandez@dechert.com and trademarks@dechert.com, by agreement of the parties.

/s/ M.K. Kassie Hines
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