

This Opinion Is Not A
Precedent Of The TTAB

Oral Hearing: September 21, 2023

Mailed: December 22, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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ZeroDensity Yazilim Anonim Sirketi
v.
Apple Inc.
—

Opposition Nos. 91266285 and 91266754¹
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Jeffrey H. Greger of Hauptman Ham, LLP
for ZeroDensity Yazilim Anonim Sirketi.

Glenn A. Gundersen, Jennifer Insley-Pruitt, Thomas Kienzle of Dechert LLP
for Apple Inc.

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Before Kuhlke, Adlin and Lynch,
Administrative Trademark Judges.

¹ These proceedings were consolidated upon motion August 31, 2022. 21 TTABVUE. “Despite being consolidated for purposes of case presentation, each proceeding retains its separate character. The final decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleading[s]; and a copy of the decision shall be placed in each proceeding file.” *One Jeanswear Grp. Inc. v. YogaGlo, Inc.*, 127 USPQ2d 1793, 1795 (TTAB 2018).

Citations in this opinion to the briefs and other materials in the case docket refer to TTABVUE, the Board’s online docketing system. See *New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Except where otherwise indicated, all TTABVUE citations are to the docket in the parent case 91266285.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Apple Inc., seeks registration on the Principal Register of the proposed marks REALITY COMPOSER (REALITY disclaimed) in standard characters for: “Downloadable computer software used in developing other software applications; downloadable application development software; downloadable computer software providing a library of virtual objects for use in developing other software applications; downloadable computer software used in producing animation and three-dimensional effects for use in other software applications,” in International Class 9;² and REALITY CONVERTER in standard characters for “Downloadable computer software used in developing other software applications; downloadable application development software; downloadable computer software used in editing, customizing, and producing three-dimensional effects,” in International Class 9.³

Opposer, Zerodensity Yazilim Anonim Sirketi, has opposed registration of Applicant’s proposed marks on the grounds that they are: 1) merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1); and 2) likely to cause confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d) with Opposer’s previously

² Serial No. 88607577, filed September 6, 2019, based on an allegation of first use and first use in commerce on June 3, 2019, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). Opposer also filed based on a foreign application under Trademark Act Section 44(d), 15 U.S.C. § 1126(d), claiming a priority date of October 2, 2019. Subject of Opposition No. 91266285 (‘285).

³ Serial No. 88852639, filed March 30, 2020, based on an allegation of first use and first use in commerce on January 13, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). Opposer also filed based on a foreign application under Trademark Act Section 44(d), 15 U.S.C. § 1126(d), claiming a priority date of October 2, 2019. Subjection of Opposition No. 91266754 (‘754).

used REALITY and REALITY-formative marks for a variety of goods and services including “audio-visual television studio and broadcast production computer systems,” “apparatus for recording, transmission or reproduction of sound or images, cameras, photographic cameras, television apparatus, video recorders, CD and DVD players and recorders, MP3 players, computers, desktop computers, tablet computers, wearable technological devices, namely, smart watches, smart wristbands, head-mounted cameras; microphones, loudspeakers, earphones, telecommunications apparatus” and “apparatus for the reproduction of sound or images, computer peripheral devices, cell phones, covers for cell phones, telephone apparatus, computer printers, scanners, photocopiers; magnetic and optic data carriers and computer software and programmes recorded thereto.”

By its answers, Applicant generally denies the salient allegations.⁴

The case is fully briefed and an oral hearing was held on September 21, 2023. We sustain the opposition on the basis of Opposer’s mere descriptiveness claims and do not reach its likelihood of confusion claims.

I. RECORD

The record includes the pleadings and, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), the files of the applications subject to the notices of opposition. In addition the record includes:

⁴ Ans., 5 TTABVue (’285, ’754).

- Opposer’s Trial Declarations of Kuban Altan, Opposer’s Vice President of Research and Development, with exhibits;⁵
- Opposer’s Notices of Reliance on printouts of pages from Opposer’s, Applicant’s and third-parties’ websites;⁶
- Applicant’s Trial Declarations of Thomas R. La Perle, Director of Applicant’s Legal Department, with exhibits;⁷ and
- Applicant’s Notices of Reliance on printouts of pages from Opposer’s and third-parties’ websites.⁸

Applicant asserts several objections to the Kuban Altan Testimony Declarations. Board proceedings are heard by Administrative Trademark Judges, not lay jurors who might easily be misled, confused, or prejudiced by unreliable evidence. *Cf. Harris v. Rivera*, 454 U.S. 339, 346 (1981) (“In **bench trials**, judges routinely hear inadmissible evidence that they are presumed to ignore when making decisions.”). We employ the standards the Board previously has applied, and accord the testimony and evidence whatever probative value it deserves. “Ultimately, the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence in this case, including any inherent limitations, which precludes the need to strike the challenged testimony and evidence if the objection is well-taken.” *Poly-Am.*,

⁵ 9 TTABVUE (public) (‘285), 10 TTABVUE (confidential) (‘285); 7 TTABVUE (confidential) (‘754), 8 TTABVUE (confidential) (‘754).

⁶ 8 TTABVUE (‘285); 6 TTABVUE (‘754).

⁷ 11 TTABVUE (‘285); 15 TTABVUE (‘754).

⁸ 12 TTABVUE (‘285); 16 TTABVUE (‘754).

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L.P. v. Ill. Tool Works, Inc., 124 USPQ2d 1508, 1510 (TTAB 2017). We have given the declarations, and their accompanying evidence, their due weight, keeping in mind any objections. *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 147, 1479 (TTAB 2017). As necessary and appropriate, we address any limitations to the testimony and evidence material to our decision. *Id.*

II. ENTITLEMENT TO A STATUTORY CAUSE OF ACTION

Entitlement to a statutory cause of action must be proven by the plaintiff in every inter partes case. *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, *3 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)). A party in the position of plaintiff may oppose registration of a mark where such opposition is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the party has a reasonable belief in damage that is proximately caused by the prospective registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, *6-7 (Fed. Cir. 2020).

Where, as here, descriptiveness of the proposed mark is in issue, plaintiff may prove its entitlement to a statutory cause of action by alleging that it is engaged in the sale of the same or related products or services (or that the product or service in question is within the normal expansion of plaintiff's business) and that the plaintiff has an interest in using the term descriptively in its business. *University of Kentucky v. 40-0, LLC*, 2021 USPQ2d 253, at *13, *15 (TTAB 2021) (opposer demonstrated entitlement to a statutory cause of action by establishing that it has a present or prospective interest in using the term "40-0"); *Poly-America*, 124 USPQ2d at 1512

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(standing established by plaintiff showing that it is engaged in the manufacture or sale of the same or related goods and that the product in question is one which could be produced in the normal expansion of plaintiff's business); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1487 (TTAB 2017) (opposer's status as competitor establishes standing to oppose registration of product configuration); *Kistner Concrete Prods. Inc. v. Contech Arch Tech., Inc.*, 97 USPQ2d 1912, 1918 (TTAB 2011) (competitor in industry has a real interest in cancelling registration for product configuration); *Kellogg Co. v. General Mills Inc.*, 82 USPQ2d 1766, 1767 (TTAB 2007) (commercial interest in allegedly descriptive term).

At minimum, Opposer has shown that it uses the term REALITY ENGINE in connection with a "broadcast compositing system which is composed of a group of integrated sub-systems including multiple specialized software programs and hardware platforms" in the United States.⁹

Thus, Opposer's goods are sufficiently related to Applicant's to demonstrate an interest in using the terms in the proposed marks. Opposer has established its entitlement to a statutory cause of action to oppose registration of Applicant's proposed marks. Moreover, once such entitlement is shown on one ground, plaintiff has a right to assert any other ground in a proceeding. *Hole In 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 10020, at *3 (TTAB 2020).

⁹ Opp. Brief, 22 TTABVUE 21; Kuban Altan Test. Decl. ¶¶ 13, 21-31, 9 TTABVUE 4-9. Applicant does not object to Mr. Altan's testimony regarding his company's product. To the extent Applicant's broad objections are directed to such testimony they are overruled as Mr. Altan possesses personal knowledge about his company's use of its marks and products.

III. Mere descriptiveness

Section 2(e)(1) of the Trademark Act prohibits registration of a term on the Principal Register that, when used in connection with the goods or services identified in the application, is merely descriptive of them. “A mark is merely descriptive if it immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought.” *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1373 (Fed. Cir. 2018) (quoting *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017)). A mark is suggestive, and not merely descriptive, if it requires imagination, thought, and perception on the part of someone who knows what the goods or services are to reach a conclusion about their nature from the mark. *See, e.g., In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1515 (TTAB 2016) (citation omitted).

We “must consider the mark as a whole and do so in the context of the goods or services at issue.” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re Calphalon Corp.*, 122 USPQ2d 1153, 1162 (TTAB 2017). “Whether consumers could guess what the product is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). Rather, “the question is whether someone who knows what the goods and services are will understand the mark to convey information about them.” *DuoProSS*, 103 USPQ2d at 1757 (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)). It is not necessary, in order to find a term merely descriptive, that the term describe each feature of the goods or services, only that it

describe a single ingredient, quality, characteristic, function, feature, purpose or use of the goods or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

“Evidence of the public’s understanding of [a] term ... may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers and other publications,” *Real Foods*, 128 USPQ2d at 1374 (quoting *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1046 (Fed. Cir. 2018)), as well as websites, “labels, packages, or in advertising material directed to the goods [or services].” *N.C. Lottery*, 123 USPQ2d at 1710 (quoting *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)); *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1565 (Fed. Cir. 2001).

We begin with Applicant’s website that provides information on the products sold under REALITY COMPOSER and REALITY CONVERTER. Excerpts are reproduced below (emphasis added):

AR [augmented reality] Creation Tools

Composer is a powerful tool that makes it easy for you to create interactive **augmented reality** experiences with no prior 3D experience. Reality Converter quickly **converts** your existing 3D models to USDZ so it works seamlessly in our tools and on all AR-enabled iPhone and iPad devices.

Reality Composer

Reality Composer for iOS, iPad, OS, and macOS makes it easy to build, test, tune, and simulate AR experiences for iPhone or iPad. With live linking, you can rapidly move between Mac and iPhone or Mac and iPad to create stunning AR experiences, then export them to AR Quick Look or integrate them into your app with Xcode.

Reality Converter beta

The new Reality Converter app makes it easy to **convert**, view, and customize USDZ 3D objects to Mac. Simply drag-and-drop common 3D file formats, such as .obj, .glTF and .usd, to view the **converted** USDZ result, customize material properties with your own textures, and edit file metadata. You can even preview your USDZ object under a variety of lighting and environment conditions with built-in IBL options.¹⁰

AR Creation Tools ... Reality Converter quickly **converts** your existing 3D models to USDZ so it works seamlessly in our tools and on all AR-enabled iPhone and iPad devices. ... The new Reality Converter app makes it easy to convert, view, and customize USDZ 3D objects on Mac.¹¹

How do we **convert** FBX files from Maya into **.reality** format in Reality Composer? ... Using Maya's latest version we are attempting to **convert** a few fbx animations, with sound into a .reality file, without success. In the **converter** we get a shutdown in conversion after about 2 seconds on two of the three animations and in the latest attempt on the 3rd animation is that the animated characters are stacking on top of each other in the viewer (see image) and we get node errors.¹²

Opposer also provided screenshots of downloads from REALITY COMPOSER software, excerpts from Applicant's software developer's internet forum, and Applicant's motion user guide:

Reality Composer lets you focus on your composition while you design it. ... To do this, run Reality Composer on an iPad or iPhone that supports ARKit. If you **compose** on a

¹⁰ Opp. Notice of Reliance (<https://developer.apple.com/augmented-reality/tools/>), 8 TTABVUE 10-13.

¹¹ Kuban Altan Test. Decl. Exh. 13 (<https://developer.apple.com>), 7 TTABVUE 62-3 (91266754). Applicant's objection to Opposer's characterization of the content of the exhibit is sustained. We accept the exhibit for what it shows on its face. We further note this exhibit includes the URL and date and is similar to one submitted under the notice of reliance.

¹² Kuban Altan Test. Decl. Exh. 15 (<https://developer.apple.com>), 7 TTABVUE 83 (91266754). Applicant's objection to Opposer's characterization of the content of the exhibit is sustained. We accept the exhibit for what it shows on its face.

Mac, you can synchronize your session between the Mac and an iOS device over a local area network connection. ... If you **compose** on a Mac, you can synchronize your composition with Reality Composer on an iOS device to try it in an AR session. ... Alternatively, **compose** directly on the iOS device.¹³

Apple provides two applications to help you create or **convert** your own 3D objects: Reality Composer: One of the developer tools bundled with Xcode 11 or later, lets you make or customize your own USDZ 3D objects and scenes. Xcode is an integrated development environment (IDE) that includes a suite of software development tools. Xcode is available on the Mac App Store. ... Reality Converter: A developer tool available on the Apple Developer website, lets you import into Motion a 3D object or scene that's in a format other than USDZ ... These tools also include a **converter** that creates USDZ files from other 3D file formats.¹⁴

In addition, the record includes the following dictionary definitions:

Augmented reality: A technology that superimposes a computer-generated image on a user's view of the real world, thus providing a composite view¹⁵

¹³ Kuban Altan Test. Decl. ¶ 72, Exh. 21, 9 TTABVUE 15, 16, 294-295. Applicant objects to the following characterization in ¶ 72: "Applicant uses the term compose within its own software program to describe what the does." Applicant does not object to the introduction of Exh. 21 or the passage: "The images below are screen shots from the Apple Reality Composer compositing software I downloaded to my mobile phone." We accept the exhibit as being what it is purported to be, but sustain Applicant's objection to Mr. Altan's characterization of the exhibit to the extent it is offering legal opinion. The document speaks for itself.

¹⁴ Kuban Altan Test. Decl. ¶ 59, Exh. 15 (motion user guide), 7 TTABVUE 13, 92 (91266754). Applicant does not challenge the authenticity of this document and we accept it for what it shows on its face.

¹⁵ Kuban Altan Test. Decl. Exh. 18 (Lexico https://www.lexico.com/en/definition/augmented_reality), 9 TTABVUE 225. This exhibit is an online dictionary definition including the URL and date, Applicant's general objection to this exhibit is overruled.

Composer: 3. (computer graphics) A system that puts images together in a buffer (such as individual windows on a desktop) to generate a final display image¹⁶

Composer: one that composes¹⁷

Compose: a) to form by putting together b) to form the substance of c) to create by mental or artistic labor¹⁸

Finally, Opposer submitted various examples of third-party uses of the words “composer,” “compositor” and “converter” in media and software related contexts:

Looking for an After Effects Composer ... We are an animation studio looking for a freelance After Effect Composer for animated film for children. We are looking for someone creative and organized that can compose traditional animation with backgrounds, adding limited effects;¹⁹

The CG-300/350 is an extremely powerful Video Titling Program designed specifically for the Live Broadcast and Video Post Production environment. It comes with a very flexible, easy to use Graphic Composer for creating High Quality Title Pages. Once the page has been composed, they can be displayed automatically or completely under manual control.;²⁰

Avid Media Composer Software (www.amazon.com);

CCSTUDIO Code Composer Studio™ integrated development environment (www.ti.com);

¹⁶ Opp. Notice of Reliance (Wiktionary <https://en.wiktionary.org/wiki/compositor>), 8 TTABVUE 226.

¹⁷ Final Office Action, TSDR 2 (www.merriam-webster.com) (App. 88607577 subject of 91266285); *see also* Opp. Notice of Reliance, 6 TTABVUE 24 (91266754).

¹⁸ *Id.* at 4; 26.

¹⁹ Kuban Altan Test. Decl. ¶ 60, Exh. 14, 9 TTABVUE 14, 69 (www.freelancer.com).

²⁰ *Id.* ¶ 64, Exh. 16, 9 TTABVUE 14, 90 (DataVideo User Guide).

COMPOSER is Watlow[]s new, easy-to-use software for configuring and customizing controllers. (www.watlow.com);

dBTechnologies Composer is a line array configuration tool which has been especially developed to optimize VIO and DVA systems alignment. (www.dbtechnologies.com);

Drive Composer is a start-up and maintenance tool for ABB's common architecture drives. The tool is used to view and set drive parameters, and to monitor and tune process performance. (new.abb.com);

Mozilla Composer is the free and open-source HTML editor and web authoring module of the Mozilla Application Suite (the predecessor to SeaMonkey). It is used to create and to edit web pages, e-mail, and text documents easily. ... Composer is a graphical WYSIWYG HTML editor. (en.wikipedia.org);

OpenText Composer Technologies solutions deliver a safe, proven methodology designed to reduce the risk of manual rip and replace systems. (www.opentext.com);

Schlumberger Visual Delivery Composer is developed by Schlumberger. ... You can check NoteWorthy Composer Viewer, Visual MODFLOW, FirmTools Panorama Composer and other related programs like VioLet Composer at the "download" section. (schlumberger-visual-delivery-composer.software.informer.com);

SOLIDWORKS Composer Easily repurpose existing 3D models to rapidly create and update high-quality graphical assets that are fully associated with your 3D design (www.solidworks.com);

Composer™ 8.1 Award-winning Composer for Windows® handles end-to-end configuration of Radius NX, PxiM, Edge, and Solus NX DSPs...including creation of customized GUIs, scheduling, presets, logic, security, and

integration of Symetrix and third-party control solutions (www.symetrix.com).²¹

Composer job description ... Compositors ensure that all the visual elements of a film are rendered seamlessly on the screen. They deal with a complex combination of images including green screen/chroma key sequences, special effects, visual effects, mattes and live action coming together to complete a believable whole. ... Their role is the crucial final step of the output of the film or game when all the elements are composed to its final render. (www.cgspectrum.com);

MEDIA COMPOSER ... Perfect stories in fewer clicks with the latest Media Composer ... Media Composer is always getting better with new features and improvements (www.avid.com);

Visual Composer Hub ... Download free and premium content elements, templates, and extensions for your WordPress site from the online marketplace. Discover new content on a weekly basis to build better sites. (https://visualcomposer.com).²²

Applicant has objected to these exhibits and accompanying testimony. While Opposer has sufficient knowledge to provide lay testimony generally on these matters, we make our own determination on how to characterize these uses and their probative value. Several examples do not reflect descriptive uses (e.g. “COMPOSER is Watlow[']s new, easy-to-use software”) or are too truncated to understand if they are sufficiently related to Applicant’s goods to be relevant. In view thereof, we do not rely on these examples for our disposition.

²¹ *Id.* ¶ 67, Exh. 19.1, 9 TTABVUE 15, 229, 234, 236, 238, 240, 245, 249, 254, 257, 263.

²² *Id.* Exh. 19.2, 9 TTABVUE 265, 267, 271.

REALITY is the subject and end result of the software that converts or composes in the creation of augmented reality. Applicant acknowledges the descriptive significance of the word REALITY in connection with its goods in the following testimony: “I assume that this lack of confusion is due to a number of factors, including the descriptive nature of the word REALITY and the significant differences in use, function, and target consumers between the products at issue.”²³ In addition, Applicant disclaimed the word REALITY in the application for REALITY COMPOSER. *In re Carlson*, 91 USPQ2d 1198, 1200 (TTAB 2009); *Bass Pro Trademarks LLC v. Sportsman’s Warehouse, Inc.*, 89 USPQ2d 1844, 1851 (TTAB 2008); *see also Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1762 (TTAB 2013), *aff’d mem.*, 565 Fed. App’x 900 (Fed. Cir. 2014). Based on the dictionary definitions and excerpts from Applicant’s website, CONVERTER leaves nothing to the imagination in connection with software that has the function and purpose of converting files. COMPOSER clearly describes the function of the software which is used in composing augmented reality.

The terms together do not form a unitary phrase such that they lose their descriptive significance. To be unitary the elements of a mark must be so integrated or merged together that they cannot be regarded as separable. *In re Lego Juris A/S*, 2022 USPQ2d 443, at *6 (TTAB 2022). The Court of Appeals for the Federal Circuit has set out the following considerations:

²³ Thomas R. La Perle Test. Decl. ¶ 19, 15 TTABVUE 6 (91266754).

A unitary mark has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent elements. In other words, a unitary mark must create a single and distinct commercial impression.

Dena Corp. v. Belvedere Int'l, Inc., 950 F.2d 1555, 21 USPQ2d 1047, 1952 (Fed. Cir. 1991).

In the context of the identified software that converts files and assists in composing scenes in augmented reality, the descriptive meanings are not removed and the combination holds no distinct meaning of its own independent of the meaning of its constituent elements. *See DuoProSS*, 103 USPQ2d at 1758 (noting that where a proposed mark consists of a combination of descriptive terms, there must be proof that the combination creates “a commercial impression that is more than merely descriptive”). In the case of REALITY COMPOSER, REALITY is disclaimed, confirming it is not a unitary phrase, as Applicant essentially concedes.²⁴ *See generally* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 1213 (2023).

Applicant’s arguments and evidence do not persuade us of a different result. Applicant argues that Opposer did not submit sufficient evidence to support the claim of mere descriptiveness, and what it did submit is “unreliable and impermissible.” App. Brief, 25 TTABVUE 24. For example, Applicant points to Opposer’s evidence submitted to show that “composer” and “converter” have industry-specific definitions arguing the examples are not relevant to its goods. However, we do not rely on this

²⁴ Thomas R. La Perle Test. Decl. ¶ 19, 15 TTABVUE 6 (91266754).

proffered “industry-specific” wording, but rather the plain meaning of the words in connection with Applicant’s software products that have the functions and purposes of converting and composing. The plain meaning of these terms is sufficient to establish mere descriptiveness.

In addition, the fact that Applicant may be the first to use these combinations of descriptive terms does not by itself remove the merely descriptive meanings. Even if Applicant is the first user of these particular combinations, that does not justify registration if the only significance conveyed by the proposed marks is merely descriptive. *See Fat Boys*, 118 USPQ2d at 1514. The Examining Attorney is not required to prove that others have used the marks at issue or that they need to use them; the correct test is whether the proposed marks convey an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods. *Fat Boys*, 118 USPQ2d at 1514; *see also KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 122 (2004) (trademark law does not countenance someone obtaining “a complete monopoly on use of a descriptive term simply by grabbing it first”); *In re Walker Mfg. Co.*, 359 F. 2d 474, 149 USPQ 528 (C.C.P.A. 1966); (quoting Board decision with approval) (“The question . . . is not whether the Board or others may or would utilize ‘CHAMBERED PIPE’ to describe applicant’s goods, but whether this designation does, in fact, describe such goods. That there are other words which others may employ to describe or define applicant’s goods does not, in any way, lessen the descriptive character of the words ‘CHAMBERED PIPE.’”); *Clairol, Inc. v. Roux Distrib. Co.*, 280 F.2d 863, 126 USPQ 397, 398 (C.C.P.A.

1960) (“Even novel ways of referring to a product may nonetheless be merely descriptive.”); *In re Bailey Meter Co.*, 102 F.2d 843, 41 USPQ 275, 276 (C.C.P.A. 1939) (“The fact that appellant may have been the first and only one to adopt and use the mark sought to be registered does not prove that the mark is not descriptive . . .”).²⁵

As noted above, the determination of whether a mark is merely descriptive must be made in relation to the goods for which registration is sought, not in the abstract. *In re Chamber of Commerce*, 675 F.3d 1297, 102 USPQ2d 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *3 (TTAB 2019) (citing *Fat Boys*, 118 USPQ2d at 1513); see *Abcor Dev. Corp.*, 200 USPQ at 218. This requires consideration of the context in which the mark is used or intended to be used in connection with those goods, and the possible significance that the mark would have to the average purchaser of the goods in the marketplace. See *Chamber of Commerce*, 102 USPQ2d at 1219 (quoting *Bayer*, 82 USPQ2d at 1831); *Nett Designs*, 57 USPQ2d at 1566; *In re Omaha Nat’l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *Abcor Dev. Corp.*, 200 USPQ at 218.

As Applicant states it “is seeking to register REALITY COMPOSER for application development software, and in particular for software used in producing animation and three-dimensional effects for use in other software applications and for providing a library of virtual objects for use in other software applications.” App.

²⁵ We add that, although Applicant’s use of the proposed marks may be viewed as use in the manner of a trademark and may be relevant to establish acquired distinctiveness, that question is not before us as Applicant does not seek registration under Section 2(f), 15 U.S.C. § 2(f). Applicant seeks to register the combined terms as inherently distinctive.

Brief, 25 TTABVUE 25. Of course, this includes use in connection with augmented reality, as confirmed by the evidence Applicant provides. An online article submitted by Applicant contains the following description of the REALITY CONVERTER and REALITY COMPOSER products:

... Reality Converter ... enables developers to **convert** common 3D file formats to Pixar’s Universal Scene Description (USDZ) protocol, which Apple adopted as its preferred 3D format in 2018. ... With its drag-and-drop interface, Reality Converter can preview how OBJ, GLTF, and USD files would appear in USDZ, manipulate textures, and revise file metadata, then **convert** them to USDZ. ... Reality Composer is among a wave of tools, including Adobe Aero, Torch and the forthcoming Project MARS toolkit for Unity, designed to help developers to create augmented reality experiences without the need for heavy coding. With Reality Converter, Apple addresses a major pain point by assisting developers in converting the 3D file formats that they are accustomed to working with over to Apple’s preferred standard.²⁶

Applicant’s evidence and testimony clearly shows that REALITY CONVERTER software is “an augmented reality-based content viewer tool for macOS for use by augmented reality (‘AR’) developers of all skill levels and experience and available for free via Apple’s developer website” and it is marketed and sold as a stand-alone product and “as part of a suite of augmented reality creation tools and guides”²⁷ An excerpt from Applicant’s website provided by Applicant explains that the “Reality Converter application for macOS gives developers the ability to convert, view, and

²⁶ App. Notice of Reliance Exh. 4 (next.reality.news), 12 TTABVUE 25-27.

²⁷ Thomas R. La Perle Test. Decl. ¶¶ 9, 12, 15 TTABVUE 4-5 (91266754); App. Notice of Reliance, Exh. 4 (<https://next.reality.news>), 12 TTABVUE 27 (“Reality Converter ... enables developers to convert ... file formats...”).

customize USDZ objects with drag-and-drop support, preview capabilities, and more.”²⁸ The identification recited in the application encompasses such a product.

Finally, Applicant argues that Opposer improperly dissected the proposed marks and the terms together are incongruous because they do not actually compose reality or convert reality. Well, that’s a relief, but not a persuasive argument. It is appropriate and often necessary to analyze each portion separately in considering the designation in its entirety. *DuoProSS*, 103 USPQ2d at 1758. Applicant’s argument that “opposer certainly has not shown that either of those phrases has any recognized or readily-understood meaning,” App. Brief., 25 TTABVUE 29, is belied by the evidence cited throughout this decision. Applicant focuses on the type of evidence that may be relevant to show the combination is generic, rather than what suffices to establish mere descriptiveness, which is Opposer’s ground for opposition. When the issue is mere descriptiveness, the question is whether the combinations of terms mean something beyond their constituent parts. *See In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1373 (Fed. Cir. 2004). As we have found, when taken in the context of the goods, they do not. The evidence shows the dictionary meaning of the terms and how the terms are used in connection with Applicant’s goods, software that converts file formats (a converter) and assists in composing (a composer) to create augmented reality, nothing is left to the imagination.

²⁸ App. Notice of Reliance Exh. 1 (<https://9to5mac.com>), 16 TTABVUE 8; *see also* Opp. Notice of Reliance, 8 TTABVUE 10-13 (<https://developer.apple.com/augmented-reality/tools/>)—products listed under the heading “AR Creation Tools.”

Opposition Nos. 91266285 and 91266754

DECISION: We sustain the oppositions to registration of REALITY COMPOSER and REALITY CONVERTER on the ground of mere descriptiveness under Section 2(e)(1).