

ESTTA Tracking number: **ESTTA737208**

Filing date: **04/01/2016**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Sherlock Systems LLC		
Entity	Limited Liability Company	Citizenship	Indiana
Address	626 North Illinois Street STE 300 Indianapolis, IN 46204 UNITED STATES		

Correspondence information	Jonathan Morton 246 West Broadway, 4th Floor New York, NY 10013 UNITED STATES jonathan@ckl.com Phone:2124685491
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Registration Subject to Cancellation

Registration No	2336753	Registration date	03/28/2000
Registrant	APPLE INC. 1 INFINITE LOOP CUPERTINO, CA 95014 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 1998/09/01 First Use In Commerce: 1998/09/01 All goods and services in the class are cancelled, namely: feature of computer software that utilizes multiple search engines to search global communication networks and provides results ranked by relevance, with summaries, and searches hard disks by content as well as file name

Grounds for Cancellation

Fraud on the USPTO	Trademark Act section 14; In re Bose Corp., 580 F.3d 1240, 91 USPQ2D 1938 (Fed. Cir. 2009)
Abandonment	Trademark Act section 14

Attachments	SherlockCanc.pdf(2137353 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jonathan G. Morton/
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Name	Jonathan Morton
Date	04/01/2016

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

IN RE REGISTRATION NO. 2,336,753

Mark: SHERLOCK

Issued: March 28th, 2000

Sherlock Systems LLC

Petitioner

v.

Apple Inc.,

Registrant.

Cancellation No.

PETITION FOR CANCELLATION

Sherlock Systems LLC (“Petitioner”), a limited liability company organized and existing under the laws of the state of Indiana, with its principle place of business at 626 N. Illinois Street, Suite 300, Indianapolis, IN 46204, believes that it has been damaged by the registration of the trademark “SHERLOCK”, which has been assigned registration No. 2,336,753, and hereby petitions to cancel the same under the provision of Section 14 of the Lanham Act, 15 U.S.C §1064(3) on the grounds that Apple Inc. has abandoned the mark, and obtained and/or maintained the registration fraudulently.

As grounds for cancellation, Petitioner asserts:

1. On July 08, of 1998 Apple Inc. (“Registrant”) submitted application serial no. 75515549 to the USPTO to register the trademark “Sherlock”, with intent to use the trademark in international class 9. The Application was submitted under Sections (1b) (15. U.S.C 1501(b)) of the Lanham Act. The Registrant

submitted a statement of use to the United States Patent and Trademark Office (USPTO) on November 10th, 1999.

2. On March 28th, 2000 USPTO issued registration no. 2,336,753 for the mark.
3. The trademark was registered for international class 9 for the following goods: “feature of computer software that utilizes multiple search engine to each global communication networks and provides results ranked by relevance, with summaries and searches hard disks by content as well as file name”.

Petitioner’s First Ground for Cancellation: Abandonment

4. On October 26th, 2007 the Registrant apparently released its sixth major graphical interface operating system (“OS”) for its desktop computers: Mac OS X Leopard.
5. The Release of Mac OS X Leopard saw with it the removal of the software application “Sherlock”. Sherlock is a software application that had been used in previous operating systems as a file and web-searching tool. This was the software application exclusively associated with the Sherlock trademark found under US Registration No: 2,336,753. See Exhibit A Exhibits B; and Exhibit C.
6. Registrant apparently produced and distributed a software called “Mac OS XX TIGER”, which seemed to be replaced by a successor version the Registrant calls “Mac OS X Leopard”. In the latter, a software service used to locate files was called “Spotlight” instead of Sherlock. Mac OS X Tiger received its latest security update on September 10th, 2009, the following security update

on November 09, 2009 contained support only for subsequent operating systems. See Exhibit D.

7. Mac OS X Tiger has not been available commercially to the general public through any of the Registrant's online or retail stores for a period well over three years.
8. Accordingly, it is clear that the Registrant has ceased use of the mark in the United States for a period of more than three years, constituting a prima facie case for abandonment per the Lanham Act 15. U.S.C §1127. See: *Block Drug Co., Inc. v. Morton-Norwich Products, Inc.* 202 USPQ 157, 159 (TTAB1979) ["[T]o provide bona fide usage respondent must demonstrate that the use has been deliberate and continuous with an intention to create a commercial impact".]
9. For the Registrant to rebut the prima facie case for abandonment they must establish intent to resume commercial use of the trademark in the foreseeable future. See: *Exxon Corp v Humble Exploration Co.*, 695 F.2d 96, 102 [An intent to use may rebut a prima facie case for abandonment]. See also: *Roulo v. Russ Berrie & Co.* 886 F.2d 931 (7th Cir. 1989); [The intent to resume use must be within the foreseeable future.]
10. Mac OS X Leopard and the many subsequent operating systems that the Registrant has released do not utilize the Sherlock software application or the Sherlock trademark. The Registrant has replaced the functionality of the Sherlock software application with other software applications, including "Dashboard" and "Spotlight" (Registration Number 3624650). See Exhibit B.

11. This is clear and unequivocal evidence of the Registrant lacks any and all intention of resuming use of the Sherlock trademark in the reasonably foreseeable future.

Petitioner's Second Ground for Cancellation: Fraudulent

Misrepresentation

12. A cancellation on the ground of fraudulent misrepresentation under Section 14(3) of the Lanham Act has been judicially expanded to include fraudulent filings under Section 8 of the Act for maintaining registrations. See *Torres v Cantine Torresella S.r.l.*, 808 F.2d 46, 48 (Fed. Cir. 1986) “fraud in obtaining renewal of a registration amounts to fraud in obtaining a registration within the meaning of [15 U.S.C §1064(3)].
13. Following registration of the trademark “Sherlock” the Registrant has submitted two Section 8 affidavits to the USPTO. See Exhibit A.
14. The affidavit submitted on March 22nd, 2010 is a screenshot of an early operating system, Mac OS 9.2.2 utilizing an early version of the Sherlock software application. See Exhibit A.
15. The Registrant ceased development of the Mac OS 9 in early 2002 and around or about that same time discontinued to make the OS available to the general public in commerce. See Exhibit E.
16. Moreover, the specimen itself dates the copyright from 1986 until 2001. See Exhibit A.
17. Accordingly, the Registrant falsely misrepresented themselves as using the Sherlock trademark in commerce at the time of the Section 8 affidavit filing in

March 22nd of 2010. See *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917 (TTAB 2006). [The Critical question is whether or not the marks were in use in connection with the identified goods at the time of the filing].

18. There is no question that the misrepresentation was material as the USPTO would not have granted the registration, but for the misrepresentation of Registrant. See *Nat'l Trailways Bus Sys. V. Trailway Van Lines, Inc.*, 269 F Supp. 352, 365 (E.D.N.Y 1965).
19. There is no question as to the intention of the Registrant to deceive and defraud the USPTO. The Registrant had full knowledge of their actions and knew that they had stopped using the trademark. Nevertheless, the Registrant submitted the specimen; fraudulently misrepresenting themselves as using the "Sherlock" trademark at the time of filing. See *Re Bose Corp.*, 580 F.3d 1240 (Fed. Cir. 2009) ["A trademark is obtained fraudulently under the Lanham Act only if the registrant knowingly makes a misrepresentation with the intent to deceive the USPTO]. See also: *Torres v Cantine Torressla S.r.l.*, 808 F2d 46, 49 (Fed. Cir. 1986) [Filing an affidavit when mark was not being used or has not been used for many years constituted Fraud]; and see also *Polo Fashions, Inc v Extra Special Prods., Inc.*, 208 U.S.P.Q. 421, 427 (S.D.N.Y. 1980).
20. Given the size of the Registrant as a corporation, it is inconceivable that the filing was a result of mere negligence or gross negligence. This is a clear-cut

instance of fraud/fraudulent misrepresentation and the Petitioner invites the Court to cancel the trademark.

21. In Summary:

- a. Apple Inc. abandoned the trademark with the removal of the Sherlock Application from Mac OS X Leopard and all subsequent OS and stopping the production and sale of Mac OS X tiger to the public for a period of well over 3 years.
- b. Apple Inc. had no intentions of resuming use of the trademark following its abandonment as the functionality of the Sherlock application was replaced by other applications in all of their subsequent OS.
- c. Apple Inc. fraudulently misrepresented themselves by the filing of a Section 8 affidavit on March 22nd 2010, along with the specimen, with the intention to deceive and defraud the USPTO.

WHEREFORE, Petitioner prays that Registration No. 2,336,753 be cancelled pursuant to 15.U.S.C 1064(3) for one of the grounds outlined above.

Dated: 1st day of April, 2016.

Respectfully submitted,

By: /s/Jonathan G. Morton
Jonathan G. Morton, Esq.
Attorney for Petitioner
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CERTIFICATE OF SERVICE

I hereby certify that on this the 4th day of April, 2016, a copy of the foregoing NOTICE OF CANCELLATION was served upon the correspondent of record for Registrant via international mail, postage prepaid, and addressed as follows:

Lisa Widup
Apple Inc.
1 Infinite Loop
MS:169-3IPL
Cupertino, California 95014 U.S.

By: /s/ Jonathan G. Morton/
Jonathan G. Morton, Esq.
Attorney for Petitioner

Exhibit A



Grab File Edit Capture Window Help

Trademark Electronic Search System (TESS)

http://tess2.uspto.gov/bin/gate.exe?f=doc&state=qa60n7.6.3

Trademark Databases Legal References AppleWeb News (182) Apple Currency Calculator OneLook® Dictionary AltaVista's Translation

PTO HOME TRADEMARK TESS HOME

Please logout

Start List At:

Channels Internet Pictures Stocks Movies Phone Book eBay Flights Dictionary Translation AppleCare

Original Text

Check Status (TARR)

Typed Drawing

Word Mark	SHERLOCK
Goods and Services	IC 009, US 0 ranked by rel
Mark	
Drawing Code	(1) TYPED D
Serial Number	75515549
Filing Date	July 8, 1998
Current Filing Basis	UNKNOWN
Original Filing Basis	1B
Published for Opposition	July 27, 1998

Sherlock - Translation

© Copyright 2001-2004 Apple Computer Inc., all rights reserved. Sherlock is a trademark of Apple

Translate French to English

Exhibit B

3/19/2016

Mac OS X 10.5: Sherlock is not supported

INTERNET ARCHIVE
Wayback Machine

4 captures
13 Jan 08 - 23 Oct 13

<http://docs.info.apple.com/article.html?artnum=306728> Go

DEC JAN MAR Close
◀ 13 ▶
2007 2008 2012 Help

Mac OS X 10.5: Sherlock is not supported

Last Modified on: November 30, 2007

Article: 306728

Features formerly provided by Sherlock can now be found in Dashboard.

Sherlock itself does not work with Mac OS X 10.5 Leopard.

Manually copying Sherlock from a version of Mac OS X prior to Leopard is not supported (and you should manually remove Sherlock).

Keywords: ktech kmosx5

Did this article help you?

It solved my issue...

Tell us what works for you.

It's good, but...

Report typos, inaccuracies, etc.

It wasn't helpful...

Tell us what would have helped.

Exhibit C

MUST READ [MICROSOFT STARTS ROLLING OUT WINDOWS 10 TO WINDOWS PHONE 8.1 USERS](#)

Believe it: Sherlock is really, really dead

For generations of Mac, Apple pushed its Sherlock application as the preferred interface for searching Web resources as well as local content. But with the release of Mac OS X Leopard, search is all about Spotlight, the integrated desktop search architecture, and Dashboard, the Mac's front end to Web services. No Sherlock allowed.



By [David Morgenstern](#) for [The Apple Core](#) | December 7, 2007 -- 17:57 GMT (01:57 GMT+08:00) | Topic: [Enterprise Software](#)

[\(/i/story/60/19/001089/sherlock175.jpg\)](#)For generations of Mac, Apple

pushed its Sherlock application as the preferred interface for searching Web resources as well as local content. But with the release of Mac OS X Leopard, search is all about Spotlight, the integrated desktop search architecture, and Dashboard, the Mac's front end to Web services. No Sherlock allowed. We could see the writing on the wall for Sherlock in the previous

Mac OS X 10.4 Tiger. Spotlight and Dashboard widgets had most if not all of Sherlock's functionality. But it still lived on the Dock for users who loved it. In Leopard, not only is Sherlock out the door, but don't even think about returning it to your Dock. In a support document released late last week, [Apple advised users to forget about Sherlock](#) (<http://docs.info.apple.com/article.html?artnum=306728>) and not to be overly adventurous in copying Sherlock from old disks.



Sherlock itself does not work with Mac OS X 10.5 Leopard. Manually copying Sherlock from a version of Mac OS X prior to Leopard is not supported (and you should manually remove Sherlock).

The history of Sherlock extends way back before Mac OS X. It arrived in the "classic" era, with Mac OS 8.5 in 1998. Sherlock provided some of the relevance technology offered by the company's AppleSearch server-based engine. I ran an AppleSearch server in my office for a couple of years at MacWEEK. Apple later added Internet searches within the Sherlock



MENU



AS

Exhibit D

INTERNET ARCHIVE
 Wayback Machine
 17 captures
 12 Oct 09 - 3 Mar 16

http://support.apple.com/downloads/Security_Update_2009_005_Tiger_P [Go]

SEP OCT JAN
 12
 2008 2009 2011

Close Help

Security Update 2009-005 (Tiger PPC)



About Security Update 2009-005 (Tiger PPC)

Security Update 2009-005 is recommended for all users and improves the security of Mac OS X. Previous security updates have been incorporated into this security update.

SHA 1 digest =77ca15c58ad4d8ddd84e570860e664d3425a2144

For explanation of what a SHA1 digest is, please visit this website:
 About SHA1 digest

For information on the security content of this update, please visit this website: Apple Security Updates.

Download

Version: 2009-005
 Post Date: September 10, 2009
 Download ID: DL931
 File Size: 77.95MB

System Requirements

- Mac OS X 10.4.11

Supported Languages

- Deutsch
- English
- Français
- 日本語
- Español
- Italiano
- Nederlands
- Dansk
- Norsk Bokmål
- Polski
- Português
- Português Brasileiro
- Русский
- Suomi
- Svensk
- 简体中文
- 繁體中文
- 한국어

Download



Last Modified: November 09, 2009

Article: HT3937

Summary

This document describes the security content of Security Update 2009-006 / Mac OS X v10.6.2, which can be downloaded and installed via Software Update preferences, or from Apple Downloads.

For the protection of our customers, Apple does not disclose, discuss, or confirm security issues until a full investigation has occurred and any necessary patches or releases are available. To learn more about Apple Product Security, see the Apple Product Security website.

For information about the Apple Product Security PGP Key, see "How to use the Apple Product Security PGP Key."

Where possible, CVE IDs are used to reference the vulnerabilities for further information.

To learn about other Security Updates, see "Apple Security Updates."

Products Affected

Product Security, Mac OS X Server 10.5, Mac OS X 10.5, Mac OS X 10.6, Mac OS X Server 10.6

Security Update 2009-006 / Mac OS X v10.6.2

■ AFP Client

CVE-ID: CVE-2009-2819

Available for: Mac OS X v10.5.8, Mac OS X Server v10.5.8

Impact: Accessing a malicious AFP server may lead to an unexpected system termination or arbitrary code execution with system privileges

Description: Multiple memory corruption issues exist in AFP Client. Connecting to a malicious AFP Server may cause an unexpected system termination or arbitrary code execution with system privileges. This update addresses the issues through improved bounds checking. These issues do not affect Mac OS X v10.6 systems. Credit: Apple.

■ Adaptive Firewall

CVE-ID: CVE-2009-2818

Available for: Mac OS X Server v10.5.8, Mac OS X Server v10.6 and v10.6.1

Impact: A brute force or dictionary attack to guess an SSH login password may not be detected by Adaptive Firewall

Description: Adaptive Firewall responds to suspicious activity, such as an unusual volume of access attempts, by creating a temporary rule to restrict access. In certain circumstances, Adaptive Firewall may not detect SSH login attempts using invalid user names. This update addresses the issue through improved detection of invalid SSH login attempts. This issue only affects Mac OS X Server systems. Credit: Apple.

■ Apache

CVE-ID: CVE-2009-0023, CVE-2009-1191, CVE-2009-1195, CVE-2009-1890, CVE-2009-1891, CVE-2009-1955, CVE-2009-1956

Available for: Mac OS X v10.5.8, Mac OS X Server v10.5.8, Mac OS X v10.6 and v10.6.1, Mac OS X Server v10.6 and v10.6.1

Impact: Multiple vulnerabilities in Apache 2.2.11

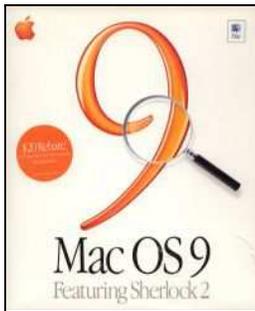
Description: Apache is updated to version 2.2.13 to address several vulnerabilities, the most serious of which may lead to privilege escalation. Further information is available via the Apache web site at <http://httpd.apache.org/>

Exhibit E



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Mac OS 9 Featuring Sherlock 2



Release Date: **10/23/1999**
Manufacturer: [Apple](#)

Mac OS 9 is the final major release of Apple's Classic Mac OS operating system. Introduced on October 23, 1999, Apple positioned it as "The Best Internet Operating System Ever," highlighting Sherlock 2's Internet search capabilities, integration with Apple's free online services known as iTools and improved Open Transport networking. While Mac OS 9 lacks protected memory and full pre-emptive multitasking, lasting improvements include the introduction of an automated Software Update engine and support for multiple users.

Apple discontinued development of Mac OS 9 in 2002, transitioning all future development to OS X. Since that time, no updates have been released. The final updates to Mac OS 9 addressed compatibility issues with OS X while running in the Classic Environment and compatibility with Carbon applications. At the 2002 World Wide Developers Conference, Steve Jobs began his keynote address by staging a mock funeral for OS 9. However, there are still users of Mac OS 9 today. Specifically retro-gamers, people using old software that was discontinued before the introduction of OS X or users of old hardware incompatible with OS X. (PowerPC Macs made before the introduction of the G3 processor.)

Apple billed Mac OS 9 as including "50 New Features" and heavily marketed its Sherlock 2 software, which introduced a 'channels' feature for searching different online resources and introduced a QuickTime-like metallic appearance. Mac OS 9 also featured integrated support for Apple's suite of Internet services known as iTools (later re-branded as .Mac, then MobileMe, which is now known as iCloud) and included improved TCP/IP functionality with Open Transport 2.5.



Speed 1 MHz



Macintosh



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