

<p><b>This Opinion is Not a Precedent of the TTAB</b></p>
---

Hearing: January 12, 2017

Mailed: February 23, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

*In re Apple Inc.*

---

Serial Nos. 85008432 and 85980567<sup>1</sup>

---

Glenn A. Gundersen of Dechert LLP,  
for Apple Inc.

Martha L. Fromm, Trademark Examining Attorney, Law Office 106,  
Mary I. Sparrow, Managing Attorney.

---

Before Cataldo, Taylor and Lykos,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Apple Inc. ("Applicant") seeks registration on the Principal Register of IBOOKSTORE (in standard characters), as a mark for the following services, as amended:

Retail store services featuring electronic publications, for use with proprietary software, provided via the Internet and other communications networks; retail store services featuring electronic publications for use with proprietary software on handheld mobile

---

<sup>1</sup> Because the issues on appeal and the examination records adduced by the Examining Attorney and Applicant are essentially identical, we have consolidated these appeals for purposes of our determination herein.

digital electronic devices and other consumer electronics in International Class 35;

Providing an Internet website portal featuring technology that allows Internet users to preview and download electronic publications, for use with proprietary software, on a wide range of topics of general interest in International Class 42<sup>2</sup> and

Providing online, non-downloadable electronic books, magazines, newspapers, journals, periodicals, plays, and newsletters on a wide range of topics of general interest in International Class 41;

Providing an online portal featuring temporary online use of online non-downloadable software to allow internet users to preview and download electronic publications in International Class 42.<sup>3</sup>

In both applications, Applicant sought to

- (1) amend the mark in the involved applications from IBOOKSTORE to IBOOKS STORE;
- (2) amend the applications to assert a claim of acquired distinctiveness under Trademark Act Section 2(f) in part as to IBOOKS based upon, *inter alia*, its ownership of prior registrations; and
- (3) disclaim STORE apart from the mark as shown.

---

<sup>2</sup> Application Serial No. 85008432 was filed on April 7, 2010, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act and a claim of priority under Section 44(d) of the Trademark Act based upon Trinidad and Tobago Application No. 41873. Applicant subsequently filed an amendment to allege use and amended its application to seek registration under Section 1(a) of the Trademark Act, claiming a date of first use in commerce since at least as early as September 30, 2013 as to the Class 35 services and since at least as early as June 10, 2013 as to the Class 42 services.

<sup>3</sup> Application Serial No. 85980567, child application of Application Serial No. 85008432, was filed on April 7, 2010, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act and a subsequently deleted claim of priority under Section 44(d) of the Trademark Act based upon Trinidad and Tobago Application No. 41873.

The Trademark Examining Attorney has refused registration of Applicant's proposed mark in both applications under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that IBOOKSTORE merely describes a feature or characteristic of the recited services. Further, in both applications the Examining Attorney rejected Applicant's claim of acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f), and rejected Applicant's amendment of its mark from IBOOKSTORE to IBOOKS STORE on the ground that the amendment is an impermissible material alteration of the mark.<sup>4</sup> The Examining Attorney also rejected Applicant's specimen of use in application Serial No. 85008432 under Trademark Act Sections 1 and 45 on the basis that the mark is displayed therein as IBOOKS STORE, and does not match the mark as it appears in the drawing.

After the Examining Attorney made the refusals final, Applicant appealed to this Board. Applicant and the Examining Attorney filed briefs and presented arguments on the issues under appeal in an oral hearing held before this panel on January 12, 2017. We reverse the refusals to register.

### I. Evidentiary Issue

Before proceeding to the merits of the refusal, we address an evidentiary matter.

Applicant attached copies of portions of its evidentiary record to its appeal briefs and reply briefs. As Applicant indicated, the evidence attached to Applicant's briefs

---

<sup>4</sup> We presume that Applicant and the Examining Attorney are familiar with the prosecution histories of the involved applications. We further note that the timelines of events in the prosecution histories of the applications are not in dispute. Accordingly, we see no reason to discuss them in detail herein.

comprises part of the record previously submitted during prosecution of the involved applications. Since it is already of record as part of the application files, its re-submission with Applicant's briefs was unnecessary. *See ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, 45 USPQ2d 2021, 2022-23 (TTAB 1998) (submission of duplicative papers is a waste of time and resources, and is and a burden upon the Board).

Parties to Board cases occasionally seem to be under the impression that attaching previously-filed evidence to a brief and citing to the attachments, rather than to the original submission is a courtesy or a convenience to the Board. It is neither. When considering a case for final disposition, the entire record is readily available to the panel. Because we must determine whether such attachments are properly of record, citation to the attachment requires examination of the attachment and then an attempt to locate the same evidence in the record developed during the prosecution of the application, requiring more time and effort than would have been necessary if citations were directly to the prosecution history.

## II. Applicable Law

### **Amendment of Applicant's Mark.**

We first turn to the Examining Attorney's refusal of registration on the ground that the amended drawing constitutes a material alteration of the original drawing.

The Examining Attorney argues that, based upon the evidence of record,

"BOOKSTORE" has an understood meaning, and an excerpt from the *Acronym Finder* website which demonstrate that the prefix "I" refers to services offered online or via the internet. Consumers encountering the

prefix “I” used with the word “BOOKSTORE” will readily perceive that the mark refers to an internet based bookstore.<sup>5</sup>

[C]onsumers will see the wording comprising the proposed amended mark as a reference to a store selling Applicant’s “IBOOKS”. “IBOOKSTORE”, on the other hand, references a place rather than a form of publication and, therefore, connotes something else.<sup>6</sup>

By representing the “IBOOK” portion of the proposed mark as “IBOOKS”, in its pluralized form, Applicant clearly delineates “IBOOKS” as a separate word. The mark in the proposed amendment, in its entirety, references a “STORE” selling “IBOOKS” which, given the common meaning of “I” and “BOOKS” would be readily perceived by the consuming public as internet based books, rather than an internet based bookstore. Accordingly, the mark in the proposed amendment has a different meaning than the original mark.<sup>7</sup>

Lastly, the Examining Attorney notes that the proposed mark amendment would impact public notice because applicants seeking registration of “IBOOKS STORE”, or even marks such as “IBOOK” or “IBOOKS”, for the same or highly related retail services or website services would not have been aware of the mark in the proposed amendment, “IBOOKS STORE”, for the identified services at the time of filing of their own applications. Furthermore, the proposed mark amendment would require an additional search of Office records for potentially conflicting earlier filed applications or registrations encompassing the wording “IBOOK” or “IBOOKS”. While not determinative, “the question of whether a new search would be required is a factor to be considered in deciding whether an amendment would materially alter a mark.” TMEP §807.14.<sup>8</sup>

Trademark Rule 2.72(a)(2) provides that an applicant may amend the drawing of the mark if “[t]he proposed amendment does not materially alter the mark.

The Office will determine whether a proposed amendment materially alters a

---

<sup>5</sup> 10 TTABVUE 7-8.

<sup>6</sup> *Id.* at 8.

<sup>7</sup> *Id.* at 9.

<sup>8</sup> *Id.* at 10.

mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.”

The general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition. If one mark is sufficiently different from another mark as to require republication, it would be tantamount to a new mark appropriate for a new application.

*In re Hacot-Colombier*, 105 F.3d 616, 620, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997) (quoting *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740, 743-44 (TTAB 1983)).

Applicant’s amended drawing is not a material alteration of the original drawing. The amended drawing, IBOOKS STORE, differs from the original IBOOKSTORE only to the extent that the term “IBOOKS” is pluralized and presented as a separate word from “STORE.” There is no additional and/or deleted wording, stylization or design element in the amended drawing that creates a different mark or evokes a different commercial impression. The crux of the Examining Attorney’s argument against allowing the amendment is that IBOOKSTORE connotes an Internet-based bookstore whereas IBOOKS STORE connotes a store selling Applicant’s Internet-based books. According to the Examining Attorney, IBOOKS STORE connotes a STORE selling Applicant’s IBOOKS whereas IBOOKSTORE connotes “a place rather than a form of publication,”<sup>9</sup> in other words, a BOOKSTORE selling books including IBOOKS. However, the Examining Attorney does not explain how this rather fine distinction

---

<sup>9</sup> *Id.* at 8.

creates a significant difference. In addition, the record indicates that Internet-based bookstores sell both hard copies of books and books in digital or electronic form.<sup>10</sup> Thus, to the extent that Internet-based books include digital or e-books, these are available from Internet-based bookstores along with hard copies of books. As a result, even if we accept the distinction drawn by the Examining Attorney between the original and amended drawing, we find that it does not create such a meaningful difference in the marks to arise to the level of a material alteration. Although the Examining Attorney points to subtle differences in the connotations evoked by the different drawings, the nature of the mark is not changed by the proposed amendment. The modified mark contains the essence of the original mark, and the new form of the mark creates the impression of being essentially the same mark as the mark in the original drawing.

Finally, the Examining Attorney fails to explain why potential applicants “would not have been aware of the mark in the proposed amendment”<sup>11</sup> for the same or related services to those recited in the involved applications. As discussed above, the mark IBOOKS STORE contains the essence of IBOOKSTORE in the original drawing. The terms IBOOK(S) and STORE comprise the mark in the original and amended drawing, and it is difficult to see how third party applicants viewing the mark would not be aware of the presence of the terms IBOOK(S) and STORE in either drawing. Similarly, the Examining Attorney fails to explain why allowing the

---

<sup>10</sup> See, e.g., April 6, 2012 Office action at 16-7.

<sup>11</sup> 10 TTABVue 10.

amendment of the drawing to IBOOKS STORE would require a new search for “potentially conflicting earlier filed applications or registrations encompassing the wording ‘IBOOK’ or ‘IBOOKS’”<sup>12</sup> inasmuch as the term “IBOOK(S)” is part of the mark in both the original and amended drawing.

Based upon the foregoing, we find that the amendment to the drawing is not a material alteration of the mark. In consequence thereof, Applicant’s amendment of its drawing is accepted, and IBOOKS STORE is the operative mark in both of the involved applications.

**Mere Descriptiveness and Acquired Distinctiveness.**

Applicant, having amended the involved applications to seek registration under Section 2(f) of the Trademark Act, has conceded that the mark IBOOKS STORE is merely descriptive under Section 2(e)(1) of the Trademark Act.<sup>13</sup> *See Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009). Thus, we need not consider the arguments and evidence presented by Applicant and the Examining Attorney on the issue of mere descriptiveness. Rather, we need only determine whether Applicant has

---

<sup>12</sup> *Id.*

<sup>13</sup> Applicant did not argue the merits of the Examining Attorney’s refusal to register under Section 2(e)(1) and, in the alternative, claim that the matter sought to be registered has acquired distinctiveness under Section 2(f). An alternative claim of acquired distinctiveness under Section 2(f) does not constitute a concession that the matter sought to be registered is not inherently distinctive. *See In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1713 (TTAB 2011); *In re E S Robbins Corp.*, 30 USPQ2d 1540, 1542 (TTAB 1992); *In re Prof'l Learning Ctrs., Inc.*, 230 USPQ 70, 71 n.2 (TTAB 1986). *See also* TMEP § 1212.02(c) (Jan. 2017) and authorities cited therein.



carried its burden of establishing by a preponderance of the evidence that the merely descriptive designation, IBOOKS STORE, has acquired distinctiveness as a mark indicating source under Section 2(f). *See Yamaha*, 6 USPQ2d at 1005; *In re Rogers*, 53 USPQ2d 1741, 1744 (TTAB 1999).

“To establish acquired distinctiveness, applicant must show that the primary significance of the [mark] in the minds of consumers is not the product but the producer.” *In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1284 (TTAB 2000). As discussed above, Applicant bears the burden of demonstrating that its mark has acquired distinctiveness. *See Yamaha*, 6 USPQ2d at 1006; *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) (“[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant”). “[L]ogically that standard becomes more difficult as the mark’s descriptiveness increases.” *Yamaha*, 6 USPQ2d at 1008.

Acquired distinctiveness may be shown by direct or circumstantial evidence. Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence is evidence from which consumer association might be inferred, such as years of use, extensive amounts of sales and advertising, and any similar evidence showing wide exposure of the mark to relevant consumers. We determine whether a mark has acquired distinctiveness on the basis of all competent evidence, including “advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, and consumer studies (linking the

name to a source).” *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005).

There is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness; the evidence required is in proportion to the degree of non-distinctiveness of the mark at issue. *Yamaha*, 6 USPQ2d 1001 at 1008. “The greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.” *In re Bongrain Int’l Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1728 n.4 (Fed. Cir. 1990) (citing *Yamaha*, 6 USPQ2d 1001 at 1008). Thus, even long periods of substantially exclusive use may not be sufficient to demonstrate acquired distinctiveness when the term in question is highly descriptive.

In support of her position that the applied-for mark is merely descriptive, the Examining Attorney made of record the following definitions of terms comprising the mark in relation to the recited services:

Bookstore – “a store that sells books.”<sup>14</sup>

I – “Internet.”<sup>15</sup>

The Examining Attorney further made of record copies of pages from third-party Internet websites in which the terms “iBookstore(s)” and “Internet bookstore(s)” are used in connection with bookstores that provide printed and electronic books over the Internet.<sup>16</sup> The Examining Attorney also made of record copies of third-party

---

<sup>14</sup> Encarta.com. Examining Attorney’s June 29, 2010 Office action at 9-10. *See also* Examining Attorney’s October 10, 2014 Office action at 6-17.

<sup>15</sup> Acronymfinder.com. *Id.* at 11-13.

<sup>16</sup> April 6, 2012 Office action at 7-20.

registrations for various “I” formative marks in standard characters for a variety of computer, media and retail goods and services, registered on the Supplemental Register.<sup>17</sup> These include, for example:

IVIDEOSONGS for “online retail store services featuring audio visual recordings” (Reg. No. 3584928);

ISHOP for “promoting the goods and services of others by providing a web site featuring coupons, rebates, price-comparison information, product reviews, links to the retail web sites of others, and discount information” (Reg. No. 3738342);

ILYRICS for “computer hardware and software programmable and downloadable for the display of song lyrics without music” (Reg. No. 4144376); and

IRADIO for “digital media streaming devices, Internet radios, mobile radios, radio receivers, radios, vehicle radios, wireless broadband radios” (Reg. No. 4296661).

Based upon the evidence of record, we find that IBOOKS STORE is merely descriptive, if not highly descriptive, of Applicant’s recited services and, as a result, Applicant needs a commensurate degree of evidence to show that its mark has acquired distinctiveness in connection therewith. *See Yamaha*, 6 USPQ2d at 1008 (“in general, the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.”)

Applicant asserts three separate grounds in support of its claim of acquired distinctiveness:

1. Apple is the owner of registrations of the mark IBOOKS (RN 4,810,756 and RN 2,446,634) and IBOOK (RN 2,470,147);

---

<sup>17</sup> June 27, 2015 Office action at 7-57.

2. The public recognized IBOOKSTORE and recognizes IBOOKS STORE as part of Apple's famous family of "i"-prefix marks;

3. Apple has made substantially exclusive and continuous use in commerce of the mark IBOOKS STORE and its predecessor IBOOKSTORE for five years.<sup>18</sup>

Turning first to Applicant's prior registrations, Trademark Rule 2.41(a) provides that ownership of a registration of "the same mark" on the Principal Register may be accepted as *prima facie* evidence of acquired distinctiveness. In relying on this rule, an applicant is essentially seeking to "tack" the use of the registered mark to its use of the present mark for purposes of transferring distinctiveness to the new mark. *See In re Flex-O-Glass, Inc.*, 194 USPQ 203, 205-6 (TTAB 1977). Thus, the analysis used to determine whether Applicant's present mark is "the same mark" as its previously registered marks, for purposes of the rule, is the analysis used in tacking cases, *i.e.*, whether the marks are legal equivalents. *See Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866, 1868 (Fed. Cir. 1991). *See also In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001).

To meet the legal equivalents test, the marks must be indistinguishable from one another or create the same, continuing commercial impression such that the consumer would consider both as the same mark. *See Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 17 USPQ2d at 1868; *In re Dial-A-Mattress Operating Corp.*, 57 USPQ2d at 1812. Aside from the legal equivalency of the marks in the registrations and the applications, Applicant is also required to establish, through submission of relevant

---

<sup>18</sup> 7 TTABVUE 9.

evidence rather than mere conjecture, a sufficient relationship between the goods in the prior registrations and the services identified in the applications to warrant the conclusion that the distinctiveness of the mark associated with the goods in the registrations will “transfer” to the goods listed in the application. *See In re Rogers*, 53 USPQ2d at 1745.

Applicant relies upon two prior registrations, both issued on the Principal Register without a showing of acquired distinctiveness under Section 2(f) in typed or standard characters:<sup>19</sup>

Reg. No. 2446634 for the mark IBOOKS for computer software used to support and create interactive, user-modifiable electronic books in International Class 9;<sup>20</sup> and

Reg. No. 2470147 for the mark IBOOK for computers, computer hardware, computer peripherals and users manuals sold therewith in International Class 9.<sup>21</sup>

Applicant further relies upon the following registration issued on the Principal Register with a claim of acquired distinctiveness under Section 2(f) in standard characters:

Reg. No. 4810756 for the mark IBOOKS for software for reading electronic publications on digital electronic devices; computer software for authoring, downloading, receiving, editing, displaying, storing and organizing text, graphics, images, and electronic publications in International Class 9.<sup>22</sup>

---

<sup>19</sup> Applicant’s March 21, 2013 communication at 15-20; Applicant’s December 28, 2015 communication at 8-11.

<sup>20</sup> Issued on April 24, 2001. Section 8 affidavit accepted; Section 15 affidavit acknowledged. First renewal.

<sup>21</sup> Issued on July 17, 2001. Section 8 affidavit accepted; Section 15 affidavit acknowledged. First renewal.

<sup>22</sup> Issued on September 15, 2015.

Essentially, it is Applicant's contention that because the mark IBOOKS in the claimed Registration Nos. 2446634 and 4810756 is the distinctive and dominant term in the instant IBOOKS STORE mark, it is the legal equivalent of the prior IBOOKS registrations and creates the same continuing commercial impression such that the consumer would consider them the same mark.

In this regard, we note that Applicant's prior Reg. No. 2446634 for the mark IBOOKS registered on the Principal Register without a showing of acquired distinctiveness, is over five years old and thus at present is no longer subject to attack by way of a cancellation proceeding based upon mere descriptiveness and instead can only be cancelled if shown to be generic. *See* 15 U.S.C. §1065. *See also In re American Sail Training Association*, 230 USPQ 879, 880 (TTAB 1986). We further note that Applicant's Reg. No. 4810756 for the mark IBOOKS registered on the Principal Register with a showing of acquired distinctiveness under Section 2(f). *Cf. In re Canron, Inc.*, 219 USPQ 820 (TTAB 1983) (claims of acquired distinctiveness may not be based upon ownership of registrations on the Supplemental Register.). We also note that Applicant disclaimed the exclusive right to use "STORE" apart from the mark as shown. Further, in view of the evidence made of record by the Examining Attorney, the word "STORE" appears, at best, to be highly descriptive of the recited services. As a result, we agree with Applicant that the word IBOOKS in the involved mark, IBOOKS STORE, is the dominant and distinguishing portion thereof.

Thus, the involved mark for which Applicant seeks to make a prima facie showing of acquired distinctiveness consists of the word IBOOKS, previously found in

Applicant's claimed registrations to be inherently distinctive or to have acquired distinctiveness, and the highly descriptive word STORE. In light of the foregoing, we find that on the record of this case the mark IBOOKS STORE creates the same, continuing commercial impression as the previously registered IBOOKS marks such that it is the legal equivalent thereof. Therefore, the marks are "the same" for purposes of Trademark Rule 2.41(a).

We now consider whether the goods in Applicant's claimed registrations are "sufficiently similar" to the services in its involved applications. *See* Trademark Rule 2.41(a)(1). As noted above, Applicant's claimed registrations identify the following goods:

computer software used to support and create interactive, user-modifiable electronic books; (Reg. No. 2446634);

software for reading electronic publications on digital electronic devices; computer software for authoring, downloading, receiving, editing, displaying, storing and organizing text, graphics, images, and electronic publications (Reg. No. 4810756).

The involved applications recite the following services:

Retail store services featuring electronic publications, for use with proprietary software, provided via the Internet and other communications networks; retail store services featuring electronic publications for use with proprietary software on handheld mobile digital electronic devices and other consumer electronics in International Class 35;

Providing an Internet website portal featuring technology that allows Internet users to preview and download electronic publications, for use with proprietary software, on a wide range of topics of general interest in International Class 42 (Serial No. 85008432); and

Providing online, non-downloadable electronic books, magazines, newspapers, journals, periodicals, plays, and newsletters on a wide range of topics of general interest in International Class 41;

Providing an online portal featuring temporary online use of online non-downloadable software to allow internet users to preview and download electronic publications in International Class 42 (Serial No. 85980567).

The goods in Applicant's Reg. No. 2446634, namely, software used to support and create electronic books, appears to be related to the services in the involved applications inasmuch as it may be used to purchase, access, preview, and download the electronic books and other publications that are the subject of the services. Similarly, the goods in Applicant's Reg. No. 4810756, namely, software for reading, downloading, displaying, and storing electronic publications appears to be closely related to the services in the involved applications inasmuch as it may be used to download, display, read and store the electronic publications provided by Applicant's services. Thus, while there are differences between the goods in Applicant's claimed registrations and its involved applications, the goods and services perform overlapping and otherwise related functions, and any differences between them are immaterial. *See In re Best Prods. Co.*, 231 USPQ 988, 989 n.6 (TTAB 1986) ("[W]e infer in the instant case that the differences between the marks BEST & Des. and BEST JEWELRY & Des., and between the identifications of services in their respective registrations ['mail order and catalog showroom services' and 'retail jewelry store services'], were deemed to be immaterial differences."); *In re Owens-Illinois Glass Co.*, 143 USPQ 431, 432 (TTAB 1964) ("Cut-glass and plastic articles of tableware are customarily sold in the same retail outlets, and purchasers of one kind



of tableware might well be prospective purchasers of the other.”); *In re Lytle Eng’g & Mfg. Co.*, 125 USPQ 308, 309 (TTAB 1960) (applicant’s ownership of prior registration of LYTLE for various services, including the planning, preparation, and production of technical publications, acceptable as *prima facie* evidence of distinctiveness of identical mark for brochures, catalogs, and bulletins).

Accordingly, we find that the inherent and acquired distinctiveness of the IBOOKS mark associated with the goods in Registration Nos. 2446634 and 4810756 will “transfer” to the related services listed in the involved applications.<sup>23</sup> See *In re Rogers*, 53 USPQ2d at 1745. We thus find that, based upon its ownership of prior Registration Nos. 2446634 and 4810756 for the mark IBOOKS, applicant has made a *prima facie* showing that its mark IBOOKS STORE has acquired distinctiveness as used in connection with the recited services sufficient to permit registration thereof under Section 2(f).

### **Specimen of Use.**

Finally, the Examining Attorney rejected Applicant’s specimen of use in Application Serial No. 85008432 under Trademark Act Sections 1 and 45 on the

---

<sup>23</sup> As a result, we need not and do not reach the question of whether the goods recited in Applicant’s Registration No. 2470147 for the mark IBOOK are sufficiently related to the services in the involved applications such that the distinctiveness of the IBOOK mark therein would transfer to such services.

Similarly, we need not and do not reach Applicant’s claim of acquired distinctiveness based upon its ownership of an asserted family of “I” formative marks, or the length and extent of its asserted use of the IBOOKS STORE mark in commerce. We observe, in any event, that Applicant did not submit a declaration under Trademark Rule 2.41(a)(2) that its IBOOKS STORE mark has become distinctive of Applicant’s services by reason of Applicant’s substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made.


ground that the specimen does not show the applied-for mark in the drawing. Specifically, “the specimen displays the mark as ‘IBOOKS STORE’; however, the drawing displays the mark as ‘IBOOKSTORE.’”

As discussed above, because Applicant’s amendment of the drawing of its mark from IBOOKSTORE to IBOOKS STORE is not a material alteration of the mark, the display of Applicant’s mark in its specimen of use as IBOOKS STORE agrees with the mark as it appears in the drawing. The Examining Attorney does not argue that the specimens fail to show use of the mark in connection with the services recited in application Serial No. 85008432, and we find that the specimen does in fact reference these services. Accordingly, we find that Applicant’s specimen, submitted with its second amendment to allege use, displays the mark as it appears in the drawing and references the services recited in the involved application.

Applicant’s specimen submitted with its second amendment to allege use is displayed below:<sup>24</sup>

---

<sup>24</sup> Applicant’s July 17, 2014 communication at 14.


[Store](#)
[Mac](#)
[iPod](#)
[iPhone](#)
[iPad](#)
[iTunes](#)
[Support](#)


# iTunes Preview

[What's New](#)
[What is iTunes](#)
[iTunes Charts](#)


## iBooks

By Apple

Open iTunes to buy and download apps.



[View In iTunes](#)

 This app is designed for both iPhone and iPad

**Free**  
 Category: Books  
 Updated: Nov 14, 2013  
 Version: 3.2  
 Size: 31.0 MB  
 Languages: English, Arabic, Catalan, Chinese, Croatian, Czech, Danish, Dutch, Finnish, French, German, Greek, Hebrew, Hungarian, Indonesian, Italian, Japanese, Korean, Malay, Norwegian, Polish, Portuguese, Romanian, Russian, Slovak, Spanish, Swedish, Thai, Turkish, Ukrainian, Vietnamese  
 Seller: Apple Inc.  
 © 2013 Apple Inc.  
 Rated 4+

**Compatibility:** Requires iOS 7.0 or later. Compatible with iPhone, iPad, and iPod touch. This app is optimized for iPhone 5.

**Customer Ratings**  
 We have not received enough ratings to display an average for the current version of this application.  
 All Versions:  
 ★★★★★ 88654 Ratings

**More by Apple**

### Description

iBooks is an amazing way to download and read books. iBooks includes the iBooks Store, where you can download the latest bestselling books or your favorite classics – day or night. Browse your library on a beautiful bookshelf, tap a book to open it, flip through pages with a swipe or a tap, and bookmark or add notes to your favorite passages.


[Apple Web Site](#)
[iBooks Support](#)
[Application License Agreement](#)
[...More](#)

### What's New in Version 3.2

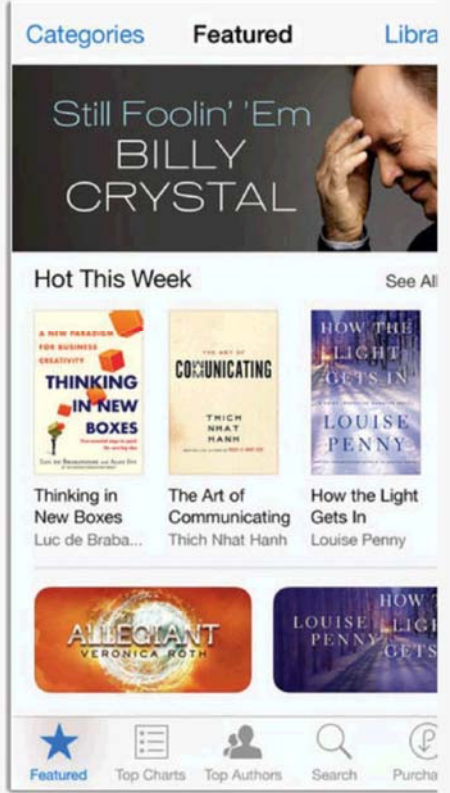
iBooks has been updated with a beautiful new design for iOS 7.

### Screenshots

[Store](#)
[Books](#)
[Edit](#)



[Categories](#)
[Featured](#)
[Libra](#)



**Summary.**

Based upon the evidence of record, including any evidence not specifically discussed herein, we find that: Applicant's amendment of its mark from IBOOKSTORE to IBOOKS STORE is not a material alteration of the mark under Trademark Rule 2.72(a)(2) and that, as a result, Applicant's operative mark in both applications is IBOOKS STORE; Applicant's amendment to seek registration on the Principal Register with a claim of acquired distinctiveness under Trademark Act Section 2(f) is a concession that the IBOOKS STORE mark is not inherently distinctive under Trademark Act Section 2(e)(1); Applicant has made a *prima facie* showing of acquired distinctiveness under Trademark Act Section 2(f) based upon its ownership of Registration Nos. 2446634 and 4810756 for the mark IBOOKS; and Applicant's specimen of use in application Serial No. 85008432 displays the applied-for mark and references the recited services under Trademark Act Sections 1 and 45 and therefore, is acceptable.

**Decision:** The refusals to register Applicant's mark IBOOKS STORE are reversed as to both applications.