Mailed: April 27, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Apple Inc.

Remand

Serial No. 77844736

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

Howard Smiga, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.

Before Bergsman, Adlin and Goodman,
Administrative Trademark Judges.

By the Board:

The Trademark Examining Attorney has refused registration of Applicant's mark on the following grounds:

1. The applied for mark, as used on the specimen of record, merely identifies a process in the nature of an industry standard and therefore, does not function as a trademark to indicate the source of the applicant's goods and to identify

and distinguish said goods from others. Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051-1052, 1127;

2. The specimen does not show the applied mark in use in commerce in connection with any of the goods specified in the Statement of Use. Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1127; 37 C.F.R. §§ 2.34(a)(1)(iv), 2.56(a); and
3. The goods to which the proposed mark is applied are not "goods in trade" pursuant to Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051-1052, 1127.

When the refusal to register was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal resumed. Applicant and the Examining Attorney filed briefs, and both appeared at an oral hearing on April 20, 2016.

Upon further consideration, we find *sua sponte* that a remand is in order. Trademark Rule 2.142(f)(1) provides that if, during an appeal from a refusal of registration, it appears to the Board that an issue not previously raised may render the involved mark unregistrable, the Board may suspend the appeal and remand the application to the Examining Attorney for further examination to be completed within thirty days.

Our review of the application file shows that Applicant may be using the subject matter sought to be registered as both a trademark and a certification mark. In this regard, we note that Neil Trevett, "the President of the Khronos Group, a not-for-

profit industry consortium that manages open standards for the authoring and acceleration of parallel computing, graphic, and dynamic media on a wide variety of computing platforms and devices,"[1] testified that his organization manages the **OpenCL** standard "for writing programs that execute across heterogeneous devices consisting of CPU's, GPU's, and other processors."[2]

> OPENCL refers to the standard originally developed by [Applicant], which [Applicant] has contributed to the Khronos Group, together with a trademark license for OPENCL from [Applicant] to Khronos so that Khronos Group can manage the ongoing development of the technical specifications and administer a conformance program for the standard. …[3]
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> * * *
>
> … Developers who see the mark OPENCL in connection with a member's implementation of the standard know that the implementation meets the specifications promulgated by Khronos Groups and have passed the criteria defined in Khronos' conformance program. …[4]
>
> * * *
>
> … Developers associate the name of an open standard with the organization managing and evolving the standard, and developers use the mark as an indication of conformance to the criteria defined by that organization. The names of the standards that Khronos Group manages are trademarks, and our members that implement the standards are using the marks under license.[5]

The Khronos Trademark Guidelines attached to the Trevett Declaration includes the information below:

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[1] Trevett Decl. ¶1 (March 10, 2015 Response).
[2] Trevett Decl. ¶4 (March 10, 2015 Response).
[3] Trevett Decl. ¶5 (March 10, 2015 Response).
[4] Trevett Decl. ¶6 (March 10, 2015 Response).
[5] Trevett Decl. ¶7 (March 10, 2015 Response).

> 1. Background
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> Any party who wishes to market and distribute an implementation that is identified by use of a Khronos Mark (in text or logo form) must execute the Khronos Adopters Agreement … and successfully pass the implementation through the conformance testing procedure as defined in the Khronos Conformance Process Document …
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> * * *
>
> 3.4 Conformant Products
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> An Adopter that has an implementation of a published specification that has been submitted to and passed the Khronos Conformance Process may use the relevant Khronos Mark in text, logo and certification mark form in association with the implementation, and Adopters may state that their products are conformant or compliant with the appropriate specifications with statement similar to:
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> *"Product is conformant with [Khronos Specification]"*
>
> *"Product is compliant with [Khronos Specification]"*
>
> *"Product complies with [Khronos Specification]"*
>
> *"Product is a full implementation with [Khronos Specification]"*
>
> or use other terms as appropriate that communicates that the implementation is officially compliant.

A certification mark "is a special creature created for a purpose uniquely different from that of an ordinary service mark or trademark . . . ." *In re Fla. Citrus Comm'n*, 160 USPQ 495, 499 (TTAB 1968). That is the purpose of a certification mark is to inform purchasers that the goods or services of a person possess certain characteristics or meet certain qualifications or standards established by another person. A certification mark does not indicate origin in a single commercial or

proprietary source the way a trademark or service mark does. Rather, the same certification mark is used on the goods or services of many different producers.

According to TMEP § 1306.01(b) (October 2015),

> The message conveyed by a certification mark is that the goods or services have been examined, tested, inspected, or in some way checked by a person who is not their producer, using methods determined by the certifier/owner. The placing of the mark on goods, or its use in connection with services, thus constitutes a certification by someone other than the producer that the prescribed characteristics or qualifications of the certifier for those goods or services have been met.

A certification mark is defined in Section 45 of the Trademark Act, 15 U.S.C. § 1127, as "a mark used upon or in connection with the products or services of one or more persons *other than the owner of the mark* to certify regional or other origin, material, mode of manufacture, quality, accuracy or other characteristics of such goods or services or that the work or labor on the goods or services was performed by members of a union or other organization." (Emphasis added). Thus, "the owner of a certification mark cannot use the identical mark as a service mark or trademark on or in connection with any goods or services that it markets or performs." *In re Monsanto*, 201 USPQ 864, 869 (TTAB 1978) (quoting *In re Florida Citrus Commission*, 160 USPQ 495, 498 (TTAB 1968).

In view thereof, a remand is appropriate to allow the Examining Attorney to consider whether **OpenCL** and design is a trademark identifying Applicant's

application programming interface or a certification mark informing the relevant public that the software meets the standards set by the Khronos Group.[6]

Accordingly, the application is remanded to the Examining Attorney for appropriate action consistent with this order.

The further examination should be completed within thirty days. Trademark Rule 2.142(f)(1). The attention of Applicant and the Examining Attorney is directed to TBMP § 1209.01 (June 2015), and the remainder of Trademark Rule 2.142(f):

> (2) If the further examination does not result in an additional ground for refusal of registration, the examiner shall promptly return the application to the Board, for resumption of the appeal, with a written statement that further examination did not result in an additional ground for refusal of registration.
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> (3) If the further examination does result in an additional ground for refusal of registration, the examiner and appellant shall proceed as provided by §§ 2.61, 2.62, 2.63 and 2.64. If the ground for refusal is made final, the examiner shall return the application to the Board, which shall thereupon issue an order allowing the appellant sixty days from the date of the order to file a supplemental brief limited to the additional ground for the refusal of registration. If the supplemental brief is not filed by the appellant within the time allowed, the appeal may be dismissed.
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> (4) If the supplemental brief of the appellant is filed, the examiner shall, within sixty days after the supplemental brief of the appellant is sent to the examiner, file with the Board a written brief answering the supplemental brief of appellant and shall mail a copy of the brief to the appellant. The appellant may file a reply brief within twenty days from the date of mailing of the brief of the examiner.
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> (5) If an oral hearing on the appeal had been requested prior to the remand of the application but not yet held, an oral hearing will be set and heard as provided in paragraph (e) of this section.

[6] Trademark Rule 2.142(f)(1) provides that the Board will not remand an application for consideration of a ground for refusal if the Examining Attorney had previously refused registration on that ground and then withdrew it. A review of the file shows that the Examining Attorney did not raise this issue during the prosecution of the application but referenced it in his appeal brief.

> If an oral hearing had been held prior to the remand or had not been previously requested by the appellant, an oral hearing may be requested by the appellant by a separate notice filed not later than ten days after the due date for a reply brief on the additional ground for refusal of registration. If the appellant files a request for an oral hearing, one will be set and heard as provided in paragraph (e) of this section.

On remand the Examining Attorney may not make a requirement or refuse registration on a new ground not specified in this order. Nor may the Examining Attorney or Applicant submit any additional evidence relating to the grounds of refusal noted at the beginning of this order.

In view of the above, the appeal is suspended.