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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Apple Inc.

Serial No. 77860835

Marie C. Seibel of Kilpatrick Townsend & Stockton LLP for applicant.

Ty Murray, Trademark Examining Attorney, Law Office 114 (Margaret Le, Managing Attorney).

Before Bucher, Taylor, and Shaw,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Apple Inc. has filed an application to register the mark ITUNES LP, in standard characters, on the Principal Register for the following goods and services:

Computer software for use in authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, playing, storing and organizing text, data, images, audio files, video files and electronic games; computer software for accessing, browsing and searching online databases; computer software to enable users to program and distribute audio, video, text and other multimedia content via communications networks; downloadable electronic publications in the nature of books or magazines in the field of entertainment, in International Class 9;

Retail store services in the field of entertainment, namely, audio, audiovisual, music, multimedia and video content and related merchandise, provided via the internet and other computer and electronic communication networks, in International Class 35;

Provision of telecommunications connections to computer databases and the Internet; transmission of data and of information via electronic communications networks; broadcasting and transmission of radio and television programs; audio broadcasting of spoken word, music, concerts, and radio programs; broadcasting pre-recorded audio and video content via computer and other communications networks; web casting services; electronic transmission of streamed and downloadable audio and video content via computer and other communications networks; providing on-line chat rooms, bulletin boards and community forums for the transmission of messages among computer users in the field of entertainment; provision of connectivity services and access to electronic communications networks, for transmission or reception of audio, video, movies and/or multimedia content, in International Class 38;

Entertainment services, namely, providing prerecorded audio and audiovisual content, information and commentary in the field of music on-line via a global computer network; providing a web site and database featuring music, videos, television programs, motion pictures, current event and entertainment news, sports, games, cultural events, and entertainment-related programs; providing online publications and non-downloadable electronic publications in the nature of books and magazines in the field of music, in International Class 41; and

Design and development of computer hardware and software; providing on-line facilities, via a global computer network, to enable users to program audio, video, movies, text and other multimedia content; providing a website featuring non-downloadable software tools for editing of digital content and entertainment content; providing search engines for obtaining data via communications networks; internet services, namely, creating indexes of information, sites and other resources available on global computer networks for others; searching, browsing and retrieving information, sites, and other resources available on global computer networks and other communication networks for others, in International Class 42.¹

¹ Application Serial No. 77860835, filed October 29, 2009, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a *bona fide* intent to use the mark in commerce.

The Examining Attorney refused registration pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a), based on applicant's failure to comply with the requirement to disclaim the word LP, on the ground that it is merely descriptive of applicant's goods and services within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). When the refusal was made final, applicant appealed and filed a request for reconsideration which was denied by the Examining Attorney. Applicant and the Examining Attorney both filed briefs.

We affirm the refusal of registration in the absence of a disclaimer in the application.

An Examining Attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a). Merely descriptive terms are unregistrable, under Trademark Act Section 2(e)(1) and, therefore, are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (CCPA 1975); *In re Ginc UK Ltd.*, 90 USPQ2d 1472 (TTAB 2007); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977); and *In re Pendleton Tool Industries, Inc.*, 157 USPQ 114 (TTAB 1968).

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith

conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Several definitions have been introduced into the record by both parties to show that LP is defined, *inter alia*, as a "microgroove phonograph record designed to be played at 33 $\frac{1}{3}$ revolutions per minute." www.merriam-webster.com. Both the Examining Attorney and applicant agree that the term LP is an abbreviation for "long playing" vinyl records, the once-dominant analog record format which has been almost entirely replaced by audio compact discs and digital music files, and that applicant is not in the business of producing vinyl records. What is disputed is whether the term LP has any additional significance to consumers, especially when it is used in connection with applicant's digital music related goods and services.

The Examining Attorney argues that a disclaimer is necessary because the term LP is descriptive when used in connection with

applicant's goods and services which will provide the format of an LP record on a digital platform. That is, LPs were, and still are, commonly packaged with original artwork, photography, and lyrics and applicant's goods and services seek to duplicate this bundling of additional material in applicant's digital music products. Accordingly, consumers would immediately understand that applicant's ITUNES LP digital content contains the same additional elements traditionally sold with LP records, i.e., lyrics, photos, and artwork.

Applicant argues that its use of LP in ITUNES LP is, at the very least, suggestive of the experience associated with a vinyl LP record which merely "calls to mind the heyday of LP records, during which liner notes, lyrics and cover art accompanied the music on an LP." Br. at 4. Applicant argues that LP describes a very specific analog medium for audio recordings and since applicant provides only digital audio and video content, "it is simply impossible for the unambiguous term 'LP' to be merely descriptive" of the digital content." Br. at 3.

In support of the requirement for a disclaimer, the Examining Attorney made of record excerpts from dictionaries, third-party websites, and applicant's iTunes website to demonstrate public understanding of the meaning of the term LP. The following examples are illustrative:

- <http://encyclopedia.thefreedictionary.com/Long+Playing> - (An article discussing the evolution of the gramophone record album including a discussion of the features of the "long playing" or "LP" record format)

"Starting in the 1930s, record companies began issuing collections of 78 rpm records by one performer or of one type of music in specially assembled albums. By the 1940's these albums featured their own colorful paper covers and were in both 10-inch and 12-inch sizes, and could include either a collection of related popular songs, either by performer or style, or extended length classical music, including complete symphonies. **The result is that when the LP came along and included multiple songs, the name "album" came along too.**"

"LPs are universally packaged in cardboard covers with a paper (**usually additional artwork, photography, and/or lyrics**) or plastic liner . . . protecting the delicate surface of the record. . . . **With the advent of long-playing records, the album cover became more than just packaging and protection, [sic] and album cover art became an important part of the music marketing and consuming experience.**" (Emphasis added) (Office Action of January 27, 2010);

- <http://encyclopedia.thefreedictionary.com/lp> - (Providing a thesaurus listing showing that "LP" is a synonym for "album" and "record")

"LP noun album, record his first LP since 1986."
(Emphasis added) (Office Action of March 7, 2011);

- <http://lpcoverlover.com> - (An excerpt from a web page devoted to LP cover artwork)

"LP COVER LOVER The World's Greatest LP Album Covers . . . **Welcome to the weird and wonderful world of record covers from the golden age of LP's.**" (Emphasis added) (Office Action of March 7, 2011);

- www.brookstone.com - (An excerpt from a retail store website featuring frames for displaying LP album covers as art)

"LP Album Cover Frames . . . Showcase your collection of classics with these record album frames. **LP covers captured the joy, imagination, and angst of entire generations.**" (Emphasis added) (Office Action of March 7, 2011);

- <http://www.apple.com/itunes/whats-new/#itunes-lp> - (An excerpt from applicant's website)

"What's new in iTunes? . . . The best thing to happen to fandom. **The visual experience of the record album returns with iTunes LP. Download select albums and experience a beautifully designed, interactive world right in your iTunes library on a Mac or PC.**" (Emphasis added) (Office Action of January 27, 2010);

- <http://www.apple.com/ituneslp-and-extras> - (An excerpt from applicant's website)

"**iTunes LP lets listeners hear an album and view lyrics, liner notes, band photos, performance videos, and more.**" (Emphasis added) (Office Action of January 27, 2010);

- <http://gigaom.com> - (A review of iTunes LP)

"When it was first unveiled, Apple's new iTunes LP format . . . promised to give consumers a new reason to buy albums instead of individual songs. **Offering expanded cover art, lyrics, videos, animation and other digital goodies, iTunes LP was intended to evoke the feeling of spinning an LP record and holding the jacket in your hands. . . . [C]onsumers were promised a digital experience that mimicked a physical one.**" (Emphasis added) (Office Action of January 27, 2010);

- www.engadget.com - (A review of iTunes LP)

"Apple iTunes LP format gets dissected, explained . . . **Did you hear the news? Apple resurrected the LP! . . .** OK, so maybe we are a little jaded -- our busy 21st century lives generally don't afford us the time to stare glassy-eyed at our computer screen (any more than we have the time to stare glassy-eyed at 12-inch album covers while sitting on the floor of our incense-soaked Haight-Ashbury crash pads)." (Emphasis added) (Office Action of January 27, 2010); and

- <http://news.cnet.com> - (A review of iTunes LP)

"New iTunes LP format is live . . . Apple has revealed its new LP format for iTunes. It's called iTunes LP. . . . **The new format includes more album art, lyrics, writing about the record, video (such as interviews with**

band members), and perhaps additional songs." (Emphasis added) (Office Action of January 27, 2010).

We agree with the Examining Attorney that this evidence shows that the term LP is understood to mean more than just the physical format of a "microgroove phonograph record designed to be played at 33 $\frac{1}{3}$ revolutions per minute." Rather, the evidence shows that the term LP has a broader meaning to consumers and is understood to encompass the additional features typically associated with a long playing record album such as cover art, song lyrics, liner notes, and band photographs. Moreover, the thesaurus listing shows that LP is synonymous with the term "album" and thus it conveys the same musical and cultural associations. The evidence regarding the history of the LP shows that the additional materials such as cover art, song lyrics, liner notes, and band photographs formed an "important part of the [LP] music marketing and consuming experience" surrounding the sale and enjoyment of record albums by music fans. Indeed, at least for older listeners who grew up listening to LP records, the Brookstone website may not be exaggerating when it proclaims that "LP covers captured the joy, imagination, and angst of entire generations."

The evidence also shows that applicant's iTunes LP service allows consumers to purchase, not only entire albums, but also additional content such as artwork, lyrics, photos, and even videos. That is, applicant is providing to its consumers, albeit

in digital form, the same visual materials that made the LP record album a "consuming experience." Applicant's own website confirms this intent to duplicate or re-create the LP album's additional materials when it proclaims: "[t]he visual experience of the record album returns with iTunes LP."

<http://www.apple.com/itunes/whats-new/#itunes-lp>. Even consumers of applicant's iTunes LP service recognize that the term LP refers to the additional materials traditionally associated with the LP record album. Third party reviews of applicant's iTunes LP service tout the connection: "iTunes LP was intended to evoke the feeling of spinning an LP record and holding the jacket in your hands"; and "Did you hear the news? Apple resurrected the LP!"

Given the demonstrated understanding of the meaning of the term LP by applicant's own consumers as more than just an outdated analog format, we agree with the Examining Attorney that when ITUNES LP is used in connection with applicant's identified goods and services, LP will convey an immediate idea of a feature of the goods or services, namely that applicant's digital music files will include precisely the kinds of additional materials commonly associated with LP record albums. *In re Abcor*, 200 USPQ at 217. We do not find, as applicant urges, that the evidence shows that LP records are so obsolete and long-forgotten that consumers would not recognize the term LP and its associations. On the contrary, applicant's musically-minded consumers seem well

aware of the significance of term LP and are quick to transfer these associations to applicant's digital content, just as the term album has migrated from 78 rpm records to LPs, to compact discs, and now to digital music.

Applicant also argues against the disclaimer requirement by citing to the registration of other music-related marks incorporating the term LP. We find the argument unpersuasive. First, only one of these marks is used in connection with musical sounds recordings and it is highly stylized. The other listed marks are for goods and services that do not encompass musical sound recordings likely to include visual materials such as those found in LP record albums. Second, it is well-settled that third-party registrations are not conclusive on the question of descriptiveness. Each case must stand on its own merits and a mark that is merely descriptive should not be registered on the Principal Register simply because other such marks appear on the register. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); *In re theDot Communications Network LLC*, 101 USPQ2d 1062 (TTAB 2011).

Finally, we are not persuaded by the argument that the mark is registrable because applicant is the only one using the term LP in connection with digital audio goods and services. It is not necessary that a term be in common usage in the particular field in order for it to be merely descriptive. See *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018, 1020

(TTAB 1983). Even if applicant were the only user of the term LP in connection with digital audio goods and services, it would not be dispositive where, as here, the term unquestionably conveys a merely descriptive connotation.

Decision: The refusal to register based on the requirement for a disclaimer of LP is affirmed. However, if applicant submits the required disclaimer of LP to the Board within thirty days, this decision will be set aside as to the affirmance of the disclaimer requirement.² See Trademark Rule 2.142(g), 37 C.F.R. § 2.142.

² The standardized printing format for the required disclaimer text is as follows: "No claim is made to the exclusive right to use LP apart from the mark as shown." TMEP § 1213.08 (a) (8th ed. 2011).