

ESTTA Tracking number: **ESTTA395569**

Filing date: **02/28/2011**

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

Proceeding	91195582
Party	Defendant Apple Inc.
Correspondence Address	JOSEPH PETERSEN KILPATRICK TOWNSEND & STOCKTON LLP 31 WEST 52ND STREET, 14TH FLOOR NEW YORK, NY 10019 UNITED STATES JPetersen@kilpatricktownsend.com, AlJones@kilpatricktownsend.com, AScott@kilpatricktownsend.com, agarcia@ktslaw.com, NYTrademarks@ktslaw.com
Submission	Other Motions/Papers
Filer's Name	Joseph Petersen
Filer's e-mail	jpetersen@ktslaw.com, aljones@ktslaw.com, aroach@ktslaw.com, sumoore@ktslaw.com, tmadmin@ktslaw.com
Signature	/Joseph Petersen/
Date	02/28/2011
Attachments	Leonard Declaration.pdf ( 17 pages )(217862 bytes )

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

In the Matter of Application Serial No. 77/525,433  
For the mark: APP STORE  
Filed: July 17, 2008  
Published: January 5, 2010

-----X	:	
MICROSOFT CORPORATION,	:	
	:	Opposition No. 91195582
Opposer,	:	
	:	
	:	
v.	:	
	:	
APPLE INC.,	:	
	:	
Applicant.	:	
-----X	:	

**DECLARATION OF DR. ROBERT A. LEONARD IN OPPOSITION TO OPPOSER  
MICROSOFT CORP.’S MOTION FOR SUMMARY JUDGMENT**

I, Robert A. Leonard, pursuant to 28 U.S.C. § 1746, hereby declare as follows:

**A. Background**

1. I am Professor of Linguistics, Chair of Department, and Director of the Forensic Linguistics Project and of the Graduate Program in Forensic Linguistics at Hofstra University in Hempstead, New York 11549.

2. I received my Ph.D. from Columbia University in 1982 with research specialties in Semantic Theory, or theory of meaning, and Sociolinguistics. I received my B.A. from Columbia College in 1970, where I was elected to Phi Beta Kappa and graduated with honors, and my M.A., M.Phil., and Ph.D. from Columbia Graduate School, where I was a Faculty Fellow. I was awarded a Fulbright Fellowship to conduct the research for my dissertation.

3. At Columbia, I additionally did course work in Lexicography (“dictionary-making”) with one of the foremost American lexicographers, Allen Walker Read. Professor

Read advised me on meaning-related research projects for years after.

4. I have been qualified as an Expert in Linguistics in State Courts in Arizona, Colorado, Florida, Indiana, Michigan, Montana, New York, Nevada and Pennsylvania, and in Federal District Court in Newark, New Jersey. I have been admitted to the Expert Panel of the 18B Assigned Counsel Plan of the City of New York.

5. I serve as a member of the Editorial Board of the Oxford University Press series *Language and the Law*. I am also a reviewer of the Professional Staff Congress of the City University of New York Research Award Program. In this capacity, I review applications for research grants made to the City University of New York.

6. My *Curriculum Vitae* and list of cases in which I have provided expert testimony in the past four years are attached hereto at Exhibits 1 and 2, respectively.

#### **B. Issue and Compensation**

7. I have been asked by Kilpatrick Townsend & Stockton LLP to render an opinion as to whether the primary significance of the term APP STORE to a majority of the relevant public is as a brand or a generic term. I was also provided with a copy of the Declaration of Nathaniel E. Durrance, dated January 10, 2011, submitted by Microsoft in this proceeding, and was asked to render an opinion as to whether Mr. Durrance's declaration and the accompanying exhibits adequately show that the significance of the term APP STORE to a majority of the relevant public is as a generic term.

8. My compensation for my service in this matter is at the rate of \$350 per hour. I have no financial interest whatsoever in the outcome of this case.

#### **C. Methodology and General Principles of Linguistics**

9. Linguistics is the scientific study of language. Linguists—like all scientists—seek to identify discernible patterns in the empirical evidence that we study. Bullets do not

randomly issue from firearms; chemical concentrations do not randomly spread throughout a human body. Similarly, words are not randomly found to issue from the keyboards and mouths of speakers of English or any other languages. Language adheres to patterns; these patterns are the subject of systematic observation of scientific linguists.

10. Linguists systematically observe patterns of data, patterns of linguistic behavior and—like all scientists—build theories that explain and predict those patterns through the construction and testing of hypotheses. The principles that emerge from linguistic analysis are published in professional journals that are vetted prior to publication and are subject to peer review which comments upon and tests the hypotheses contained therein. The linguistic principles that I have applied in my analysis in this matter all spring from this scientific, peer-reviewed process.

11. In conducting my linguistic analysis of the term APP STORE, I consulted a broad cross-section of material including the LexisNexis database, The Corpus of Contemporary American English (“COCA”), internet search results and dictionaries.

12. The LexisNexis databank offers the ability to conduct linguistic research utilizing a vast catalog of content from thousands of global news sources, company and industry intelligence providers, biographical and reference sources and a host of other material. It presents a representative source of highly reliable information from which a linguist can make analysis and observations regarding the use of language.

13. COCA is an online collection of over 410 million words of popular texts from such publications as *The New York Times*, *Popular Mechanics*, *Newsweek*, *The Chicago Tribune*, and *PCWorld* published during the years 1990-2010. COCA is a “balanced” corpus, meaning that it includes an equal number of texts and words from a wide variety of popular publications

each year. It is accepted among experts in the field of linguistics as representative of current language use.

14. The Google search engine can add to linguistic analyses. It can serve as an aggregating tool and presents linguists with an additional corpus against which analysis may be run.

15. In my research in connection with this matter, my focus was on analyzing uses of the term APP STORE in order to determine whether the predominate usage of the term is as a proper noun referring to Apple's online application marketplace or as a generic term for *any* online application marketplace.

16. In making this determination, I paid close attention to the capitalization (or lack thereof) of that term in common usage. This is because, in standard English, names considered to represent specific entities (e.g., New York, Randy Johnson, the Container Store) are denoted by the use of initial capital letters, as opposed to common names (e.g., city, baseball pitcher, business), which are not denoted by the use of initial capital letters. Writers use initial capital letters with names they associate with a particular entity, demonstrating that the name directly refers to or is proprietary to that entity. (See *The Cambridge Grammar of the English Language*, Rodney Huddleston and Geoffrey K. Pullum, Cambridge University Press, 2002, pages 1757-1759).

17. In addition, the definite article "the" presupposes a specific or previously defined reference (e.g., "the dog is on my chair," indicating one particular dog). In contrast, indefinite articles such as "a" or "an" do not indicate a specific or previously defined referent. Indefinite articles refer to something belonging to a group or a class (e.g., "a dog is a friendly animal," indicating that dogs, as a class of animals, are friendly). (See *The Cambridge Grammar of the*

*English Language*, Rodney Huddleston and Geoffrey K. Pullum, Cambridge University Press, 2002, pages 369-371).

18. In conducting my assessment, I was also sensitive to the use of metaphor in language. An understanding of metaphor is essential to understanding linguistic cognition. (See George Lakoff and Mark Johnson, *Metaphors We Live By*, Univ. of Chicago Press 1980).

19. A metaphor is a figure of speech based on a comparison which is implied rather than directly expressed. For example, the phrase “He was a lion in the battle” is a metaphor, where the comparison is implied, while “He fought like a lion,” where the comparison is directly expressed, is called a simile. Language change is often metaphorical, moving from the directly expressed to the implied comparison. Abstract terms often grow out of physical objects. For example, the phrase “right on target” presumably referred to hitting a physical target but became metaphorical and now is widely used to refer generally to a point that is well made. Metaphor is a constant process, dynamic, readily available and ever-changing and just because a term is generic in one context does not mean that through metaphor that same term is generic in another.

20. In evaluating how consumers use the term APP STORE it is essential, from a linguistics standpoint, to evaluate uses of the term as a whole. Brands are the product of their totality and must be seen as such. Human beings process information in integral meaningful units. (Ferdinand de Saussure, *Cours de Linguistique Generale* (1916)). For example, when a person hears the term “New York,” ordinarily he or she immediately comprehends that the term refers to a specific place in the United States; the listener would not ordinarily comprehend that term by thinking of the word “new” and the word “York” separately.

21. The brand “The Container Store” illustrates this point. There can be no question that the term “container” is generic for a type of product that “contains or can contain something,

as a carton, box, crate, can, etc.” (*The Random House College Dictionary*, 1988: 289). Similarly, there can be no question that the term “store” is generic for a physical place or location where goods and services can be obtained by immediately present consumers.

22. It would be incorrect linguistically to assume that the term “The Container Store” is generic for any physical place or location offering for sale and selling container type products. This is because the critical question from a linguistics standpoint is the empirical question of how consumers use the term The Container Store *as a whole*. While I have not conducted an exhaustive examination of how consumers use this particular term, it is likely on its face that speakers conceive of the term “The Container Store” to refer not to just any store offering container type products, but rather a specific one or specific group of ones. The concept of a store dealing solely in containers may well have been novel when The Container Store was launched and, since that time, consumers can come to associate the compound term “The Container Store” to refer to services or goods offered by that particular store or brand owner even though the terms “container” and “store” are commonplace terms. In other words, the term The Container Store can function as a brand even though each of its constituent parts is unquestionably generic when they are removed from their contextual whole.

#### **D. Findings**

23. Based upon my review of the empirical evidence, the predominant usage of the term APP STORE is as a proper noun to refer to Apple’s online application marketplace. My conclusions in this respect are based upon my analysis of the usage of “app store” in databases such as LexisNexis, COCA, and the internet, as well as my review of dictionaries. While in certain limited instances, Mr. Durrance’s report has identified generic uses of the term “app store,” a comprehensive analysis reveals that such uses represent a *minority* of the total uses of that term.

24. Brands are the cumulative sum of their parts, not their parts in isolation. “App Store” is a noun phrase in which “App” is the adjective modifier of the noun “Store,” in the same way that “Chap” is the adjective modifier of the noun “Stick” in the brand “Chap Stick” and “Little” is the adjective modifier of the noun “Tavern” in the brand “Little Tavern.” Although “app” also refers to a class or group of things, when it is placed before another class or group of things, it is used adjectivally, not nominally, in the same way that “container” is used adjectively in the brand “The Container Store.”

25. I understand that Apple publicly announced its launch of its APP STORE branded online application marketplace on March 6, 2008. Under my supervision, a search was conducted of the LexisNexis data bank for appearances of the term “app store” appearing in the All News-US News database *prior* to March 7, 2008. The point of this research was to determine whether the term APP STORE was in use in connection with the distribution of software programs prior to Apple’s launch of its service. Attached as Exhibit 3 is a true and correct copy of the relatively few articles returned by this search.

26. The fact that this search returned so few hits (the vast majority of which involve merely the coincidental appearance of the word “app” and the word “store” or use the term “store” as a verb) establishes that the term APP STORE was not in fact in general use in connection with the distribution of software programs prior to Apple’s adoption of the term as a trademark. In other words, this research shows that Apple did not appropriate a term that was already a generic term for services associated with the distribution of software programs.

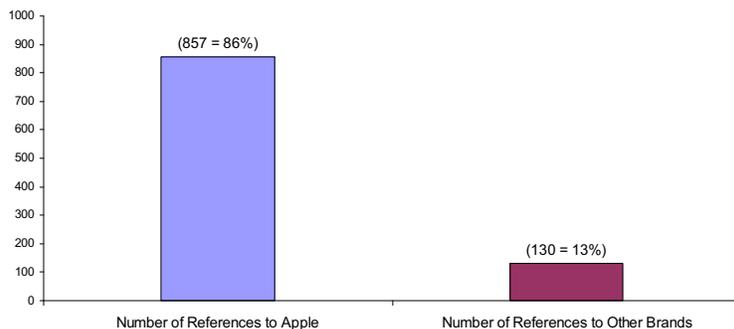
27. As indicated above, I also reviewed the LexisNexis data bank with respect to references to APP STORE appearing *after* Apple’s launch of its APP STORE service. Not surprisingly, Apple’s launch of its APP STORE service engendered a multitude of published

materials using the term APP STORE. As explained in more detail below, my analysis of these results establishes that the vast majority of uses of the term APP STORE refer exclusively to Apple’s online application marketplace.

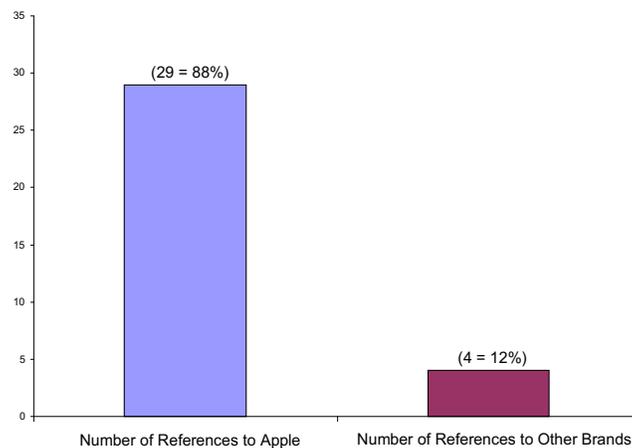
28. Specifically, under my direction a search was conducted within LexisNexis’s “MegaNews/US News” database. I understand from LexisNexis that the “MegaNews/US News” database offers access to the broadest set of media publications in LexisNexis’s U.S. database. A true and correct copy of LexisNexis’ summary of the materials included within this database is attached as Exhibit 4.

29. The search was conducted on February 17, 2011, using the search term “app store” without any limitations such as capitalization (or lack thereof). The search was run on references appearing in the database within the three months immediately prior to the date the search was run.

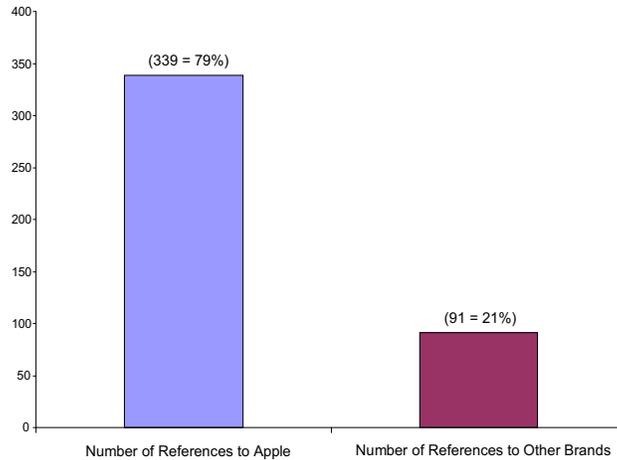
30. This LexisNexis search yielded 2,537 hits. An analysis of the first 1,000 of these hits revealed that 857 uses of the term APP STORE explicitly related to Apple’s App Store service, while only 130 instances related to companies other than Apple, and 13 were not clearly decipherable as to brand usage. A true and correct copy of the first 1,000 hits from this search is attached as Exhibit 5. Thus, according to these findings, 86% of usage associates “App Store” with Apple. These results are summarized graphically as follows:



31. Likewise, a review of the COCA database on February 24, 2011, revealed that there were 33 instances of use of the term “app store.” The search was run against the COCA database that collects materials from the date range 1990-2010. Significantly, all of the references to “app store” returned in this search postdated Apple’s announced launch of the service. A true and correct copy of these references is attached as Exhibit 6. My analysis of these references revealed that 29 of these are properly classified as references to Apple’s APP STORE service. The remaining four references constituted generic use of the term “app store.” Thus, 88% of the total uses of the term “app store” found in COCA constitute use of the term as a proper noun. These results are summarized graphically as follows:



32. Also, a Google search was conducted under my direction in order to further test the reliability of the results from the LexisNexis and COCA searches. For the term “App Store”, from the first 45 pages (the point at which Google ended its display with: “In order to show you the most relevant results, we have omitted some entries very similar to the 444 already displayed”), 339 uses of “App Store” explicitly referred to Apple, while 91 referred to other online marketplaces and 14 results were not clearly decipherable as either brand usage or generic use. Thus, based upon this analysis, **79%** of usage primarily associated “App Store” with Apple. These results are summarized graphically as follows:



33. Thus, my analysis of three separate databases—LexisNexis, COCA, and the internet—all establish that *the vast majority of uses of the term APP STORE in those databases refer specifically to Apple’s service*. From this, the data indicate, with a high degree of certainty, that the predominant usage of APP STORE is as a proper noun to refer to Apple’s online application marketplace.

34. Further, I have been provided with a copy of a declaration of Thomas La Perle at Apple and I note that in his declaration Mr. La Perle identifies how Apple’s principal competitors brand and describe their competing online application marketplaces. I understand from this testimony that these competitors have found ways of branding and describing their own online application marketplace without using the term APP STORE.

35. The fact that Apple’s principal competitors do not brand or describe their services by using the term APP STORE corroborates my analysis of the LexisNexis, COCA and internet data bases. While Apple’s principal competitors may use the words “app” or “store” individually, the fact that they avoid using the combined phrase “App Store” is further recognition that APP STORE has achieved brand significance with consumers. If APP STORE were in general use in describing *any* online marketplace, I would expect Apple’s principle competitors to have used the term as such. That this is not the case further reinforces my finding

that the predominant usage of the term APP STORE is as a proper noun to refer to Apple's online application marketplace.

36. My review of dictionaries further confirms my opinion that the predominant usage of the term APP STORE is as a proper noun to refer to Apple's online application marketplace. First, a search of conventional dictionaries (reference works that are traditionally accepted among linguists) returns no listing for "app store." To a linguist, this fact alone is evidence that a term is not generic, for if it were, like the entry "drug store" (in, e.g., Merriam-Webster's Collegiate), one would expect it to appear as such in a traditional dictionary.

37. Even a broader search of additional resource material found on the Internet supports the conclusion that the *predominate* usage of the term APP STORE is as a proper noun. For example, a search on Google's "Definitions of **App Store** on the Web" returns the following Apple-specific result:

"The App Store is a service for the iPhone, iPod Touch and iPad created by Apple Inc. which allows users to browse and download applications from the iTunes Store that were developed with the iPhone SDK and published through Apple."

([http://www.google.com/search?hl=en&client=firefox-a&hs=orU&rls=org.mozilla:en-US:official&defl=en&q=define:App+Store&sa=X&ei=RctZTbCkEtCctweF48y\\_Cw&ved=0CBYQkAE](http://www.google.com/search?hl=en&client=firefox-a&hs=orU&rls=org.mozilla:en-US:official&defl=en&q=define:App+Store&sa=X&ei=RctZTbCkEtCctweF48y_Cw&ved=0CBYQkAE))

A true and correct copy of the print-out showing the above search result is attached as Exhibit 7.

38. Similarly, according to Dictionary.com's "Computer Definitions," "App Store" is:

"An extension to Apple's iTunes online store that offers free and paid applications for the iPhone and iPod touch. Launched with the iPhone 3G in July 2008, the App Store is an additional menu option on the iTunes Store Web page. See [mobile app stores](#), [iPhone](#) and [jailbreak](#)."

(<http://computer.yourdictionary.com/app-store>)

A true and correct copy of the above definition is attached as Exhibit 8.

39. The “FreeDictionary By Farlex” website offers the following definition of APP STORE:

An extension to Apple's iTunes online store that offers free and paid applications for the iPhone and iPod touch. Launched with the iPhone 3G in July 2008, the App Store is an additional menu option on the iTunes Store Web page. See iPhone, iPod touch and jailbreak.

(<http://encyclopedia2.thefreedictionary.com/App+Store>)

A true and correct copy of the above definition is attached as Exhibit 9.

40. PC Magazine’s online Encyclopedia includes the following:

(1) An online store for downloading [applications](#). See [online app store](#).

(2) Apple's online store for downloading free and paid [iPhone](#), iPod touch and iPad applications from third-party developers. Launched along with the iPhone 3G in the summer of 2008, the [App Store](#) is integrated into Apple's iTunes software, and downloads and updates are activated through iTunes.  
[http://www.pcmag.com/encyclopedia\\_term/0,2542,t=App+Store&i=59366,00.asp](http://www.pcmag.com/encyclopedia_term/0,2542,t=App+Store&i=59366,00.asp)

A true and correct copy of the above definition is attached as Exhibit 10.

41. The manner in which online dictionaries treat the term APP STORE is therefore reflective of the usage of the term revealed through my other analyses. Specifically, these results show that while there exist isolated examples of generic use of the term APP STORE, the *majority* of the definitions define APP STORE as a service offered exclusively by Apple. In sum, my review of online dictionary definitions for the term APP STORE reinforces my conclusion that the *predominant* usage of the term APP STORE is as a proper noun referring to Apple’s online application marketplace.

#### **E. Flaws in Mr. Durrance’s Report**

42. I understand that Microsoft claims that the materials gathered in Mr. Durrance’s

declaration establish definitively that to a majority of the relevant public the term APP STORE functions as a generic term. In my opinion, the evidence Microsoft has submitted falls far short of proving that APP STORE is perceived by consumers as a generic term.

43. First, Mr. Durrance searched only for lower case uses of the term “app store” in determining that “approximately 80%” of the search results “discussed app stores other than Apple’s.” (Durrance Dec. at 2). This ignores entirely the vast number of uses of the term employing capitalization (which, as noted above, is indicative of a proper noun or brand). In other words, Mr. Durrance apparently selectively chose his evidence and submitted only those pieces of evidence that he concluded were helpful to his argument that APP STORE is a generic term. This approach is antithetical to scientific analysis, including linguistic analysis. This approach might be likened to trying to determine whether a forest is mostly populated by evergreen trees or deciduous trees and then counting only the deciduous trees.

44. Thus, Mr. Durrance’s analysis does not demonstrate whether the references he found represent, say, 10% of the uses of the term APP STORE or, say, 90% because no effort was made to identify the total number of uses of the term. As noted above, a more comprehensive search of the term reveals that generic uses of the term APP STORE are in the small minority of usage.

45. No clearly identified methods of assessment can be found in Mr. Durrance’s report in terms of measuring the “consumer awareness” of the mark in association with Apple, the “consumer’s use of “App Store” to identify competitors’ retail stores,” or the “widely used” appearance of “App Store” “in the general press” or “in the trade ... as the generic name for online stores featuring apps” (Microsoft Brief, p. 1). Indeed, I understand that Mr. Durrance’s report included numerous repetitions of the identical examples incorporating the term “app

store.” Further, I understand that Mr. Durrance’s report erroneously counted numerous instances of references to Apple’s APP STORE service as “generic.”

46. The fact that there are no scientific methods of assessment in the Durrance report means that it cannot accurately report on any of those findings that claim to assess or measure the pervasiveness of awareness or use. In contrast, my analysis calls on scientific, widely-accepted corpus linguistic methods of analysis.

47. The cornerstone of Microsoft’s argument that APP STORE is a generic term is its contention that the term “store” is generic for online e-commerce websites. As noted above, Microsoft’s singular focus on the merely constituent parts of the term APP STORE, *i.e.*, the “app” and the “store”, is misguided from a linguistic standpoint.

48. However, just in case there is any legal significance regarding whether the term “store” is generic for e-commerce websites, I provide the following assessment of the meaning of “store” in the context of online retail services.

49. First, there can be little doubt that “store,” when seen in isolation, is the generic term for a physical place or location where goods and services can be obtained by immediately present consumers. Indeed, all of the dictionary definitions for the term “store” gathered in Exhibit 5 in Mr. Durrance’s declaration refer to the meaning of the word “store” as a *physical place* where things can be purchased.

50. In the context of an *online* service, however, the composite use of “store” takes on a very different meaning from the definitions given in dictionaries, which suggest a brick and mortar physical location where customers enter a building to purchase goods. Instead, used in this context, the term “store” is used in a metaphorical sense.

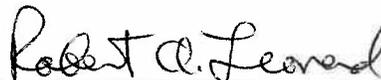
51. Apple and other entities have transmuted the term “store” and have

metaphorically morphed “store” from a physical building and source of commerce with bricks and mortar, physical sales-people, and physically-touchable displays of merchandise, into a metaphoric type of non-physical store. This metaphorical use of “store” arose sometime in the early 2000s after Amazon’s 1995 and eBay’s 1996 online shopping websites were launched. But I could not find any evidence that either Amazon or eBay used “store” in their online sites at that time. The morphing of the term apparently happened sometime between their website launches and Apple’s use of the term. The significance of this for purposes of my analysis is that there is no linguistic basis to assume that the term “store” is generic in the online context.

52. Accordingly, Microsoft’s contention that the term APP STORE is generic for an online application marketplace must be rejected. As summarized above, the empirical evidence analyzed above leads to the contrary conclusion.

I declare under penalty of perjury of the laws of the United States that the foregoing is true and correct.

Dated: February 28, 2011

  
Robert A. Leonard  
Robert A. Leonard



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

In the Matter of Application Serial No. 77/525,433  
For the mark: APP STORE  
Filed: July 17, 2008  
Published: January 5, 2010

-----X		
MICROSOFT CORPORATION,	:	
	:	Opposition No. 91195582
Opposer,	:	
	:	
	:	
v.	:	
	:	
APPLE INC.,	:	
	:	
Applicant.	:	
-----X		

**CERTIFICATE OF SERVICE**

This is to certify that a copy of the foregoing Declaration of Dr. Robert A. Leonard in Opposition to Microsoft Corp.'s Motion for Summary Judgment has been served on Applicant by depositing said copy with the United States Postal Service as First-Class Mail, postage prepaid, in an envelope addressed to:

William O. Ferron, Jr.  
Seed IP Law Group PLLC  
701 5<sup>th</sup> Avenue, Suite 5400  
Seattle, WA 98104

This the 28<sup>th</sup> day of February, 2011.



KILPATRICK TOWNSEND & STOCKTON LLP  
31 West 52nd Street  
New York, New York 10019  
(212) 775-8700 (phone)  
(212) 775-8800 (facsimile)

*Attorneys for Applicant Apple Inc.*