

ESTTA Tracking number: **ESTTA395558**

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

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

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Date	02/28/2011
Attachments	Microsoft v. Apple - Final Opp for Filing.PDF ( 62 pages )(454675 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

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MICROSOFT CORPORATION,	:	
	:	Opposition No. 91195582
Opposer,	:	
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	:	
v.	:	
	:	
APPLE INC.,	:	
	:	
Applicant.	:	
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**APPLICANT APPLE INC.'S BRIEF IN OPPOSITION TO OPPOSER MICROSOFT CORP.'S  
MOTION FOR SUMMARY JUDGMENT**

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## INTRODUCTION

Apple is a market leading computer hardware, software and mobile computing technology and services company. Its APP STORE™ mobile software download service has transformed the way that mobile device users customize and expand the functionality of their devices. Apple, long renowned for its innovation and product design, introduced the APP STORE service and coined the APP STORE mark just over two years ago. In that short period of time, the service has experienced phenomenal growth and success, and is now used by over 160 million consumers worldwide who have downloaded more than 10 billion software programs.

Microsoft now asks the Board to summarily eradicate Apple's commercial rights in its APP STORE mark on the purported basis that APP STORE has become generic. Having itself faced a decades-long genericness challenge to its claimed WINDOWS mark, Microsoft should be well aware that the focus in evaluating genericness is on the mark *as a whole* and requires a fact-intensive assessment of the primary significance of the term *to a substantial majority of the relevant public*. Yet, Microsoft, missing the forest for the trees, does not base its motion on a *comprehensive* evaluation of how the relevant public understands the term APP STORE as a whole.

What it offers instead are out-of-context and misleading snippets of material printed by its outside counsel from the internet and allegations regarding how the public allegedly interprets the *constituent parts of the term APP STORE*, i.e., “app” and “store.” Recognizing the many issues of fact raised by its motion and trying to sidestep them, Microsoft also concocts the argument that all “store” formative marks such as APP STORE should be *per se* generic. Microsoft's proofs, and its attempt to create a new genericness standard from whole cloth, do not warrant an award of summary judgment in Microsoft's favor.

At most, Microsoft demonstrates that the term APP STORE *describes* the nature of Apple's online software marketplace.<sup>1</sup> It falls far short of proving by clear and convincing evidence that a *majority* of the relevant public uses the term APP STORE generically for *any* online software marketplace. APP STORE is no

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<sup>1</sup> The examiner accepted Apple's substantial evidence that its APP STORE mark has acquired distinctiveness pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), and Microsoft has not sought to challenge this finding. Thus, if the Board concludes, as it should, that the term APP STORE is at most descriptive of Apple's services, then the Board should dismiss Microsoft's opposition.

more generic than other arguably descriptive terms that courts and the Board have long recognized as capable of serving as valid marks, including such terms as BOOKS ON TAPE (for cassettes on which books are recorded), THE MONEY STORE (for money lending); VISION CENTER (for retail services involving optical services and related goods such as eyewear); WEBPHONE (for computer software and computer hardware that enable real-time audio communication over computer networks); CASH MANAGEMENT ACCOUNT (for, among other things, stock brokerage services); THE BEEF JERKY OUTLET (for retail store services featuring beef snacks); DICTAPHONE (for dictation machines); POLY PITCHER (for polyethylene pitchers); INSTANT MESSENGER (for real time text messaging service), and a host of other marks discussed below.

Further, Microsoft acknowledges that Apple's principal competitors have all found ways of competing with Apple by offering online software marketplace services of their own without using the term APP STORE. Particularly apt, then, is the Board's recent statement that "[i]n circumstances where a coined term used as a trademark is quickly taken up by the public but not by competitors and the stakes are 'the fateful step' of full 'eradication' of an applicant's 'commercial rights,' the evidentiary burden [of showing genericness] is *heavy indeed*." *In re Trek 2000 Int'l, Ltd.*, 97 U.S.P.Q.2d 1106, 1114 (T.T.A.B. 2010) (emphasis added) (rejecting a genericness challenge to the mark THUMBDRIVE for portable storage devices).

Given the multiple deficiencies in its proofs, it is clear that Microsoft has not satisfied its heavy burden on summary judgment. Apple's opposition, however, does not rest solely on the fact that Microsoft has not demonstrated the lack of genuine issues of fact for trial. Rather, Apple offers testimony from a renowned linguistics expert, Dr. Robert Leonard, who, based upon rigorous examination of the empirical evidence, concludes that "the predominant usage of the term APP STORE is as a proper noun to refer to Apple's online application marketplace." If there can be any doubt regarding whether genuine issues of fact exist warranting trial (and there should not be), Dr. Leonard's declaration unquestionably removes it. Accordingly, Microsoft's motion should be denied.

## **STATEMENT OF FACTS**

### **I. APPLE'S APP STORE SERVICE.**

On July 11, 2008, Apple, the world famous technology company, launched its APP STORE service.

This service allows users of Apple’s iPhone, iPod and, most recently, iPad mobile devices, and users of computers running Apple’s iTunes software, to browse for and license a wide range of third party software programs, including games, business, educational, finance, news, sports, productivity, social networking, health, reference, travel, and utility software. Declaration of Thomas La Perle, Esq., dated February 28, 2011 (“La Perle Dec.”) ¶¶ 4, 10.

Prior to the introduction of the APP STORE service, mobile operators offered a variety of mobile software such as downloadable ringtones, wallpapers and games. *Id.* ¶ 5. These services were branded with a variety of terms that bore no similarity to APP STORE. For example, AT&T called its mobile software service “Media Mall” which it now calls “AppCenter.” *Id.*

When it launched, the APP STORE service represented a different kind of online software service and was an instant commercial and critical success. *Id.* ¶ 6. As a columnist for *The New York Times* remarked soon after the launch of the service, “[n]othing like the App Store has ever been attempted before.” *See id.* ¶ 7, Ex. 2. As a complement to its revolutionary service, Apple coined the term APP STORE as a means of branding its new service. *See id.* ¶ 9; *see also* Leonard Dec. ¶ 26 (concluding 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.”).

The APP STORE service serves as the distribution center for a variety of software programs, including many programs developed by third parties and programs developed by Apple. For example, if a user of an Apple mobile device wishes to play the popular “Angry Birds” video game, she would touch the “App Store” icon on her mobile device, search for the “Angry Birds” program and obtain a copy of that program on her device by licensing the software through the APP STORE service. La Perle Dec. ¶ 12.

In order to distribute software programs through the APP STORE service, third party software developers are required to sign a distribution agreement in which the developer appoints Apple as its worldwide agent for delivery of the software programs. *Id.* ¶ 14. All of the software programs that are available through the APP STORE service are licensed to consumers, not sold. *Id.* ¶ 15.

To date, there have been more than 10 billion downloads of programs through the service by more than 160 million consumers worldwide. An average of over a million downloads take place every hour worldwide. *Id.* ¶ 18. There are currently more than 350,000 software programs available for download on the APP STORE service. *Id.*

## **II. APPLE'S BRANDING OF ITS APP STORE ONLINE SOFTWARE MARKETPLACE.**

Apple has extensively advertised, marketed and promoted the APP STORE service and the APP STORE mark. In particular, Apple has spent millions of dollars on print, television and internet advertising. *Id.* ¶ 19. Apple's efforts and the resulting commercial success of the APP STORE service have conditioned a majority of consumers to perceive APP STORE as a trademark, not a generic term. *See* Leonard Dec. ¶¶ 29-32, 41. Moreover, Apple has obtained forty two (42) registrations of the APP STORE mark in foreign jurisdictions. *See* La Perle Dec. ¶ 36.

Since the APP STORE service was launched in 2008, Apple has prominently featured the APP STORE mark in print advertising. The mark has been featured in print advertising sponsored both by Apple as well as AT&T (which offers wireless connectivity for Apple's mobile devices). These ads have appeared in such magazines and newspapers as *Fortune*, *The New Yorker*, *The Economist*, *Newsweek*, *Time*, *The New York Times*, the *Washington Post*, as well as numerous other regional and local newspapers. *See* La Perle Dec. ¶ 20, Ex. 5.

As part of its marketing, Apple has implemented a unique television advertising campaign featuring the tag lines "There's An App For That" and "There's An App For Just About Everything." *Id.* ¶ 21. These commercials highlight the different computer software programs available through the APP STORE service and the variety of functions each computer software program serves. These commercials verbally refer to the APP STORE mark and also depict the APP STORE mark as featured on Apple's devices. *Id.* Apple has aired these and other commercials regarding its APP STORE services on all the major television broadcast stations, including ABC, CBS, NBC, FOX, The CW, BET, Comedy Central, CNN, ESPN, MTV, TBS, TNT, and VH1. *Id.* As a result, millions of consumers have been exposed to Apple's television campaigns. *Id.*

Not surprisingly given the success of Apple's APP STORE service, the service and Apple's APP STORE mark have been the subject of significant positive unsolicited media coverage. These articles recognize

the APP STORE mark as referring exclusively to Apple's service. *See Id.* ¶ 27, Ex. 12.

### **III. APPLE VIGOROUSLY PROTECTS ITS APP STORE MARK.**

The phenomenal popularity of Apple's online software marketplace has prompted a number of competitors to offer their own marketplaces. In fact, Microsoft, Google, Nokia, Research in Motion (Blackberry), Sprint, Verizon and other major companies now offer an online software marketplace for mobile operating systems that compete with Apple's mobile operating system (in fact, Apple's competitors hold a larger market share than Apple in respect of mobile operating systems). *Id.* ¶ 37. As Microsoft itself acknowledges, Opposer's Mot. For Summ. J. 15, these competitors have found ways of branding and describing their own online software marketplace without using the term APP STORE. La Perle Dec. ¶ 37. For example, Microsoft itself uses the term MARKETPLACE to refer to its service and uses the descriptor "virtual store for apps." January 10, 2011 Declaration of Nathaniel E. Durrance in Support of Microsoft Corporation's Motion for Summary Judgment, Dkt. No. 7 ("Durrance Dec.") ¶ 23.

In limited instances third parties have made improper use of the term APP STORE. La Perle Dec. ¶ 38. In response, Apple has contacted those parties and requested that they cease and desist from further use of the mark. *Id.* In most every instance, the entities contacted by Apple agreed to cease use of Apple's APP STORE mark. Those few which refused to cease use of Apple's APP STORE mark made reference to Microsoft's challenge of Apple's rights in its APP STORE mark, which has received widespread attention in the press, and have refused to cease using APP STORE pending a ruling in this proceeding. *Id.* ¶ 39.

## **ARGUMENT**

### **I. MICROSOFT FACES A "STRINGENT STANDARD" IN ASKING FOR SUMMARY JUDGMENT IN ITS FAVOR.**

Summary judgment is only appropriate where there are *no genuine issues of material fact in dispute*, thus leaving the case to be resolved as a matter of law. *See Fed. R. Civ. P. 56(c)*. Microsoft, as the party moving for summary judgment, has the burden of demonstrating the absence of any genuine issue of material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 322-37 (1986).

Microsoft, in order to prevail on its motion, must establish by *clear and convincing evidence* that there is no genuine issue of fact regarding the genus of the goods or services at issue and that the relevant consuming

public understands Apple's proposed mark to refer primarily to that genus of goods or services. *See H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 U.S.P.Q. 528, 530 (Fed. Cir. 1986); *Interpayment Servs. Ltd. v. Docters & Thiede*, Opp'n No. 91119852, 2002 WL 140168, at \*3 (T.T.A.B. Jan. 31, 2002) (non-precedential) (copy attached); *Lockermate Corp. v. Curtis*, Opp'n No. 91115439, 2002 WL 834492, at \*3 (T.T.A.B. Apr. 30, 2002) (non-precedential) (copy attached). Microsoft is held to a "stringent standard," and summary judgment is "not a substitute for the trial of disputed issues of fact." *Walters Gardens, Inc. v. Pride Of Place Plants, Inc.*, Opp'n No. 911537 55, 2004 WL 1149499, at \*6 (T.T.A.B. May 4, 2004) (non-precedential) (copy attached).

Apple, in order to have the opportunity to submit proofs at trial, need only show that, on the evidence of record, a reasonable fact finder could resolve the matter in its favor. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 850, 23 U.S.P.Q.2d 1471, 1472-73 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 202, 22 U.S.P.Q.2d 1542, 1544 (Fed. Cir. 1992); *see also Visa Int'l Serv. Ass'n v. Life-Code Sys., Inc.*, 220 U.S.P.Q. 740, 742 (T.T.A.B. 1983) (on a summary judgment motion, "[t]he nonmoving party is not required to adduce evidence sufficient to prove its case . . ."; it need only show "*that there is a genuine issue as to a material fact and that, therefore, there is a need for a trial.*") (emphasis added). The Board does not resolve issues of fact on summary judgment; it only determines whether a genuine issue exists. *Meyers v. Brooks Shoe Inc.*, 912 F.2d 1459, 1461, 16 U.S.P.Q.2d 1055, 1056 (Fed. Cir. 1990), *overruled on other grounds by A.C. Aukerman Co. v. R.L. Chaides Constr. Co.*, 960 F.2d 1020, 1038-39, 22 U.S.P.Q.2d 1321, 1333 (Fed. Cir. 1992). The evidence should be viewed in a light most favorable to Apple as the non-movant, and all justifiable inferences should be drawn in Apple's favor. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 767, 25 U.S.P.Q.2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 970 F.2d at 850, 23 U.S.P.Q.2d at 1472.

The determination of whether a mark is generic is the type of factual dispute that is rarely appropriate for resolution on summary judgment. *See e.g., Bath & Body Works, Inc. v. Luzier Personalized Cosmetics, Inc.*, 76 F.3d 743, 748, 37 U.S.P.Q.2d 1779, 1783 (6th Cir. 1996) (district court's finding that BATH AND BODY was generic was erroneous insofar as "the public," and thus the jury, might reach a different conclusion); Order

Denying Defendant's Motion for Summary Judgment on Genericness, *Microsoft Corp. v. Lindows.com, Inc.*, Case No. C01-2115C (W.D. Wash. Jan. 22, 2003) (in view of the conflicting evidence offered by the parties, summary judgment inappropriate in connection with defendant's summary judgment motion seeking a ruling that WINDOWS was generic as a matter of law for a graphical computer operating environment);<sup>2</sup> *Riggs Mktg., Inc. v. Mitchell*, 993 F. Supp. 1301, 1307, 45 U.S.P.Q.2d 1247, 1252 (D. Nev. 1997) (summary judgment unwarranted where "the public could arguably associate Plaintiff's 'universal' machine with [Plaintiff itself], and thus find 'universal' is not generic"); *SportsChannel Assocs. v. Comm'r of Patents & Trademarks*, 903 F. Supp. 418, 426-27, 37 U.S.P.Q.2d 1106, 1112-14 (E.D.N.Y. 1995) (evaluating conflicting evidence as to whether the term SPORTSCHANNEL for a sports-oriented television channel was generic and, in view of the conflicting evidence, denying defendant's motion for summary judgment).

As one court explained, so long as "facts are at issue that could cause a reasonable jury to decide the mark is a descriptive mark with secondary meaning or a suggestive mark, then the mark would be protected by trademark law and summary judgment for Defendant [on the issue of genericness] would be improper." *J & J Snack Foods Corp. v. Earthgrains Co.*, 220 F. Supp. 2d 358, 376, 65 U.S.P.Q.2d 1897, 1910-11 (D.N.J. 2002) (finding insufficient evidence to show that BREAK & BAKE is generic as a matter of law).

## **II. THE GENERICNESS INQUIRY FOCUSES ON THE TERM'S PRIMARY SIGNIFICANCE TO A SUBSTANTIAL MAJORITY OF THE RELEVANT PUBLIC.**

As Microsoft is well aware from its lengthy efforts trying to defend its claimed WINDOWS mark in a case that was ultimately settled out of court before a final decision was reached,<sup>3</sup> generic terms are common names that the relevant purchasing public understands *primarily* as describing the genus of goods or services being sold. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344, 57 U.S.P.Q.2d 1807, 1810 (Fed. Cir. 2001) (reversing refusal to register mark 1-888-MATTRESS because evidence did not show that the relevant public referred to the mark as a class of services). The test for genericness is not whether some portion of the

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<sup>2</sup> A copy of this decision is attached as Exhibit C to Ms. Jones' declaration.

<sup>3</sup> For a summary of Microsoft's lengthy battle to claim trademark rights in the term WINDOWS, see *Microsoft Corp. v. Lindows.com, Inc.*, 64 U.S.P.Q.2d 1397, 1411 (W.D. Wash. 2002) (denying Microsoft's motion for a preliminary injunction, finding "serious questions regarding whether Windows is a non-generic name and thus eligible for the protections of federal trademark law").

relevant public views a term as generic, but whether the term's *primary* significance to a *substantial* majority of the *relevant* public is as a generic term. *See Ginn*, 782 F.2d at 989, 228 U.S.P.Q. at 530; *see also In re Trek 2000*, 97 U.S.P.Q.2d at 1108 (“The critical issue is to determine whether the record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods or services in question.”); 15 U.S.C. § 1064(3) (“The primary significance of the registered mark to the relevant public . . . shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.”).

Making this determination “involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered . . . understood by the relevant public primarily to refer to that genus of goods or services?” *Ginn*, 782 F.2d at 990, 228 U.S.P.Q. at 530. If the primary significance of the term in the minds of the relevant public is that it refers to the *producer* and not to the class of goods or services, then the term is not generic. *See id.* (reversing Board decision holding that FIRE CHIEF for magazines was generic); *see also In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1571, 4 U.S.P.Q.2d 1141, 1144 (Fed. Cir. 1987) (reversing the Board’s decision and holding CASH MANAGEMENT ACCOUNT for brokerage services *not* generic because the relevant public viewed the mark as referring to the producer and not the class of services). Competent sources evincing the purchasing public’s understanding of a contested term include purchaser testimony, consumer surveys, dictionary definitions, trade journals, newspapers and other publications. *In re Dial-A-Mattress*, 240 F.3d at 1344, 57 U.S.P.Q.2d at 1810.

The Seventh Circuit Court of Appeals has cautioned that casting a term into the public domain through a finding of genericness is a “fateful step.” *Ty Inc. v. Softbelly’s Inc.*, 353 F.3d 528, 531, 69 U.S.P.Q.2d 1213, 1215 (7th Cir. 2003). The court explained that this is because such a finding:

penalizes the trademark’s owner for his success in making the trademark a household name and forces him to scramble to find a new trademark. And it may confuse consumers who continue to associate the trademark with the owner’s brand when they encounter what they thought a brand name on another seller’s brand. . . . The fateful step ordinarily is not taken until the trademark has gone *so far toward becoming the exclusive descriptor of the product that sellers of competing brands cannot compete effectively without using the name to designate the product they are selling.*

353 F.3d at 531, 69 U.S.P.Q.2d at 1215 (emphasis added); *see also In re Trek 2000*, 97 U.S.P.Q.2d at 1108

(quoting *Ty Inc.*, 353 F.3d at 531, 69 U.S.P.Q.2d at 1215).

### **III. MICROSOFT’S EVIDENCE PROVIDES AN INSUFFICIENT BASIS UPON WHICH TO GRANT SUMMARY JUDGMENT IN MICROSOFT’S FAVOR.**

Microsoft concedes, as it must, that the critical issue is whether a *majority* of the relevant public use the term APP STORE as a generic term for the services at issue. *See* Opposer’s Mot. for Summ. J. 5. However, it then makes no attempt to identify the relevant public and likewise fails to identify with specificity the class of services at issue.<sup>4</sup> Most significantly of all, Microsoft also fails to submit any evidence *actually assessing the universe of uses of the term APP STORE*.

What Microsoft offers instead is a hodge-podge of out-of-context snippets of material that Microsoft argues reflect generic uses of the term APP STORE. Microsoft makes no attempt to assess whether such uses constitute a small or large fraction of the total uses of the term APP STORE. Worse, in many instances Microsoft counts the same uses multiple times and mischaracterizes brand usage as generic use. Microsoft, therefore, falls far short of satisfying the stringent standard governing its summary judgment motion.

#### **A. Microsoft Errs By Dissecting the Term APP STORE.**

##### **1. The Board Should Examine APP STORE as a Whole.**

Microsoft reaches the wrong conclusion because it begins with the wrong standard. It argues that “[t]erms that combine the generic name of a product with the generic designator ‘store’ or ‘warehouse’ are generic and unregistrable for retail store services featuring the product.” Opposer’s Mot. for Summ. J. 6. Microsoft, seeking to sidestep the many factual issues raised by its motion, urges the Board to adopt what would amount to a *per se* rule for evaluating whether a term is generic. However, it offers no reason for the Board to deviate from its long-established, fact-specific inquiry with respect to the genericness issues.

In focusing on the constituent parts of the term APP STORE, Microsoft grossly misrepresents the genericness test. It is well established that the focus in evaluating genericness is on the *mark as a whole*. As the Board has explained, “[w]hether a mark is a phrase or a compound word, the inquiry remains the same: *is the*

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<sup>4</sup> While Microsoft’s brief offers no definition for the relevant service, at times it refers generally to “retail store services featuring apps,” Opposer’s Mot. for Summary J. at 8, 17, and at other times to “online stores featuring apps,” *id.* at 11. Apple submits that the proper definition of the class of services is an online marketplace featuring downloadable software programs and the relevant public is consumers of downloadable software programs.

*sum total of the separate components no less generic than the components themselves, or does the combination yield something more?” McCormick Del., Inc. v. Williams Foods, Inc.,* Opp’n 92028967, 2001 WL 253633, at \*5 (T.T.A.B. Feb. 14, 2001) (emphasis added) (copy attached) (finding the mark BAG’N SEASON *not* generic for seasoning mixes for meats and roasting bags combined in the same packages); *see also Union Carbide Corp. v. Ever-Ready Inc.,* 531 F.2d 366, 379, 188 U.S.P.Q. 623, 635 (7th Cir. 1976) (“Dissecting marks often leads to error. Words which could not individually become a trademark may become one when taken together.”), *superseded on other grounds by statute as stated in Scandia Down Corp. v. Euroquilt, Inc.,* 772 F.2d 1423, 227 U.S.P.Q. 138 (7th Cir. 1985). As the Federal Circuit cautioned in *In re Steelbuilding.com,* “[a]n inquiry into the public’s understanding of a mark *requires consideration of the mark as a whole.* Even if each of the constituent words in a combination mark is generic, the combination is not generic unless the entire formulation does not add any meaning to the otherwise generic mark.” 415 F.3d 1293, 1297, 75 U.S.P.Q.2d 1420, 1421 (Fed. Cir. 2005) (emphasis added).

As Dr. Leonard explains, this approach is sound as a matter of linguistics because human beings interpret terms such as APP STORE as a whole. Consumers do not grasp the meaning of the term by separately analyzing its component parts. Leonard Dec. ¶ 20.

Thus, the courts and the Board have long recognized that compound terms can serve as valid trademarks even when each of the constituent terms forming the compound have a generic meaning. *See Cal. Cooler, Inc. v. Loretto Winery, Ltd.,* 774 F.2d 1451, 1455-56, 227 U.S.P.Q. 808, 811 (9th Cir. 1985) (CALIFORNIA COOLER not generic for a beverage of wine, sparkling water and fruit juice produced in California); *Vision Center v. Opticks, Inc.,* 596 F.2d 111, 116, 202 U.S.P.Q. 333, 339-40 (5th Cir. 1979) (VISION CENTER not generic for a business dealing in optical goods and related services); *Blisscraft of Hollywood v. United Plastics Co.,* 294 F.2d 694, 702, 131 U.S.P.Q. 55, 62 (2d Cir. 1961) (POLY PITCHER not generic of a polyethylene pitcher); *Telechron, Inc. v. Telicon Corp.,* 198 F.2d 903, 907, 94 U.S.P.Q. 363, 366 (3d Cir. 1952) (TELECHRON not generic for electric clocks); *Dan Robbins & Assocs., Inc. v. Questor Corp.,* 599 F.2d 1009, 1014, 202 U.S.P.Q. 100, 106 (C.C.P.A. 1979) (TINKERTOY not generic for construction set toys); *Burger King Corp. v. Pilgrim’s Pride Corp.,* 705 F. Supp. 1522, 1525-26, 12 U.S.P.Q.2d 1526, 1529-30 (S.D. Fla. 1988),

*aff'd without op.*, 894 F.2d 412 (11th Cir. 1990) (CHICKEN TENDERS not generic to the general consuming public for chicken parts, even if it might be generic to the chicken industry); *Schmidt v. Quigg*, 609 F. Supp. 227, 230, 226 U.S.P.Q. 518, 521 (E.D. Mich. 1985) (HONEY BAKED HAM not generic for hams that are honey glazed); *Park 'N Fly, Inc. v. Park & Fly, Inc.*, 489 F. Supp. 422, 427, 204 U.S.P.Q. 204, 209 (D. Mass. 1979) (PARK 'N FLY not generic for airport parking operations); *Dictaphone Corp. v. Dictamatic Corp.*, 199 U.S.P.Q. 437, 445-47 (D. Or. 1978) (DICTAPHONE not generic for dictating equipment or machines); *In re Am. Online, Inc.*, 77 U.S.P.Q.2d 1618, 1623 (T.T.A.B. 2006) (INSTANT MESSENGER not generic for real time text messaging service); *In re Homes & Land Publ'g Corp.*, 24 U.S.P.Q.2d 1717, 1718 (T.T.A.B. 1992) (RENTAL GUIDE not generic for a magazine listing rental properties); *In re Minnetonka Inc.*, 3 U.S.P.Q.2d 1711, 1713 (T.T.A.B. 1987) (SOFT SOAP not generic for liquid soap after originally held to be a generic name in *In re Minnetonka, Inc.*, 212 U.S.P.Q. 772 (T.T.A.B. 1981)).

## **2. Microsoft's "Noun Plus Store" Test Grossly Oversimplifies the Genericness Test.**

Microsoft argues that whenever a mark combines a product name with the word "store" (*i.e.*, employs a noun plus the word "store"), the combined term *can under no circumstances* serve as a source identifier for retail services featuring the product. Microsoft greatly oversimplifies and misapprehends the genericness test. Indeed, the authority cited by Microsoft undercuts its proposition and other authority, along with sheer common sense, flatly contradict it.

Microsoft principally relies upon the Board's decision in *In re Computer Store, Inc.*, 211 U.S.P.Q. 72 (T.T.A.B. 1981), in support of its "noun plus store" rule. However, in that proceeding the Board affirmed the examiner's refusal to register THE COMPUTER STORE on the basis that the mark was *merely descriptive*, finding that the applicant's evidence of acquired distinctiveness was "not persuasive." *Id.* at 73. Thus, the decision was not based on a finding of genericness, but rather on a finding of descriptiveness unsupported by secondary meaning.

Microsoft's reliance upon *Mil-Mar Shoe Co. v. Shonac Corp.*, 75 F.3d 1153, 37 U.S.P.Q.2d 1633 (7th Cir. 1996), is also misplaced. While the Court in *Mil-Mar* found the terms "Shoe Warehouse" and "Warehouse Shoes" generic, it did so where the defendant "*presented evidence that hundreds of retail shoe stores use some*

form of either ‘Shoe Warehouse’ or ‘Warehouse Shoes’ in their names.” 75 F.3d at 1159, 37 U.S.P.Q.2d at 1638 (emphasis added). Here, and as Microsoft concedes, Apple’s principal competitors have all adopted terms other than APP STORE to refer to their respective online software marketplaces. The few third parties making commercial use of APP STORE have, for the most part, agreed to stop using the term in response to Apple’s objections.<sup>5</sup>

Moreover, Microsoft’s reflexive “noun plus store” rule cannot account for the Seventh Circuit’s upholding of a registration for THE MONEY STORE for money lending. *See Money Store v. Harriscorp Finance, Inc.*, 689 F.2d 666, 216 U.S.P.Q. 11 (7th Cir. 1982). In fact, there the Seventh Circuit affirmed a finding that the term THE MONEY STORE was a *suggestive mark* and therefore was registerable even without a showing of acquired distinctiveness. 689 F.2d at 673, 216 U.S.P.Q. at 18.

If the Board were to depart from well-established precedent and adopt Microsoft’s one-size fits all “noun plus store” rule, in one fell swoop it would effectively invalidate numerous valid and subsisting trademark registrations which contain a product name followed by the word “store.” Clearly, the Board should avoid a formulation of the genericness test that would suddenly cast so many third party registrations into the public domain. For example, the following third party registrations would all be effectively cancelled were the Board to endorse Microsoft’s argument:

Trademark	Registration Number	Goods/Services
THE CONTAINER STORE	1,164,143	Retail store services in the area of household accessories, storage items, storage systems, and space organizers, in International Class 42.
WOOD STORE	2,339,880	Providing on-line retail services in the field of woodworking including woodworking tools, plans and kits, products, and related supplies and publication subscriptions via a global computer network, in International Class 35.
AWARDSTORE	2,659,403	Retail store services featuring plaques, trophies, laser engraved acrylic

<sup>5</sup> Likewise unavailing for Microsoft are the Board’s decisions in *In re AEW, Inc.*, Ser. No. 74/447,347, 1999 WL 285499 (T.T.A.B. May 7, 1999) (non-precedential), *available at* <http://des.uspto.gov/Foia/RefervePdf?flNm=74447347-05-07-1999&system=TTABIS> (addressing the term DISCOUNT AUTO PARTS STORES) and *In re Italian Store, Inc.*, Ser. No. 77/041,070, Dkt. No. 19, 2010 WL 2104134 (T.T.A.B. May 10, 2010) (non-precedential) (addressing the term THE ITALIAN STORE). While in both those decisions the Board concluded that the terms at issue were generic, it did so upon evaluating all the proffered evidence on the issue of how the public perceives those terms. These decisions, *which did not arise in the context of a summary judgment motion*, simply do not support the reflexive “noun plus store” rule urged by Microsoft here.

		and stone, embroidery, digital screen printing, uniform creation, personalization and corporate identification programs and the like, in International Class 35.
SWAG STORE	3,773,696	Online retail stores and retails stores featuring a wide variety of consumer goods, including branded and non-branded commercial items and gift cards; Online retail outlet featuring digital dollars, prize money, gift certificates, and redeemable coupons for goods and services; Online retail outlet featuring marketing goods and services of others, in International Class 35.
THE AUTO STORE	2,562,711	Pre-owned motor vehicle dealerships, in International Class 35.
THE ENGAGEMENT RING STORE	2,237,873	Retail jewelry store services, in International Class 42.
THE GENERATOR STORE	3,367,291	Retail store services featuring electric power generators for home and industrial use, in International Class 35.
THE PAPER STORE	1,212,989	Retail store services, featuring paper and plastic tableware, greeting cards and party and gift wrapping supplies, in International Class 42.
THE RADIATOR STORE	3,022,200	Retail and wholesale store services featuring automotive and vehicular systems and their components, in International Class 35.
THE SHADE STORE	3,559,896	On-line retail store services featuring window blinds, curtains, decorative window treatments and related goods, in International Class 35.
DIGITAL MAP STORE	3,080,989	Online retail store featuring maps, map software, and GPS equipment, in International Class 35.

See Declaration of Alicia Jones, Esq., dated February 28, 2011 (“Jones Dec.”), ¶ 2, Ex. A.

**3. Definitions of “App” and “Store” Are Not Probative of Consumer Perception of the Combined Phrase APP STORE.**

In a variant of its unsupportable “noun plus store” argument, Microsoft urges the Board to review the constituent elements of the term APP STORE and, based upon this parsing, argues that the Board should find the composite term to be generic. Opposer’s Mot. for Summ. J. 6-7. Microsoft’s argument invites reversible error. The Federal Circuit has cautioned that the “Board cannot simply cite definitions and generic uses of the constituent terms of a mark, or in this case, a phrase within the mark, *in lieu of conducting an inquiry into the meaning of the disputed phrase as a whole to hold a mark, or a phrase within in the mark, generic.*” *In re Am. Fertility Soc’y*, 188 F.3d 1341, 1347, 51 U.S.P.Q.2d 1832, 1836 (Fed. Cir. 1999) (emphasis added).

Thus, the Board has rejected a genericness challenge to the term THE BEEF JERKY OUTLET for retail store services featuring beef snacks. See *In re Am. Food Co.*, Ser. No. 76/101,362, Dkt. No. 12, 2004 WL 2368423 (T.T.A.B. Sept. 29, 2004) (non-precedential). In that case, and similar to Microsoft’s arguments here,

the examining attorney argued that “THE BEEF JERKY OUTLET is a compound term; that the individual words are generic terms for, respectively, dried beef strips and a commercial market; and that the individual words retain their generic significance when joined to form the compound term herein.” *Id.* at \*2. The Board flatly rejected this argument, concluding “although the terms ‘BEEF JERKY’ and ‘OUTLET’ may be generic for, respectively, a type of beef snack and a commercial market, the record falls short of establishing that the phrase THE BEEF JERKY OUTLET, *as a whole*, is generic.” *Id.* at \*4 (emphasis added).

**4. Microsoft Has Not Proven That The Term “STORE” is Generic for *Online Retail Services*.**

Not only does Microsoft’s parsing of APP STORE violate the linguistically sound rule that marks need be evaluated as a whole, it is far from clear that Microsoft is correct in asserting that the term “STORE,” by itself, is generic for *online* retail services. Microsoft fails to support this assertion—in fact its own evidence tends to support the opposite conclusion—and Apple’s proofs too show that “store” is at most descriptive of online retail services.<sup>6</sup>

As Dr. Leonard’s declaration establishes, the term “store,” while generic for brick and mortar retail services, is descriptive of online retail web services. *See* Leonard Dec. ¶ 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 is particularly the case where the marketplace at issue offers not physical goods such as those offered by the internet retailer Amazon.com, but intangible software licenses. *See* La Perle Dec. ¶ 15.<sup>7</sup>

Microsoft’s *own evidence* shows that there is at least a question of fact as to whether “store” is generic for retail services that are transacted entirely in cyberspace. The dictionary definitions it proffers in its

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<sup>6</sup> We are aware of no authority declaring the term “store” generic for online (as opposed to brick and mortar) retail services.

<sup>7</sup> While Apple did disclaim “store” as Microsoft argues, it is well established that a disclaimer operates as a concession that a term is descriptive; it is not, as Microsoft suggests, a concession that the disclaimed term is generic. *See In re Halocarbon Prods. Corp.*, Serial No. 76/588,421, Dkt. No. 9, 2006 WL 1706434, at \*4 (T.T.A.B. June 7, 2006) (non-precedential) (“Further, the fact that the applicant has disclaimed the term HALOCARBON in another registration for the same goods is not persuasive evidence that the term is generic rather than merely descriptive”).

“Summary of Undisputed Facts” define “store” as “a *place* where goods are sold.” Opposer’s Mot. for Summ. J. 3 (emphasis added). Further, Microsoft provides snippets of two dictionary definitions for the term “store,” both of which reflect the fact that the term “store” is typically applied to a retail outlet with a *physical* presence. For example, Microsoft’s reference to a definition found in the *New Oxford American Dictionary* defines “store” as a “retail *establishment* selling items to the public.” *Id.* at 9. To the same effect, Microsoft quotes from *Dictionary.com* defining “store” as “an *establishment* where merchandise is sold, usually on a retail basis.” *Id.* (emphasis added). Even Microsoft, when describing its online software marketplace, sees fit to add the term “virtual” before “store.” It undoubtedly does so to convey to consumers that the “store” is not what is typically envisioned by consumers when they hear that term. *See* Durrance Dec. Ex 21, at 8 (describing Microsoft’s online software marketplace as a “*virtual store for apps.*”) (emphasis added).<sup>8</sup>

Microsoft errs in assuming that when terms are generic outside of the internet context, they are necessarily generic within it. The Board’s decision in *Netspeak Corp. v. Columbia Telecomm. Group, Inc.*, Opp’n No. 91110328, Dkt. No. 40, 2004 WL 1195623 (T.T.A.B. May 13, 2004) (non-precedential), illustrates the fallacy in this assumption. There, the Board rejected a genericness challenge to the term WEBPHONE for computer software and computer hardware that essentially provided a telephone service over the internet. Reminiscent of Microsoft’s arguments here, in that case the applicant “asks that we cancel opposer’s registration for the mark WEBPHONE based on dictionary definitions of the separate words, a few articles from printed publications, and records of the USPTO showing disclaimers of the term ‘web.’ ” *Id.* at \*9.

The Board found applicant’s evidence “weak or ambiguous” and explained that “evidence showing the *descriptiveness* of ‘web’ is not sufficient to show that ‘web phone’ is generic.” *Id.* (emphasis added). Of particular significance here, the Board further concluded, “[w]hile opposer’s goods enable people to use their computers as they would use a telephone, *clearly the computer hardware and computer software are not really a ‘telephone.’* ” *Id.* (emphasis added).

Likewise, Apple’s services enable people to obtain software as they would if they visited a physical

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<sup>8</sup> It is for this same reason that Apple, when using the term “store” in connection with online retail services, modifies the word by indicating that the service is an “online” store or “applications store,” or “electronic store.” La Perle Dec. ¶ 33.

brick and mortar store. However, Apple's online software marketplace is no more a store than opposer's goods in the WEBPHONE decision were really a "telephone."

**B. Apple's Competitors Have Proven That They Can Compete Quite Effectively Without Using the Term APP STORE.**

Microsoft offers conflicting evidence on the issue of whether competitors are using the term APP STORE to describe their own online software marketplaces. Microsoft concedes that Apple's principal competitors have all found terms other than APP STORE to describe their services. Opposer's Mot. for Summ. J. 14. At the same time, Microsoft contends that there are other competitors that make commercial use of the term APP STORE. *Id.* at 13. Microsoft's own conflicting evidence, if anything, serves to highlight the factual issues lurking beneath the surface of its motion.

Microsoft has compiled a list showing that Apple's principal competitors in the online software marketplace space all use terms other than APP STORE to refer to their service or describe that service generally. *Id.* at 15. For example, by Microsoft's own concession Google has named its service ANDROID MARKET and uses the descriptor "marketplace." RIM/Blackberry refers to its service as APP WORLD and uses the descriptor "storefront." Microsoft itself uses the term MARKETPLACE to refer to its service and uses the descriptor "virtual store for apps." Finally, Nokia, HP/Palm and Samsung refer to their own services as OVI STORE, APP CATALOG and SAMSUNG APPS respectively and each describe their services as an "application store." Durrance Dec. ¶ 23. Mr. La Perle's declaration also identifies the brand names adopted by Apple's competitors with respect to their competing online software marketplaces. La Perle Dec. ¶ 37.

Microsoft's acknowledgment that Apple's principal competitors have all found a way to describe their online software marketplaces indisputably cuts against its claim that no genuine issue exists and APP STORE should be found generic as a matter of law. As the Board concluded in *In re Trek 2000*, "where the evidence of record does not show that competitors use the designation in issue, *this may create doubt*, depending on the totality of the record, as to whether a term primarily refers to a genus of goods such that 'sellers of competing brands cannot compete effectively without using the name to designate the product they are selling.'" 97 U.S.P.Q.2d at 1109 (quoting *Ty Inc.*, 353 F.3d at 531, 69 U.S.P.Q.2d at 1215) (emphasis added).

The Board in *Trek* emphasized the reason why the absence of competitor use of a term is so significant

to the genericness inquiry. “In circumstances where a coined term used as a trademark is quickly taken up by the public but not by competitors and the stakes are ‘the fateful step’ of full ‘eradication’ of an applicant’s ‘commercial rights,’ the evidentiary burden [of showing genericness] is *heavy indeed*.” *Id.* at 1114 (emphasis added). The Board continued, “[w]hile evidence of competitor use is not required to satisfy this burden, where the record demonstrates both trademark and generic uses, evidence of the lack of competitor use, at a minimum, *may create doubt sufficient to tip the balance in favor of registration*.” *Id.* (emphasis added).

As for the other commercial uses of APP STORE identified by Microsoft, Opposer’s Mot. for Summ. J. 13, Apple has objected to such uses as detailed in Mr. La Perle’s declaration. *See* La Perle Dec. ¶ 38. In fact, in response to Apple’s demands the majority of such third parties have agreed to stop using APP STORE. *Id.* ¶ 39. The fact that Apple actively polices unauthorized uses of APP STORE and has stopped most such uses as a result of its efforts, further supports a finding that APP STORE is not generic. *See In re Trek 2000*, 97 U.S.P.Q.2d at 1112-13 (fact that media outlets agreed to stop using THUMBDRIVE generically supported applicant’s arguments that the term was not generic); *see also Zimmerman v. Nat’l Ass’n of Realtors*, 70 U.S.P.Q.2d 1425, 1430 (T.T.A.B. 2004) (“To the extent that individuals or local real estate groups misuse these registered terms, the previous litigation with Ms. Freeman illustrates the extent of respondent’s policing efforts with respect to such uses, demonstrates that respondent does not permit such uses to go uncontested, and shows that respondent continually takes affirmative steps to emphasize the proprietary status of its collective service marks. In short, the record shows no evidence of generic use of REALTOR or REALTORS by competitors.”).

**C. The Fact That Mainstream Dictionaries Do Not Have a Definition for the Term APP STORE Supports a Finding that the Term is Not Generic.**

While Microsoft goes to great lengths to identify alleged dictionary definitions for “app” and “store,” absent from its motion are dictionary definitions for the term “APP STORE” as a composite term. Dr. Leonard was likewise unable to identify any traditional dictionaries defining the term APP STORE. Leonard Dec. ¶ 36. Significantly, when he searched non-traditional dictionaries, Dr. Leonard discovered definitions for APP STORE, the vast majority of which defined the term as referencing Apple’s groundbreaking online software marketplace. *Id.* at ¶ 41.

For purposes of this summary judgment motion, the Board can only conclude that there are no

traditional dictionary definitions for the combined term APP STORE. This fact unquestionably supports a finding of non-genericness. *See In re Trek 2000*, 97 U.S.P.Q.2d at 1112 (rejecting genericness challenge to the term THUMBDRIVE for portable storage devices at least in part on the basis that “the record shows that the more mainstream reference works (*e.g.*, Merriam-Webster Online, copyright 2007) do not have a listing for THUMBDRIVE”); *see also In re Steelbuilding.com*, 415 F.3d at 1298-99, 75 U.S.P.Q.2d at 1423 (“The record does not contain any examination of dictionary definitions or other sources that might have indicated that joining the separate words ‘steel’ and ‘building’ would create a word that, in context, would be generic.”); *Door Sys., Inc. v. Pro-Line Door Sys.*, 83 F.3d 169, 171, 38 U.S.P.Q.2d 1771, 1773 (7th Cir. 1996) (“The term ‘door systems’ does not appear in the dictionary. Its component words do, of course, but that in itself cannot count for much; otherwise it could be argued that ‘Seven-Up’ is generic, which no one believes”).

**D. Microsoft’s Evidence of Trade Use, General Press Use, and Consumer Use Does Not Show by Clear Evidence That APP STORE is Generic.**

Microsoft, seeking to avoid highlighting an issue of fact at all costs, offers the Board only specific instances of uses of the term APP STORE which Microsoft contends are generic uses. What is missing from Microsoft’s submission is any evidence, expert or otherwise, regarding whether such uses represent a majority of the uses of the term or simply a small, inconsequential subset of how the relevant public uses the term APP STORE. Microsoft’s failure to assess the universe of uses of the term APP STORE alone warrants the denial of its motion. This is because without such an assessment Microsoft *misses the forest for the trees*, and cannot possibly meet its burden of showing that a *majority* of the relevant public understands the term APP STORE to be generic. *See Leonard Dec.* ¶ 43 (Mr. Durrance “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.”).<sup>9</sup>

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<sup>9</sup> Microsoft, when it suits its purposes, knows how to assess the universe of uses of a term alleged to be generic. In seeking to defend its WINDOWS mark from a genericness claim, Microsoft submitted expert testimony from a professor of language and literature assessing the percentage of generic uses of the term WINDOWS measured against total uses of the term. *See Jones Dec. Ex. C* at 17 (Order denying Lindows.com’s motion for summary judgment).

## 1. Mr. Durrance's Methodology is Deeply Flawed.

Microsoft's first mistake lies in the methodology it used to try to show that APP STORE is generic. Rather than evaluating the full spectrum of uses of the term, it instructed its outside counsel, Nathaniel Durrance, to look exclusively for generic uses of the term APP STORE. Mr. Durrance states in his declaration that he went about doing so by running a search for "app store" (lower case only) using Westlaw's case-sensitive search setting in Westlaw's USNEWS database and limited his analysis to the period January 1, 2010 and November 10, 2010. Durrance Dec. ¶ 2. Mr. Durrance testifies that his search resulted in 1,077 hits during the time period he selected and that he reviewed "and found that 867 articles, approximately 80%, discussed app stores other than Apple's." *Id.* ¶ 3.

Mr. Durrance's untutored survey is entitled to no weight whatsoever. Mr. Durrance admits that he limited his search to references to APP STORE *appearing in all lower cases*. In such circumstances, the Board is left to wonder whether the references Mr. Durrance allegedly located represent 51% of the total references to APP STORE in the database he selected or 5% (this uncertainty is in fact clarified in Dr. Leonard's declaration in which Dr. Leonard attests to the fact that his more comprehensive review established that the vast majority of public references to APP STORE refer specifically to Apple's service). Mr. Durrance's failure to sample the proper universe is fatal to the reliability of Mr. Durrance's evaluation of whether a *majority* of the relevant public views APP STORE to be a generic term. *See* Leonard Dec. ¶¶ 43-46.

Further, Mr. Durrance submits only truncated versions of the articles upon which he relies, providing up to 30 words before and after each occurrence of the searched term. Durrance Dec. ¶ 2, Ex. 1. By providing only a snippet of text, Mr. Durrance denies the Board (and Apple) an opportunity to evaluate the references in their full context. This error further vitiates the reliability of Mr. Durrance's testimony and informal survey. As the Federal Circuit has explained, "Search engine results—which provide little context to discern how a term is actually used on the webpage that can be accessed through the search result link may be insufficient to determine the nature of the use of a term or the relevance of the search results to registration considerations." *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 967, 82 U.S.P.Q.2d 1823, 1833 (Fed. Cir. 2007) (Bayer asserted—and the Federal Circuit agreed—that a list of Google search result summaries intended to prove the

descriptiveness of the ASPIRINIA mark was of lesser probative value than evidence that provides the context within which a term is used.) *See also Gen. Motors Corp. v. Aristide & Co., Antiquaire de Marques*, 87 U.S.P.Q.2d 1179, 1183 (T.T.A.B. 2008) (according little weight to opposer’s evidence of truncated search engine results purporting to show use of the term “LASALLE” in connection with opposer’s former CADILLAC LASALLE mark).

Finally, even the conclusion Mr. Durrance draws from the articles he collected in Exhibit 1 is incorrect. Mr. Durrance calculated that approximately 80% of the articles he gathered through his lower case search “discussed app stores other than Apple’s.” Durrance Dec. ¶ 3. However, as demonstrated in the accompanying declaration of Alicia Grahn Jones, of the 1,077 references included in Durrance’s Exhibit 1, 447 references or approximately 42% are references to Apple. *See Jones Dec. ¶ 6, Ex. B.* Moreover, a number of the references in Durrance’s Exhibit 1 are repeats. *Id. Ex. B.*

In sum, Mr. Durrance’s testimony misses entirely the issue of whether a *majority* of the relevant public understands the term APP STORE to be generic. Accordingly, and particularly when viewed in light of Apple’s conflicting proofs, *see infra*, Mr. Durrance’s declaration provides an insufficient basis for an award of summary judgment in Microsoft’s favor. *See In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d at 1571, 4 U.S.P.Q.2d at 1143 (“The mixture of usages unearthed by the NEXIS computerized retrieval service does not show, by clear evidence, that the financial community views and uses the term CASH MANAGEMENT ACCOUNT as a generic, common descriptive term for the brokerage services to which Merrill Lynch first applied the term.”).

**2. The References to APP STORE Collected in the Durrance Declaration Do Not Show, By Clear Evidence, that the Relevant Public Understands the Term APP STORE to be Generic.**

Even putting aside for the moment the flawed methodology by which Mr. Durrance collected and analyzed his results, even taken on their own terms these references do not establish by clear evidence that the relevant consuming public understands APP STORE to be a generic term.

As for the press references offered by Microsoft, the Board has long recognized that “writers . . . either through ignorance, carelessness or indifference frequently use a trademark in a generic sense.” *Formica Corp. v.*

*The Newman Corp.*, 149 U.S.P.Q. 585, 586 (T.T.A.B. 1966), *rev'd on other grounds*, 396 F.2d 486, 158 U.S.P.Q. 104 (C.C.P.A. 1968). Of course, the problem recognized by the Board in *Formica* over forty years ago has only grown in significance. As the Board recently observed, “[t]oday, with a 24-hour news cycle and 24/7 online global activity, undoubtedly many trademarks are misused repeatedly, perhaps, in part, because there is less time for editing and reflection before news reports or blog posts are released, and, in part, because what was the casual spoken word between people is now the written word posted to the world.” *In re Trek 2000*, 97 U.S.P.Q.2d at 1113.

Further, Microsoft has not offered any evidence concerning the degree to which the materials upon which Mr. Durrance relies have actually been received by the relevant public. In fact, many of the references selectively quoted by Microsoft appear to be published by entities that are so obscure that it is impossible to determine whether their use of APP STORE could possibly have any discernible impact of consumer perception of the term. For example, among the snippets of internet content quoted in Mr. Durrance’s declaration include references published by websites named “FierceMobile Content,” Durrance Dec. Ex. 14, at 2, a blog named “androinica,” *Id.* Ex. 14, at 7, “gigaom,” *Id.* Ex. 14, at 9, “fudzilla,” *Id.* Ex. 14, at 18, “snapvoip,” *Id.* Ex. 14, at 22, “brighthand,” *Id.* Ex. 14, at 22, “mobilwhack,” *Id.* Ex. 16, at 18, and many other equally obscure websites.

As the Board has remarked, “the evidentiary value of the Internet articles, books, and third-party websites, to the extent such evidence has been offered to show consumer perception of [the mark at issue], is limited, because the audience for those materials is not clear.” *Tea Bd. of India v. Republic of Tea Inc.*, 80 U.S.P.Q.2d 1881, 1900 n.28 (T.T.A.B. 2006). *See also Utah Lighthouse Ministry v. Found. for Apologetic Info. & Research*, 527 F.3d 1045, 1052, 86 U.S.P.Q.2d 1865, 1968 (10th Cir. 2008) (“Such evidence would have been more probative of consumer perceptions if the plaintiff had also presented ‘evidence as to the circulation of Ski Magazine, the regard in which likely consumers of [the plaintiff’s] services hold the magazine, or the percentage of those consumers that read the magazine. Likewise, in this case . . . [internet evidence] would support [the] claim . . . only if accompanied by some kind of evidence that the relevant market of consumers has visited the websites containing these hits.”) (internal citation omitted).

Finally, Microsoft argues that comments made by Apple’s Chief Executive Officer, Steve Jobs, support

Microsoft's argument that APP STORE is generic. Opposer's Mot. for Summ. J. 16. Here as well Microsoft fails to provide any evidence as to whether such statements, which in fact were made during an earnings call to the investment community, were even heard by any sizeable number of consumers of mobile applications. Given the limited audience for such earnings statements, the most reasonable inference is that they could not possibly have had any meaningful impact on consumer perception of the term APP STORE. See *Zimmerman*, 70 U.S.P.Q.2d at 1434-35 (generic uses of the term "REALTOR" by federal judges in published legal opinions entitled to little weight because such references likely had little impact on the public's perception of the term).

Taken together, Microsoft's proofs *at most* show that the term APP STORE conveys the characteristics of Apple's online software marketplace (*i.e.*, a portal wherein consumers can evaluate and thereafter license software programs). See *In re Gyulay*, 820 F.2d 1216, 1217, 3 U.S.P.Q.2d 1009, 1009 (Fed. Cir. 1987) (A mark is "merely descriptive" if it "immediately conveys . . . knowledge of the ingredients, qualities, or characteristics of the goods . . . with which it is used."). While APP STORE may well be an "apt name" for Apple's online software marketplace, "[a]ptness is insufficient to prove genericness." See *In re Am. Food Co.*, Ser. No. 76/101,362, 2004 WL 2368423, at \*4 (reversing examiner's conclusion that the term THE BEEF JERKY OUTLET for retail store services featuring beef snacks was generic).

**IV. APPLE'S CONFLICTING EVIDENCE ESTABLISHES THAT THERE IS AT LEAST A GENUINE ISSUE FOR TRIAL REGARDING WHETHER THE RELEVANT PUBLIC PREDOMINANTLY UNDERSTANDS APP STORE TO BE A TRADEMARK.**

As detailed above, Microsoft's proofs fall far short of establishing by clear and convincing evidence that the primary significance of the term APP STORE to a substantial majority of the relevant public is as a generic term. Accordingly, its motion should be denied without any proofs from Apple. However, Apple does not rest its opposition on the manifold defects apparent in Microsoft's evidence. Rather, Apple submits *affirmative evidence* that serves to remove any possible doubt that there is *at least* a genuine issue of material fact as to whether a *majority* of the relevant public primarily understands the term APP STORE as a brand name, and not the common term for the class of services at issue.

**A. Apple Was the First to Use the Term APP STORE in Connection with an Online Software Marketplace.**

Microsoft does not dispute that Apple was the first to use the term APP STORE in connection with an

online software marketplace. Before Apple’s launch of its APP STORE service, mobile operators and others offered mobile users the opportunity to download applications such as ringtones, wallpaper and games. These services were branded and described with terms that bore no similarity to APP STORE. La Perle Dec. ¶ 5.

When it launched, the APP STORE service represented a different kind of online software service and it was an instant commercial and critical success. As David Pogue, technology columnist for *The New York Times*, noted “[n]othing like the App Store has ever been attempted before.” David Pogue, *Pogue's Posts: A Candy Store for the iPhone*, N.Y. TIMES, July 17, 2008. See also Laura M. Holson, *Cellphone Carriers Relax Grip on Content*, N.Y. TIMES, Aug. 4, 2008, at C1 (calling the APP STORE “nothing short of revolutionary”). La Perle Dec. Exs. 2-3. As a complement to its revolutionary service, Apple coined a new term, APP STORE, to refer exclusively to its new service. La Perle Dec. ¶ 9.<sup>10</sup>

Accordingly, and in marked contrast to Microsoft’s adoption of its WINDOWS mark, this is not a situation where the mark was void *ab initio* because it existed as a generic term prior to its adoption as a trademark. Cf. *Harley Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 811, 49 U.S.P.Q.2d 1458, 1461 (2d Cir. 1999) (“Even the presumption of validity arising from federal registration . . . cannot protect a mark that is shown on strong evidence to be generic as to the relevant category of products prior to the proprietor's trademark use and registration.”) (citation omitted).

There can be no question that the phenomenal popularity of the APP STORE service has made it the gold standard by which other online software marketplaces are judged. That this is so, however, hardly constitutes grounds for declaring APP STORE generic.

**B. Dr. Leonard’s Declaration, at a Minimum, Establishes a Genuine Issue of Fact as to Whether the term APP STORE is Understood by the Relevant Public as a Mark.**

In stark contrast to the non-scientific, cherry-picked references submitted by Microsoft’s outside counsel, Apple offers a declaration from a renowned linguist who, applying scientific method, provides a

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<sup>10</sup> As detailed in Mr. La Perle’s declaration, a company named Salesforce.com, Inc. announced that it planned to brand one of its services with the mark APPSTORE as a feature of its APPEXCHANGE application service provider services and filed an intent-to-use trademark application for this mark. Salesforce never commenced offering the service under the APPSTORE mark and ultimately abandoned its trademark application. La Perle Dec. ¶ 41.

*comprehensive* assessment of the use of the term APP STORE, *i.e.*, an assessment that reveals both brand and generic uses of the term. Based upon his evaluation, Dr. Leonard concludes that the *predominant* usage of the term APP STORE is as a proper noun to refer to Apple’s online software marketplace. Leonard Dec. ¶ 23.

Dr. Leonard analyzed references to APP STORE appearing in The Corpus of Contemporary American English (“COCA”), 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* during the years 1990-2010. *Id.* ¶¶ 11, 13, 23, 31. Dr. Leonard explains, “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; as such, it is accepted among experts in the field of sociolinguistics as representative of current language use.” *Id.* ¶ 13. Dr. Leonard’s review of this database established that **88%** of the references to APP STORE in that database constitute references to Apple’s APP STORE service. *Id.* ¶ 31.

Based upon his review of the LexisNexis databank, Dr. Leonard concludes “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.” *Id.* ¶ 26 (emphasis added). Dr. Leonard’s analysis of the LexisNexis search results reveals that 86% of the APP STORE references in the materials Dr. Leonard sampled refer specifically to Apple’s APP STORE service. *Id.* ¶ 30.

Further, and as corroboration of the results he obtained through his analysis of COCA and LexisNexis databases, Dr. Leonard surveyed references to APP STORE returned through the Google search engine. As with his other analyses, Dr. Leonard’s analysis of the search results yielded by the Google search engine reflect the fact that the vast majority of uses of the term APP STORE in fact refer to specifically to Apple’s APP STORE services. *Id.* ¶ 32. Based upon his analyses of the databases he reviewed, Dr. Leonard attests, with “a high degree of certainty, that the *predominant* usage of the term APP STORE is as a proper noun to refer to Apple’s online application marketplace.” *Id.* ¶ 33 (emphasis added).

Dr. Leonard’s analysis makes plain that Microsoft offers the Board only a self-serving sliver of the total uses of APP STORE. Dr. Leonard’s more complete analysis, which is rooted in scientific method, shows that the types of uses identified by Microsoft are in fact in the minority; the vast majority of uses of the term refer

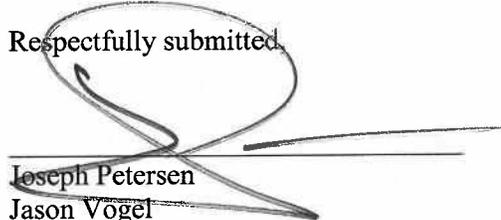
specifically to Apple's groundbreaking service and as such refute Microsoft's contention that the term is generic. See *Books on Tape, Inc. v. Booktape Corp.*, 836 F.2d 519, 520, 5 U.S.P.Q.2d 1301, 1302 (Fed. Cir. 1987) (rejecting genericness challenge to the term BOOKS ON TAPE for cassettes on which books are recorded, basing such finding on the fact that "[w]hile there have been some vernacular uses of 'books on tape' in newspaper articles, *the great majority of those materials concern only petitioner* and the fact that petitioner originated a new industry.") (emphasis added).

**CONCLUSION**

Microsoft has failed to meet its high burden of proof necessary for it to prevail on summary judgment. At a minimum, Apple has demonstrated the existence of genuine issues of fact concerning whether the primary significance of the term APP STORE to a substantial majority of the relevant public is as a source identifier for Apple's online marketplace featuring downloadable software programs.

Respectfully submitted,

Dated: February 28, 2011



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**APPENDIX**  
**BOARD DECISIONS**



2002 WL 140168 (Trademark Tr. &amp; App. Bd.)

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2002 WL 140168 (Trademark Tr. &amp; App. Bd.)

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board  
Patent and Trademark Office (P.T.O.)

INTERPAYMENT SERVICES LIMITED

v.

DOCTERS &amp; THIEDE

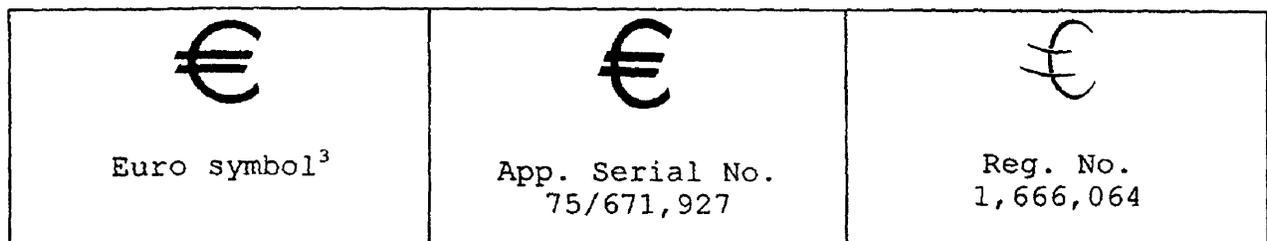
Opposition No. 119,852

January 31, 2002

Before Cissel, Wendel, and [Rogers](#)  
Administrative Trademark Judges.

By the Board:

On August 9, 2000, Interpayment Services Limited filed a Notice of Opposition to registration of the mark set forth in Application Serial No. 75/671,927<sup>[FN1]</sup> on the grounds that (i) applicant's proposed mark, when used in connection with financial goods and services, so resembles opposer's previously used and registered design mark for banking services (Registration No. 1,666,064<sup>[FN2]</sup>) as to be likely to cause confusion, mistake or deception; and (ii) applicant's proposed mark is identical or substantially similar to the symbol adopted by the European Union for the euro, the new common European currency, and thus is incapable of acting as a trademark. The designs at issue in this case are reproduced below:

<sup>[FN3]</sup>

On August 13, 2001, opposer filed a motion seeking summary judgment on the grounds that applicant's proposed mark, because of its similarities to the euro symbol, is generic or merely descriptive of applicant's financial goods and services.

**Construction of Pleadings**

As noted above, the opposition was brought on the grounds that applicant's proposed mark is likely to be con-

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fused with opposer's previously used and registered mark, and that applicant's proposed mark so closely resembles the euro symbol as to be incapable of acting as a trademark. This latter ground does not clearly identify a legally cognizable basis for opposition.

To reach the merits of this case, we construe the pleaded claim that applicant's proposed mark is incapable of acting as a trademark as a claim that applicant's proposed mark is generic.<sup>[FN4]</sup> Specifically, we view the claim that applicant's mark so closely resembles the euro symbol as to be incapable of acting as a trademark as intended to assert that applicant's mark so closely resembles the euro symbol as to be considered the functional equivalent thereof, and generic when used in connection with applicant's financial goods and services, which, *inter alia*, convert other currencies into euros and euros into other currencies.<sup>[FN5]</sup> See *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1557, 4 USPQ2d 1141 (“Generic terms, by definition incapable of indicating source, are the antithesis of trademarks, and can never attain trademark status”).

Applicant, in its answer, contends that opposer lacks standing to bring the genericness claim. In the Notice of Opposition, opposer asserts that it is “a financial services company that provides a variety of banking services in the United States and elsewhere in the world”; that opposer “provides international money transfer and foreign exchange services, including the issuance, collection, administration and processing of travelers cheques, international money orders, bank drafts, wire transfers, and lines of credit”; and that applicant's proposed mark “is identical or substantially similar to the symbol adopted by the European Union for the euro, the new common European currency”. Accordingly, we find that opposer has pleaded its need to use the euro symbol in its financial services business and thus has pleaded facts that, if proven, would establish opposer's standing to oppose. *James River Petroleum, Inc. v. Petro Stopping Centers, L.P.*, 57 USPQ2d 1249 (TTAB 2000) (“When a plaintiff challenges a mark on the ground of descriptiveness and/or genericness, ... the plaintiff may establish its standing by pleading [and later proving] that it is engaged in the sale of the same or related products or services [or that the product or service in question is within the normal expansion of the plaintiff's business], and that the plaintiff has a competitive need or equal right to use the term in a descriptive manner...”).

### **Motion For Summary Judgment**

\*2 We turn to the motion for summary judgment on the grounds that applicant's proposed mark, because of its similarities to the euro symbol, is generic or merely descriptive of applicant's financial goods and services. On the ground of genericness, opposer argues that applicant's proposed mark is the generic symbol for the euro currency; that the euro symbol is generic for the central feature of goods and services that convert other currencies to euros or convert euros to other currencies; and that the term euros, or equivalent symbol

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would be so recognized by the relevant purchasers as the generic symbol for currency conversion goods and services. Therefore, opposer asserts, it should be freely available for use by competitors of applicant.

In support of its motion, opposer submits 23 pages printed from the European Union's website in which the euro, its symbol, and its origin are discussed, including an enlarged version of the euro symbol reprinted earlier herein; a copy of the drawing page for application Serial No. 75/671,927, with the mark also reprinted herein; one page from applicant's website showing use of applicant's proposed mark in connection with services offering an electronic currency whereby consumers can deposit US dollars to purchase items priced in Deutsch marks; the August 10, 2001 deposition testimony of Rob Docters, a partner in the applicant partnership, stating that applicant's services will license software that converts currency, including the euro; the declaration of Duncan

Walker, General Counsel for opposer, stating that opposer and other financial services companies located in the United States and around the world use the euro symbol “to identify transactions or monetary valuations in that currency”; a series of printouts from webpages describing the efforts of computer and software businesses to offer customers the use of the euro symbol on their computers; and a series of newspaper articles indicating that the introduction of the euro and the euro symbol has received widespread publicity in the U.S.<sup>[FN6]</sup>

In opposing entry of summary judgment for opposer on the claim that its proposed mark is generic, applicant argues that its mark is not identical to the euro symbol, but that, even if it were identical, applicant has not applied to register its mark for currency or negotiable instruments, and the record contains no evidence that the public perceives the euro symbol as generic when applied to computer software for use in on-line financial transactions; computer hardware and software that disperses and creates digital cash; magnetically encoded credit and debit cards; magazines in the field of finance; or on-line financial transaction services, namely electronic cash transactions, electronic credit card transactions, and electronic debit transactions.

In support of its position, applicant relies on the August 10, 2001 deposition testimony of Rob Docters, a partner in the applicant partnership, who describes how applicant's mark differs from the euro symbol, and states that applicant's services will support all established currencies, not just euros. Applicant also relies on printouts of PTO electronic records of 14 current or past trademark applications and certain registrations incorporating currency symbols.<sup>[FN7]</sup>

**\*3** The burden is on the party moving for summary judgment to show the absence of a genuine issue of material fact, and that it is entitled to judgment as a matter of law. See *Fed. R. Civ. P. 56*. The Board may not resolve issues of material fact against the non-moving party. See *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996); *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993); and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). To prevail on its motion for summary judgment, opposer must establish that there is no genuine issue of fact regarding the genus of the goods or services at issue and that the relevant consuming public understands applicant's proposed mark to refer primarily to that genus of goods or services. See *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

After careful consideration of the evidentiary submissions presented by each party, we find that no genuine issues of material fact exist and that applicant's proposed mark, even if considered identical to the euro symbol, is not generic for computer software for use in on-line financial transactions; computer hardware and software that disperses and creates digital cash; magnetically encoded credit and debit cards; magazines in the field of finance; or on-line financial transaction services, namely electronic cash transactions, electronic credit card transactions, and electronic debit transactions. The ample record evidence showing the public perception of the euro symbol shows a public association of the euro symbol as generic designation for a type of currency, and not for the goods and services with which applicant intends to use the proposed mark.

Accordingly, we find, *sua sponte*, that applicant is entitled to summary judgment in its favor on opposer's claim that applicant's mark is generic as applied to applicant's financial goods and services. That is, even though applicant has not filed a cross-motion for summary judgment on this issue, we grant summary judgment to applicant, i.e. judgment on the claim that the mark is generic as applied to applicant's goods and services. See *The Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098 (TTAB 1996); *Accu Personnel Inc. v. Accustaff Inc.*, 38 USPQ2d 1443 (TTAB 1996).

We turn to the motion for summary judgment on the ground that applicant's proposed mark, because of its similarities to the euro symbol, is merely descriptive of applicant's financial goods and services, which, *inter alia*, convert other currencies into euros and euros into other currencies. As noted above, the opposition was brought on the claims that applicant's proposed mark was likely to be confused with opposer's previously used and registered mark, and that applicant's proposed mark so closely resembled the euro symbol as to be incapable of acting as a trademark. While we construed the latter ground liberally, so as to be able to consider the motion for summary judgment on the claim of genericness, we find no references, express or implied, in the Notice of Opposition to Section 2(e)(1) or mere descriptiveness.

\*4 Notwithstanding the evidence submitted with opposer's motion for summary judgment regarding the descriptiveness of the euro symbol as applied to applicant's financial goods and services, a party may not obtain summary judgment on an issue which has not been pleaded. *See Fed. R. Civ. P. 56(a) and 56(b); Paramount Pictures Corp. v. White*, 31 USPQ2d 1768 (TTAB 1994).<sup>[FN8]</sup> However, rather than deny opposer's motion for summary judgment, we defer consideration until the issue of descriptiveness has been properly pleaded.

Opposer is given leave to amend its pleading solely for the purpose of adding the claim that applicant's proposed mark, because of its similarities to the euro symbol, is merely descriptive of applicant's financial goods and services.<sup>[FN9]</sup>

Opposer is allowed 30 days from the date stamped on this order to file an amended notice of opposition as described above, failing which the remaining basis for the motion for summary judgment will be denied and discovery and trial dates will be reset only with regard to the Section 2(d) claim.

Applicant is allowed until 60 days from the date stamped on this order in which to file its answer to the anticipated amended pleading and its response to opposer's motion for summary judgment on the issue of mere descriptiveness. If opposer does not amend its pleading, applicant need not file either an amended answer or response to the motion. If opposer does amend its pleading and applicant fails to answer and contest the motion for summary judgment, then judgment may be entered against applicant on the descriptiveness claim.

## Conclusion

To reprise the status of the various claims discussed herein, we note that the Section 2(d) claim awaits trial; that judgment has been entered in favor of applicant, the non-moving party, on the claim that the proposed mark is generic<sup>[FN10]</sup>; that a claim under Trademark Act Sections 1, 2, 3 and 45 that the proposed mark fails to function as a trademark would be premature until there is use of the proposed mark in connection with the listed goods and services; and that opposer must amend the pleadings before the Board may consider the summary judgment motion on, or trial of, the claim that the mark is merely descriptive as applied to applicant's goods and services.

FN1. Application Serial No. 75/671,927 was filed on March 30, 1999 under Trademark Act Section 1(b) based on applicant's assertion of a *bona fide* intention to use the mark in commerce in connection with:

Computer software for use in on-line financial transactions; computer hardware and software that disperses and creates digital cash; magnetically encoded credit and debit cards (Int. Cl. 9).

Art prints and publications, namely magazines in the field of finance (Int. Cl. 16).

On-line financial transaction services, namely electronic cash transactions, electronic credit card transactions, and electronic debit transactions (Int. Cl. 36).

FN2. Registration No. 1,666,064 issued November 26, 1991 for “banking services, namely, issuance, collection, administration, and processing of travelers cheques, international money orders, negotiable bank drafts, checks, wire transfers, lines of credit” (Int. Cl. 36).

FN3. In the general information provided to the public regarding its new currency (“EURO ESSENTIALS”), the European Union defines and provides examples of the graphic symbol for the euro. The image shown above was copied by the Board from the European Union's website at <http://europa.eu.int/euro/html>.

FN4. The pleaded claim that applicant's proposed mark is incapable of acting as a trademark also could be construed as a claim that the applicant's mark does not function as a trademark under §§1, 2, 3 and 45 of the Act. See, e.g., *In re Volvo Cars of North America, Inc.*, 46 USPQ2d (TTAB 1998) (DRIVE SAFELY held incapable of functioning as a mark); *In re Remington Products Inc.*, 3 USPQ2d 1714 (TTAB 1987) (PROUDLY MADE IN USA held incapable of functioning as a mark). However, insofar as the instant application is based on applicant's assertion of a *bona fide* intention to use the mark in commerce, a claim that the proposed mark fails to function as a trademark is premature. See *Michael S. Sachs, Inc. v. Cordon Art, B.V.*, 56 USPQ2d 1132 (TTAB 2000).

FN5. We note that this construction is supported by opposer's motion for summary judgment on the ground of genericness.

FN6. Under Fed. R. Civ. P. 56(e), the Board may permit the parties to supplement their summary judgment affidavits or to submit additional affidavits. We exercise our discretion under the rule in favor of considering the additional evidence offered with opposer's reply brief, namely the affidavit from opposer's attorney supporting opposer's summary judgment evidence, including the web site printouts and Nexis articles. See *Shalom Children's Wear Inc. v. In-Wear A/S*, 26 USPQ2d 1516 (TTAB 1993).

FN7. In each instance the degree of stylization of the marks, the presence of other elements in the marks, or the goods and services with which the marks are used, varied widely from the mark and goods at issue here. Thus, these trademark applications or registrations were accorded no weight in reaching our decision herein.

FN8. An exception lies where the parties, upon summary judgment motion, have treated an unpleaded issue on its merits. However, as opposer acknowledges in its reply brief (p.1), applicant does not address the mere descriptiveness claim or opposer's supporting evidence in its response to the motion for summary judgment. Thus, the unpleaded claim of mere descriptiveness has not been treated on the merits and the Board cannot deem the pleadings to have been amended by agreement of the parties to allege mere descriptiveness.

FN9. A party which seeks summary judgment on an unpleaded issue may move to amend its pleading to assert the matter. See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993).

FN10. The genericness claim is dismissed with prejudice.



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THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board  
Patent and Trademark Office (P.T.O.)

LOCKERMATE CORPORATION

v.

RACHEL MARIE CURTIS

Opposition No. 115,439

April 30, 2002

Before Simms, [Quinn](#) and [Hairston](#)  
Administrative Trademark Judges

By the Board:

Racheal Marie Curtis seeks to register the mark LOCKERPAL (in stylized form as shown below),

# LOCKERPAL

for “collapsible stand for school lockers consisting primarily of movable shelves.” <sup>[FN1]</sup> Registration has been opposed by Lockermate Corporation on the grounds that applicant's mark so resembles its previously used corporate and trade name, LOCKERMATE, and its previously used and registered marks, LOCKERMATE (in stylized form)<sup>[FN2]</sup> and LOCKER MATE (in stylized form)<sup>[FN3]</sup>; and LOCKER family of marks, (i.e., LOCKERBOXX (in stylized form)<sup>[FN4]</sup>; LOCKERMIRROR (in stylized form)<sup>[FN5]</sup>; LOCKERNOTES (in stylized form)<sup>[FN6]</sup>; LOCKERMATE PENCIL BOXX (in stylized form)<sup>[FN7]</sup>; LOCKER LINER (in stylized form)<sup>[FN8]</sup>; LOCKERMATE ADJUST-A-SHELF (in stylized form)<sup>[FN9]</sup>; LOCKER POCKETS<sup>[FN10]</sup>; and LOCKER MAGNETS (in stylized form),<sup>[FN11]</sup> all for use on or in connection with goods similar to those of applicant's, as to be likely, when used in connection with applicant's goods, to cause confusion, or to cause mistake, or to deceive.

Opposer has also alleged that its LOCKERMATE mark, family of “LOCKER” marks, trade name and corporate name, LOCKERMATE, are distinctive, well known and famous in the marketplace for its goods and that applicant's use of the LOCKERPAL mark dilutes the distinctive quality and reputation of opposer's marks and the goods associated therewith. <sup>[FN12]</sup>

Applicant, in its answer, has denied the salient allegations of the notice of opposition. Applicant has also asserted a counterclaim against the marks, LOCKERBOXX (Registration No. 1,636,557); LOCKERMIRROR (Registration No. 1,669,939); LOCKERNOTES (Registration No. 1,667,254)<sup>[FN13]</sup>; LOCKER LINER (Registration No. 1,980,309); and STUDENT LOCKER KIT (Registration No. 1,852,092), on the ground that these marks are the generic designations of

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the goods sold under each of the marks.

Opposer, in its answer to the counterclaim, has denied the salient allegations thereof.

This case now comes up for consideration of applicant's motion for summary judgment on both the notice of opposition and the counterclaim. The motion is fully briefed.

Preliminarily, it is noted that opposer/counterclaim defendant has permitted Registration No. 1,852,092 for the mark, STUDENT LOCKER KIT, to be cancelled under Section 8 of the Trademark Act.

Accordingly, the Board will not consider applicant's motion for summary judgment on the counterclaim as it regards this registration. Additionally, opposer/counterclaim defendant is allowed until **thirty days** from the mailing date of this order to show cause why such cancellation should not be deemed to be the equivalent of a cancellation by request of opposer/counterclaim defendant without the consent of the adverse party, and should not result in entry of judgment against opposer/counterclaim defendant as provided by [Trademark Rule 2.134\(a\)](#). In the absence of a showing of good and sufficient cause, judgment as to Registration No. 1,852,09 may be entered against opposer/counterclaim defendant. See [Trademark Rule 2.134\(b\)](#).

\*2 If, in response to this order, opposer/counterclaim defendant submits a showing that its failure to file a Section 8 affidavit was the result of inadvertence or mistake, judgment as to Registration No. 1,852,092 will not be entered against it.

In that case, applicant/counterclaim plaintiff will be given time in which to elect whether it wishes to go forward with the counterclaim against Registration No. 1,052,092, or to have the counterclaim against said registration dismissed without prejudice as moot. See *C. H. Guenther & Son Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450 (TTAB 1988) and TBMP § 602.02(b).

Turning back to applicant's motion for summary judgment as it concerns the notice of opposition, applicant essentially argues that there is no genuine issue of material fact regarding the absence of a likelihood of confusion between the parties' asserted marks.<sup>[FN14]</sup>

In response, opposer argues that there are issues of material fact (i.e., whether opposer's use and promotion of the "LOCKER"/"LOCKERMATE" family of marks is indicative of origin, the fame of opposer's pleaded marks, and whether opposer's pleaded marks are arbitrary and entitled to a wide scope of protection) which preclude a grant of summary judgment.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See *Fed. R. Civ. P. 56(c)*. Applicant, as the party moving for summary judgment, has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986). The evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993).

After reviewing the parties' arguments and supporting evidence, we find that there are genuine issues of material fact that preclude disposition of the opposition by summary judgment. At a minimum, there exist issues of material fact as to whether opposer has developed a family of "Locker" marks, as to the strength of opposer's pleaded marks<sup>[FN15]</sup>, and as to the fame of opposer's marks.

In view thereof, applicant's motion for summary judgment on the opposition is denied.

We now consider applicant's motion for summary judgment on the counterclaim on the ground that there is no genuine issue of material fact that the terms LOCKERBOXX; LOCKERMIRROR; LOCKERNOTES; and LOCKER LINER are the generic designations of the goods sold thereunder.

In response, opposer argues that the marks are not generic and that the issue of descriptiveness versus genericness has been addressed during the prosecution stage of the underlying applications, and the marks are capable of identifying the source of the goods. Additionally, as regards the LOCKERMIRROR mark, opposer argues that the issue of whether the mark is generic was decided by the Board in a previous decision, and that the mark is capable of distinguishing opposer's goods from goods of others.

\*3 After a careful review of the parties' arguments and supporting evidence, and again drawing all inferences in favor of opposer as the non-moving party, we find that applicant has not met its burden of showing that it is entitled to disposition of the counterclaim by summary judgment. Notably, applicant, as the party contending that the terms LOCKERBOXX, LOCKERMIRROR, LOCKERNOTES, and LOCKER LINER are generic bears the burden of establishing by clear and convincing evidence the absence of any genuine issue of material fact that these designations are generic. *See, e.g., In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Additionally, the court in *In re Merrill Lynch*, citing to *In re Automatic Radio Manufacturing Co., Inc.*, 404 F.2d 1391 (CCPA 1969), stated that "it seems elementary that one must find out how people in the trade and the purchasers use the term with respect to the involved goods in order to determine whether or not they are descriptive [or generic]." *Id.* at 1142. Evidence of the public's understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications. *In re Northland Aluminum Products*, 777 F.2d 1556, 1559, 227 USPQ 961, 963 (Fed. Cir. 1985); and *Dan Robbins & Associates, Inc. v. Questor Corp.*, 559 F.2d 1009, 1014, 202 USPQ 100, 105 (CCPA 1979).

In this instance, applicant has provided relatively little evidence to show that the terms are generic. For example, as evidentiary support for its assertion that the designation LOCKERBOXX is generic, applicant has submitted the dictionary definitions of the terms "locker" and "box," and only three printouts from Internet sites showing use of the term "locker box." <sup>[FN16]</sup> Moreover, it is unclear from these scant submissions whether the term is used in a descriptive or generic manner. Such evidence falls far short of establishing the absence of a genuine issue of material fact for trial. At a minimum, there exist genuine issues of material fact as to the relevant public's perception of the terms LOCKERBOXX, LOCKERMIRROR, LOCKERNOTES, and LOCKER LINER with regard to the goods sold respectively thereunder, and as to whether those terms are generic. In our opinion, these issues will have to be resolved only after the parties have had an opportunity to submit their proofs at trial.

In view of the foregoing, applicant's motion for summary judgment on the counterclaim is denied.

Discovery having already closed, trial dates only are reset as indicated below.

THE PERIOD FOR DISCOVERY TO CLOSE:	CLOSED
Testimony period for plaintiff in the opposition to close: (opening 30 days prior thereto)	July 15, 2002
Testimony period for defendant in the opposition and	September 13, 2002

plaintiff in the counterclaim to close:  
(opening 30 days prior thereto)

Testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff in the opposition to close:  
(opening 30 days prior thereto)      November 12, 2002

Rebuttal testimony period for plaintiff in the counterclaim to close:  
(opening 15 days prior thereto)      December 27, 2002

**\*4** IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party WITHIN THIRTY DAYS after completion of the taking of testimony. [Trademark Rule 2.125](#) .

In accordance with the provisions of [Trademark Rule 2.128\(a\)\(2\)](#), briefs shall be due as follows.

Brief for plaintiff in the opposition shall be due:      February 25, 2003

Brief for defendant in the opposition and plaintiff in the counterclaim shall be due:      March 27, 2003

Brief for defendant in the counterclaim and reply brief, if any, for plaintiff in the opposition shall be due:      April 26, 2002

Reply brief, if any, for plaintiff in the counterclaim shall be due:      May 11, 2003

If the parties stipulate to any extension of these dates, the papers should be filed in triplicate and should set forth the dates in the format shown in this order. See [Trademark Rule 2.121\(d\)](#).

An oral hearing will be set only upon request filed as provided by [Trademark Rule 2.129](#).

FN1. Application Serial No. 75/537,747 filed August 17, 1998 and reciting April 15, 1996 as the date of first use of the mark and June 7, 1998 as the date of first use of the mark in commerce.

FN2. Registration No. 1,858,626 for “shelf assembly, holder for personal items, mirror,” issued October 18, 1994, Section 8 and Section 15 affidavits filed, and reciting August 22, 1993 as the date of first use and date of first use of the mark in commerce. The mark is lined for the color red, but no claim is made to the color of the mark.

FN3. Registration No. 1,291,090 for “shelf assembly having a pair of shelves releasably mounted on upright rails,” issued August 21, 1984, Section 8 affidavit accepted, Section 15 affidavit acknowledged, and reciting August 2, 1983 as the date of first use and date of first use of the mark in commerce.

FN4. Registration No. 1,636,557 on the Supplemental Register for “plastic container or holder for personal items,” issued

February 26, 1991, first renewal December 19, 2001, and reciting November 18, 1988 as the date of first use and date of first use of the mark in commerce.

FN5. Registration No. 1,669,939 on the Supplemental Register for “mirrors,” issued December 24, 1991, Section 8 affidavit accepted, and reciting April 10, 1988 as the date of first use and date of first use of the mark in commerce.

FN6. Registration No. 1,667,254 on the Supplemental Register for “paper note pads,” issued December 3, 1991, Section 8 affidavit accepted, and reciting January 15, 1991 as the date of first use and date of first use of the mark in commerce.

FN7. Registration No. 1,681,227 for “plastic containers or holders for personal items,” issued March 31, 1992, Section 8 affidavit accepted, Section 15 affidavit acknowledged, and reciting January 18, 1991 as the date of first use and date of first use of the mark in commerce. The term “Pencil Boxx” has been disclaimed.

FN8. Registration No. 1,980,309 on the Supplemental Register for “self-adhesive removable paper for use in lockers,” issued June 11, 1996, and reciting December 7, 1994 as the date of first use and date of first use of the mark in commerce. The mark is lined for the color red, but no claim is made to the color of the mark.

FN9. Registration No. 2,024,784 for “plastic pre-assembled legless shelf units used within lockers,” issued December 24, 1996, and reciting May 1, 1993 as the date of first use and date of first use of the mark in commerce.

FN10. Registration No. 2,058,840 for “nylon pouches for holding personal items in lockers,” issued May 6, 1997, and reciting May 31, 1996 as the date of first use and date of first use of the mark in commerce. The term “Locker” has been disclaimed.

FN11. Registration No. 2,117,061 on the Supplemental Register for “plastic disks holding magnets for retaining objects on a ferrous metal support,” issued November 25, 1997, and reciting April 28, 1996 as the date of first use and date of first use of the mark in commerce. The mark is lined for the color yellow.

FN12. The Board notes that opposer's allegation of dilution is legally insufficient, inasmuch as there is no allegation as to when opposer's mark became famous. See *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000). See also, *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164 (TTAB 2001). If opposer intends to pursue its claim of dilution, the notice of opposition must be amended accordingly. In this regard, opposer is allowed until **THIRTY DAYS** from the mailing date of this order to file an amended notice of opposition, failing which no further consideration will be given to the dilution claim.

FN13. The Board notes that applicant, although referring to the LOCKERNOTES mark as one of the marks against which it has filed a counterclaim, cited to an incorrect registration number therefor, i.e., Registration No. 2,058,840 instead of Registration No. 1,667,254. Applicant is allowed until **THIRTY DAYS** from the mailing date of this order to file an amended counterclaim correcting this error.

FN14. Applicant also argues that its applied-for mark does not dilute the distinctiveness of opposer's pleaded marks. However, and as stated herein at footnote 12, opposer has inadequately pleaded its dilution claim. Accordingly, no consideration has been given to the parties' arguments on that issue. See generally, TBMP § 528.07(a) and the authorities cited therein.

FN15. In this regard, we note that while the excerpted search report results, and other electronically generated evidence of third-party uses of the term “Locker” with other matter, submitted by applicant are sufficient to raise a genuine issue of material fact as to the nature and extent of such third-party use, see, e.g., *Lloyd's Food Products Inc. v. Eli's Inc.*, 987

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[F2d 766, 25 USPQ2d 2027 \(Fed. Cir. 1993\)](#), this evidence is not competent to prove that opposer's pleaded marks are entitled to only a narrow scope of protection.

FN16. It appears that one of the printouts is merely an enlarged duplicate.

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END OF DOCUMENT



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THIS OPINION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board  
Patent and Trademark Office (P.T.O.)

WALTERS GARDENS, INC.  
v.  
PRIDE OF PLACE PLANTS, INC.

Opposition No. 91153755

Mail date: May 20, 2004

Before [Quinn](#), [Hohein](#) and [Bucher](#)  
Administrative Trademark Judges

By the Board:

Applicant is seeking to register the mark PIILU for “live plants.”<sup>[FN1]</sup> As grounds for the opposition, opposer alleges that applicant's mark is the cultivar name and, thus, the generic name for a *Clematis* plant.<sup>[FN2]</sup> Applicant, in its answer, denies the salient allegations of the notice of opposition.<sup>[FN3]</sup>

This case now comes up on opposer's fully-briefed motion, filed November 21, 2003, for summary judgment in its favor on the ground that applicant's mark is the cultivar name of a *Clematis* plant and, thus, the generic name of the goods.<sup>[FN4]</sup> In addition, applicant has filed objections to most of the evidence submitted by opposer, which we address first.

#### **Applicant's objections to evidence**

Applicant's objection to opposer's Exhibit Nos. 1 and 2 (photocopies of books) as unauthenticated is overruled. Applicant's objection to Exhibit No. 2 as not being introduced by way of a witness testifying to the truth, identification, or authenticity of such exhibit is overruled. [Trademark Rule 2.122\(e\)](#) allows the introduction of printed publications, including books. On summary judgment, said materials need not be introduced by way of notice of reliance or affidavit or declaration of a witness. *See* TBMP Section 528.05(e) (2<sup>nd</sup> ed. Rev. 1 March 2004). Both submissions contain appropriate information for self-authentication, including: title, editor or compiler, organization for whom materials were compiled, publisher, city of publishing, and copyright date. *Cf.* [Wright & Gold, 31 Federal Practice and Procedure: Evidence § 7140 \(2000\)](#), discussing Fed. R. Evi. 902(6), (“The rule extends to both domestic and foreign publications.”) We note that Exhibit No. 1 is published in the United Kingdom and is in English. Applicant's objections to opposer's Exhibit No. 1 that it allegedly evidences foreign use by applicant and that it may contain references in a language other than English are overruled.<sup>[FN5]</sup> To the extent applicant is objecting to Latin references to the genus and species of plants, and foreign terms used as the cultivar names of plants, applicant objection is without merit. Such references go to the practice in the field of naming plants and may be highly relevant to public perception in the United States of the term applicant seeks to register, and of the ultimate issue before us: whether the PIILU is the generic name of a *Clematis* plant.

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\*2 Applicant's objection to opposer's Exhibit Nos. 3, 6, 7, 8 and 9 (Internet printouts) as unauthenticated, and thus as hearsay, is overruled. Opposer has now submitted a declaration in support of said exhibits. See *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998). Cf. *Tampa Rico Inc. v. Puros Indios Cigars Inc.*, 56 USPQ2d 1382 (TTAB 2000) (“... this defect is curable...”). Applicant's objections to Exhibit Nos. 6-10 and 13 as allegedly evidencing foreign use by applicant and because they may contain references in a language other than English are overruled. For the most part, the references are also in English. In addition, as stated previously, Latin terms for genus and species, and foreign terms used as cultivar names, may be relevant to this proceeding.

Applicant's objection to opposer's Exhibit Nos. 4, 10, 11, 12, 13, 14 and 17 (responses to discovery requests, including produced documents) as unauthenticated is overruled. Trademark Rule 2.127(e)(2) permits the filing of responses to discovery requests, including produced documents, for purposes of summary judgment. See also TBMP Section 528.05(c) (2<sup>nd</sup> ed. Rev. 1 March 2004). Applicant's objections to Exhibit No. 13 as irrelevant because it allegedly evidences foreign use by applicant and because it may contain references in a language other than English are overruled for reasons stated previously. Applicant's objection to opposer's Exhibit No. 16 (copy of a periodical article) as unauthenticated is overruled. Trademark Rule 2.122(e) allows the introduction of printed publications, including excerpts from periodicals. On summary judgment, said materials need not be introduced by way of notice of reliance or affidavit or declaration of a witness. See TBMP Section 528.05(e) (2<sup>nd</sup> ed. Rev. 1 March 2004). The submission contains appropriate information for self-authentication: name of periodical, date of publication, page numbers, title to article, and author of article. Cf. Wright & Gold, *supra*, discussing Fed. R. Evi. 902(6), (“... no extrinsic evidence is required to authenticate printed materials purporting to be newspapers or periodicals.”)

Applicant's objection to opposer's Exhibit No. 5 (affidavit of Clarence H. Falstad, III) is overruled. Affidavits may be submitted on summary judgment even though they may be self-serving in nature and there is no opportunity for cross examination. See TBMP Section 528.05(b) (2<sup>nd</sup> ed. Rev. 1 March 2004).

Applicant's objection to opposer's Exhibit No. 15 as unauthenticated is sustained. The exhibit is composed of an apparent letter from applicant to opposer, dated 1998, and an accompanying press release. While such information may be introduced by way of affidavit or declaration or as discovery responses, the exhibit in question does not appear to be part of any discovery response. Although an affidavit was submitted in support of the exhibit, it does not establish the affiant's personal knowledge of the documents and his competency to testify to the matters therein. Instead, the affiant, who identifies himself as opposer's laboratory director, states only that he is familiar with the submissions by way of written and verbal correspondence with another of opposer's employees and by way of examination of the documents at issue. However, this does not establish affiant's. Why, for example, the affidavit of the addressee, an apparent employee of opposer, was not submitted is not explained.<sup>[FN6]</sup> See TBMP Sections 528.05(a)-(c) (2<sup>nd</sup> ed. rev'd March 2004).

\*3 Applicant's objection to opposer's Exhibit No. 18 as unauthenticated is moot. The exhibit appears to be a TESS printout from the Office database of the status of applicant's subject application Serial No. 76201447. At this time, such printouts may only be introduced on summary judgment by way of affidavit or declaration or by way of a discovery deposition. See *Id.* at subsections (a), (b), (c), and (e). Nonetheless, the application file is of record for all purposes, including summary judgment, in this opposition. See Trademark Rule 2.122(b); and TBMP Section 528.05(a) (2<sup>nd</sup> ed. Rev. 1 March 2004). Thus, the TESS printout is simply redundant information.

Applicant did not object to opposer's Exhibit No. 19, a copy of the notice of opposition, which is, of course, of record.

Applicant's objection to the cover pages of opposer's Exhibit Nos. 6-9 as out-of-court statements by an unidentified declarant offered for the truth thereof is overruled. The cover page to each exhibit is no more than an index identifying the

submissions made with the exhibit.

**Opposer's motion for summary judgment**

As general background in the plant naming field, opposer argues that plants are scientifically named according to the International Code of Botanical Nomenclature by providing a Latin genus and species name; that cultivars, or cultivated varieties, are plants that originated and persist due to human manipulation; that the International Code of Nomenclature for Cultivated Plants (hereinafter ICNCP), established in 1953, provides a framework for identifying, naming, registering and using cultivar names; that the ICNCP recognizes the difference between scientific names, which must be available in all countries for use by any person, and trademarks, which are not universally available for any person to use; that a cultivar status of a term is identified by placing the term between single quotation or downward vertical marks following the Latin genus name; that the Royal Horticultural Society (hereinafter RHS) is the international cultivar registration authority for *Clematis* names; and that the RHS registered the term PIILU as a cultivar for *Clematis* in the year 2000.

With respect to this particular case, opposer argues that Uno and Aili Kivistik, of Estonia, first developed the plant *Clematis* 'PIILU' in 1984, which they flowered in 1987 and named in 1988.<sup>[FN7]</sup> According to opposer, PIILU was registered by Aili Kivistik with the Estonian Plant Production Inspectorate Variety Control Department, which is the identified registering party of PIILU with the RHS; and The International Clematis Register and Checklist for 2002, published by RHS, acknowledges the Kivistik family and identifies the first published reference to *Clematis* 'Piilu' in a 1992 catalogue.

It is opposer's position that the plant industry is composed of four identifiable groups: organizations, businesses, hobbyists, and the media. Opposer contends that, because Internet offerings and catalogues are commonplace ways in which plants are marketed, purchasers in the United States often purchase plants from distant sellers, and have been exposed to use of the term PIILU used as a cultivar since as early as 1992, the first known published (foreign) reference and, as to references in the United States, at least since 1999. According to opposer, it has been offering the cultivar *Clematis* 'Piilu' since 2000. Opposer argues that applicant's own use of the term PIILU, like that of the Kivistik family, demonstrates that, until recently, they treated *Clematis* 'Piilu' as a cultivar name and not as a trademark. Opposer argues that, in response to its interrogatory request seeking from applicant information concerning "...the genus, species, subspecies, varietal, cultivar, common, and commercial names, if any, for the cultivar of *Clematis* sold and promoted in association with the PIILU mark," applicant stated it "...does not know the answer to this interrogatory request..." Subsequently, opposer argues, applicant, on September 19, 2003, submitted a notification of name change, apparently to opposer's attorney, which, opposer argues further, contradicts applicant's response to opposer's discovery request.

\*4 Opposer argues that, as the cultivar name for a *Clematis* plant, PIILU is the generic name for the plant and cannot be registered. Opposer's motion is accompanied by the following exhibits: International Code of Nomenclature for Cultivated Plants 1995; The International Clematis Register and Checklist 2002; printouts from applicant's website; various e-mail exchanges between the Kivistiks and applicant's president, Rick Sorenson; the affidavit of Clarence H. Falstad, III, laboratory director for opposer, describing, in part, his perception of and experience in the plant industry; website printouts from various *Clematis* organizations, both foreign and domestic, copies of web catalogues and Internet sites, both foreign and domestic, selling *Clematis* 'Piilu' without trademark designation; hobbyist websites including references to *Clematis* 'Piilu', such site appearing to be exclusively foreign; published articles from periodicals, accessed from websites, both foreign and domestic, referencing *Clematis* 'Piilu' from 2000-2003; Clematis Catalog 1999 from J. van Zoest, Holland; opposer's spring catalogs for the years 2000-2003 referencing *Clematis* 'Piilu'; copies of e-mail exchanges between applicant's president and third parties concerning awards won by the *Clematis* 'Piilu'; a copy of Aili Kivistik's 2003 authorization for Australian agent, identifying 'PIILU' as the variety and leaving blank "also known as," further specified as "breeder's code, trade name etc. for variety"; a copy of applicant's responses to opposer's second set of dis-

covery requests; a copy of a signed 1998 letter and accompanying press release from Mr. Sorenson, applicant's president, to opposer;<sup>[FN8]</sup> a copy of Mr. Sorenson's 1999 article in "American Nurseryman," Climbing the Walls, inconsistently referring to C. 'Piilu' and Piilu®; a copy of applicant's notification of change of name of cultivar; a TESS printout of the status and accompanying information of applicant's application; and a copy of the notice of opposition.

In response,<sup>[FN9]</sup> applicant indicates that it is the exclusive U.S. distributor and the owner of the trademark rights for the *Clematis* plants originating with the Kivistik family of Estonia. Applicant argues that PIILU is a well established trademark, its first international use being since 1992, and its use in the United States being since 1998. Applicant accuses opposer of using applicant's mark as a generic term, and of submitting no evidence that applicant's "...well-known mark PIILU is ... generic." Applicant argues that it widely licenses its mark in the U.S.; and that its mark is not found as a cultivar name in any U.S. or international database. Applicant argues that the RHS does not list applicant's mark as a cultivar in its database; that any alleged "registration" on an RHS checklist was done by a third party; that there is no requirement that applicant use a trademark notice every time it uses its mark; that use of its mark in single quotes does not result in "automatic genericide"; that opposer has not produced any surveys of consumer perception of the term PIILU; that the foreign uses establish the strength of applicant's mark; and that the foreign uses do not show that PIILU is a cultivar name in the United States.

\*5 Applicant's response is accompanied by the declaration of its attorney in support of twenty Internet printouts including: order forms from opposer's website wherein *Alcea r.* 'Peaches 'n' Dreams' is displayed inconsistently with *Alcea r.* 'Peaches 'n' Dreams'®; various catalogue or website sales offerings of applicant's *Clematis* plant showing uses of applicant's mark as Piilu, *Clematis* 'Little Duckling' "Piilu"® (Patens), *Clematis* Kivistik, Piilu, The Kivistik Collection Piilu t.m.; printouts from the Estonian Plant Production Inspectorate; a printout from the RHS plant selector database which found zero entries for the term piilu; a TESS printout and accompanying article concerning a mark (ENDLESS SUMMER) for live ornamental plants; a printout from opposer's website; an excerpt from the International Clematis Register for the disclaimer that "[I]nformation given in the Register can only be as good as that supplied by the registrant"; an excerpt of guidance notes for International Cultivar Registration Authorities; printouts showing the inconsistent uses of *Helleborus* Royal Heritage® and *Helleborus* 'Royal Heritage', of *Weigela Florida* 'wine & roses' and Wine & Roses® *Weigela*, of *Penstemon* 'Red Rocks' and *Penstemon x mexicali* 'Red Rocks'®, of Ambridge Rose® Cv. Auswonder, Pat Austin® Cv. Ausmum, Wenlock® Cv. Auswen and 'Ambridge Rose' (Auswonder), 'Wenlock' (Auswen) and a TARR printout for the registration of WENLOCK for live rose plants; various printouts showing terms used as trademarks and terms used as cultivars; printouts from various U.S. databases where plant names may be registered or listed; and search results from various databases. In addition, applicant's response is accompanied by a copy of a January 6, 2003 email from the Kivistik family to opposer expressing the Kivistik's position that Piilu has not become generic for their *Clematis* cultivar; that plants of the cultivar were given to members of The International Clematis Society during the 1998 visit, but no permission was given to members to propagate and sell in North America; that any sales by non-licensed growers are being done without permission; and that applicant may agree to sub-license opposer to grow the *Clematis* cultivars. The declaration of applicant's president also accompanies applicant's response, and is made in support of applicant's position as exclusive distributor in the United States of the Kivistik's plants; indicating further that applicant distributes plant licenses, including four in Canada, one in Australia, and eight in the United States; and that applicant began use in the United States of the mark in 1998, importing the first plants in the spring of 1999. A copy of the parties' executive protective agreement for the exchange of confidential information also accompanies applicant's response.

In reply, opposer maintains its position that 'Piilu' is a generic term as the term was set aside as the taxonomic name for a *Clematis* cultivar to give the worldwide community a uniform way to identify a specific plant. Opposer argues that applicant's "database arguments" are misleading as exemplified by applicant's position that the RHS "does not list PIILU anywhere in its plants keyword search database." Opposer contends that applicant misleadingly searched only RHS's

“Plant Selector” database, which does not list the term “piilu,” but RHS’s “Plant Finder” database does yield a citation to *Clematis ‘Piilu’* as a cultivar name. Opposer argues that applicant inflates opposer’s foreign submissions by stating, “...from everywhere in the world except the United States,” when opposer has submitted ample evidence of use of the term “piilu” in the United States. Opposer contends that its foreign sources help clarify how the term “piilu” is perceived in the United States, are relevant in light of the doctrine of foreign equivalents, and are relevant in view of the international effort in establishing taxonomic names, including cultivar names, for plants. Opposer also argues that applicant’s own inconsistent use of PIILU demonstrates that it is the cultivar name, and that applicant recently has made attempts to remove this generic term from the public domain and make the term its trademark.

**\*6** In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. See *Fed. R. Civ. P. 56*. The movant is held to a stringent standard. See *10A Wright, Miller & Kane, Federal Practice and Procedure: Civil 3d § 2727 (1998)*. Summary judgment is not a substitute for the trial of disputed issues of fact. *Id.* at 2712. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy’s Inc.*, 961 F.2d 200, 22 USPQ 1542 (Fed. Cir. 1992).

Cultivar names, designations given to cultivated varieties or subspecies of plants or agricultural seeds, are the generic names of the plant or seed variety as known to the public. Market realities and lack of laws concerning the registration of varietal and cultivar names have created a number of problems in this area. Some varietal names are not attractive or easy to remember by the public. As a result, many arbitrary terms are used as varietal names. Problems arise when trademark registration is sought for varietal names, when arbitrary varietal names are thought of as being trademarks by the public, and when terms intended as trademarks by plant breeders become generic through public use. These problems make this a difficult evidentiary area. See *TMEP § 1202.12 (3<sup>rd</sup> ed. Rev. 2, June 24, 2002)*. Cf. *In re Delta and Pine Land Co.*, 26 USPQ2d 1157 (TTAB 1993), where registration of the word DELTAPINE, identifying the prominent portion of applicant’s acknowledged varietal names which combined the term DELTAPINE with another term, was refused (“...this is an unusual case and ... little or no precedent exists....”)

After careful consideration of the extensive record submitted by both parties, we find that genuine issues of material fact exist, at a minimum, with respect to the public perception in the United States of the term PIILU.

Accordingly, opposer’s motion for summary judgment is denied. Moreover, given the nature of the intense factual considerations which are necessary to ascertain whether PIILU is a trademark or a cultivar name, we find the matter unsuitable for determination on summary judgment. Thus, this case is going to trial (or settlement). No further summary judgment motions are to be filed.

#### **Protective agreement noted**

**\*7** The stipulated protective agreement accompanying applicant’s response to opposer’s motion for summary judgment is noted. The parties are referred, as appropriate, to TBMP §§ 412.03 (Signature of Protective Order), 412.04 (Filing Confidential Materials With Board), 412.05 (Handling of Confidential Materials by Board) (2<sup>nd</sup> ed. Rev. 1, March 2004).

The parties are advised that only confidential or trade secret information should be filed pursuant to a stipulated protective agreement. Such an agreement may not be used as a means of circumventing paragraphs (d) and (e) of *37 CFR § 2.27*, which provide, in essence, that the file of a published application or issued registration, and all proceedings relating

thereto, should otherwise be available for public inspection.

**Proceedings resumed; dates reset**

Proceedings are resumed. Discovery closed on November 6, 2003, in accordance with applicant's consented motion to extend dates, filed September 8, 2003. Trial dates are reset as indicated below:

THE PERIOD FOR DISCOVERY TO CLOSE:	<b>CLOSED</b>
30-day testimony period for party in position of plaintiff to close:	August 31, 2004
30-day testimony period for party in position of defendant to close:	October 30, 2004
15-day rebuttal testimony period to close:	December 14, 2004

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. [Trademark Rule 2.125](#).

Briefs shall be filed in accordance with Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by [Trademark Rule 2.129](#).

FN1. Application Serial No. 76201447, filed on January 29, 2001, claiming a *bona fide* intention to use the mark in commerce. Applicant includes a statement that PIILU translates into English as "little duckling."

FN2. Although opposer articulates language which appears to invoke Section 2(d) of the Trademark Act, likelihood of confusion with a previously used or previously used and registered mark, opposer does not plead a mark, and further combines such language with allegations that applicant's mark is a cultivar name for live *Clematis* plants. *See* paragraph no. 5 of the notice of opposition. Such allegations appear to be amplifications of opposer's claim that applicant's mark is generic. Thus, the only pleaded claim, and the claim before us, is that applicant's mark, as a cultivar name, is the generic name for the goods.

FN3. Opposer's consented motion, filed September 28, 2003, to extend discovery and trial dates is granted.

FN4. To the extent that opposer argues (at p. 12 of its brief) that applicant's mark is deceptive or deceptively misdeceptive, said issues have not been pleaded and are not before us. *See Fed. R. Civ. P. 56(a)*; and TBMP Section 528.07(a) (2<sup>nd</sup> ed. Rev. 1 March 2004).

FN5. The Board notes in passing the some of applicant's exhibits also are in foreign languages, at least in part.

FN6. At trial, the business records of a party are to be introduced by way of a testimonial deposition as exhibits thereto. *See* TBMP Sections 702 and 703 (2<sup>nd</sup> ed. Rev. 1 March 2004). The Board notes that consideration of Exhibit 15 would not have changed our decision on summary judgment.

FN7. Opposer notes that Uno Kivistik died in 1998.

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FN8. Inasmuch as applicant's objection to this submission as unauthenticated was sustained, the submission was not considered.

FN9. Applicant's objections to opposer's evidentiary submissions have already been ruled on.

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Trademark Trial and Appeal Board  
Patent and Trademark Office (P.T.O.)

\*1 MCCORMICK DELAWARE, INC. AND MCCORMICK &amp; COMPANY, INCORPORATED

v.

WILLIAMS FOODS, INC.

Cancellation No. 28,967

February 14, 2001

Before Hanak, Wendel and [Rogers](#)  
Administrative Trademark Judges.

By the Board:

Petitioners seek to cancel the registration of respondent's mark SEASON 'N BAKE for "meat seasonings sold together with a roasting bag" in Class 16.<sup>[FN1]</sup> As grounds for the cancellation, petitioners allege that respondent's mark, when used on the identified goods, so resembles petitioners' previously used and registered marks as to be likely to cause confusion, mistake or deception. Petitioners' pleaded registered marks are:

**Bag'n Season**

for "seasoning mixes for meats and roasting bags combined in unitary packages and sold in the seasoning departments of retail outlets" in Class 46<sup>[FN2]</sup> and SEASON 'N FRY for "seasoning and flavor intensifier" in Class 30.<sup>[FN3]</sup>

In its answer, respondent admits that the dates of issuance and the dates of first use of petitioners' pleaded registrations are prior to any date of first use upon which respondent can rely.<sup>[FN4]</sup> Respondent also admits that goods sold under the parties' respective marks are similar; that the goods are sold to the same classes of consumers in the same channels of trade; and that the parties' respective goods are competitive.<sup>[FN5]</sup> With respect to its SEASON 'N BAKE mark and petitioners' pleaded BAG'N SEASON mark, respondent admits that the packaging of the parties' respective goods uses the same color scheme.<sup>[FN6]</sup> With respect to its SEASON 'N BAKE mark and petitioners' SEASON 'N FRY mark, respondent admits that "both consist of the word 'SEASON' and a word identifying a cooking process separated by an apostrophe and the letter 'N'." DD<sup>[FN7]</sup> Respondent otherwise denies the salient allegations of the petition to cancel, and filed a counterclaim to cancel petitioners' pleaded registration for the mark BAG'N SEASON (Registration No. 980,062), alleging that BAG'N SEASON is the generic name for the goods for which the mark is registered.

Petitioners deny the salient allegations of the counterclaim.

This case now comes up on the following motions:

- 1) petitioners' fully briefed motion for summary judgment in their favor on respondent's counterclaim;
- 2) respondent's fully briefed cross motion for summary judgment in its favor on its counterclaim;
- 3) petitioners' motion for summary judgment in their favor on their main claim of likelihood of confusion;
- 4) respondent's motion to defer consideration of petitioners' motion on their main claim and motion to allow respondent discovery under [Fed. R. Civ. P. 56\(f\)](#) with respect to petitioners' motion;
- 5) petitioners' fully briefed motion for sanctions against respondent under [Fed. R. Civ. P. 11](#);
- 6) respondent's motion for determination of sufficiency of objections to requests for admission; and
- \*2 7) respondent's motion to compel discovery and for discovery sanctions.

The Board has carefully reviewed the parties' respective arguments and evidentiary submissions with respect to the above-identified motions, according the evidence its appropriate probative weight.

**Petitioners' motion for appropriate sanctions, including dismissal of the counterclaim with prejudice, under [Fed. R. Civ. P. 11](#)**

In support of their motion, petitioners argue that, subsequent to respondent's filing of its counterclaim, the Federal Circuit issued its decision in *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (1999); and that in view of said decision, petitioners' counsel "suggested to" respondent's counsel that respondent's counterclaim was without legal basis and should be withdrawn. Additionally, petitioners argue that respondent did not make a reasonable inquiry as to whether BAG'N SEASON is generic because respondent did not produce any evidence of the generic use of BAG'N SEASON. Petitioners contend that BAG'N SEASON is a phrase, not a compound word, because there are two separate words and a separate abbreviation. Thus, according to petitioners, the holding of *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) is not applicable because *American Fertility* expressly limits *Gould Paper* to "compound terms formed by the union of words." See *American Fertility*, 188 F.3d at 1348. Petitioners also speculate that respondent may have brought the counterclaim for the improper motive of harassing petitioners into settlement or into withdrawing their petition to cancel.

In response, respondent argues that its counterclaim is not frivolous simply because the parties have different interpretations of the applicability of the case law. It is respondent's position that BAG'N SEASON is a compound word that is generic under *Gould Paper*; and that a term may be generic yet not represented in any dictionary. In addition, respondent contends that petitioners portray their mark inconsistently in "attempting to characterize" the term as a phrase rather than a compound word, thus actually undermining petitioners' claim that their mark is a phrase. Respondent has identified the following portrayals of petitioners' mark: BAG'N SEASON; BAG 'N SEASON; BAG'nSEASON. Respondent states that its counterclaim was brought for a proper purpose, namely, to prevent its registered mark from being cancelled on the ground that there is likelihood of confusion with a term respondent believes is generic.

Under [Fed. R. Civ. P. 11\(b\)](#),<sup>[FN8]</sup> the signatory to a document is certifying that the document under scrutiny was not brought for an improper purpose; and that, after reasonable inquiry into both the law and the facts, the signer has concluded that there are good grounds to support the document.

The disagreement of respondent and petitioners over the applicability of the law set forth in *American Fertility* to the circumstances presented herein, and their disagreement whether petitioners' mark is a compound word or a phrase, do not support the imposition of sanctions under [Fed. R. Civ. P. 11](#).

\*3 In view thereof, petitioners' motion for sanctions against respondent pursuant to [Fed. R. Civ. P. 11](#) is denied.

**The parties' cross motions for summary judgment on respondent's counterclaim to cancel petitioners' BAG'N SEASON mark as generic**

By their motion for summary judgment, petitioners seek judgment as a matter of law on respondent's counterclaim, arguing that there are no genuine issues of material fact and that their mark BAG'N SEASON is not generic for "seasoning mixes for meats and roasting bags combined in unitary packages and sold in the seasoning departments of retail outlets."

By its cross motion for summary judgment, respondent seeks judgment as a matter of law on its counterclaim, arguing that there are no genuine issues of material fact and that petitioners' mark BAG'N SEASON is generic because it is a compound term that is composed of words that have the same meaning taken individually or combined.

A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See [Celotex Corp. v. Catrett](#), 477 U.S. 317, 106 S.Ct. 2548 (1986). The mere fact that we are presented with cross motions does not dictate that summary judgment is appropriate. We will examine the evidence to see whether, if there are no genuine disputes, either party is entitled to summary judgment as a matter of law.

A generic term identifies a type of goods or services and not the source of such goods or services. 3 *Callman Unfair Competition, Trademarks & Monopolies*, Section 18.03 (4<sup>th</sup> ed. 1983). A determination that a term is generic requires evidence showing the genus of the goods or services at issue and an understanding by the general public that the term refers primarily to that genus of goods or services. See [H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.](#), 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986); and [American Fertility](#), 51 USPQ2d at p. 1834. The holding of *Gould* provides additional assistance in determining genericness with respect to compound words, where it can be shown that the public understands the individual terms to be generic for a genus of goods and services and the joining of the individual terms into one compound word lends no additional meaning to the term. See [American Fertility](#), 51 USPQ2d at p. 1837.

In support of their motion, and in response to respondent's cross motion, petitioners argue that BAG'N SEASON is understood by the public to refer to its product and not generally to "products that combine seasoning mix and roasting bags." Petitioners argue that there is no evidence of generic use of BAG'N SEASON, that its competitors do not use BAG'N SEASON to sell their competing products, and that respondent has indicated through the discovery depositions of its officers that it knows of no generic use of BAG'N SEASON. In addition, it is petitioners' position that BAG'N SEASON is a phrase, not a compound word, and, thus, cannot be generic even if the components taken individually were found to be generic (which, in any event, petitioners do not believe to be the case).

\*4 In support of its cross motion, and in response to petitioners' motion for summary judgment, respondent argues that the Federal Circuit in *American Fertility* articulated two different tests for determining genericness, one for phrases and another for compound terms. Respondent contends that petitioners' BAG'N SEASON mark is a compound term that combines the generic words "bag" and "season" in a union that has no unique meaning apart from its components; that the words separately and combined describe a container and the act of enhancing the flavor of food; and that, because the words separately and combined have the same meaning, genericness has been established conclusively. Respondent argues that petitioners' packaging "bolsters the conclu-

sion” that BAG'N SEASON is generic because information directly below the mark describes what the product is and how a consumer is to use the product: “Cooking Bag & Seasoning Blend” and “Roasting Bag & Seasoning Blend.” Respondent argues that petitioners have used their mark in an inconsistent presentation format, apparently trying to establish that the mark is a variable phrase and not a compound term, because a measurable space between certain components may exist. The presentation formats identified by respondent are: BAG 'N SEASON, BAG'nSEASON, and BAG'n SEASON.

As evidentiary support for their arguments, petitioners have submitted the following: relevant pages from five representative dictionaries indicating an absence of entries for the term BAG'N SEASON; results of a NEXIS search disclosing eight references to BAG'N SEASON, all of which refer to petitioners' product; results of Internet searches using the GOOGLE, ALTA VISTA, and GOTO search engines wherein all disclosures from the searches of BAG'N SEASON refer to petitioners' products; the declaration of Virginia Maycock, director of Internet Marketing Applications for the McCormick Schilling Division of petitioner McCormick & Company, averring in part that the phrase BAG'N SEASON does not appear on the packaging of petitioners' major competitors or on respondent's web site,<sup>[FN9]</sup> with accompanying exhibits including copies of competitors' packaging and an excerpt from respondent's web site; the deposition testimony of respondent's officers and personnel that they are not aware of any use of BAG'N SEASON to refer to something other than petitioners' products, that they do not use BAG'N SEASON to refer to respondent's products, and that BAG'N SEASON is not generic for the products.<sup>[FN10]</sup> In addition, petitioners have submitted excerpts from responses to their discovery requests; the declarations of Judith Sapp, petitioners' attorney, and Robert W. Skelton, vice president, general counsel and secretary of McCormick & Company concerning the presentation formats of BAG'N SEASON; pricing lists for petitioners' goods; actual packaging for petitioners' goods showing the mark thereon; and excerpts from the Office's database of registered and pending marks, and other Office records.

\*5 As evidentiary support for its arguments, respondent has submitted the following: photocopies of packaging for petitioners' goods; dictionary definitions of the words “bag” and “season;” copies of on-line advertisements showing “n” as a connector between two words; a copy of a trademark search for ““n” used to join words in the food products category and for “season” used in the food industry; and an excerpt from the deposition of John F. Sauer (discussed further at footnote 11 herein).

After careful consideration of the evidentiary submissions presented by each party, we find that petitioners have met their burden of establishing that no genuine issues of material fact exist and that their registered mark BAG'N SEASON is not generic for “seasoning mixes for meats and roasting bags combined in unitary packages and sold in the seasoning departments of retail outlets.” In coming to this conclusion, we find it immaterial whether BAG'N SEASON is a phrase or a compound word. Contrary to respondent's position, the Court in *American Fertility* did not articulate two separate tests for genericness depending on whether the mark was a compound term or a phrase. Rather, the Court made it eminently clear that the correct legal test is that set forth in *Marvin Ginn*, requiring evidence of “the genus of the goods or services at issue” and the understanding by the general public that the mark refers primarily to “that genus of goods or services,” and that *Gould* does not justify a short-cut around this test but, rather, may provide additional assistance in determining the genericness of compound words only. See *American Fertility*, 51 USPQ2d at p. 1837. Whether a mark is a phrase or a compound word, the inquiry remains the same: is the sum total of the separate components no less generic than the components themselves, or does the combination yield something more? Here, there is no evidence to establish that the combination of words BAG'N SEASON is perceived by the public as a generic phrase or term. Rather, the evidence establishes that there is no genuine issue of material fact, and that, as a matter of law, BAG'N SEASON is not generic.

Accordingly, respondent's cross motion for summary judgment in its favor on its counterclaim is denied; petitioners' motion for summary judgment in its favor on respondent's counterclaim is granted; and the counterclaim is dismissed with prejudice.<sup>[FN11]</sup>

**Petitioners' motion for summary judgment on likelihood of confusion; respondent's motion to defer consideration of petitioner's motion on their main claim; and respondent's motion for a continuance under 56(f)**  
Petitioners seek judgment, as a matter of law, arguing that there are no genuine issues of material fact, and a likelihood of confusion exists between their registered mark BAG'N SEASON for "seasoning mixes for meats and roasting bags combined in unitary packages and sold in the seasoning departments of retail outlets" and respondent's registered mark SEASON 'N BAKE for "meat seasonings sold together with a roasting bag."

\*6 In response, respondent moved for deferment of the Board's consideration of petitioners' motion for summary judgment on likelihood of confusion, pending the Board's decision on the parties' cross motions for summary judgment on the counterclaim. Respondent also moved for discovery pursuant to [Fed. R. Civ. P. 56\(f\)](#) with respect to petitioners' motion for summary judgment on likelihood of confusion.

In view of our decision granting petitioners' motion for summary judgment, and denying respondent's cross motion for summary judgment, on the counterclaim, respondent's motion for deferment is now moot and need not be considered.

In support of its 56(f) motion, respondent argues that it does not have all the facts necessary to respond to petitioners' motion and seeks discovery in the following areas:<sup>[FN12]</sup>

- 1) Specific facts and documentation relating to petitioners' design of the packaging in which BAG'N SEASON products are currently sold;
- 2) Specific facts and documentation relating to petitioners' actual and continuous use of BAG'N SEASON in connection with the goods set forth in Registration No. 980,062;
- 3) Specific facts and documentation relating to petitioners' marketing and advertising for BAG'N SEASON from at least the period immediately preceding and through the period after the re-launch and re-design of the BAG'N SEASON product;
- 4) Information regarding any discontinuance of use of petitioners' mark;
- 5) Documentation relating to specific interrogatories associated with each of the above requests; and
- 6) Information supporting petitioners' claim that BAG'N SEASON products are extremely popular with customers.

In response, petitioners argue that respondent's 56(f) motion does not comply with the requirements of the Rule because the declaration of respondent's attorney in support of the motion is deficient. Specifically, petitioners argue that the declaration omits the essential statement under [28 U.S.C. 1746](#) as follows: "I declare (or certify, verify or state) under penalty of perjury that the foregoing is true and correct. Executed on (date)." In addition, petitioners argue that respondent has not pled that petitioners have abandoned their mark and, thus, is not entitled to discovery on this unpleaded issue; and that the remaining information sought by respondent is in respondent's possession or is irrelevant.

In reply, with respect to her declaration in support of the 56(f) motion, respondent's attorney argues that, by signing the statement, she made a certified statement under Patent and [Trademark Rule 10.19\(b\)](#) that is equivalent to the language specified in [28 U.S.C. 1746](#).

While the better practice would have been to set forth the language of 28 U.S.C. 1746, we agree with respondent's attorney that her declaration is sufficient. Moreover, by referencing 28 U.S.C. 1746 in her statement, respondent's attorney has indicated her familiarity with the language and incorporated the requisite language by reference. Thus, respondent's motion under Fed. R. Civ. P. 56(f) is properly before us.

\*7 As a general rule, motions under 56(f) will be liberally treated. If a party has demonstrated a need for discovery which is reasonably directed to facts essential to its opposition to the motion for summary judgment, discovery will be permitted. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). We note at the outset that petitioners did not respond to most of respondent's discovery requests, served well before the filing of petitioners' summary judgment motions.<sup>[FN13]</sup>

The only discovery which may be requested at this time is that specifically directed to the issues raised by petitioners motion for summary judgment on likelihood of confusion. Despite respondent's arguments to the effect that petitioners have raised the issue of abandonment by discussing their relaunch and redesign of the BAG'N SEASON product line, any alleged abandonment by petitioners of their mark was not pleaded in respondent's counterclaim or raised as a defense by respondent. Moreover, even if it were pleaded, abandonment is not at issue in the summary judgment motion. Thus, discovery requests concerning the issue of abandonment are not essential to respondent's opposition to petitioners' motion for summary judgment and lie beyond the permissible scope of discovery under Rule 56(f).

Accordingly, respondent's motion for 56(f) discovery is **denied** as to the following areas:

- 1) specific facts and documentation relating to petitioners' actual and continuous use of BAG'N SEASON in connection with the goods set forth in Registration No. 980,062, and documentation related thereto (respondent's first set of interrogatories Nos. 30, 10 and 20, and respondent's first set of requests for production of documents No. 30); and
- 2) information regarding any discontinuance of use of petitioners' mark, and documentation related thereto (respondent's first set of interrogatories, No. 29, and respondent's first set of requests for production of documents No. 10).

We find that respondent's remaining requests under 56(f) are essential to its opposition of petitioners' motion for summary judgment. Accordingly, respondent's motion for 56(f) discovery is **granted** and respondent is entitled to discovery as follows:

- 1) specific facts and documentation relating to petitioners' design of the packaging in which BAG'N SEASON products are currently sold, and documentation related thereto;
- 2) specific facts and documentation relating to petitioners' marketing and advertising for BAG'N SEASON from at least the period immediately preceding and through the period after the re-launch and re-design of the BAG'N SEASON product, and documentation related thereto; and
- 3) information supporting petitioners' claim that BAG'N SEASON products are extremely popular with customers.

Petitioners' are allowed until **thirty days** from the mailing date of this order to serve responses to respondent's first set of interrogatories Nos. 1, 7, 8, 9, 17, 20, 21, 22, and to respondent's first requests for production of documents Nos. 7, 9, 22, 30, 41, and 3, with document request No. 3 limited to interrogatories for which 56(f) discovery has been granted, as requested.

\*8 Respondent is allowed until **sixty days** from the mailing date of this order to file its response to petitioners'

motion for summary judgment on their claim of likelihood of confusion.

**Respondent's motion for determination of sufficiency of objections to requests for admission and respondent's motion to compel discovery**

Consideration of respondent's discovery motions are deferred pending consideration of petitioners' motion for summary judgment on their main claim. In the event that proceedings are resumed, the Board will allow time for petitioners to respond to respondent's discovery motions.

We find it necessary at this point, however, to address the parties' apparent dispute as to the adequacy of service with respect to respondent's first set of interrogatories and first requests for production of documents.

Respondent's attorney indicates that, on November 2, 1999, she served petitioners' counsel by first class mail and by facsimile transmission, with respondent's first interrogatories and document requests and that, inadvertently, the certificate of service for the copy transmitted by facsimile was also attached to the original discovery requests served by first class mail. Respondent's attorney avers that she personally placed the discovery requests at issue in an envelope properly addressed to petitioners' counsel and deposited them with her law firm's mail service on November 2, 1999, for delivery by first class mail.

In letters dated January 6 and 21, 2000, petitioners' counsel informed respondent's counsel that no responses to the first requests for interrogatories and documents have been made because petitioners have not been served with them. More specifically, petitioners' attorney informed respondent that respondent's certificates indicate that service was made by facsimile, which does not constitute service under [Fed. R. Civ. P. 5\(b\)](#) or [Trademark Rule 2.119](#). In response to respondent's January 14, 2000 request that petitioners' counsel advise respondent if petitioners' counsel had not received the hard copies sent by first class mail, petitioners' counsel stated that respondent's "certificate of service speaks for itself."

While respondent's certificate of service may have been inadequate on its face, respondent's attorney has stated by affidavit that she deposited the discovery requests in question with her law firm's mail service for delivery by first class mail and petitioners' attorney has not denied that the hard copies were received by mail. A mistake on the face of the certificate of service will not cause the papers otherwise properly served to be disregarded where there has been actual receipt. See, for example, Wright & Miller, [4A Federal Practice and Procedure: Civil 2d, Sections 1147-1150 \(1987, supp. 2000\)](#).

Accordingly, the Board will not entertain any arguments concerning the adequacy of respondent's service by first class mail of its first set of interrogatories and first requests for production of documents in view of petitioners' apparent actual receipt by first class mail thereof.

**\*9** The parties are reminded that they are expected to cooperate with one another in the discovery process and to treat one another cordially and reasonably, to avoid the need for Board intervention and "micro-management" of the case. The Board is not a court, and this proceeding is an administrative hearing on the question of registrability only. See Section 17 of the Trademark Act; and TBMP Section 102.01. Moreover, with respect to discovery, each party (and its attorney) has a duty to seek only relevant discovery and to provide relevant discovery. See TBMP Section 412.01. The Board expects this case to proceed accordingly.

FN1. U.S. Registration No. 2,242,205, registered on April 27, 1999, claiming use in commerce since January 28, 1997.

FN2. U.S. Registration No. 980,062, registered on March 5, 1974, claiming use in commerce since March 24, 1972. Section 8 accepted; Section 15 acknowledged; first renewal June 28, 1994.

FN3. U.S. Registration No. 1,041,898, registered on June 22, 1976, claiming use in commerce since August 13, 1975. Section 8 accepted; Section 15 acknowledged; first renewal February 28, 1996.

FN4. Paragraph Nos. 3 and 8 of respondent's answer.

FN5. Paragraph Nos. 10, 11, and 13 of respondent's answer.

FN6. Paragraph No. 10 of respondent's answer.

FN7. Paragraph No. 12 of respondent's answer.

FN8. The full text of [Fed. R. Civ. P. 11\(b\)](#) is as follows: **Representations to Court.** By presenting to the court (whether by signing, filing, submitting, or later advocating) a pleading, written motion, or other paper, an attorney or unrepresented party is certifying that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, —

- (1) it is not being presented for any improper purpose, such as to harass or to cause unnecessary delay or needless increase in the cost of litigation;
- (2) the claims, defenses, and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;
- (3) the allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and
- (4) the denials of factual contentions are warranted on the evidence or, if specifically so identified, are reasonably based on a lack of information or belief.

FN9. More specifically, Ms. Maycock identifies Williams (respondent herein) and Tone as petitioners' major competitors with respect to the roasting bag and seasoning mix products; and that Williams sells its goods under the SEASON'N BAKE mark while Tone sells its goods under the DURKEE and FRENCH'S marks.

FN10. More specifically, the excerpts submitted by petitioners are from the depositions of George M. Young, senior vice president for respondent; Rob Atkinson officer of respondent and John F. Sauer, vice president of marketing for respondent. While petitioners have submitted some excerpts from Mr. Sauer's deposition to prove that respondent's officers do not believe BAG'N SEASON is generic, we are mindful that, as pointed out by respondent with accompanying excerpts from the deposition, Mr. Sauer may not understand the meaning of ““generic” with respect to trademarks. Thus, we have accorded Mr. Sauer's statements in this regard their limited probative weight.

FN11. The fact that respondent's motion for summary judgment was denied does not amount to a finding that its counterclaim was frivolous. Consequently, the Board will not entertain any renewed motion under [Fed. R. Civ. P. 11](#) to that effect. See, for example, [Fed. R. Civ. P. 11\(b\) and \(c\)](#), Advisory Committee's Notes (1993).

FN12. For each area for which discovery is sought under [Fed. R. Civ. P. 56\(f\)](#), respondent identified its specific request numbers from its original discovery requests. Although it appears that petitioners responded to some of the requests before the summary judgment motions were filed, because of the suspension of proceedings herein after the motions were filed, they did not respond to all of respondent's discovery requests.

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FN13. Petitioners' non-responsiveness to respondent's discovery requests is the subject of respondent's pending motion to compel discovery and motion for determination of the sufficiency of objections to requests for admissions.

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**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

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

**CERTIFICATE OF SERVICE**

This is to certify that a copy of the foregoing Applicant's Brief 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.  
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This the 28<sup>th</sup> day of February, 2011.



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