This Opinion is not a
Precedent of the TTAB

Mailed: November 13, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Apple, Inc.

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Serial No. 78521891

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Jason M. Vogel and Philip A. Rosenberg of Kilpatrick Townsend & Stockton LLP,
for Apple, Inc.

Sui Duong, Trademark Examining Attorney, Law Office 116,
Christine Cooper, Managing Attorney.

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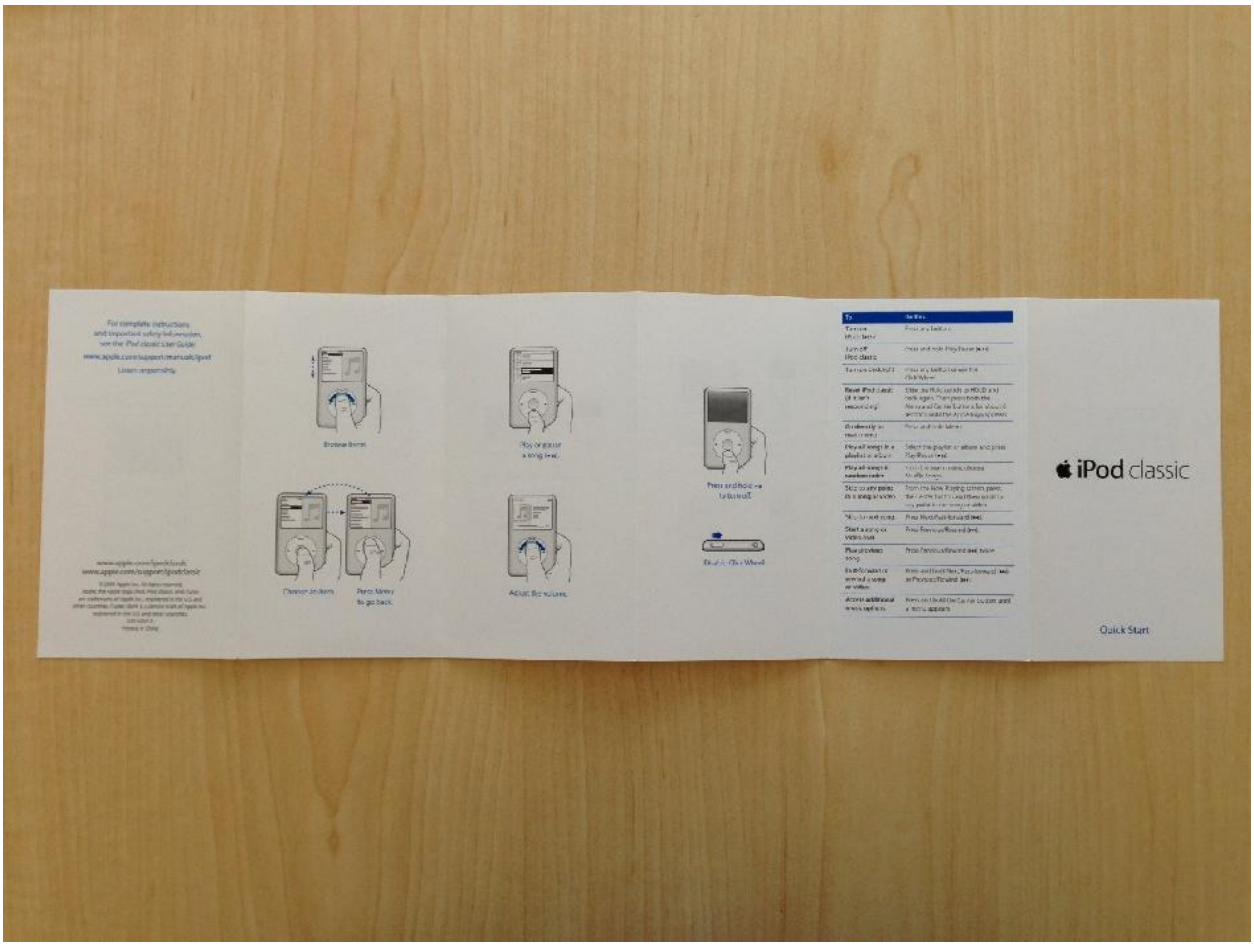
Before Ritchie, Adlin and Heasley,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Apple, Inc. ("Applicant") seeks registration on the Principal Register of the mark IPOD (in standard characters) for "Printed materials and publications, namely, brochures, pamphlets, and leaflets, all relating to computer software, computer hardware, and multimedia apparatus and instruments and sold or distributed in connection with handheld mobile digital media devices" in International Class 16.[1]

[1] Application Serial No. 78521891, filed on November 23, 2004. The application was originally based on an alleged *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, and on Section 44(d) of the Trademark Act, intending to perfect to Section 44(e). On March 24, 2010, Applicant amended its application, electing to

With its Statement of Use filed July 12, 2013, Applicant submitted as a specimen a photograph of the goods, specifically its IPOD Quick Start Guide:



In an Office Action dated August 13, 2013, the Examining Attorney advised Applicant that "The specimen does not show the applied-for mark in use in commerce in connection with any of the goods specified in International Class 016, and therefore is not acceptable. Specifically, Applicant has submitted a user's manual for a digital audio player. User's manuals of this nature do not show the

not perfect to Section 44(e), and instead basing its application on Section 1(a) of the Trademark Act, claiming first use anywhere and first use in commerce since at least as early as November 10, 2001. The application was published for opposition on May 18, 2010, and a notice of allowance issued on July 13, 2010.

mark's use in commerce as they are merely instructional material included with applicant's electronic goods."[2]

Applicant responded on December 23, 2013, arguing that its Quick-Start Guide met the requirements of Section 1(a) of the Trademark Act.[3] Applicant also amended its description of goods by adding the phrase "namely, brochures, pamphlets, and leaflets, all relating to computer software, computer hardware, and multimedia apparatus and instruments and sold or distributed in connection with handheld mobile digital media devices."[4]

Registration was again refused in an Office Action dated January 24, 2014, on the ground that the specimens did not show Applicant's mark in use in connection with "goods in trade" under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051-52, 1127. Applicant's July 18, 2014 response submitted the full IPOD Quick Start Guide, in order to show that the specimen contained "more than 'basic' information,"[5] including the following:

[2] Office Action, August 13, 2013.

[3] Response to Office Action, December 23, 2013, p. 1.

[4] Response to Office Action, December 23, 2013.

[5] 8 TTABVUE 15, Applicant's brief, p. 11.



Download and install iTunes:
www.apple.com/ipod/start

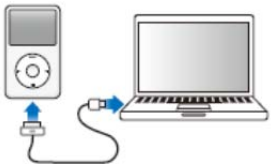
View the user guide:
www.apple.com/support/manuals/ipod



Get music and more at the iTunes Store.



Also import music from CDs.



Connect to USB port on computer
(not keyboard) to set up and
begin charging.



Follow onscreen instructions
(may take a few minutes to appear
when iPod classic is charging).



Sync content while the battery charges.



Charge fully or at least 4 hours,
while computer is awake.



To disconnect after syncing, click Eject (⏏).



Then remove the cable.



Additionally, with its July 18, 2014 Office Action Response, Applicant submitted as substitute specimens manuals bearing the logo:

Made for iPod

According to the record, these manuals were published by third parties Yamaha

and SONY, which Applicant has licensed to sell electronic goods, such as wireless transmitters and universal docks, compatible with its iPod.[6] On August 19, 2014, after examining Applicant's multiple specimens of record, the Examining Attorney issued a final refusal to register under Sections 1, 2 and 45 of the Trademark Act, on the ground that Applicant's brochures, pamphlets, and leaflets are not "goods in trade."[7]

When the refusal was made final, Applicant appealed and requested reconsideration.[8] The Examining Attorney denied the request for reconsideration, and this appeal was resumed.[9] We affirm the refusal to register.

I. Applicable Law.

A refusal that a mark is not being used on "goods in trade" is based on Sections 1, 2 and 45 of the Trademark Act. *In Re Ameritox Ltd.,* 101 USPQ2d 1081, 1084 (TTAB 2011) (citing *In re Shareholders Data Corp.,* 495 F.2d 1360, 181 USPQ 722, 723 (CCPA 1974)). Although the Trademark Act does not define "goods," it provides that a "trademark," by definition, is used by a trademark owner "to identify and distinguish his or her goods" and "to indicate the source of the goods…." 15 U.S.C. § 1127.[10] These provisions "carry the necessary implication that a prerequisite to

[6] 8 TTABVUE 8, Applicant's brief, p. 4.

[7] 10 TTABVUE 3.

[8] 1 TTABVUE; 4 TTABVUE.

[9] 5 TTABVUE; 6 TTABVUE.

[10] It further provides that, "a mark shall be deemed to be in use in commerce--…on goods when--

obtaining a trademark is that the subject matter to which it is applied must be goods." *Shareholders Data,* 181 USPQ at 723. *Accord In Re Thomas White Int'l, Ltd.,* 106 USPQ2d 1158, 1161 (TTAB 2013) ("Before rights in a term as a trademark can be established, the subject matter to which the term is applied must be 'goods in trade.'"). *See also* Trademark Manual of Examining Procedure ("TMEP") § 1202.06 (October 2015) and cases cited therein.

The issue presented in this case is whether Applicant's printed materials and publications, namely, brochures, pamphlets, and leaflets, constitute "goods in trade" or whether they are merely incidental to the iPod handheld mobile digital media device, in connection with which they are sold or distributed. *See Shareholders Data,* 181 USPQ at 723. The determination of whether an applicant's identified goods are, as claimed, independent goods in trade, or are merely incidental to primary goods, is made on a case-by-case basis. *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 F.3d 1376, 103 USPQ2d 1672, 1676 (Fed. Cir. 2012). *See also Thomas White,* 106 USPQ2d at 1161. In drawing this distinction, each case applies the same fundamental standard:

> The fundamental question in each case is: What is being offered for sale under a distinguishing and identifying symbol? It is the thing being offered for sale which constitutes the stock in *trade* to which a *trade* mark or service [trade] mark attaches, for which it fulfills the commercial purpose for which registration is intended to provide protection. Those are the goods and services which are to be appropriately identified in applications for

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(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and **(B)** the goods are sold or transported in commerce." 15 U.S.C. § 1127.

> registration of the marks. All else is mere support and background, for which registration of marks is not contemplated by the statute.

In re SCM Corp., 209 USPQ 278, 280 (TTAB 1980). *Accord Ameritox Ltd.*, 101 USPQ2d 1081, 1085.

As the Board has observed, "The operations of any commercial enterprise could, with a little imagination, be subdivided into a plethora of activities, to each of which a separate name could be appended." *SCM Corp.,* 209 USPQ at 280. Incidental items, such as letterhead, invoices, and business forms, do not generally qualify as goods in trade because they are not the primary product being offered for sale in commerce. *Thomas White,* 106 USPQ2d at 1161.

II. Analysis.

Applicant argues that the brochures, pamphlets, and leaflets it proffers as specimens fit the statutory definition of "goods in trade" because they are transported in commerce bearing the IPOD mark, 15 U.S.C. § 1127, and because they have utility to consumers as the type of product named in the trademark application.[11] *See* TMEP § 1202.06(a) ("While a formal sale is not always necessary, items sold or transported in commerce are not "goods in trade" unless they have utility to others as the type of product named in the trademark application."). The Examining Attorney responds that Applicant's paper inserts are only provided incidentally with its iPod device, that the inserts are not sold or distributed independently, and that they have no viable existence apart from the iPod device.[12]

[11] 8 TTABVUE 9, Applicant's brief, p. 5.

[12] 10 TTABVUE 6.

To determine whether an item is merely incidental to a primary product or service, we consider such factors as whether it: (1) is simply a conduit or necessary tool useful only in connection with the primary goods or services; (2) is so inextricably tied to and associated with the primary goods or services as to have no viable existence apart therefrom; and (3) is neither sold separately from nor has any independent value apart from the primary goods or services. *Lens.com,* 103 USPQ2d at 1676 (items incidental to services not independent goods in trade). *See also Thomas White*, 106 USPQ2d at 1162. *See generally,* 3 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 19:87 (4th ed. 2015).

Applicant attempts to limit the three factors elucidated in *Lens.com* to the facts of that case, in which computer software was merely a conduit for *services*.[13] *Lens.com*, 103 USPQ2d at 1676. But the "goods in trade" refusal is not limited to articles supporting services; it extends equally well to incidental articles accompanying principal goods. The *Lens.com* decision cites *In re MGA Entertainment Inc.,* 84 USPQ2d 1743, 1746-47 (TTAB 2007), which found that boxes used to store puzzle pieces did not constitute goods in trade because "consumers [we]re likely to regard the puzzle boxes as nothing more than point of sale containers, as opposed to separate goods in trade." *Lens.com,* 103 USPQ2d at 1676. Similarly, in *In Re Douglas Aircraft Co., Inc.,* 123 USPQ 271 (TTAB 1959) the Board found that the applicant's books, pamphlets, booklets, brochures and similar print materials were incidental to its manufacture and sale of high strength,

[13] 8 TTABVUE 12-13, Applicant's brief at pp. 8-9.

lightweight structural materials under the mark AIRCOMB:

> The bulletins and the other printed material appear to be *informational and explanatory in nature* for distribution to customers and potential customers to advertise and promote the advantages and uses of applicant's "AIRCOMB" material. They contain nothing of a literary nature or of general reading interest. …
>
> This material serves only to advertise, *explain*, and publicize the goods in which applicant deals; and as such do not constitute "goods" of applicant within the meaning contemplated by the Statute.

Id. at 272(emphasis added).

Applicant asks us to limit the three *Lens.com* factors to the particular facts of cases in which it has been applied[14]: to packaging, as in *MGA Entertainment*,[15] to advertising material, as in *Paramount Pictures*,[16] to conduits for rendering services, as in *Ameritox*,[17] and to incidental items an applicant uses to conduct its business.[18] That, however, misconstrues the *Lens.com* holding, which enunciates more generally applicable factors. The "goods in trade" refusal raises a question that is always the same: what is being offered for sale? *SCM Corp.,* 209 USPQ at 280. That is determined on a case-by-case basis. *Lens.com,* 103 USPQ2d at 1676.

Here, all three *Lens.com* factors support the conclusion that Applicant's brochures, pamphlets, and leaflets are incidental to its primary good in trade: the iPod. Indeed, Applicant's original specimens are paper inserts providing nothing

[14] 8 TTABVUE 11, Applicant's brief, p. 7.

[15] *In re MGA Entertainment Inc.*, 84 USPQ2d 1743 (TTAB 2007).

[16] *Paramount Pictures, Inc. v. White*, 31 USPQ2d 1768 (TTAB 1994) *aff'd*, 108 F.3d 1392 (Fed Cir. 1997).

[17] *In re Ameritox Ltd.*, 101 USPQ2d 1081 (TTAB 2011).

[18] TMEP § 1202.06.

more than elementary guidance to new iPod purchasers, but not other consumers. They show how to turn the device on, how to navigate forward or backward in a song or playlist, how to browse lists of offerings, how to pause playing, and where to purchase songs on Applicant's iTunes Store.[19]

There is no evidence that Applicant advertises these paper inserts independently. *See In Re MGA Entm't, Inc.,* 84 USPQ2d 1743, 1746 (TTAB 2007) ("Moreover, there is no evidence that applicant advertises or promotes the toy laptop computer boxes as carrying cases for the toy laptop computers."). There is no evidence that Applicant sells or distributes these inserts separately. *See Lens.com,* 103 USPQ2d at 1675 ("It is not contested that Lens.com does not sell software."); *Thomas White,* 106 USPQ2d at 1162 ("[t]here is no evidence in the record that applicant charges for the report."). Rather, as Applicant admits, and as reflected in the identification of goods,"[T]hey are shipped in the same box as the IPOD device itself…."[20] Applicant is not attempting to establish a business in such brochures, pamphlets, and leaflets. *See Paramount Pictures, Inc. v. White*, 31 USPQ2d 1768, 1775 (TTAB 1994), *aff'd*,108 F.3d 1392 (Fed Cir. 1997) (applicant's flier/game "is distributed by applicant for the purpose of promoting his band, not for the purpose of establishing a trade in games…."). Applicant's business is selling handheld mobile digital media devices. There is no evidence that consumers patronize Applicant's retail stores seeking these paper inserts; rather, they seek the media

[19] 10 TTABVUE 7-8.

[20] 8 TTABVUE 11, Applicant's brief, p. 7.

devices. *See Thomas White,* 106 USPQ2d at 1162 ("Such customers do not solicit or purchase such reports for their intrinsic value….").

Hence, all of the factors favor refusal. Applicant's paper inserts are useful only in connection with the iPod device; they are so inextricably tied to and associated with the iPod device as to have no viable existence apart therefrom; and they are not sold separately and have no independent value apart from the iPod device. *Lens.com,* 103 USPQ2d at 1676.

Applicant argues that the computing and technology trade regularly distributes similar printed publications with computing goods, and that "the PTO widely accepts as suitable trademark specimens, printed publications analogous to Apple's Specimens," as evidenced by third party registrations.[21] The Examining Attorney

[21] 8 TTABVUE 10, Applicant's brief, p. 6. Applicant's cited third-party registrations consist in the main of multiple-class applications for a wide range of electronic goods and/or services, with specimens of printed materials relating thereto. 4 TTABVUE 55 et seq. They include, for example, a 2001 registration for EMBRYONICS, Reg. No. 2432034, its specimen showing the front page of the Owner's Manual for the Prenatal Sound System accompanying "Electronic and/or battery operated vibrating, musical sound devices used to stimulate babies in utero and infants…." and constituting "Printed materials, namely, flash cards, instructional manuals, brochures"; a 2012 registration for ORACLE, Reg. No. 4102532, for computer peripherals, seminars, courses and workshops relating to computers, computer services, and "printed materials, namely books, pamphlets, user manuals, instruction manuals, newsletters and magazines concerning computer software, computers and related topics…," exemplified by its specimen, the front page of an "Oracle Universal Installer and OPatch User's Guide"; a 2012 registration for BAUSCH & LOMB, Reg. No. 4102774, for ophthalmic lens cleaning solutions, ophthalmic pharmaceuticals, contact lenses, ophthalmic surgical instruments, and "printed matter, namely, brochures, pamphlets, newsletters, product inserts, patient fitting guides and product care guides in the field of eye care and health of the eye," accompanied by a one-page specimen package insert describing how to use a lens cleaning solution; a 2007 registration for MEDICALERT, Reg. No. 3334545, for electronic storage devices, jewelry containing emblems with personal and/or medical information, data processing services, communication, namely electronic transmission of personal and/or medical information, and "printed materials, namely pamphlets, brochures, booklets, posters, and manuals in the fields of health, personal safety, and health and emergency response procedures…," its

responds that the Trademark Office does not regularly allow registration of goods akin to Applicant's paper insert; that ten of the 22 registrations to which Applicant refers were cancelled, and that many of the cited registrations are for owners' manuals with specimens that are different in kind from Applicant's paper insert.[22] The Examining Attorney further argues that in some of the third-party registrations, the specimens consist of extracts from more complex and lengthy printed materials.[23]

Applicant contends that the Examining Attorney's response sets "some unknown minimum page number threshold that must be traversed for a specimen to be considered a valid good in trade," and argues that the number of pages and the complexity of the publications are irrelevant. [24]

Even though the length and complexity of a publication is not in and of itself determinative, those factors may nonetheless reveal the value of the publication—i.e., whether a consumer would regard it as independently and intrinsically valuable—consonant with the *Lens.com* factors. By Applicant's reasoning, one could obtain a registration for a paper insert in a box of tea saying, "steep in hot water." More is required to constitute a good in trade.

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specimen consisting of a four-page folder describing the benefits of MedicAlert membership. Dec. 23, 2013 Response to Office Action, Exhibits B and E (Exhibit E contained additional registrations, cancelled, which Applicant did not cite or rely upon in its Response).

[22] 10 TTABVUE 10. The cancelled registrations are Nos. 2672306, 3381636, 1756129, 2841572, 1841310, 2559461, 2613064, 2602038, 1899477, and 1893092.

[23] 10 TTABVUE 10.

[24] 8 TTABVUE 16, Applicant's brief, p. 12.

The proffered third-party registrations variously identify their print goods as being "in the field of" computer goods, or "directed to users of" or "for use with" those goods, and a few even state that the print materials are "sold in connection with" the computer goods.[25] But they fail to demonstrate the context or manner in which the specimen publications were advertised, offered or sold to consumers, and they fail to indicate whether consumers would deem them to have intrinsic value. The subject Application, by comparison, identifies its print items as "sold or distributed in connection with handheld mobile digital media devices," and the print materials are in fact distributed in the same boxes as those devices. Absent some underlying principled reasoning that is not evident from the face of Applicant's cited third-party registrations, they do not warrant a departure from the established rule that incidental items do not generally qualify as goods in trade because they are not the primary product being offered for sale in commerce. *Shareholders Data,* 181 USPQ at 723. *See also Thomas White,* 106 USPQ2d at 1161. They do not support the conclusion that Applicant's brief paper insert specimens are intrinsically valuable, or satisfy the *Lens.com* factors.

"Even if some prior registrations had some characteristics similar to [the instant] application, the PTO's allowance of such prior registrations does not bind the Board or this court." *In re Nett Designs, Inc.,* 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). *Accord In re Rodale Inc.,* 80 USPQ2d 1696, 1700 (TTAB 2006) ("Although consistency in examination is a goal of the Office, the decisions of

[25] *See* n. 21.

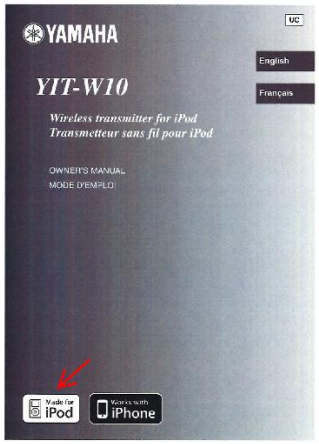
previous Trademark Examining Attorneys are not binding on us, and we must decide each case based on the evidence presented in the record before us.") *quoted in Dalton v. Honda Motor Co.,* 425 F. App'x 886, 894 (Fed. Cir. 2011).

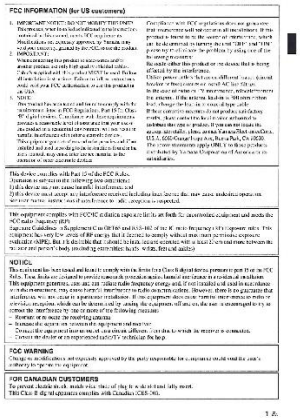
Finally, in its July 18, 2014 response to the Examining Attorney's Office Action, Applicant submitted as substitute specimens manuals bearing the logo 

, published by third parties Yamaha and SONY, which Applicant has licensed to sell goods, such as wireless transmitters and universal docking stations, compatible with the iPod.[26] Applicant avers that their licensed use of this logo inures to its benefit under 15 U.S.C. § 1055.[27] The manuals submitted as substitute specimens range from two to ten pages in length, and prominently display the YAMAHA and SONY marks on their front covers, with the "Made for iPod" logo in the corner:

[26] *See* 8 TTABVUE 17-20, Applicant's brief, pp. 13-16.

[27] 8 TTABVUE at 19, Applicant's brief, p. 15.





We agree with the Examining Attorney that the substitute specimens bearing this mark do not overcome the "goods in trade" refusal.[28] The substitute specimens suffer from the same deficiencies as the original specimens, as there is nothing in the record to show that they have independent, intrinsic value as goods in trade.

The composite 

design-and-word mark is registered to Applicant for use on electronic goods.[29] Consumers would tend to view those electronic goods,

[28] After reviewing the original and substitute specimens, the Examining Attorney issued a final refusal, stating, "Applicant's amended identification, as shown through its submitted specimen, identifies goods which are not goods in trade. Its International Class 016 goods are only 'sold or distributed in connection with handheld mobile digital media devices' and inextricably tied to and associated with applicant's principal goods, i.e., its digital media devices. The specific printed materials identified by the applicant have no independent value apart from applicant's digital media devices and registration of applicant's mark must, therefore, be finally refused." Office Action, August 19, 2014.

[29] Registration No. 3341286, registered on November 20, 2007; Sections 8 and 15 affidavits accepted and acknowledged.

such as compatible wireless transmitters and docking stations, as the goods being offered for sale, not the manuals, which are incidental and "about" the compatible goods, rather than "made for" the iPod. *See Lens.com,* 103 USPQ2d at 1676; *SCM Corp.,* 209 USPQ at 280; *Thomas White*, 106 USPQ2d at 1162.[30]

Consequently, neither Applicant's original specimens nor its substitute specimens indicate use in commerce of the applied-for mark on goods in trade.

Decision: The refusal to register Applicant's mark IPOD is affirmed.

[30] Applicant asserts that separate parties can co-brand products such as the substitute specimens. For example, the INTEL INSIDE logo appears on computers manufactured by parties other than the Intel Corporation. *See generally* 1 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:8 (4th ed. 2015). The substitute specimens, however, show Applicant's registered "MADE FOR IPOD" design-and-word mark, raising the issue as to whether the registered mark appearing in the substitute specimens, taken in its entirety, has the same overall commercial impression as the applied-for mark. According to TMEP § 807.12(a),"In an application filed under §1(a) of the Trademark Act, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods/services, as shown by the specimen." TMEP § 807.12(a), (citing 37 C.F.R. § 2.51(a)). Since the Examining Attorney did not raise this issue during examination, and since we decide this *ex parte* appeal on a separate ground—that none of the specimens display the applied-for mark on goods in trade—we find it unnecessary to remand the case to the Examining Attorney for further examination at this time. *See* 37 C.F.R. § 2.142(f).