

<b>RESPONSE SIGNATURE</b>	/Lisa G. Widup/
<b>SIGNATORY'S NAME</b>	Lisa G. Widup
<b>SIGNATORY'S POSITION</b>	Intellectual Property Counsel
<b>DATE SIGNED</b>	02/18/2009
<b>AUTHORIZED SIGNATORY</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Wed Feb 18 14:56:34 EST 2009
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PTO Form 1957 (Rev 9/2005)  
OMB No. 0651-0050 (Exp. 04/30/2011)

## **Response to Office Action To the Commissioner for Trademarks:**

Application serial no. **77525433** has been amended as follows:

### **ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

#### **I. APP. SERIAL NO. 78907865 for APPSTORE**

The Examiner cites Application Serial No. 78907865 for APPSTORE by Salesforce.com, Inc. and states that there may be a likelihood of confusion between the two marks under Trademark Act Section 2(d), 15 U.S.C. §1052(d) and that action on the present case may be suspended pending final disposition of Salesforce.com, Inc.'s application. Applicant submits that on December 5, 2008 Salesforce.com, Inc. filed an Express Abandonment of the application and respectfully requests that the application be deemed abandoned and removed as a potential obstacle to the registration of the present application.

#### **II. DESCRIPTIVENESS OBJECTION**

The Examiner refuses registration under Section 2(e)(1), 15 U.S.C. §1052(e)(1) on the basis that the mark merely describes a feature, function, purpose or use of applicant's services. Applicant respectfully

disagrees and submits that the APP STORE mark is not merely descriptive and is, at most, suggestive of the services covered in the application.

In order for a mark to be non-registrable because of descriptiveness, it must not only be descriptive, but must be "merely" descriptive of the goods or services to which it relates. See TMEP § 1209.01(b). Stated differently, to be non-registrable, the mark must do nothing other than immediately convey an understanding of the goods for which registration is sought. See *In re Quik-Print Copy Shops*, 205 U.S.P.Q. 505 n.7 (C.C.P.A. 1980) ("merely" descriptive means "only" descriptive); *In re Colonial Stores, Inc.*, 157 U.S.P.Q. 382, 385 (C.C.P.A. 1968) (holding the mark nondescriptive because it "does not tell the potential purchaser only what the goods are, their function, their characteristics or their use, or . . . their ingredients." (emphasis in original)).

Whether a mark is suggestive or merely descriptive must be determined, not in the abstract, but, rather, in relation to the goods or services for which registration is sought; the context in which the mark is used, or intended to be used, in connection with those goods or services; and the possible significance which the mark would have, because of that context, to the average purchaser of the goods or services in the market place. See TMEP § 1209.01(b); *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 U.S.P.Q.2d 1859 (Fed. Cir. 1987); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 U.S.P.Q. 215 (C.C.P.A. 1978); *In re Venture Lending Assocs.*, 226 U.S.P.Q. 285 (T.T.A.B. 1985); *In re Realistic Co.*, 440 F.2d 1393 (C.C.P.A. 1971) (finding CURV not merely descriptive of permanent wave curling solution); *In re Waldorf Paper Prods. Co.*, 155 U.S.P.Q. 174 (T.T.A.B. 1967) (finding STRIP-FLAP for an opening device for paper board containers not merely descriptive even through the opening device containing strips and flaps); *Ex parte Great West Lubricants, Inc.*, 118 U.S.P.Q. 169 (Comm'r Pat. 1958) (finding TUBE-O-LUBE used on a cartridge of lubricating grease not descriptive but suggestive).

The term "APP" is not merely descriptive. In fact, it is completely arbitrary. Arbitrary marks are "inherently distinctive" and are registrable on the Principal Register without proof of acquired distinctiveness. TMEP § 1209.01. The term "APP" may, arguably, sometimes be used as a slang abbreviation for the word "application", but this term has many other incongruous meanings. Attached as Exhibit A are printouts of online dictionary definitions of the term "application". As demonstrated, "APP" is an abbreviation for a number of app-formative words, such as apparatus, apparent, appendix, applied, appointed, approved and approximate. Attached as Exhibit B is a printout from website Dictionary.com showing the definition of the term "APP". The Examiner's evidence of dictionary definitions fails to offer any possible alternative definition besides the one supporting the Examiner's position from Microsoft's Encarta English Dictionary. When used in connection with the word "STORE" it is not apparent what the goods or services are. For example, the service could be offering physical objects such as apparatus or it could be commenting on an inherent trait or quality of the items, such as "approved". As the term "APP" can have several different meanings, applicant submits that at most, the mark is suggestive of applicant's services.

Further, applicant does not offer "store" services. The word "STORE" is usually used in the traditional sense of a brick-and-mortar store or in the modern sense of an online retail store. Applicant's software is only available for download to subscribers through its iPhone portable electronic device or its iTunes digital media player application. None of applicant's APP STORE software is available for purchase through a store in the traditional sense of the word, namely brick-and-mortar or online retail stores. It requires several mental steps to associate applicant's services to a traditional "store" service. As the term "STORE" is not used in the traditional sense of the word and can have different meanings, applicant

submits that at most, the mark is suggestive of applicant's services.

The Examining Attorney bears the burden of demonstrating that a mark is merely descriptive. See *In Re Bel Paese Sales Company*, 1 U.S.P.Q.2d 1233, 1236 (TTAB 1986). "There is often a thin line of demarcation between a suggestive term and a merely descriptive term, and . . . any doubt with respect to the issue of descriptiveness should be resolved in Applicant's behalf." *In re Grand Metropolitan Foodservice Inc.*, 30 U.S.P.Q.2d 1974, 1976 (TTAB 1994). In the case at hand, the Examiner offers online dictionary definitions of the words "APP" and "STORE" from Microsoft Corporation's Encarta World English Dictionary. These definitions, however, are not sufficient to prove that the mark as a whole is merely descriptive. Applicant submits that, on the contrary, such an interpretation would improperly dissect its mark rather than view it as a whole, which is the proper test when considering the issue of descriptiveness. In fact, when viewed together as "APP STORE", the mark has only one meaning and that is as an indicator of source to applicant's services. Attached as Exhibit C are printouts of the first 100 hits from a Google search for the mark "APP STORE". The vast majority of the more than 8 million results from the search use the term to refer to applicant's services. Of the first 100 references, all but one refers to applicant. This evidence demonstrates that the mark has only one meaning, and that is as an indicator of source for applicant's services.

Moreover, applicant's mark creates a clearly recognizable double entendre. A "double entendre" is an expression that has a more than one connotation or significance as applied to the goods or services. A mark that has a "double entendre" will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services. TMEP § 1213.05(c). In the context of applicant's services, in addition to other possible connotations, "APP" will be immediately recognized as an abbreviation of the applicant's well-known APPLE name and mark, and the mark as a whole, APP STORE, will be immediately recognized as a variant of the applicant's well-known APPLE STORE mark. These marks are registered under, inter alia, Reg. Nos. 2462798, 2424976 and 2683410 (collectively, the "APPLE STORE Marks"). Copies of these registrations are attached as Exhibit D. Such readily apparent meaning is not merely descriptive, and is in fact highly distinctive, in relation to the goods and services. Therefore the mark should not be refused on mere descriptiveness grounds. See TMEP §1213.05(c).

Finally, the USPTO's prior acceptance of the cited Application Serial No. 78907865 for APPSTORE by Salesforce.com, Inc. (the "APPSTORE Mark"), as discussed above, is compelling evidence supporting the registrability of applicant's mark. The Examiner had initially issued a mere descriptiveness refusal against the APPSTORE Mark. However, Salesforce filed an Appeal and Request for Reconsideration against this refusal, and on remand, the Examiner withdrew the refusal and approved the APPSTORE Mark for publication. The applicant's APP STORE mark and the cited APPSTORE Mark are essentially identical. Thus, if APPSTORE was deemed registrable, then APP STORE must similarly be registrable.

Based on the foregoing, applicant respectfully requests withdrawal of the refusal under Section 2(e)( 1) for mere descriptiveness.

### III. ADDITIONAL INFORMATION REQUESTED

The Examiner has requested additional information about applicant's services. Applicant submits that it offers a broad array of computer software for download onto handheld mobile digital electronic devices through global computer and wireless communications networks. Attached as Exhibit E are printouts from applicant's website describing the services used in connection with the APP STORE mark.

#### IV. FILING BASES OF APPLICATION

The Examiner requests whether applicant intends to reply upon Section 44(e) as an additional filing basis. Applicant submits that it does not intend to rely upon Section 44(e) as a basis for registration and requests that the mark proceed based solely on Section 1(b) with a claim of Convention Priority under Section 44(d).

#### CONCLUSION

Having responded to all of the issues raised in the Office Action, Applicant requests that the mark be passed to publication.

Respectfully submitted,  
Lisa G. Widup  
Apple Inc.

#### EVIDENCE

Evidence in the nature of Internet printouts from online dictionaries, Google search results, TESS records and screenshots of Applicant's website has been attached.

**Original PDF file:**

evi\_69181200158-135705694\_.\_APP\_STORE\_Exhibits\_A\_\_\_B.pdf

**Converted PDF file(s)** (10 pages)

Evidence-1  
Evidence-2  
Evidence-3  
Evidence-4  
Evidence-5  
Evidence-6  
Evidence-7  
Evidence-8  
Evidence-9  
Evidence-10

**Original PDF file:**

evi\_69181200158-135705694\_.\_APP\_STORE\_Exhibit\_C.pdf

**Converted PDF file(s)** (16 pages)

Evidence-1  
Evidence-2  
Evidence-3  
Evidence-4  
Evidence-5  
Evidence-6  
Evidence-7  
Evidence-8  
Evidence-9  
Evidence-10  
Evidence-11

Evidence-12  
Evidence-13  
Evidence-14  
Evidence-15  
Evidence-16

**Original PDF file:**

evi\_69181200158-135705694\_.\_APP\_STORE\_Exhibit\_D.pdf

**Converted PDF file(s)** (7 pages)

Evidence-1  
Evidence-2  
Evidence-3  
Evidence-4  
Evidence-5  
Evidence-6  
Evidence-7

**Original PDF file:**

evi\_69181200158-135705694\_.\_APP\_STORE\_Exhibit\_E.pdf

**Converted PDF file(s)** (5 pages)

Evidence-1  
Evidence-2  
Evidence-3  
Evidence-4  
Evidence-5

**CLASSIFICATION AND LISTING OF GOODS/SERVICES**

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 038 for Telecommunication services; Electronic transmission of computer software and applications via via the internet and other computer and electronic communication networks; Provision of connectivity services and access to electronic communications networks for transmission or reception of computer software and applications

Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use:** The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Based on Foreign Application: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and will submit a copy of a foreign registration, and translation thereof, if appropriate. 15 U. S.C. Section 1126(d), as amended.

**Proposed:**

**Tracked Text Description:** [ ~~Telecommunication services~~]; ~~Electronic transmission of data via the internet, global computer networks, wireless networks and electronic communication networks~~; [ ~~Electronic transmission of computer software and applications via via the internet and other computer and electronic communication networks~~]; ~~Provision of frame relay connectivity services for data transfer~~; [ ~~Provision of connectivity services and access to electronic communications networks for transmission or reception of computer software and applications~~]; ~~Providing access to global computer networks, wireless networks and electronic communications networks for transmission or reception of data~~Class 038 for

Electronic transmission of data via the internet, global computer networks, wireless networks and electronic communication networks; Provision of frame relay connectivity services for data transfer; Providing access to global computer networks, wireless networks and electronic communications networks for transmission or reception of data

**Filing Basis: Section 1(b), Intent to Use:** The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Based on Foreign Application: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and will submit a copy of a foreign registration, and translation thereof, if appropriate. 15 U. S.C. Section 1126(d), as amended.

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 042 for Maintenance, repair and updating of computer software and applications and of handheld mobile digital electronic devices and other consumer electronics; providing information concerning computer software and web-based applications via the internet and other computer and electronic communication networks; Providing consulting services and technical troubleshooting support for computer software and applications and for handheld mobile digital electronic devices and other consumer electronics; Providing search engines for obtaining data via communications networks; Providing temporary use of computer software and online facilities to enable users to access and download computer software and applications; Internet services, namely, creating indexes of information, sites and other resources available on global computer networks for others; Searching, browsing and retrieving information, sites, and other resources available on global computer networks and other communication networks for others

Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use:** The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Based on Foreign Application: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and will submit a copy of a foreign registration, and translation thereof, if appropriate. 15 U. S.C. Section 1126(d), as amended.

**Proposed:**

**Tracked Text Description:** [ ~~Maintenance, repair and updating of computer software and applications and of handheld mobile digital electronic devices and other consumer electronics~~]; Maintenance, repair and updating of computer software; [ ~~providing information concerning computer software and web-based applications via the internet and other computer and electronic communication networks~~]; providing technical information concerning computer software via the internet and other computer and electronic communication networks; [ ~~Providing consulting services and technical troubleshooting support for computer software and applications and for handheld mobile digital electronic devices and other consumer electronics~~]; Providing computer software and hardware consulting services; [ ~~Providing search engines for obtaining data via communications networks~~]; technical support services, namely, troubleshooting support for computer software and handheld mobile digital electronic devices and other consumer electronics; [ ~~Providing temporary use of computer software and online facilities to enable users to access and download computer software and applications~~]; computer services, namely, providing search engines for obtaining data via electronic communications networks; Providing temporary use of non-downloadable

~~computer software to access and download computer software; [ Searching, browsing and retrieving information, sites, and other resources available on global computer networks and other communication networks for others];~~ Internet services, namely, creating indexes of information, sites and other resources available on global computer networks for others; Searching and retrieving information, sites, and other resources available on global computer networks and other electronic communication networks for others

Class 042 for Maintenance, repair and updating of computer software; providing technical information concerning computer software via the internet and other computer and electronic communication networks; Providing computer software and hardware consulting services; technical support services, namely, troubleshooting support for computer software and handheld mobile digital electronic devices and other consumer electronics; computer services, namely, providing search engines for obtaining data via electronic communications networks; Providing temporary use of non-downloadable computer software to access and download computer software; Internet services, namely, creating indexes of information, sites and other resources available on global computer networks for others; Searching and retrieving information, sites, and other resources available on global computer networks and other electronic communication networks for others

**Filing Basis: Section 1(b), Intent to Use:** The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Based on Foreign Application: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and will submit a copy of a foreign registration, and translation thereof, if appropriate. 15 U. S.C. Section 1126(d), as amended.

## **ADDITIONAL STATEMENTS**

### **Disclaimer**

No claim is made to the exclusive right to use STORE apart from the mark as shown.

### **Claim of Prior Registration(s)**

Applicant claims ownership of U.S. Registration Number(s) 2424976, 2462798, 2683410.

## **SIGNATURE(S)**

### **Declaration Signature**

I hereby elect to bypass the submission of a signed declaration, because I believe a declaration is not required by the rules of practice. I understand that the examining attorney could still, upon later review, require a signed declaration.

### **Response Signature**

Signature: /Lisa G. Widup/ Date: 02/18/2009

Signatory's Name: Lisa G. Widup

Signatory's Position: Intellectual Property Counsel

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to

withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Serial Number: 77525433

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