

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

MICROSOFT CORPORATION,)	
)	Opposition No. _____
Opposer,)	
)	
v.)	
)	Docket No. 663005.80652
APPLE INC.,)	
Applicant.)	
_____)	

NOTICE OF OPPOSITION

Opposer Microsoft Corporation (hereinafter “Opposer” or “Microsoft”) believes that it would be damaged by registration of the mark APP STORE shown in U. S. Trademark Application Serial No. 77/525433, filed by Apple Inc. (hereinafter “Applicant” or “Apple”), and therefore opposes that registration. The application as published in the Official Gazette is summarized as follows:

Serial No.: 77/525433
Filed: July 17, 2008
Applicant: Apple Inc.
Mark: APP STORE
For: Retail store services featuring computer software provided via the internet and other computer and electronic communication networks; Retail store services featuring computer software for use on handheld mobile digital electronic devices and other consumer electronics, in Class 35;
Electronic transmission of data via the internet, global computer networks, wireless networks and electronic communication networks; Providing access to global computer networks; wireless networks and electronic communications networks for transmission or receipt of data, in Class 38;
Maintenance, repair and updating of computer software; Providing a website featuring technical information relating to computer software

provided; Providing computer software consulting services; technical support services, namely, troubleshooting in the nature of diagnosing and repairing computer software problems; computer services, namely, providing search engines for obtaining data via electronic communications networks; Providing temporary use of non-downloadable computer software to enable users to program, organize and access audio, video, text, multimedia content and third-party computer software programs; 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, in Class 42

Classes: 35, 38, and 42

Published: January 5, 2010
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Opposer has requested and received an extension of time to oppose.

The grounds for this opposition are as follows:

1. Opposer is in the business, *inter alia*, of developing and marketing computer software programs and products for a wide range of applications.
2. Opposer markets its goods through various channels, including its own online retail stores and online and brick and mortar stores owned by retailers.
3. A computer system includes several layers of computer programs that make it work. The foundation layer is commonly called the “platform” and the top layer is the “application” layer. “Applications” are computer programs that assist in the performance of specific tasks, such as word processing, accounting and many other functions.
4. The term “app” is a common, generic name for software applications, as reflected in usage by consumers, competitors, dictionaries, the trade press, the general press and Apple itself.

5. For example, Apple’s website encourages consumers to discover “apps made just for iPad,” and describes its APP STORE as offering “tens of thousands of apps ...” as shown in Exhibits 1 and 2 filed herewith.

6. Sample dictionary definitions of the term “app,” shown in Exhibits 3 through 5 filed herewith, include:

- Merriam-Webster Online defines “app” as “application,” and defines “application” as “a program (as a word processor or a spreadsheet) that performs one of the major tasks for which a computer is used” (<http://www.merriam-webster.com/dictionary/app/> and <http://www.merriam-webster.com/dictionary/application/>);
- Webster’s Online Dictionary, Dictionary of Computing, defines “app” as “application program” (<http://www.webster-dictionary.com/dictionary/app/>);
- Citing *The American Heritage Dictionary of the English Language* published by The Houghton Mifflin Company (4th Ed. 2010), the FreeDictionary.com website defines “app” as “A computer application” (<http://www.thefreedictionary.com/app/>).

7. The term “store” is a common, generic, widely used name for a place where retail services are performed, as reflected by the sample dictionary definitions of the term “store,” shown in Exhibits 6 through 7 filed herewith, and TTAB cases holding that combining a generic term with the term “Store” is a generic phrase:

- Citing *Collins English Dictionary-Complete and Unabridged*, published by HarperCollins Publishers, the FreeDictionary.com website defines “store” as “an establishment for the retail sale of goods and services” (<http://www.thefreedictionary.com/store/>);
- Merriam-Webster Online defines “store” as “a business establishment where usually diversified goods are kept for retail sale <a grocery store>” (<http://www.merriam-webster.com/net/store/>);
- Non-source identifying generic words like “The” and “Store” cannot create a trademark in an otherwise generic term, as reflected in TTAB cases such as *In re Italian Store*, 2010 WL 2104134 (TTAB 2010) (“The Italian Store” generic for delicatessen selling Italian food).

8. Applicant's application to register APP STORE disclaims the term "store."

9. When viewed as a whole, the combination of the generic term "app" with the generic term "store" is nothing more than the sum of its parts and is not capable of identifying and distinguishing a single source. An "app store" is plainly a store that sells apps.

10. The term "app store" is used by many retailers as part of the name of their retail stores selling software applications. Examples include, but are not limited to the following, as shown in Exhibits 8 through 12 filed herewith:

- AppStoreHQ (see <http://www.appstorehq.com>)
- DC App Store (see <http://appstore.dc.gov/>)
- Shopify App Store (see <http://apps.shopify.com/>)
- PocketGear App Stores (see <http://appstore.pocketgear.com/>)
- MobiHand, Inc. – The App Store Company (see <http://corporate.mobihand.com/>)

11. The term "app store" is used by the trade press as the common name for stores selling software applications. Examples include, but are not limited to the following, as shown in Exhibits 13 through 17 filed herewith:

- "RIM's BlackBerry Mobile App Store Revamp: Better Late Than Never....[I]mproving a mobile app store also helps bring developers to a platform" (<http://gigaom.com/2010/06/16/rims-blackberry-mobile-app-store-revamp-better-late-than-never/>)
- "AT&T's Palm Pixi Plus Now Free with Contract ... The webOS includes an on-device app store, and a growing collection of third-party software is available" (<http://www.brighthand.com/default.asp?newsID=16658&news=ATT+Palm+Pixi+Plus+webOS+Discount>)
- "Giz Explains: All The Smartphone Mobile App Stores Although it might not be evident in the feature-by-feature breakdown above, there are two distinct kinds of app store It's a combination of these different lineages and divergent policy choices that make the smartphone app store experience

so varied” (<http://gizmodo.com/5199933/giz-explains-all-the-smartphone-mobile-app-stores>)

- “APP Store Comparison, Apple vs Blackberry vs Nokia vs Android Shootout Techradar did a App store shootout about a month ago So go find out how the other app stores are doing!”
<http://snapvoip.blogspot.com/2009/01/app-store-comparison-apple-vs.html>)
- “List of App Stores Today we entered information on the first five mobile app stores [M]any other manufacturers and vendors will start offering their own version of app stores” (<http://appstorelist.com/>)

12. The term “app store” is used by the general press as a name for retail stores selling software apps. Examples include, but are not limited to the following, as shown in Exhibits 18 through 22 filed herewith:

- “Decline in App Store Downloads after 2013 Requires Strategic Thinking from Mobile Marketers....According to ABI Research studies, downloads of mobile applications from “app stores” will peak in 2012-2013”
<http://www.forbes.com/feeds/businesswire/2010/06/17/businesswire141232472.html>)
- “Samsung 46” 3D LED HDTV Review ... Samsung did improve their web connected app store. The layout to the app store is very intuitive, and it looks like an actual app store on your computer.”
http://www.associatedcontent.com/article/5486970/samsung_46_3d_led_hdtv_review.html?cat=15)
- “A Pulitzer Winner Gets Apple’s Reconsideration [A]pplications, or ‘apps,’ can be rejected Apple alone determines what is objectionable for its online app store”
<http://www.nytimes.com/2010/04/17/books/17cartoonist.html>)
- “Are you ready for a GPS app store? It’s the hottest thing to come along in the tech world since blogging: The app store. And soon you might just have an app store for every gadget in your arsenal.”
http://news.yahoo.com/s/ytech_wguy/20100430/tc_ytech_wguy/ytech_wguy_tc1889)
- “The success of Apple’s app store has spurred rivals to launch their own versions. But with the exception of Android, few other app stores – including the BlackBerry World and the Palm app store – have come close to becoming a viable competitor to iPhone’s App Store.”
<http://www.cnn.com/2010/TECH/04/27/google.nexus.one/>)

13. “App store,” like “computer store,” “the Italian store,” “Discount Auto Parts Stores” and “shoe warehouse,” is a generic term for retail store services featuring software “apps.” See *In re Computer Store*, 211 USPQ 772 (TTAB 1981) (“The Computer Store” generic for stores selling computers); *In re Italian Store*, 2010 WL 2104134 (TTAB 2010) (“The Italian Store” generic for delicatessen selling Italian food.); *In re AEW, Inc.*, 1999 WL 285499 (TTAB 1999) (“Discount Auto Parts Stores” generic for auto parts stores); *Mil-Mar Shoe Co. v. Shonac Corp.*, 75 F.3d 1153, 1157 (7th Cir. 1996) (“Shoe Warehouse” generic for stores selling shoes).

14. Applicant’s APP STORE mark is used for online retail store services featuring mobile software apps for purchase by consumers.

15. The services claimed by Applicant in Classes 38 and 42 are provided by Applicant in the course of and in connection with its retail store services, and are the type of services that would normally be provided by an online retail store featuring downloadable software apps.

16. On information and belief, Applicant does not use APP STORE as a trademark for some or all of the claimed services in Classes 38 and 42.

17. On information and belief, some or all of the claimed services in Class 38 and 42 are incidental to Applicant’s claimed retail services in Class 35 and should not be considered a separately registrable service. See TMEP §1301.01(a)(iii).

18. Opposer Microsoft and retailers selling Microsoft and other apps are entitled to use APP STORE in connection with retail store services and services incidental and related thereto.

19. Opposer Microsoft will suffer damage if Applicant secures a federal registration for this generic term in that such registration will discourage or prevent

Microsoft and retail stores that sell Microsoft apps from using APP STORE in connection with such services.

WHEREFORE, Opposer prays that this opposition be sustained, Applicant's application denied, and the mark refused registration.

Correspondence Address

Please direct all communications to:

William O. Ferron, Jr.
BillF.docketing@SeedIP.com
LitCal@SeedIP.com
SEED IP Law Group PLLC
701 Fifth Avenue, Suite 5400
Seattle, Washington 98104

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Respectfully submitted,

Seed IP Law Group PLLC



William O. Ferron, Jr.
Nathaniel E. Durrance
701 Fifth Avenue, Suite 5400
Seattle, Washington 98104
(206) 622-4900

Attorneys for Opposer
MICROSOFT CORPORATION