

Response to Office Action



This Response is timely filed in response to a June 11, 2019, post-registration Office Action for RN 3621571, addressing Registrant’s Combined Declaration of Use and Renewal, filed on May 9, 2019. The Office Action included concerns over the specimen and an audit.

1. Specimen Concerns

Registrant filed a Combined Declaration of Use and Renewal on May 9, 2019, with a specimen described as a “photograph of packaging for Registrant's iPhone Xs Max device displaying the registered mark on the box.”

An Office Action issued alleging that the specimen “shows the mark used on or in connection with goods that are different from those identified in the registration. . . . Specifically, the specimen shows use for an ‘iPhone XS Max, Space Gray’ cellular telephone handset (Class 9).”

Registrant respectfully differs with that conclusion. The USPTO has accepted Registrant’s iPhone device as a Class 28 product on multiple occasions, including for this same registration’s Section 8 & 15 filings. The 8 & 15 maintenance specimen is essentially identical to the specimen filed with the May 2019 renewal application, except the device models differ (iPhone 6 vs. iPhone Xs Max), as shown below:

Specimen filed with the Section 8 & 15	Specimen filed with the Section 8 & 9
	
<p><u>Specimen Description:</u> “photograph of packaging for Registrant's iPhone 6 device displaying the registered mark on the box”</p>	<p><u>Specimen Description:</u> “photograph of packaging for Registrant's iPhone Xs Max device displaying the registered mark on the box”</p>

The USPTO accepted the Section 8 & 15 specimen without objection. See **Exhibit A** (a copy of the USPTO’s Notice of Acceptance and Acknowledgment approving the iPhone specimen and Registrant’s Combined Declaration of Use and Incontestability with the iPhone specimen).

The USPTO also recognized the iPhone device as a Class 28 product in Registrant’s RN 3746840. The USPTO accepted that registration’s Class 28 renewal specimen without objection. See **Exhibit B** (a copy of Registrant’s Section 8 & 9 and the USPTO’s notice of acceptance).

The iPhone device defies strict categorization: it is simultaneously a hand-held unit for playing electronic games, video games, and the like, as well as a phone, a camera, a music player, a streaming device for watching movies and TV shows, a digital personal assistant, a GPS navigational device, a device for making financial payments, a computer, a fitness tracker, a flashlight, and more.

There are so many games played on the iPhone device that Registrant awards an *iPhone Game of the Year* to a third-party game for use on the iPhone device. **Exhibit C** contains portions of two Apple press releases, announcing the 2018 and 2019 winners of Apple's *iPhone Game of the Year* award. ("*Apple presents the best of 2018*" (iPhone Game of the Year - Donut County); "*Apple celebrates the best apps and games of 2019*" (iPhone Game of the Year: "Sky: Children of the Light" (thatgamecompany). *Highlighting added.*).

In addition, the iPhone device has been recognized as the most popular video game device. See **Exhibit D** ("*By the numbers, Apple's iPhone tops PlayStation, Xbox as most popular video game device,*" USA Today, March 16, 2019).

The Office Action cited no authority holding that a product depicted in a specimen cannot support use of a mark in more than one class, nor could Registrant locate any such authority.

For these reasons, Registrant respectfully requests that the USPTO accept the specimen as filed with the Combined Declaration of Use and Renewal under Sections 8 and 9 on May 9, 2019.

2. Audit Request

The Office Action requires Registrant to submit proof of use of the APPLE mark in commerce with the following goods: (1) standalone video game machines and (2) LCD game machines, in International Class 28, during the relevant period for filing the affidavit of use.

Registrant submits two additional specimens in this TEAS Response to Office Action form, covering those goods (an iPhone Xr specimen for LCD game machines; an iPad specimen for standalone video game machines), and has included also the required verified statement supporting those requested proofs of use.

Conclusion

Registrant has addressed all the issues raised in the Office Action and requests that Combined Declaration of Use and Renewal under Sections 8 and 9 be approved. Please contact the undersigned Attorney of Record if there are any remaining questions.