

EXHIBIT 25

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

Proceeding	91195582
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

MICROSOFT CORPORATION,)	
)	Opposition No. 91195582
Opposer,)	
)	Serial No. 77/525433
v.)	
)	
APPLE INC.,)	Attorney Docket No. 663005.80652
)	
Applicant.)	
_____)	

**OPPOSER MICROSOFT CORPORATION'S
MOTION FOR SUMMARY JUDGMENT**

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I. Introduction and Summary of Argument

Apple's "App Store" is an online store where users can purchase and download apps for use on their iPods, iPads and iPhones. Microsoft opposes Apple's Application Serial No. 77/525433 for APP STORE on the grounds that "app store" is generic for retail store services featuring apps and unregistrable for ancillary services such as searching for and downloading apps from such stores.

Microsoft moves for summary judgment refusing registration of APP STORE. The following undisputed facts establish that "app store" is generic for retail store services featuring apps:

- "App" is a common generic name for the goods offered at Apple's store, as shown in dictionary definitions and by widespread use by Apple and others.
- "Store" is generic for the "retail *store* services" for which Apple seeks registration, and indeed, Apple refers to its "App Store" as a store.

These facts alone establish genericness as a matter of law under the cases holding that a generic product name followed by "store" is generic for retail store services featuring the product. See Section IV.B., below.

The undisputed facts further show that the combined term "app store" is commonly used in the trade, by the general press, by consumers, by Apple's competitors *and even by Apple's founder and CEO Steve Jobs*, as the generic name for online stores featuring apps. A search of Westlaw's US ALL NEWS database found over 1,000 current articles using "app store" as the generic name for stores featuring apps. Indeed, in a recent interview, Apple CEO Steve Jobs criticized the proliferation of app stores for Google's competing Android platform as follows:

In addition to Google's own app marketplace, Amazon, Verizon and Vodafone have all announced that they are creating their own **app stores** for Android. There will be at least four **app stores** on Android which customers must search through to find the app they want and developers will need to work to distribute their apps and get paid.

(Declaration of Nathaniel Durrance ("Durrance Decl.,") ¶ 4, Ex. 2) (emphasis added). This undisputed evidence confirms that "app store" is generic.

The Class 38 and 42 services for which Apple seeks registration (*e.g.*, downloading, searching for, and updating apps from its app store) are offered with and ancillary to its primary retail store services. Like bagging groceries in a grocery store, they are not separately registrable services. Further, a generic name for a primary service cannot be registered for services offered with the primary service lest competitors be prevented from fairly describing their services.

“App store” is a generic name that Apple should not be permitted to usurp for its exclusive use. Competitors should be free to use “app store” to identify their own stores and the services offered in connection with those stores. Microsoft’s motion for summary judgment should be granted and Apple’s application to register APP STORE refused.

This motion is supported by the Declaration of Nathaniel Durrance filed herewith.

II. Summary of Undisputed Facts

The following facts are not in dispute:

1. Apple seeks registration for APP STORE, *inter alia*, for “retail store services.” Application Serial No. 77/525433 (emphasis added).
2. “App” is used in the trade, by the press, by relevant consumers, by Apple’s competitors and by Apple as the name for software applications, especially applications for mobile devices. (Durrance Decl. ¶¶ 1, 4, 9-19, 22; Exs. 1-2, 7-17, 20)
3. Apple uses “app” to name the goods offered at its “App Store.” (Durrance Decl. ¶¶ 9-10, 12-15; Exs. 7-8, 10-13)
4. Dictionaries define “app” as a software application. (Durrance Decl. ¶¶ 5-6; Exs. 3-4)
5. Apple refers to its “App Store” as a “store.” (Durrance Decl. ¶¶ 12, 14-15; Exs. 10, 12-13) For example, Apple has described its “App Store” in a September 2009 press release as follows:

“Apple® today announced that more than two billion apps have been downloaded from its revolutionary App Store, the largest applications **store** in the world. There are now more than 85,000 apps available....”

(Durrance Decl. ¶ 14, Ex. 12 at 1) (emphasis added); *See also Id.* at 4-6 (Apple press releases from July 14, April 24, and November 4, 2009).

6. Apple refers to its other online retail stores as “store(s)” (*e.g.*, iTunes Store”).

(Durrance Decl. ¶ 14, Ex. 12)

7. Dictionaries define “store” as a place where goods are sold. (Durrance Decl. ¶¶ 7-8, Exs. 5-6)

8. “App store” is used in the trade press, the general press, by consumers, by Apple’s competitors and by Apple’s founder and CEO, Steve Jobs, as the name for online stores offering apps for download. (Durrance Decl. ¶¶ 1, 4, 9-19, 24; Exs. 1, 7-17, 20-21, 22)

9. Apple filed Application Serial No. 77/525433 on July 17, 2008, for APP STORE listing the following services:

Class 35: 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.

Class 38: 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.

Class 42: 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.

10. Apple’s trademark application for APP STORE disclaims “store.” (Application Serial No. 77/525433)

11. Apple's "App Store" allows customers to view, search, purchase and download apps. (Durrance Decl. ¶¶ 9-10, 12; Exs. 7-8, 10)

12. All of the services claimed in Apple's APP STORE trademark application are offered in connection with its online retail store services. (Durrance Decl. ¶¶ 9-10, 12; Exs. 7-8, 10)

13. Consumers who access Apple's "App Store" from a personal computer do so through the "STORE" option on Apple's iTunes website as shown in the specimens of use filed by Apple in its APP STORE application, which are screenshots from its iTunes store. (Durrance Decl. ¶ 9, Ex. 7)

14. Apple's specimens of use show the "App Store" as an option to select under the iTunes "Store" category. (Durrance Decl. ¶ 9, Ex. 7)

15. Apple's specimens show a search box that allows users to search for apps, music, movies, etc. with the text "Search Store" in the search box. (Durrance Decl. ¶ 9, Ex. 7)

16. Apple's Class 38 specimen shows an app being downloaded from its App Store. (Durrance Decl. ¶ 9, Ex. 7)

17. Apple's Class 38 specimen shows a "Get App" button used to purchase apps from its App Store. (Durrance Decl. ¶ 9, Ex. 7) The current version of Apple's App Store uses a "Buy App" button for this purpose. (Durrance Decl. ¶ 12, Ex. 10 at 5)

III. Legal Standard for Summary Judgment – No Material Facts in Dispute and Moving Party Entitled to Judgment as a Matter of Law

Summary judgment is encouraged in *inter partes* trademark proceedings before the Board, *Phoenix Closures, Inc. v. Yen Shaing Corp.*, 9 USPQ2d 1891, 1892 (TTAB 1988), because the issues are limited to registrability and are therefore "particularly suitable" for disposition by summary judgment. *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 222 USPQ 741, 744 n.2 (Fed. Cir. 1984).

Summary judgment is appropriate where there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. *Giant Food, Inc. v. Standard Terry*

Mills, Inc., 229 USPQ 955, 961 (TTAB 1986). No genuine issue for trial exists where the record taken as a whole could not lead a rational trier of fact to find for the non-moving party.

Matsushita Electric Industrial Co. Ltd. v. Zenith Radio Corp., 475 U.S. 574, 587 (1987). A dispute is genuine only if, on the entirety of the record, a reasonable trier of fact could resolve a factual matter in favor of the non-moving party. *Sweats Fashion, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560 (Fed. Cir. 1987), citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986). Disputes over facts that will not affect the outcome under the governing law are immaterial and do not preclude summary judgment.

IV. Legal Standards for Genericness

A. General Standard for Genericness

“A term is generic and not a mark if it refers to the class, genus or category of goods and/or services on or in connection with which it is used.” *In re Lens.com, Inc.*, 83 USPQ2d 1444, 2007 WL 1196583, *2 (TTAB 2007), citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) and *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

“The determination of whether a term is generic involves a two-part inquiry: First, what is the category or class of the goods or services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that category of goods or services?” *In re Lens.com, Inc.*, 83 USPQ2d 1444, 2007 WL 1196583, *2 (TTAB 2007), citing *H. Marvin Ginn Corp., supra*.

Whether a term is generic is determined at the time the issue arises. *In re Thunderbird Products Corporation*, 406 F.2d 1389, 160 USPQ 730, 732 (CCPA 1969); *see also Buell Motorcycle Co. v. Honda Motor Co. Ltd.*, 2003 WL 21796056, *3-4 (TTAB 2003) (non-precedential). Thus, the appropriate inquiry in this Opposition is whether “app store” is currently generic.

Once an applied-for mark is determined to be generic, registration must be denied and secondary meaning evidence proffered by the applicant is irrelevant. *In re Candy Bouquet International, Inc.*, 73 USPQ2d 1883, 2004 WL 2202265, *7 (TTAB 2004) (“If applicant’s mark is generic, which we have found in this case, then no amount of evidence of acquired distinctiveness can establish that the mark is registrable”); *see also Weeks Dye Works, Inc. v. Valdani, Inc.*, 2010 WL 2104147, *6 (TTAB 2010) (non-precedential) (collecting cases).

B. The Generic Name for a Product, Followed by “Store,” Is Generic for Retail Store Services Featuring the Product

Terms 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. THE COMPUTER STORE, for example, was held generic for stores selling computers. *In re Computer Store*, 211 USPQ 72 (TTAB 1981). In that case, the applicant’s marketing materials described its services as a “store” and the Board reasoned that:

... there is no question that the word “store” in the mark “THE COMPUTER STORE” conveys the meaning of a business establishment where goods are collected and kept for retail sale ... It follows that a “Computer Store” is a retail outlet where computers and computer parts are sold and serviced.

Id. at 74. The Board held that THE COMPUTER STORE was generic and therefore unregistrable for the service of selling computers and for ancillary services offered at the store such as photocopying, technical support, use of a blueprint library. *Id.*

The same result was reached by the Seventh Circuit in *Mil-Mar Shoe Co. v. Shonac Corp.*, 75 F.3d 1153, 1157 (7th Cir. 1996), where SHOE WAREHOUSE was held generic for stores selling shoes. After concluding that “warehouse” was a commonly used name for a type of retail store where goods are sold “in high volume, from a relatively large store, at discount prices,” *id.* at 1159, the Court found that “‘Shoe Warehouse,’ like ‘Shoe Outlet’ or ‘Shoe Mart’ *definitely* qualifies as generic; it is the generic term for a type of retail store that sells shoes.” *Id.* at 1159-60 (footnotes omitted) (emphasis added).

The Board has followed this rule in other cases, such as *In re AEW, Inc.*, 1999 WL 285499 (TTAB 1999) (non-precedential) (DISCOUNT AUTO PARTS STORES generic for auto parts stores) and *In re Italian Store*, 2010 WL 2104134 (TTAB 2010) (non-precedential) (THE ITALIAN STORE generic for delicatessen selling Italian food).

C. Appropriate Evidence to Prove Genericness

Evidence of genericness may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. *In re Lens.com, Inc.*, 83 USPQ2d 1444, 2007 WL 1196583 at *2, citing *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985). The Board and federal courts frequently find the following sources to be relevant:

- Dictionaries are a credible source of evidence of genericness “[b]ecause generic use implies use consistent with common understanding.” *Mil-Mar*, 75 F.3d at 1158.
- “Significant use of a term by competitors in the industry has traditionally been recognized ... as indicating genericness.” *Mil-Mar*, 75 F.3d at 1159.
- Generic use by the party seeking trademark protection is relevant because “[a] kind of estoppel arises when the proponent of [a] trademark use is proven to have itself used the term before the public as a generic name.” *Colt Defense LLC v. Bushmaster Firearms, Inc.*, 486 F.3d 701, 707 (1st Cir. 2007).
- Generic use by consumers is direct evidence of genericness. *See In re Jonathan Drew, Inc. dba Drew Estate*, 2009 WL 5253035, *4-5 (TTAB 2009) (non-precedential) (“consumer blogs, discussion groups and forums” are direct evidence of genericness).

V. **The Undisputed Facts Establish That “App Store” Is Generic for Retail Store Services Featuring “Apps”**

A. **“App” Is a Generic Name for Software Applications**

The Oxford English Dictionary defines “app” as “[a]n application, esp. an application program” and indicates that “app” has been in use since 1985. (Durrance Decl. ¶ 5, Ex. 3 at 1) Other dictionaries confirm that “app” is a shorthand term for “application.”

- *New Oxford American Dictionary (app for Apple’s iPhone)* defines “app” as “short for application” and defines “application” as “computing: a program or piece of software written to fulfill a particular purpose of the user”
- *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”

(Durrance Decl. ¶¶ 5-6, Exs. 3-4)

“App” is commonly used in the trade as a generic name for software applications of the type featured at Apple’s store. Indeed, Apple advertises its App Store as having “The World’s largest collection of mobile apps,” invites users to “Download apps” and “Find more perfect apps,” and lists categories of “Apps” in a scrollable banner at the bottom of the screen (*i.e.*, “Apps for iPhone,” “Apps for Cooks,” “Apps for Work,” “Apps for Music,” etc.) as seen below:



Apple's iPhone website, November 8, 2010 (red emphasis added) (Durrance Decl. ¶ 10, Ex. 8). See also Apple's App Store Facebook page, which prominently displays its App Store Logo with the tagline "**Apps for iPhone iPod touch and iPad**" (Durrance Decl. ¶ 13, Ex. 11).

Like these advertisements, Apple's App Store is replete with generic uses of "app" to identify the products offered at its store, including:

- "App of the Week"
- "Apps from iPhone TV ads"
- "Great Free Apps"
- "Apps Starter Kit"
- "Buy App" button selected by users to buy apps from the store

(Durrance Decl. ¶¶ 9-10, 12; Exs. 7-8, 10); See also "app store" uses cited in Section V.C. and Section V.D., below, which include generic use of "app."

"App" is so well known that it has just been named the "Word of the Year" for 2010 by the American Dialect Society, a leading group of US linguists. (Durrance Decl. ¶ 24; Ex. 22)

It is beyond dispute that "app" is a generic name for software applications of the type offered at Apple's "App Store."

B. "Store" Is Generic for Retail Store Services

"Store" is a common, generic name for retail store services. See, e.g., *In re Computer Store*, 211 USPQ at 74, *In re Italian Store*, 2010 WL 2104134 at *1, *In re AEW, Inc.*, 1999 WL 285499 (all cases where the Board found "Store" to be generic for retail store services).

Various dictionary definitions confirm the common understanding of the term "store":

- *New Oxford American Dictionary (app for Apple's iPhone)* defines "store" as "a retail establishment selling items to the public"
- *Dictionary.com* defines "store" as "an establishment where merchandise is sold, usually on a retail basis"

(Durrance Decl. ¶¶ 7-8; Exs. 5-6)