

<p>This Opinion is not a Precedent of the TTAB</p>
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Mailed: January 13, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Apple Inc.

Serial No. 86857587

Notice of Correction

Glenn A. Gundersen, Jennifer Insley-Pruitt, and Jesse Lambert of Dechert LLP
for Apple Inc.

Robert A. Cohen, Trademark Examining Attorney, Law Office 103,
Stacy Wahlberg, Managing Attorney.

By the Board:

On January 12, 2020, the Board mailed a final decision in this proceeding. It has come to the Board's attention that there were several errors in the decision that included the following: (1) the wording "technologically advanced keyboards" on pages 7, 40, and 74 should have been specified as "technologically advanced keyboards for mobile digital devices," and (2) the wording "the genus at issue in this case: "technologically advanced keyboards for mobile digital devices" should have been specified as "technologically advanced keyboards." In addition, there were two

typographical errors: (1) the word “first” was incorrectly omitted from page 71, and (2) the wording the “Applicant argues that” was duplicated on page 65.

The Board regrets these errors and provides immediately below its corrected decision. In all other respects, the Board’s decision remains as written. Applicant’s time for filing a request for reconsideration, an appeal, or commencing a civil action continues to run from the January 12, 2021 mailing date of the Board’s original decision. *See* Trademark Rule 2.145(d), 37 C.F.R. § 2.145(d).

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Stacy Wahlberg, Managing Attorney.

Before Cataldo, Wellington and Lebow,
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

Applicant, Apple Inc., applied to register the mark SMART KEYBOARD, in standard characters, on the Principal Register for an “Accessory for a handheld mobile digital device, namely, a protective and decorative cover for a tablet computer that functions as a computer stand and incorporates a keyboard,” in International Class 9.¹

¹ Application Serial No. 86857587 was filed on December 22, 2015, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging a date of first use anywhere and in commerce of November 11, 2015. Applicant submitted a voluntary disclaimer of “KEYBOARD.”

he Trademark Examining Attorney originally refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that SMART KEYBOARD is merely descriptive of Applicant's goods. When the descriptiveness refusal was made final, Applicant filed a notice of appeal, as well as a request for reconsideration wherein it amended the application to seek registration on the basis that the mark has acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

In a subsequent office action, the Examining Attorney rejected Applicant's 2(f) claim and issued a new refusal under Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051-1053 and 1127, on the ground that SMART KEYBOARD is a generic term, and maintained, in the alternative, the 2(e)(1) descriptiveness refusal and the determination that the showing of acquired distinctiveness is insufficient. When the Sections 1, 2, and 45 genericness refusal was made final, Applicant filed a request for reconsideration and amended the application to seek registration on the Supplemental Register.

In a further office action, the Examining Attorney denied Applicant's second request for reconsideration and issued a new refusal under Sections 23(c) and 45 of the Trademark Act, 15 U.S.C. §§ 1091 and 1127. The new refusal effectively only amended the statutory basis for the genericness refusal from a proposed mark on the Principal Register to one on the Supplemental Register. When the genericness refusal, now under Sections 23(c) and 45, was made final, Applicant requested reconsideration, which once more was denied.

The appeal is fully briefed and an oral hearing was held on November 19, 2020.

We affirm the refusal.

I. Preliminary Issue – Applicant’s Motion to Remand

On December 19, 2020, one month after oral argument for this appeal, Applicant filed a request for suspension of the appeal and remand of the application to the Examining Attorney “so that Applicant may amend the Application [back] to the Principal Register and seek registration under Section 2(f) of the Trademark Act in light of Applicant’s November 11, 2020 attainment of five years of substantially exclusive and continuous use of the SMART KEYBOARD mark.”² Applicant requests that the Board remand the application at this late stage of the appeal in order to provide the Examining Attorney an opportunity to withdraw the genericness refusal based on Applicant’s attainment of five-year-use status.³

A request for suspend and remand an application to introduce evidence after an appeal has been filed must include a showing of good cause.⁴ *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 1207.02 and 1213. “The length of the delay in making the request after the reason for the remand becomes known, **or the point in the appeal process at which the request for remand is made,** will be considered in the determination of whether good cause exists. Generally, the later in the appeal proceeding that the request for remand is filed, the stronger the

² 35 TTABVUE 2.

³ Notably, Applicant failed to notify the Board at the oral hearing held in this matter on November 19, 2020—just one day before the five-year use date—that Applicant intended to seek remand of the application to claim acquired distinctiveness under a different theory.

⁴ *Id.* at 3.

reason that must be given for good cause to be found.” TBMP § 1207.02 (emphasis added).

Under the circumstances, we find that remand of the application at this stage would unduly delay this appeal which, together with prosecution, has already lasted more than five years. “[C]reation of the record to be considered in an ex parte appeal must, at some point, be concluded.” *In re Zanova, Inc.*, 59 USPQ2d 1300, 13002 (TTAB 2001).⁵ Applicant’s request for remand and suspension is denied.

II. Genericness – Applicable Law

Because Applicant’s claim of acquired distinctiveness was not made in the alternative, it was a concession that the proposed mark is not inherently distinctive and, thus, not registrable on the Principal Register absent proof of acquired distinctiveness. *See Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) (“Where an applicant seeks registration on the basis of Section 2(f), the mark’s descriptiveness is a nonissue; an applicant’s reliance on Section 2(f) during prosecution presumes that the mark is descriptive.”). Applicant’s amendment to seek registration on the Supplemental Register had the same effect. *See e.g., Perma Ceram Enters. Inc. v. Preco Indus., Ltd.*, 23 USPQ2d 1134 n.11 (TTAB 1992) (An application for registration on the Supplemental Register is a

⁵ We further observe that Applicant’s request for remand, if granted, would be futile inasmuch as the Examining Attorney has already denied Applicant’s claim of acquired distinctiveness based on evidence and, in view of our affirmance of the genericness refusal, the additional claim of acquired distinctiveness is moot. *See In re Johanna Farms, Inc.*, 223 USPQ 459, 461 (TTAB 1984) (“once [a term is] determined to be generic, no amount of purported evidence of secondary meaning can provide legal protection to the generic term”).

concession that the mark was merely descriptive of the identified goods or services “at least at the time of the registrant’s first use of the term.”). As a result of Applicant’s amendment to seek registration on the Supplemental Register, the question of whether Applicant’s alleged mark has acquired distinctiveness under Trademark Act Section 2(f) is not before us.

Thus, we must determine whether SMART KEYBOARD is capable of distinguishing Applicant’s goods from those of others. “Generic terms do not so qualify.” *In re Emergency Alert Sols. Grp., LLC*, 122 USPQ2d 1088, 1089 (TTAB 2017); *see also In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001) (generic terms “are by definition incapable of indicating a particular source of the goods or services”). A generic term “is the common descriptive name of a class of goods or services” and unregistrable on either the Principal or the Supplemental Register. *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015) (citing *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)). “To allow trademark protection for generic terms, i.e., names which describe the genus of goods being sold, even when these have become identified with a first user, would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.” *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987).

The Examining Attorney must establish that a proposed mark is generic. *In re Hotels.com, L.P.*, 573 F.3d 1300, 91 USPQ2d 1532, 1533 (Fed. Cir. 2009); *Merrill*

Lynch, 4 USPQ2d at 1143. There is a two-part test used to determine whether a designation is generic: (1) what is the genus (class or category) of the goods or services at issue? and (2) does the relevant public understand the designation primarily to refer to that genus of goods or services? *Princeton Vanguard*, 114 USPQ2d at 1830 (citing *Marvin Ginn*, 228 USPQ at 530); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1462 (TTAB 2014).

III. Genus of the Goods at Issue

Our first task is to determine the proper genus of the goods at issue. In defining the genus, we commonly look to the identification of goods in the application. *In re Reed Elsevier Prop. Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) (a proper genericness inquiry focuses on the identification set forth in the application or certificate of registration); *In re Serial Podcast, LLC*, 126 USPQ2d 1061, 1063 (TTAB 2018) (proper genus generally is “set forth by the [identification of goods] in each subject application.”).

The Examining Attorney asserts that “applicant’s identification of goods helps to clarify the overall genus but itself does not completely define it.”⁶ Rather, “[t]he body

⁶ 23 TTABVUE 6 (Examining Attorney’s Brief). Citations to TTABVUE throughout the decision are to the Board’s public online database that contains the appeal file, available on the USPTO website, www.USPTO.gov. The first number represents the docket number in the TTABVUE electronic case file and the second represents the page number(s). Citations to the examination record refer to the Trademark Office’s online Trademark Status and Document Retrieval system (TSDR) and the page references are to the downloadable .pdf versions of the documents.

of evidence ... shows that the term ‘SMART KEYBOARD’ is used to refer to a category of technologically advanced keyboards for mobile digital devices, thus comprising a genus of goods; applicant’s goods being one example of a keyboard-centered peripheral featuring technological means for communicating with a device such as a tablet or computer.”⁷ The record includes the following definitions:

- Smart – “(hardware) incorporating some kind of digital electronics” (encyclopedia2.thefreedictionary.com);⁸ and “*informal*. Equipped with, using, or containing electronic control devices, as computer systems, microprocessors, or missiles: *a smart phone; a smart copier*” (dictionary.infoplease.com).⁹
- Smart Device – “an electronic gadget that is able to connect, share and interact with its user and other smart devices (techopedia.com).¹⁰
- Keyboard – “a set of keys, usually arranged in tiers, for operating a typewriter, typesetting machine, computer terminal, or the like” (dictionary.infoplease.com), and “the whole arrangement of keys (as on a computer or typewriter)” (merriam-webster.com).¹¹

The Examining Attorney also provided numerous printouts of third-party Internet webpages and articles showing use of the term SMART KEYBOARD and close derivatives to describe various types of technologically advanced keyboards. Ordinarily, we would discuss that evidence within the context of the second prong of the *Marvin Ginn* test. However, since the Examining Attorney relies on public perception evidence, in addition to the identification of goods, to determine the genus,

⁷ 15 TTABVUE 3 (January 7, 2020 Request for Reconsideration Denied).

⁸ April 4, 2016 Office Action, TSDR 8.

⁹ *Id.* at 15.

¹⁰ November 17, 2016 Final Office Action, TSDR 8.

¹¹ April 4, 2016 Office Action, TSDR 17-22.

it is appropriate to list some of that evidence here, which includes the following (bold emphasis added):

- An advertisement for an Always Innovating “Swiss Army Knife” Smart Keyboard featuring USB adapters and Bluetooth technology: “Have you ever dreamt of a keyboard that can do it all? ... **Our smart keyboard is obviously a USB keyboard/touchpad...** it also offers Bluetooth connectivity. No need of all those cables on your desk. ... First, there is a USB chain. No need to look for this dongle: it’s here, just accessible in your keyboard. We have also added a USB-to-HDMI Dual Screen Adapter. ... Add a second monitor (including TV) to your PC” (alwaysinnovating.com);¹²



- Articles discussing a smart keyboard developed by Das Keyboard:
 - “**Do We Really Need a ‘Smart Keyboard,’**” (August 29 and 30 2016): “As the Internet of Things evolves, it seems that an ever growing number of devices are connected to the Internet. ... An **example of this is the smart keyboard that’s developed by Das.** The device uses an array of LEDs underneath the keys to try and help us to work more efficiently. Smart Keyboards – The product ... allows users to program their keyboard to do various things at various times. ... Because it’s a cloud-enabled output device, [it] is different than any other keyboard ever made.... (adigaskell.org and dzone.com);¹³
 - “Das Keyboard Launches New Q-Series Cloud-Connected Smart Keyboard for up to \$249” (date unknown): Das Keyboard today introduced the future of mechanical keyboards with the long-anticipated launch of its groundbreaking Q-series – a family of smart, cloud-connected keyboards that increase productivity by empowering users to stream information from the Internet directly to their Q-enabled

¹² June 28, 2017 Office Action, TSDR 19.

¹³ *Id.* at 20-21; February 5, 2018 Office Action, TSDR 97-98.

keyboards” (wccfttech.com):¹⁴



- Articles discussing a OneBoard “smart keyboard,” and a point-of-sale website listing:

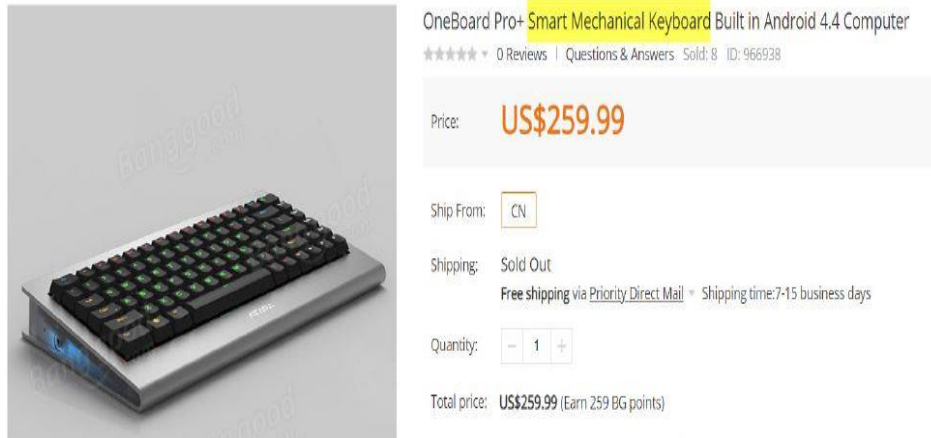
“This Smart Keyboard Can Recognize Its Owner” (January 21, 2015): “It offers an unprecedentedly accurate, unique, and permanent typing pattern for further verification and recognition purposes.’ Arguably better than the security aspects of the keyboard are its other benefits. For one thing, it harnesses the energy generated from typing to power itself or other small devices” (fastcompany.com);¹⁵

--“OneBoard to rule them all? **This smart keyboard PC runs Windows or Android**” (May 25, 2015): “This very clever PC-in-a-keyboard plugs into almost any screen.... **As manufacturers turn almost every device into something smart and connected,** Beijing-based AC000 has come up with a smart keyboard that actually makes sense.... While keyboard peripherals have been all the rage for modern tablet devices, OneBoard looks to flip the relationship. It’s a computer contained entirely within the keyboard, and all a user will need to do is plug into the screen” (cnet.com);¹⁶

¹⁴ October 2, 2018 Office Action, TSDR 34-41. The Examining Attorney also provided an Amazon.com listing for a Das “Smart Mechanical Gaming Keyboard,” which is described as the “ultimate smart RGB Keyboard for professionals who like to game: no interruptions, fully programmable,” and “the world’s first Smart Crossover (Work/Gaming) Keyboard.” May 9, 2019 Final Office Action, TSDR 34-37.

¹⁵ February 5, 2018 Office Action, TSDR 99-101. Other articles discussing this smart keyboard were provided from the PBS News Hour (pbs.org), *id.* at 113-114; the American Chemical Society (acs.org) and Science Daily (sciencedaily.org), *id.* at 92-94; the News and Observer newspaper (Raleigh, NC), June 28, 2017 Office Action, TSDR 10; futurity.org, *id.* at 34-39; Popular Science (popsci.com), October 2, 2018 Office Action, TSDR 42-46); and gadgetify.com, May 9, 2019 Final Office Action, TSDR 30-33.

¹⁶ *Id.* at 89-91.



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- Advertisement for a Samsung **Smart Wireless Keyboard**: “Enhance your Smart TV experience with the VC-KBD2500 Wireless Keyboard. ... Connect to your smartphone or tablet with the wireless keyboard, and write text messages and emails more comfortably. ... It provides complete control of your Samsung TV and Smart Hub so you don’t need a separate mouse” (samsung.com/us):¹⁸



- Advertisement for a Belkin Mobile Wireless Keyboard: “Never choose between your tablet and your smartphone again. Now you can wirelessly pair up to two devices at the same time with a Bluetooth **Smart keyboard**. In fact, any Bluetooth 4.0 enabled device can be paired with the Mobile Wireless Keyboard” (belkin.com);¹⁹

¹⁷ May 9, 2019 Final Office Action, TSDR 29 (point-of-sale listing on banggood.com).

¹⁸ *Id.* at 105-108.

¹⁹ *Id.* at 170-171.



- Articles and advertising for a Satechi Bluetooth wireless **smart keyboard**:

--“Must-have tech gadgets for college; GADGETS” (September 11, 2015): “Satechi’s BT wireless smart keyboard works with both Mac and PC computers, as well as iOS and Android smartphones and tablets” (Dayton Daily News);²⁰

--Amazon.com listing for a Satechi Bluetooth Wireless **Smart Keyboard** with 4-Device Sync for Macbook Pro, Macbook Air, iMac, Mac Pro and iOS Devices” (amazon.com);²¹

Compare with similar items



- Amazon.com listing for an ONHI wireless Bluetooth smart keyboard case: “7 COLORS BACK-LIT IPAD SMART KEYBOARD – 2017 new apple ipad pro case 10.5 with keyboard have [sic] 7 different backlight colors ... to bring you ... visual enjoyment and comfortable typing experience” (amazon.com);²²

²⁰ June 28, 2017 Office Action, TSDR 9. The Examining Attorney also provided a transcript from NBC-13 WVTM in Birmingham, AL discussing features of Satechi’s Bluetooth Wireless Smart Keyboard” (October 6, 2014). 15 TTABVUE 15-16 (Request for Reconsideration Denied, Part 1).

²¹ February 5, 2018 Office Action, TSDR 175-183.

²² *Id.* at 197-198.



- New York Times article, “STATE OF THE ART; Less Than A Laptop, And More” (July 5, 2001) discussing several technologically advanced smart keyboards made by Logitech, AlphaSmart keyboard, Perfect Solution, QuickPad, and CalcuScribe: “Now, these aren’t traditional laptops by any stretch; they’re more like glorified keyboards (In fact, you can use most of them as keyboards when you’re not on the road). ... Smart keyboards start up and shut off instantly, are apparently crash-proof, save your work automatically and preserve your files when the batteries are removed. **The best-known smart keyboard is the AlphaSmart 3000 ... created by a pair of former Apple engineers.** ... These strange devices, populating a rarefied product space somewhere between handheld devices and laptops, require about as much power and maintenance as a Frisbee”;²³
- Article from the Bradenton Herald, “Gadgets any father (or anyone, really) would love” (May 15, 2014): “Smart keyboard saves inputting headaches[.] Anytime you use a set-top box such as Apple TV or Roku you are forced into the cumbersome process of inputting username and passwords with the remote, scrolling around for one letter at a time. To the rescue comes Logitech’s Harmony Smart Keyboard, a one-touch media control, universal remote and a keyboard for your system. Look at the smart keyboard as a control center....; and a Logitech webpage for its Harmony **Smart Keyboard**” (Logitech is one of the companies mentioned in the above New York Times article as a smart keyboard developer) (support.logitech.com);²⁴

²³ 15 TTABVUE 11-15 (Request for Reconsideration Denied, Part 1).

²⁴ *Id.* at 19-21; February 5, 2018 Office Action, TSDR 200-202.



Applicant argues that “the Trademark Office has misconstrued the genus of Apple’s goods.”²⁵ Noting that a proper genericness inquiry focuses on the description of goods set forth in an application, *Magic Wand*, 19 USPQ2d at 1552, Applicant asserts that it is “not trying to register a mark for a technologically advanced keyboard. [Applicant’s] SMART KEYBOARD accessory combines a tablet keyboard, cover, and stand into a single unit. The Examining Attorney ignores the multifaceted nature of [Applicant’s] product in defining the relevant genus, thereby narrowing the product and its functionality and skewing the genericness analysis.”²⁶

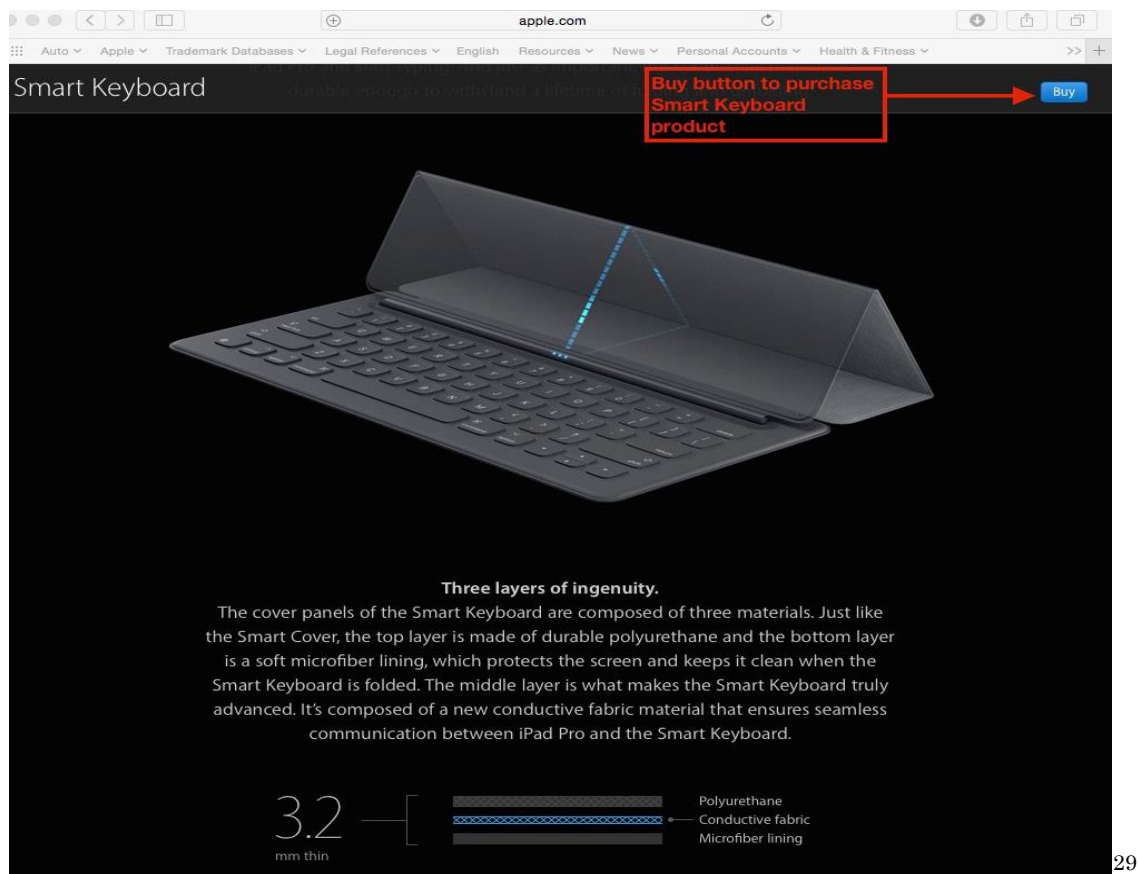
Applicant elevates form over substance. As the Examining Attorney observes, “Applicant’s identification of goods structurally places the keyboard element toward the end of the description, but doing so does not otherwise alter the core nature of the goods.”²⁷ Thus, while the good described in the application is an “accessory for a handheld mobile digital device, namely, a protective and decorative cover for a tablet computer that functions as a computer stand and incorporates a keyboard,” the same good can also be described, perhaps more aptly, as either: (1) an accessory for a

²⁵ 20 TTABVUE 3 (Applicant’s Brief).

²⁶ *Id.* at 6.

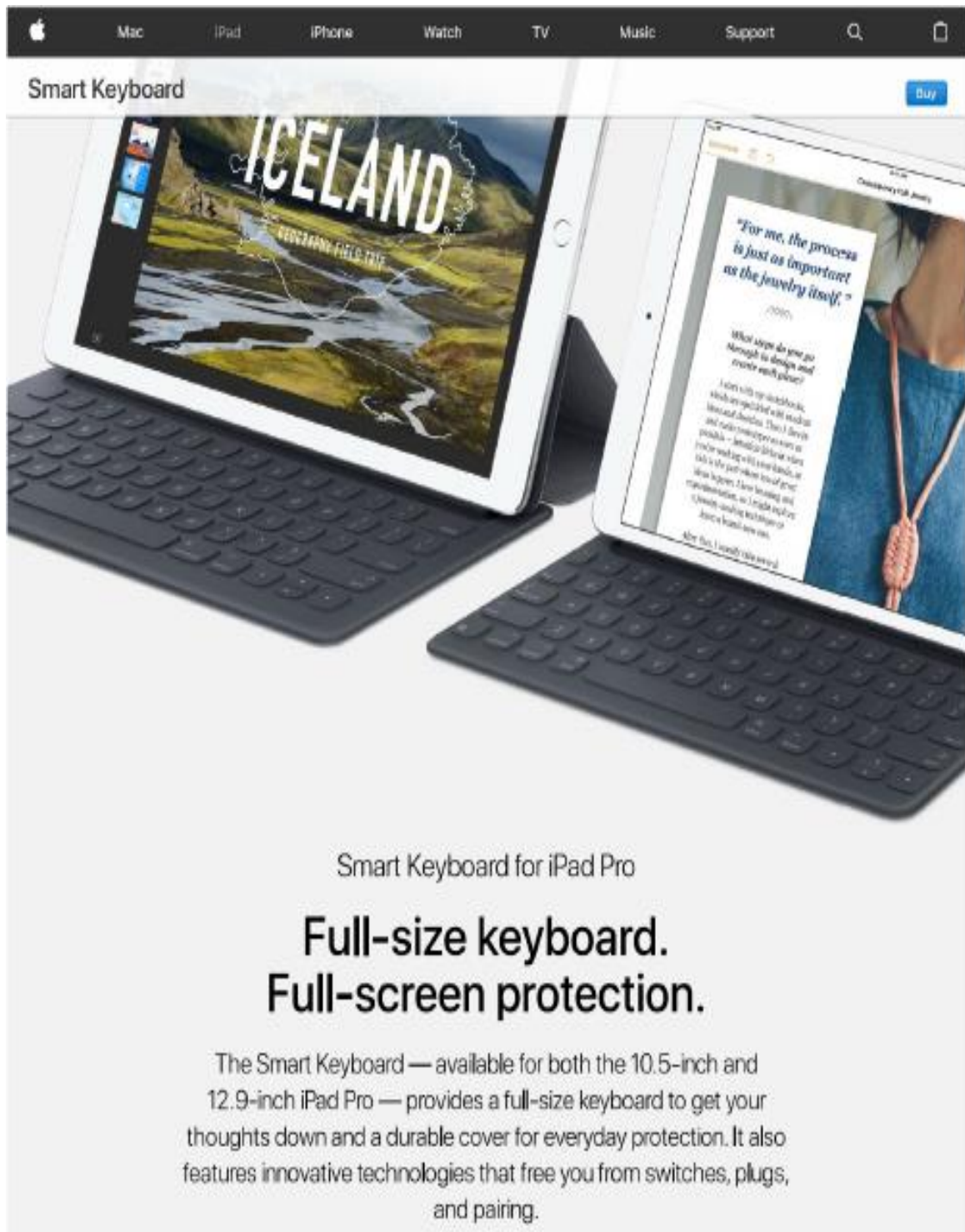
²⁷ 23 TTABVUE 8 (Examining Attorney’s Brief).

handheld mobile digital device, namely, a keyboard that functions as tablet computer cover and folds into a stand, or as (2) an accessory for a handheld mobile device, namely, a keyboard that folds into a computer stand and becomes a tablet computer cover. Applicant's specimen of use, promotion of the goods on its website and other websites (such as Amazon.com), as well as a number of reviews of Applicant's goods on third-party websites, drives home the point that "[t]he keyboard and connective technology are the core features of the goods," as noted in the following excerpts of evidence:²⁸



²⁸ *Id.*

²⁹ Specimen of Use, submitted on December 22, 2015 with TEAS RF New Application.



The image is a screenshot of the Apple website's product page for the Smart Keyboard. At the top, a dark navigation bar contains the Apple logo and links to Mac, iPad, iPhone, Watch, TV, Music, Support, a search icon, and a shopping bag icon. Below this, the text 'Smart Keyboard' is displayed on the left, and a blue 'Buy' button is on the right. The main visual is a photograph of two iPad Pro devices. The iPad on the left is a 12.9-inch model, displaying a landscape image with the word 'ICELAND' in large white letters. The iPad on the right is a 10.5-inch model, displaying a text-heavy article with a quote: 'For me, the process is just as important as the jewelry itself.' Both iPads are attached to their respective Smart Keyboards, which are black with a full-size keyboard layout. The background of the page is a light gray.

Smart Keyboard for iPad Pro

**Full-size keyboard.
Full-screen protection.**

The Smart Keyboard — available for both the 10.5-inch and 12.9-inch iPad Pro — provides a full-size keyboard to get your thoughts down and a durable cover for everyday protection. It also features innovative technologies that free you from switches, plugs, and pairing.

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³⁰ December 22, 2017 Response to Office Action, TSDR 15.



Type • Watch • Cover

Easy to use. Even easier to take with you.

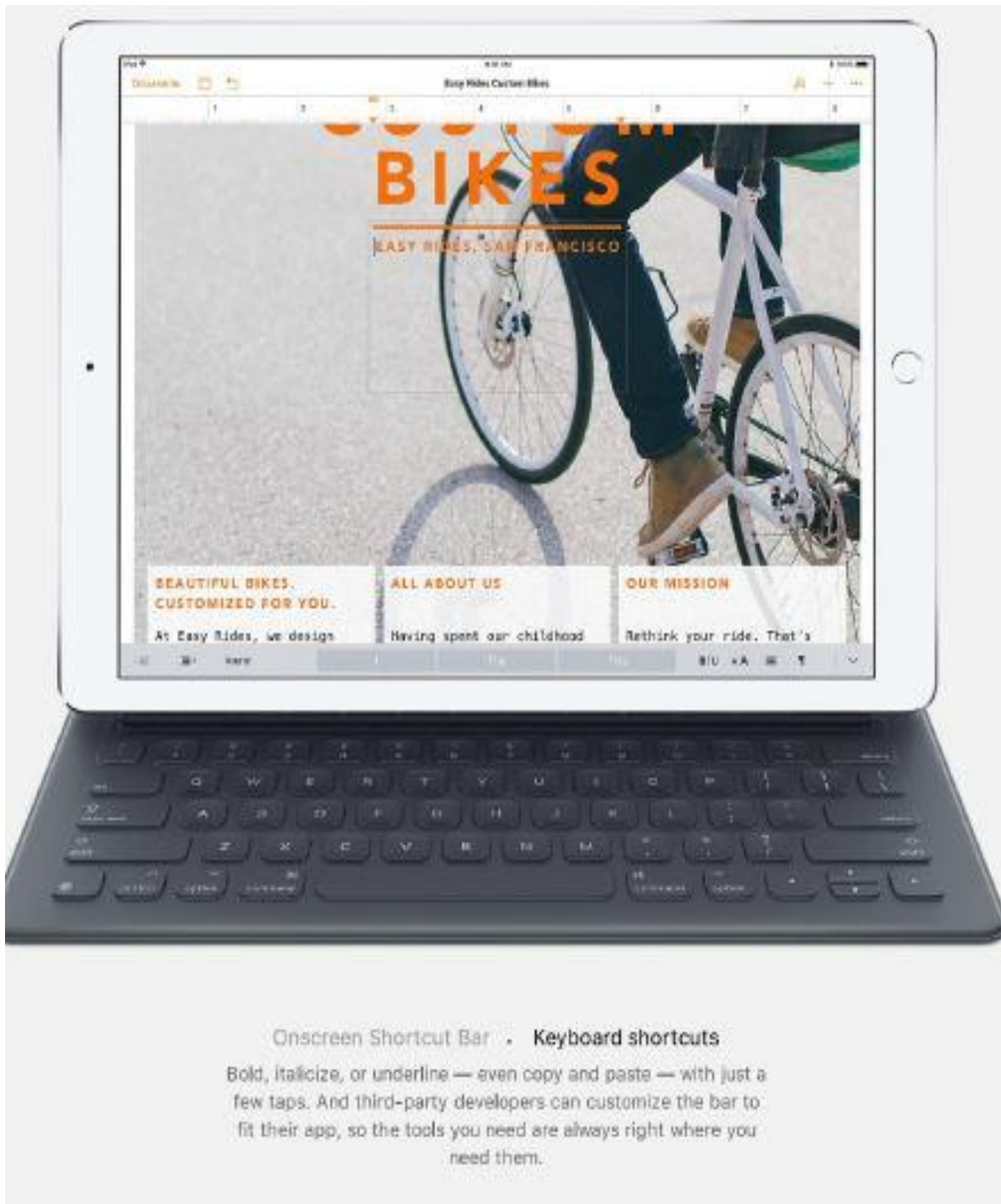
Unfold the Smart Keyboard when you need it. Fold it to create a slim, lightweight cover when you don't. The elegant design is durable enough to withstand everyday use. And your 23rd draft.

Shortcuts at your fingertips.

Discover all kinds of useful shortcuts for getting things done on your iPad Pro.

31

³¹ *Id.* at 16.



No plugs.

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³² *Id.* at 17.

No switches. No pairing.

The Smart Connector transfers both data and power between iPad Pro and the Smart Keyboard — no batteries or charging required. Just attach the keyboard and start typing. When you remove it, the onscreen keyboard automatically reappears.



Smart Connector



Innovation across the board.

There are no gaps between keys to trap crumbs or coffee. Instead, the keys are laser ablated into a single sheet of durable custom-woven fabric coated in a water-resistant finish. The fabric also provides spring-like tension for each key, eliminating the need for bulky conventional mechanisms.

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³³ *Id.* at 18.



Smart Keyboard for iPad Pro.

Type. On a totally new type of keyboard.

For many, a keyboard remains a convenient way to put thoughts down and get work done. The Smart Keyboard — available for both the 9.7-inch and 12.9-inch iPad Pro — features innovative technologies that free you from switches, plugs, and even pairing. It's a perfect blend of utility and portability.

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³⁴ 4 TTABVUE 208 (Request for Reconsideration).

³⁵ *Id.* at 225.



Applicant complains that “the examining Attorney previously stated that the identification ‘adequately defines the genus at issue’ but later chose “to look past the identification of goods in [the] application, imposing its own definition of the genus ... as ‘technology advanced keyboards.’”³⁷ However, “[t]he Examining Attorney ignores the multifaceted nature of [Applicant’s] product in defining the relevant genus, thereby narrowing the product and its functionality....”³⁸

We disagree with Applicant’s assessment. Just as a reclining chair does not cease to be a reclining chair if it features a function that converts to be a bed and/or has a retractable desk; a showerhead does not cease to be a showerhead if it features a handle and/or an embedded light; and a turntable does not cease to be a turntable

³⁶ February 5, 2018 Office Action, TSDR 186.

³⁷ 20 TTABVUE 6 (Applicant’s Brief, internal citations omitted).

³⁸ *Id.*

because it has legs that act as a stand and/or an embedded CD-player; neither does Applicant's keyboard cease to be a keyboard because it has additional features. The core of the goods, as demonstrated by Applicant's own specimen, advertising and promotion of its SMART KEYBOARD goods, as well as other evidence in the record in the nature of product reviews for Applicant's goods, are indeed keyboards. Not just any keyboards: keyboards that are "smart," in that they are able to connect, share and interact with its user and other smart devices.³⁹ The fact that the keyboard can be folded into a cover ("And when you're done, it folds into a slim, lightweight cover") does not make it not a keyboard.

As the Examining Attorney correctly notes, while "a proper genericness inquiry focuses on the description of [goods] set forth in the [application]," *Magic Wand*, 19 USPQ2d at 1552, other relevant evidence of record may be considered in order to properly determine the genus at issue. The Board considered this issue in *In re DNI Holdings Ltd.*, 77 USPQ2d 1437-1438 (TTAB 2005), where an applicant attempted to "carve out" what were "arguably its core services" to avoid a genericness refusal. There, the Board held that *Magic Wand* did not restrict the genus analysis to the identification of goods or services. Rather, the focus on the identification is based on the premise that the identification accurately reflects actual conditions of use of the involved term:

In determining the first part of the *Marvin Ginn* genericness inquiry in

³⁹ Applicant's counsel was also asked at the oral hearing whether "smart" had a recognized meaning in connection with Applicant's goods and related computer goods having at least some level of processing ability, which Applicant denied, responding (paraphrasing): "Well, what does smart mean?"

this case, we are faced immediately with the question of whether it is consistent with the letter and the spirit of the Lanham Act for an applicant to carve out from the recitation contained in the application what are arguably its core services in order to avoid a likely finding of genericness. Specifically, applicant has deftly carved out any reference to “sports betting services,” all the while admitting that its website may well offer sports betting services. Must this Board turn a blind eye to the reality of what is being offered on the named website, restricting our purview to the recitation of services in the application itself, as suggested by the *Magic Wand* case?

We do not believe that is what *Magic Wand* requires. The *Magic Wand* case involved a petition to cancel the registration of the service mark TOUCHLESS on the ground that the term TOUCHLESS was generic for “automobile washing services.” The petitioner in that case attempted to focus on a “relevant public” that was unwarranted by the description of services, namely, manufacturers and dealers of car wash equipment, and not the automobile owners and operators to whom the automobile washing services would be directed. Thus, the decision’s statement that “a proper genericness inquiry focuses on the description of [goods and] services set forth in the certificate of registration” must be read in that context, i.e., as an explanation of the error in petitioner’s attempt to focus on a relevant public not warranted by the actual recitation of services. Further, the quoted reference from the *Magic Wand* case is preceded by the Federal Circuit’s observation that “[t]he description in the [application or] registration certificate identifies the [goods and] services in connection with which the [applicant or] registrant uses the mark.” ... Thus, it is clear that the analytical focus on the recitation of services is based on the premise that the recitation accurately reflects actual conditions of use of the involved term.

Somewhat analogous to the situation in *DNI Holdings*, Applicant, here, appears to have purposely “structured” its identification of goods in a manner that deemphasizes the core function of its goods in order to avoid a likely finding of genericness. However, we need not turn a blind eye to the reality of what is offered by Applicant’s description of goods as shown by the evidence, including Applicant’s own evidence. Based on that evidence, we find that “technologically advanced keyboards for mobile digital devices” is an accurate description of the genus of the

goods at issue which include keyboards that contain various levels of smart features, and that Applicant's goods fit comfortably within that genus.

IV. Relevant Public Understanding of SMART KEYBOARD

The second part of the *Marvin Ginn* test considers whether the term sought to be registered is understood by the relevant public primarily to refer to the genus of goods under consideration. "The relevant public for a genericness determination is the purchasing or consuming public for the identified goods." *Frito-Lay N. Am., Inc. v. Pinceton Vanguard, LLC*, 124 USPQ2d 1184, 1187 (citing *Magic Wand*, 19 USPQ2d at 1553). *See also Sheetz of Del., Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341, 1351 (TTAB 2013). We agree with the Examining Attorney that "the relevant public comprises ordinary consumers who purchase applicant's goods, because there are no restrictions or limitations to the channels of trade or classes of consumers."⁴⁰

The relevant public is the purchasing or consuming public for the identified goods. *Magic Wand*, 19 USPQ2d at 1553. "Evidence of the public's understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers and other publications." *Merrill Lynch*, 4 USPQ2d at 1143; *see also In re Cordua Rests.*, 823 F.3d 594, 118 USPQ2d 1632, 1634 (Fed. Cir. 2016). In some cases, dictionary definitions and an applicant's own description of its goods may suffice to show genericness. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987); *see also In re Am. Fertility Soc'y*, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999). Competitor

⁴⁰ 23 TTABVUE 9 (Examining Attorney's Brief). Applicant does not argue otherwise.

use may also provide evidence of genericness. See *BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 35 USPQ2d 1554, 1558 (Fed. Cir. 1995) (“The cases have recognized that competitor use is evidence of genericness.”) (citing *Remington Prods., Inc. v. N. Am. Philips Corp.*, 892 F.2d 1576, 13 USPQ2d 1444, 1446 (Fed. Cir. 1990)); *Philip Morris Inc. v. Brown & Williamson Tobacco Corp.*, 230 USPQ 172, 176 (TTAB 1986) (finding evidence that competitors have used a particular word as the name of their goods is persuasive evidence of genericness).

The Examining Attorney provided evidence consisting of “news articles, point of sale displays, blog posts, computer hardware publications, patents, and published patent applications” to show “generic us [sic] of ‘smart keyboard’ as a label for technologically advanced keyboards in the years prior to applicant’s launch of its product, and ongoing to this day.”⁴¹

- **News Articles, Industry Reviews, and Point of Sale Displays
Identifying and/or Discussing a “Smart Keyboard”**

In addition to all of the evidence referenced in the genus discussion above, the Examining Attorney provided news articles, blog and industry reviews, and point of sale listings that he contends, taken together, show “that ‘smart keyboard’ would be understood by consumers to refer to a group of technologically advanced keyboards,” including the following (emphasis added):

- Article from The Austin American-Statesman, “Tanisys signings hint at sales rise” (October 4, 1994): “In addition to SpinWizard, Tanisys officials say the company is close to completing agreements with makers of computer keyboards.... A big keyboard-maker is expected this fall to demonstrate a **‘smart’ keyboard** with special Windows commands

⁴¹ *Id.* at 10.

built into little-used function keys....”;⁴²

- Passage from a book, “Coping with Dyslexia” (Published 2000): “To carry this technology with you to school, you would need a laptop computer. Laptops can be expensive. **An alternative is a ‘smart keyboard.’** Smart keyboards usually run on regular batteries.... can be used for spell checking or note taking. You can use them to list homework assignments. You can also begin writing projects that you will finish when you get home. **When choosing a smart keyboard, you should select one that is easy to operate.** You don’t need a fancy complex machine with functions you will never use”;⁴³
- Article from the Daily News, “Ball State U. report results inform advertisers of behavior during commercials” (October 3, 2006): “The observers recorded the different behavior in five-second increments using the Alphasmart Dana, known as Dana for short. **It’s a smart keyboard** with a screen that responds to touch and allows observers to monitor behavior changes in the viewing subject.”;⁴⁴
- Article from Network World, “Windows 8 Update: Microsoft sets Oct. 26 release date; EU eyeballs Windows 8 browser policy, **tablet keyboards with brains**” (July 19, 2012): “**Smart keyboards** Microsoft put a lot of thought into what’s the best keyboard for Windows 8 tablets and came up with two answers. First, a QWERTY keyboard for users to type on with all their fingers, and then a split QWERTY keyboard with the halves pushed out toward the right and left edges for typing with thumbs”;⁴⁵
- Article from the St. Paul Pioneer Press: “A quiet morning, with the newspaper ... the birds ... the cats ... and what’ve they got now” (July 19, 2012): “...popular in Remington’s manual typewriters launched in 1878. It kept the keys from jamming. Here we are in 2012, and everyone is still learning and using it. ... Can’t someone design a **smart computer keyboard** that can still recognize the old qwerty style, but at the push of a button switch to a newer, more logical standard?”;⁴⁶
- Article from the Los Angeles Times: “Movers and shakers in a motion-

⁴² May 9, 2019 Final Office Action, TSDR 10-11.

⁴³ June 28, 2017 Office Action, TSDR 26-29.

⁴⁴ 15 TTABVUE 17-19 (Third Request for Reconsideration Denied, Part 1).

⁴⁵ June 28, 2017 Office Action, TSDR at 13.

⁴⁶ *Id.* at 14.

sensor revolution; An O.C. father and son are hoping their device providing precise data on athletes' movements will catch on like GPS" (September 6, 2013): "Smart helmets. **Smart keyboards,' he said. 'We definitely want to be a driving force for that transformation'**";⁴⁷

- Article from Upstart Business Journal: "Ritzy Blackberry-Porsche is a beautiful heartbreaker" (November 20, 2013): "The phone is beautiful. Fans of the Italian cars will see the resemblance-Italian leather and all. And with a customized BlackBerry 10.2 OS that includes a 'priority hub' for easily managing conversations across platforms; **a smart keyboard that learns how you type....**";⁴⁸
- Stigviewer.com product discussion: "**Smart (intelligent or programmable) keyboard** is used in conjunction with a KVM switch when the KVM switch is connected to ISs of different classification and/or sensitivity" (August 4, 2014): "Keyboards that include USB ports, smart card slots, and removable media slots are considered smart keyboards";⁴⁹
- Article from the Chicago Business Journal: "Naperville entrepreneur to pitch anti-bullying tech on Shark Tank" (September 23, 2016): "ReThink is an app that uses patent-pending, sophisticated context sensitive algorithms to sense when a hurtful message is about to be sent, and send an alert asking students to pause and think before sending. **Essentially, it's a smart keyboard** that knows when kids are about to say something mean, and asks them to stop before they do something harmful.... The tech has steadily gained traction since Prabhu first launched the app in 2014: the app been downloaded thousands of times on Google Play";⁵⁰
- Article from firstpost.com: "LG Rolly Keyboard is a Full-Sized **Smart Bluetooth Keyboard** That's Quite Portable" (August 28, 2015): "LG has announced a new bluetooth keyboard called the LG Rolly Keyboard, which rolls up to resemble a tiny soundbar or a mobile battery. When unrolled, the Rolly becomes a full-size smart bluetooth keyboard";⁵¹
- Published study titled "Designing Smartphone Keyboard for Elderly

⁴⁷ *Id.* at 12.

⁴⁸ *Id.* at 11.

⁴⁹ *Id.* at 18.

⁵⁰ *Id.* at 7-8.

⁵¹ October 2, 2018 Office Action, TSDR 54.

Users” in “Communications in Computer Science,” from the 18th Int’l Conference 2016, Toronto, Canada (July 17-22, 2016), authors from LG Electronics in Seoul, South Korea, publisher in Switzerland, editor in Greece, published in Library of Congress: “This study aims to explore the cognitive perception by elderly users when using smartphone keyboard, and to discover the suitable design that achieves higher satisfaction and performance. ... A **prototype of a Smart Keyboard**, which user can manually adjust the key’s overall height, each key’s width, and font size and bold styling of characters in each key, is installed in a 5.5 inch touch screen smartphone.”;⁵²

- Website, forrestluu.com, discussing collaboration with Dell computers to design a new keyboard (© 2017): “**dell smart keyboard**[.] Dell wanted to explore future interpretations of the keyboard. Our team set out to provide design solutions that embrace current trends, user behavior/needs, and provide an enhanced experience”;⁵³



- Website, kickstarter.com, development project: “Nums: Ultra-thin Smart Device to Transform Laptop Trackpads. ... It transforms your MacBook trackpad into a smart number computer. ... **Simply attach the ultra-thin smart keyboard onto the trackpad**, download the application ... and you are all set.”



- Newegg.com listing for a VIBOTON S1 Mini 2.4GHz Wireless **Smart**

⁵² June 28, 2017 Office Action, TSDR 30-32.

⁵³ *Id.* at 33.

Keyboard: “Perfect for PC, Tablet, Android TV Box, Google TV Box, Xbox360, PS3 ... etc. Ultra-thin shortcut key design, swift switch between multiple devices. Compact size for ease of carrying ... Built-in wireless smart touchpad with 360-degree flip design”;⁵⁴



- Article from joyofapple.com, “10 Best iPad Smart Keyboard Cases (Most Sold)” (November 30, 2018) with excerpts shown below:⁵⁵

What Is A Smart Keyboard?



Apple iPad Pro Smart Keyboard

The iPad Pro smart keyboard is a detachable, wireless keyboard accessory for iPad Pro. It lets you type on the iPad without using its touchscreen interface.

Since its release, many manufacturers have created smart keyboard alternatives. This gives users more options to find a style that fits them.

...

⁵⁴ *Id.* at 109-112.

⁵⁵ May 9, 2019 Final Office Action, TSDR 44-54.



Zagg Rugged Smart Keyboard

Get a heavy-duty smart keyboard that is perfect for your adventurous spirits with Zagg Rugged smart keyboard. You don't have to worry about getting dirt or water splashed on it, as the Zagg Rugged smart keyboard will handle it all for you.

...



Brydge iPad Smart Keyboard

The Brydge smart keyboard provides a modern design that compliments your iPad very well. Increase your productivity with the help of this smart keyboard.

Connect your iPad with the Brydge smart keyboard via bluetooth and you can then enjoy a smooth typing

- Article from ikream.com, “7 Best **Smart Keyboard** [sic] For 12.9-inch iPad Pro” (April 2, 2019): “No sure what **Smart Keyboard** for the 12.9-inch iPad Pro to get? That’s why we’ve assembled this list of the **seven**

best smart keyboards for you. Follow along below, and we'll show you our top picks";⁵⁶

Apple Smart Keyboard

Coming up as first on our list, we have Apple's very own Smart Keyboard.



Logitech iPad Pro 12.9 Smart Keyboard

Coming up as second on our list, we have Logitech's own iPad Pro 12.9-inch Smart Keyboard. This one operates similarly to Apple's Smart Keyboard, connecting up to your iPad Pro by way of the Smart Connector. There's no batteries or Bluetooth connection needed here — just set your iPad Pro on the Smart Connector part of the accessory, and the connection happens almost instantly. The keyboard on this one is actually detachable so that you have extra flexibility. What's unique about this keyboard is that the keys are

...

Fintie Smart Keyboard Case For iPad Pro 12.9

If you're looking for an excellent and professional Smart Keyboard for the iPad Pro, you cannot go wrong with the one that's made by Fintie. This one is designed for the 3rd generation (2018) model, an

...

Logitech Create

Logitech makes a second keyboard for the iPad Pro, actually. Called the Logitech Create, this one connects up to your tablet directly through the Smart Connector. What's really neat about this Smart Keyboard is that it has a row of iOS shortcuts right on the keyboard — press one of the buttons and you can instantly open up an app, search, or more. This

⁵⁶ *Id.* at 55-62.

Raydem Smart Keyboard For iPad Pro 12.9-inch

Next, we're looking at the Raydem Smart Keyboard designed for the iPad Pro 12.9-inch model. This one is third-party accessory maker, but they provide a cheap way for anyone to get into a Smart Keyboard. Just set your iPad Pro on the Smart Connector portion, and the connection happens almost instantly. The keyboard is a full-size keyboard, so once the attachment completes, you essentially have a MacBook Air in your hands. The keys are comfortable and easy to use, and the case provides a little extra protection for your iPad Pro.

- Article from bibblebytes.com, “Best **Smart Keyboards** For 12.9 Inch iPad Pro 2019, comparing Applicant’s product with several other technologically advanced keyboards;⁵⁷
- Amazon.com listings for Trent iPad Case Airbender Star with Detachable Wireless Bluetooth **Smart Keyboard**” for the Apple iPad.⁵⁸



- **Patent Evidence Identifying and/or Discussing a “Smart Keyboard”**

The Examining Attorney also provided U.S. patents and published patent applications that identify and/or discuss a “smart keyboard” within the context of various inventions. According to the Examining Attorney, this patent evidence, from parties apparently unrelated to Applicant, “shows that ‘smart keyboard’ is understood to be a common name for a broad range of technologically advanced

⁵⁷ *Id.* at 38-43.

⁵⁸ *Id.* at 76-86.

keyboards,” and includes the following (arranged in date order, emphasis added):⁵⁹

- Patent No. 7091955B2, titled “Multi-purpose Keyboard,” (issued August 16, 2006), describing in the background of the invention, what can give a keyboard the status of being a “smart keyboard”:⁶⁰

Due to different key layouts in different countries, it is necessary to implement a look-up technique in order to use the same basic keyboard for a plurality of countries. . . . Macros can be stored on the computer’s memory, or embedded in the keyboard hardware (usually memory means), **which gives the keyboard the status of “smart keyboard.”**

Due to recent developments of a combination between TV and the Internet, a new type of keyboard design is flourishing nowadays. ...

It is ... an object of this invention to provide a method and apparatus for replacing a keyboard on a host machine...., which associates between a keyboard and a computer’s application...., [and] which associates between a keyboard and a computer’s setup....⁶¹

- Patent Application No. 2010/0149105A1, titled “Portable Electronic Device” (published June 17, 2010) for an invention described as “a portable electronic comprised by a main enclosure, a QWERTY keyboard assembly, and a holder:”⁶²

1. Technical Field[.] The present disclosure relates to portable electronic devices and, particularly, to **a portable electronic device with a smart keyboard.**⁶³

- Patent No. 7831923B2, titled “Providing Visual Keyboard Guides According to a Programmable Set of Keys,” for “a system and method for providing visual keyboard guides” (issued November 9, 2010) with

⁵⁹ 23 TTABVUE 12 (Examining Attorney’s Brief).

⁶⁰ November 17, 2016 Office Action, TSDR 51-64.

⁶¹ *Id.* at 54-55.

⁶² *Id.* at 48-50.

⁶³ *Id.* at 49.

repeated references to use of the invention with a “smart keyboard” throughout the summary, drawing description, and claims, e.g.:⁶⁴

SUMMARY... [The] **smart keyboard** detects the presence of a user’s finger tips in proximity to individual keys of the smart keyboard without the user having to actually depress the keys of the keyboard. ... Moreover, **the smart keyboard may be a physical keyboard similar to conventional keyboards or may be a virtual keyboard**, such as a projected keyboard or the like. ...⁶⁵

CLAIMS (13). 1. A method, in a data processing device, for providing visual keyboard guides, comprising: receiving an input specifying one or more keys of a **smart keyboard**, less than a total number of keys of the smart keyboard, for which visual guides are to be provided in response to detecting a presence of a user’s instrument over the one or more keys; ... receiving an input from the **smart keyboard** indicating at least one key of the **smart keyboard** with which a user’s instrument is in proximity, the **smart keyboard** having sensors for detecting a presence of the user’s instrument in proximity to the at least one key of the **smart keyboard**....⁶⁶

- Patent Application No. 2011/0208974A1, titled “Countermeasure Against Keystroke Logger Devices” (published August 25, 2011) for an anti-key logging protocol executable by a computer platform and a corresponding keystroke input device (e.g., keyboard or keypad), which functions as a countermeasure to a key logger device, and describing a preferred embodiment that refers to a “smart keyboard”:⁶⁷

The keystroke input device (**a.k.a., “smart keyboard”**) 204 includes a processor and memory, wherein the processor is operable to execute certain aspects of the AKL protocol in cooperation with the computer platform (i.e., the processor of the computer platform) as a countermeasure to a keystroke logger device. Similarly to a standard keyboard, **the smart keyboard** may also

⁶⁴ *Id.* at 65-87.

⁶⁵ *Id.* at 72.

⁶⁶ *Id.* at 66.

⁶⁷ February 5, 2018 Office Action, TSDR 80-87.

include alphabetic characters, numbers, symbols, punctuation symbols and various function or navigation keys; and may communicate keystroke information to the computer platform. ... (numbered figure specifications omitted).⁶⁸

- Patent No. 8135889, titled “Direct Connection Single User-Interface Control of Multiple Computers and Displays” (issued March 13, 2012), which repeatedly describes a “smart keyboard” in drawings of various embodiments of the invention, e.g.:⁶⁹

FIG. 1 illustrates a first example embodiment of a system for providing single user-interface control of multiple computers and displays [and] ... includes a **smart keyboard device** (i.e., a peripheral computer device) storing a configuration map, and a computer mouse (i.e., a peripheral computer device) operatively connected to the keyboard device. The system further includes a first computer, a second computer, and a third computer each capable of being operatively connected to **the smart keyboard device** via a direct communication link. ...

The **smart keyboard device** provides traditional keyboarding capability as well as an interface to the computer mouse (e.g., a USB [universal serial bus] interface or a PS/2 interface). The **smart keyboard device** is further capable of automatically tracking a current mouse position of the computer mouse, mapping mouse position of the computer mouse to display position of at least two computers, and automatically directing the current mouse position of the computer mouse, any current mouse command of the computer mouse, and any current keyboard command of **the smart keyboard device** directly to one of the computers (numbered figure specifications omitted).⁷⁰

- Patent No. 8432362B2, titled “Keyboards and Methods Thereof” (issued April 30, 2013) for an invention relating “to advanced input device technology. More particularly, the present invention relates to

⁶⁸ *Id.* at 85.

⁶⁹ *Id.* at 48-68.

⁷⁰ *Id.* at 60.

keyboards that incorporate one or more touch pad, virtual human interface device (HID), and projector functions” and identifying various embodiments of the invention used with a “**smart keyboard**,” e.g.:⁷¹

According to one embodiment of the present invention, a method and a “**smart keyboard**” are provided which integrate a virtual human-computer interface, a micro-projector, or both on a magic keyboard. ...

In one embodiment, **the smart keyboard** may be implemented as a stand-alone device that may directly and wirelessly connect to or be integrated into a host master/slave device.

In one embodiment, **the smart keyboard** is programmable to provide a set of user-definable buttons and touchable boxes to meet the needs of specific applications.⁷²

- Patent Application No. 20150029404A1, titled “**Smart keyboard**” (published January 29, 2015), which uses the term “smart keyboard” repeatedly in the abstract, background, summary, and claims of the invention.⁷³

What is claimed is: 1. A **smart keyboard** for establishing bidirectional communication between a television and a portable device. . . . 14. **The smart keyboard of claim 1, wherein the portable device is a mobile phone, a tablet personal computer, or a digital assistant. . . .**⁷⁴

Description of the Prior Art.... Particularly, when the mobile phone and the television are developed toward intelligence, the keyboard provided by the prior art can not (sic) satisfy a requirement of the user, **so a smarter and more convenient smart keyboard is very essential for the user.**⁷⁵

⁷¹ November 17, 2016 Office Action, TSDR 88-112.

⁷² *Id.* at 101.

⁷³ *Id.* at 38-47.

⁷⁴ *Id.* at 38.

⁷⁵ *Id.* at 41-42.

- Patent Application No. 2015/0116219A1, titled “Smart Mouse System and Method of Use” (published April 30, 2015) for an invention related to transferring data from one computer to another and other uses, and describing a “smart keyboard” as an independent embodiment with similar functions as a smart mouse;⁷⁶

The smart keyboard is an independent embodiment of the smart mouse that can adopt similar connectivity between multiple computers and a single keyboard. The **smart keyboard** active computer functionality can be added as part of the Mousetop window computer switching or could be separately switched between computers without a smart mouse using specific keystrokes or functions to toggle between active computers sharing the same keyboard. **In this disclosure, references to the smart mouse also refer to similar functions embodied in a smart keyboard.**⁷⁷

- Patent No. 9423836, titled “Super-slim Touch Keyboard and Super-slim Device **for Smart Keyboard** Having the Same” (issued August 23, 2016) for an invention described as “a portable electronic comprised by a main enclosure, a QWERTY keyboard assembly, and a holder”;⁷⁸
- Patent Application No. 2017/0277287A1, titled “Computing Device Contact Mitigation” (published September 28, 2017) for an invention that assists in eliminating occurrences of unintentionally triggered device contacts that interfere with computing, and describe a smart keyboard in one example implementation of the invention:⁷⁹

Looking now at FIG. 1, this figure depicts an example computing device in accordance with an implementation. The computing device may comprise, for example, a notebook, detachable notebook/tablet, **a smart keyboard**, or another computing device that includes a keyboard and touchpad. As shown, the computing device includes a display, keyboard, touchpad, and keyboard management module (numbered figure specifications omitted).⁸⁰

⁷⁶ February 5, 2018 Office Action, TSDR 31-47.

⁷⁷ *Id.* at 43.

⁷⁸ *Id.* at 12-30.

⁷⁹ *Id.* at 69-79.

⁸⁰ *Id.* at 76.

The Examining Attorney also relies on additional U.S. patent evidence identified by Applicant in its request for reconsideration of the final refusal. According to the Examining Attorney, “Applicant has provided a search result summary of the USPTO’s PAIR database showing ‘keyboard’ paired with **other** terms but of note actually found even more patents, some 34 total, that involve ‘smart keyboard’ or other smart peripherals,” including the following listed patents, the third of which is owned by Applicant (numbered figure specifications omitted):

- Patent No. 10419214B2, titled “Mobile Device Management Delegate for Managing Isolated Devices” (issued September 17, 2019) for a device manager, wherein the term ‘smart keyboard’ is used as part of the description of an advanced peripheral device used in some embodiments of the invention:⁸¹

In some embodiments, smart peripheral device represents a peripheral device that includes, at a minimum, storage sufficient to store peripheral key part and sufficient functional or processing capability to push or otherwise transmit peripheral key part over either a local connection or a networked connection. The smart peripheral device is represented by a **smart keyboard**, a flash drive, and a graphics adapter, all of which may be compatible with USB or another suitable peripheral bus. In these examples, **smart keyboard** and graphics adapter may be intended to provide human-useable I/O interfaces for headless embodiments of gateway device....⁸²

- Patent No. 10328341B2, titled “Programmable Actuation Inputs of an Accessory and Methods Thereof” (issued June 25, 2019) for providing efficient management and utilization of computer gaming accessories (e.g., headset, a keyboard, and mouse) in which a “smart keyboard” is referenced in one of the invention’s embodiments:⁸³

⁸¹ 15 TTABVUE 22-27, 16 TTABVUE 2-10, 17 TTABVUE 2-10 (Request for Reconsideration Denied, Parts 1-3).

⁸² 16 TTABVUE 7 (Request for Reconsideration Denied, Part 2).

⁸³ 17 TTABVUE 11-12, 14 TTABVUE 2-8, 18 TTABVUE 2-9, 11 TTABVUE 2-10 (Request for Reconsideration Denied, Parts 3-6).

It is further noted that the functions described above that can be performed by the computing device can be delegated to a processor of the keyboard. Hence, **a smart keyboard** can be adapted by a user to have programmable thresholds for AP and RP and to perform substitution functions of the AMS application as will be described below.⁸⁴

- Patent No. 10234960B1, titled “Variable Response Key and Keyboard” (issued March 19, 2019), **owned by Applicant by assignment**, which discusses the use of a “smart keyboard” or “smart keyboard system” eighteen times in the course of explaining various embodiments of the invention, for example:⁸⁵

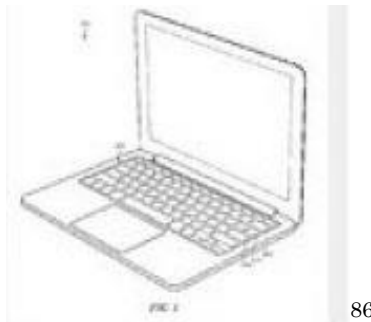


FIG. 1 illustrates one example of an electronic device with a **smart keyboard including smart keys**; ...⁸⁷

The following disclosure generally relates to a “**smart**” **input device used in electronic devices**. A smart input device may vary certain operational parameters or adjust material properties to provide a different feel or response when it receives an input force. A smart input device may be stiffer, travel less, move differently, or otherwise react differently to a received input force as a property of the smart input device is varied.

For example, in one embodiment, a **smart keyboard** including a group of keys is disclosed, the **smart keyboard** providing a

⁸⁴ 14 TTABVUE 4 (Request for Reconsideration Denied, Part 4).

⁸⁵ 11 TTABVUE 11, 12 TTABVUE 2-9, 13 TTABVUE 2-9, 10 TTABVUE 2-6 (Request for Reconsideration Denied, Parts 6-9).

⁸⁶ 11 TTABVUE 11 (Request for Reconsideration Denied, Part 6).

⁸⁷ 12 TTABVUE 3 (Request for Reconsideration, Part 7).

variable or adaptable output (or other response) in response to a force exerted on an input surface. ...⁸⁸

FIG. 2 provides a schematic diagram of an example **smart keyboard system** according to various embodiments. The **smart keyboard system** includes a key with an MR variable response material, magnetic field source, controller, and a key cap configured to receive an input force on an input surface of the key cap. ...⁸⁹

In one embodiment of the **smart keyboard system**, one or more pairs of electromagnets are fitted on opposing sides of an MR material, the MR material disposed below or adjacent a key cap of the group of key, the MR material being a magneto-rheological elastomer.⁹⁰

- **Other Evidence Related to the Term “Smart”**

In addition to the evidence provided regarding use of the term “smart keyboard,” the Examining Attorney also provided evidence of the term “smart” being “used in direct connection with a variety of computer peripherals, including computer mice, and wearables that feature novel and non-traditional connectivity with their parent device” that are “not seen by consumers, as source identifiers.”⁹¹ That evidence includes several articles from trendhunter.com, and computeralliance.com.au, smartandhealth.com discussing various computer mice described as a “smart mouse,” and another from gadgetsandwearables.com discussing “smart rings” and listing other “smart” computer compatible gadgets such as smartwatches, smart scales, and

⁸⁸ 12 TTABVUE 4 (Request for Reconsideration Denied, Part 7).

⁸⁹ *Id.* at 8.

⁹⁰ 10 TTABVUE 2 (Request for Reconsideration Denied, Part 8).

⁹¹ 23 TTABVUE 16 (Examining Attorney’s Brief).

smart glucometers.”⁹² He provides this evidence to support the proposition that “[u]se of a term as an adjective or adjectival phrase does not prevent that term from being generic if it refers to the relevant genus or category of goods,” citing *In re Serial Podcast, LLC*, 126 USPQ2d 1061, 1068 (TTAB 2018) (quoting TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) (Oct. 2017) §1209.01(c)(ii) and cases cited therein).

- **Applicant’s Arguments and Evidence Regarding Public Understanding of “SMART KEYBOARD”**

Applicant argues that the evidence of record “is simply insufficient to meet the legal standard to demonstrate genericness.”⁹³ Specifically, Applicant argues

[T]here is no evidence of such widespread third-party use before [Applicant] introduced the product in November 2015, nor is there current ongoing use. The Trademark Office has therefore failed to make the strong showing required to prove that the relevant public understands SMART KEYBOARD to refer to the specific class or category of goods identified in the application – namely, a protective and decorative cover for a tablet computer that functions as a computer stand and incorporates a keyboard goods identified in the application – namely, a protective and decorative cover for a tablet computer that functions as a computer stand and incorporates a keyboard.⁹⁴

As discussed above, the genus in this case is not limited to Applicant’s characterization of the goods based on an identification carefully crafted to avoid a genericness refusal. Rather, it is based on the actual nature of those goods as shown by the evidence, which indicates that the genus to be: technologically advanced keyboards for mobile digital devices. We turn now to Applicant’s various arguments directed to the sufficiency of the evidence.

⁹² February 5, 2018 Office Action, TSDR 110-131.

⁹³ 20 TTABVUE 4 (Applicant’s Brief).

⁹⁴ *Id.* at 7-8.

1. “The Evidence From Obscure Sources Has Little Probative Value”

Applicant argues that “[m]any of the websites cited by the examining attorney have so little traffic from U.S. visitors that the Alexa web analytics service doesn’t even list them. Thus, a significant portion of the examining attorney’s evidence ... can be excluded on the basis that the general public is simply unlikely to see what appears there.”⁹⁵ Applicant points specifically to the evidence “such as that drawn from” the websites joyapple.com, computerlanguage.com, smartandhealth.com, mybleant.com, forrestluu.com, bibblebytes.com, and nordicsemi.com.⁹⁶ According to Applicant:

[T]here is a distinct lack of substantiating evidence from national newspapers or other mainstream press. Only two of the news clippings offered with the office actions are from a periodical with a broad national readership, but neither refers to “smart keyboard” in connection with the relevant goods. . . .

The rest of the periodical evidence introduced by the Office is drawn from local newspapers or periodicals in various parts of the country. This evidence also fails to support the refusal of Apple’s mark in connection with the identified goods.⁹⁷

The Examining Attorney asserts that Applicant’s obscurity argument “is not persuasive as it would exclude local and regional publications which serve the same bodies of consumers, be it college students, general consumers, engineers, doctors, or other general or sophisticated consumers that purchase applicant’s goods. Websites, newspaper articles and publications are generally a competent source for determining

⁹⁵ *Id.* at 8 (internal citations omitted).

⁹⁶ *Id.*

⁹⁷ *Id.* at 9.

how the public perceives the mark in connection with applicant's goods.”⁹⁸

Applicant's argument that “a significant portion of the examining attorney's evidence can be excluded” because it comes from websites that are poorly trafficked is unpersuasive. First, the Alexa webpage printouts provided by Applicant are barely legible. Second, Applicant provided no explanation or analysis of the data contained in those printouts; Applicant simply refers to them and concludes that a “significant portion” of the websites are poorly trafficked, but that conclusion has no context. Poorly trafficked as compared to what? The relevant public considered in this case is not the “the general public,” as Applicant suggests, but rather the purchasing or consuming public for technologically advanced keyboards. Third, Applicant has provided no evidence regarding the metrics and insights provided by the Alexa data it provided. Apart from indications that the search results pertain to traffic for the last 90 days prior to the search, we have no evidence regarding how the metrics for the results are obtained, such as whether the results are obtained based on samples or direct measurements.

Fourth, the websites highlighted by Applicant in its brief as being sites “that the general public is simply unlikely to see” are cherry-picked from what Applicant acknowledges to be “cumulative office action evidence,”⁹⁹ but none of them are individually relied on by the Examining Attorney as definitive in and of themselves.

⁹⁸ 23 TTABVUE 17 (Examining Attorney's Brief).

⁹⁹ 20 TTABVUE 7 (Applicant's Brief).

Rather, the evidence comes “from a variety of publications”¹⁰⁰ and sources, some of which are well-known, others perhaps lesser known, which, taken as a whole with the all of the other evidence in this case consistently shows “smart keyboard” being used to describe technologically advanced keyboards.

We disagree with Applicant’s contention that “there is a distinct lack of substantiating evidence from national newspapers or other mainstream press” and that “[o]nly two of the news clippings [from the New York Times] offered with the office actions are from a periodical with a broad national readership, but neither refers to “smart keyboard” in connection with the relevant goods.”¹⁰¹ A significant portion of the evidence comes from well-known publications and online sources, such the Los Angeles Times, Chicago Business Journal, cnet.com, fastcompany.com, or is corroborated by other evidence by online retailers.

For example, information regarding one of the Das smart keyboards, similar to those mentioned in three of the provided tech websites (adigaskell.org, dzone.com, and wccftech.com),¹⁰² is corroborated by a recent Amazon.com point-of-sale listing of the product with 1,322 product reviews and referred to as “the world’s first Smart Crossover (Work/Gaming) Keyboard” that was “named best crossover (work/play) computer by washable.”¹⁰³ An article regarding a Logitech smart keyboard discussed

¹⁰⁰ 23 TTABVUE 14 (Examining Attorney’s Brief).

¹⁰¹ 20 TTABVUE 9 (Applicant’s Brief).

¹⁰² June 28, 2017 Office Action, TSDR 20-21; February 5, 2018 Final Office Action, TSDR 97-98; October 2, 2018 Office Action, TSDR 34-41.

¹⁰³ May 9, 2019 Final Office Action, 34-37.

in a 2014 article in the Bradenton Herald, a Florida publication, and Logitech's current website, provides updated information about smart keyboards developed by that company, which the New York Times article identified as one of the companies developing smart keyboards back in 2001.¹⁰⁴

And a Satschi-branded "smart keyboard" mentioned in a Birmingham, Alabama NBC local news broadcast in 2014, was reported on in 2015 by the Dayton Daily News, an Ohio publication, and listed in a recent Amazon.com point-of-sale page (inviting potential purchasers to compare that product with other keyboards including another wireless Bluetooth keyboard from Applicant).¹⁰⁵ We need not discuss each piece of evidence provided by the Examining Attorney here. Suffice to say, having reviewed the record in its entirety, we find that the wide range of website and publication evidence provided by the Examining Attorney is expansive and covers a wide range of relevant consumers over a course of many years.

Applicant argues that apart from the cited New York Times article, "[t]he rest of the periodical evidence introduced by the Office ... fails to support the refusal of [Applicant's] mark in connection with the goods."¹⁰⁶ Applicant similarly argues that "[t]he other record evidence consists of obscure publications unrelated to tablet computer accessories for consumers. They shed no light on how consumers

¹⁰⁴ 15 TTABVUE 11-15, 19-21 (Third Request for Reconsideration Denied); February 5, 2018 Final Office Action, TSDR 200-202.

¹⁰⁵ 15 TTABVUE 15-16 (Third Request for Reconsideration Denied, Part 1); June 28, 2017 Final Office Action, TSDR 9; February 5, 2018 Office Action, TSDR 175-183.

¹⁰⁶ 20 TTABVUE 9 (Applicant's Brief).

understand SMART KEYBOARD.”¹⁰⁷ Applicant characterizes the purported irrelevance of some of those publications in the following examples:¹⁰⁸

- An article from the Chicago Business Journal refers to a software app that knows when “kids are about to say something mean,” not a keyboard.
- An article from the St. Paul Pioneer Press asks whether “someone [will] design a smart computer keyboard” and expresses hope that someone has “some smarter alternatives out there.” It does not refer to an existing genus of keyboard products.
- An article from the Los Angeles Times similarly hypothesizes about “new sciences” that might emerge in the future, including potentially “smart helmets” or “smart keyboards.” As with the prior reference, this does not refer to any particular keyboard product on the market.
- An article from the News and Observer refers to a computer security device being developed by researchers that recognizes a particular computer user by the way he or she types.
- A page from the book *Coping with Dyslexia* that refers to a stand-alone word processor that can be used as an alternative to a laptop computer. The book was published more than 17 years ago and no longer appears to be in print.

Applicant’s depiction of the referenced articles, is clearly tempered by its characterization of the genus at issue and misses the point. **All of the articles** provided by the Examining Attorney (including the third-party website evidence mentioned above), definitively relate to, discuss, or promote, technologically advanced keyboards. For example, viewed in the proper context,

- The Chicago Business Journal article is not just about a software application that knows when “kids are about to say something mean”; it’s about an application based on a “smart” technology, “[e]ssentially, it’s a smart keyboard” that can address that subject matter.

¹⁰⁷ *Id.* at 10.

¹⁰⁸ *Id.* at 9-11.

- The St. Paul Pioneer Press article is not simply an “expression of hope” that someone will come up with something called a “smart computer keyboard”; it’s an article discussing the need for a particular type of “smart keyboard,” (a particular type of technologically advanced keyboard) that can, “at the push of button switch” between “the old qwerty style” of keyboard to “a newer, more logical standard.” That the particular “smart keyboard” referred to in the article may not have existed at the time the article was written is immaterial. What is important is the article’s recognition that a “smart keyboard” would address the keyboard problem discussed in the article.
- The same is true with respect to cited Los Angeles Times article, which does not simply hypothesize about “new sciences” that might emerge in the future, but a recognition that a “smart keyboard,” something the articles make clear is well-understood by a wide swath of the public, could be utilized to advance motion-sensor technology.
- The article from the News and Observer—and eight other articles from fastcompany.com, cnet.org, acs.org, sciencedaily.org, popsci.org, pbs.org, futurity.org, gadgetify.org., as well as a point-of-sale listing—is not merely about a computer security device that can recognize its owner, but rather a technologically advanced keyboard, a “smart keyboard” that achieves that purpose, and provides other technologically advanced features such using typing to power itself and other small devices.
- The excerpt from book “Coping with Dyslexia” does not simply refer to a stand-alone computer alternative to a laptop computer; it refers specifically to a “smart computer” as an alternative to a stand-alone word processor, one that can be used for spell checking or note taking. Applicant speculates, without support, that the book “no longer appears to be in print.” That the book was published 17 years ago is indicative of the many years that the term “smart keyboard” has been in use to describe a technologically advanced keyboard.

2. “Non-U.S. References Do Not Establish Genericness in the United States”

Applicant challenges certain evidence provided by the Examining Attorney as being foreign based, and therefore not probative of U.S. consumer perception.

Specifically, Applicant contends that

Much of the evidence introduced by the examining attorney is from

foreign websites, including firstpost.com from India, wccftech.com from Dubai, twice.com from the United Kingdom, and Pulse.ng from Nigeria. Similarly, the examining attorney has introduced a page from a book, HCI International 2016, which itself is a compilation of abstracts of posters presented at a scientific conference in Canada. The cited page describes a research project involving a virtual keyboard with customizable keys, which was installed on the touchscreen of a smartphone. The research was conducted in South Korea, and the virtual keyboard was a prototype. There is no indication that the keyboard has ever been commercialized.¹⁰⁹

The Examining Attorney argues that the “foreign sourced evidence in the record, which is comprised of seven sources out of a much larger record of evidence, carries probative weight. All of the evidence is in the English language and is accessible over the internet from the United States and use the “smart keyboard” term in a generic, non-source identifying manner.”¹¹⁰

In *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1835 (Fed. Cir. 2007), the Federal Circuit disagreed with the Board’s conclusory statement in that case that references originating in foreign countries are not probative. To the contrary, the Court asserted that “information originating on foreign websites or in foreign news publications that are accessible to the United States public may be relevant to discern United States consumer impression of a proposed mark,” citing inter alia *In re King Koil*, 79 USPQ2d 1048, 1050 (TTAB 2006) (assigning some probative value to information of foreign origin) and *In re Remacle*, 66 USPQ2d 1222 n. 5 (TTAB 2002) (finding use of foreign website information acceptable as internet is a widely-available resource and noting that “it is reasonable to assume that professionals in

¹⁰⁹ *Id.* at 11-12.

¹¹⁰ 23 TTABVue 18 (Examining Attorney’s Brief).

... computers, telecommunications and many other fields are likely to utilize all available resources, regardless of country of origin or medium.”). “The probative value, if any, of foreign information sources must be evaluated on a case-by-case basis.” *Id.*

We agree with the Examining Attorney that foreign-sourced evidence in this case is probative, particularly the websites that are foreign websites from English speaking countries including those in which English is an official or primary language (e.g., United Kingdom, Australia, India, Nigeria, and Dubai (UAE)) and they are in English, thus making them accessible to U.S. consumers. Particularly in the age of the Internet where geography is no obstacle, it is not unreasonable to infer that consumers seeking information and product reviews about a product, particularly in the global field of consumer electronics, would be impacted by the information provided by foreign sources. Moreover, as the Examining Attorney notes, “[t]he subject matter of the articles, “smart keyboards” are part of the larger computer hardware universe and something that many large computer companies sell globally, including applicant.”¹¹¹ As he further observes, “several of the articles discuss a “smart keyboard” product with pricing in U.S. Dollars, have staff writers within the United States, tout that their readership is in the United States, or keyboards that interact with software operating systems that are used globally, such as Android.”¹¹²

We also agree with the Examining Attorney that the seven foreign sources at issue

¹¹¹ *Id.* at 19.

¹¹² *Id.*

are part of a much larger record of evidence. Thus, while we find those to be probative, we do not rely on any one of them specifically, and instead find that they are corroborative of the evidence at large. Several of them just corroborate other U.S. website evidence providing similar information. For example, wccfttech.com (Dubai) provides corroborating information about the Das smart keyboard provided by U.S. websites in the record, adigaskell.org and dzone.com, and a U.S. Amazon.com point-of-sale advertisement. Pulse.com (Nigeria) provides corroborating information about the OneBoard smart keyboard already provided by the U.S. websites in the record, fastcompany.com, cnet.com, acs.org, sciencedaily.org, popsci.com, and gadgetify.com, a transcript from pbs.org, an article in the News and Observer newspaper, and a banggood.com point-of-sale listing.

3. “Patents Do Not Evidence Genericness”

Applicant argues the patent evidence cannot support a finding of genericness in this case. Specifically, Applicant asserts that “the text of patents has no influence on how average consumers use or perceive a term. Inventors and patent attorneys read patents; consumers do not.”¹¹³ “In any event,” Applicant argues, “the number of patents cited is far from sufficient to prove genericness: [t]wo of the cited patents do not even mention ‘smart keyboard,’ and are entirely irrelevant; [o]nly thirteen of them actually cover some form of keyboard technology; [and] [o]nly one patent No. 9,423,836, describes an invention that is similar to the goods identified, showing a

¹¹³ 20 TTABVUE 14 (Applicant’s Brief).

keyboard, cover, and stand.”¹¹⁴ Moreover, Applicant asserts, “[e]ven if one assumed that some of these patents were relevant, they are infinitesimal in comparison to the overall number of patent applications filed covering keyboard technology”:¹¹⁵

As of November 2019, the word “keyboard” appears in the text of approximately 568,000 patents and 698,000 published patent applications. The earliest patent cited by the examining attorney was filed in 2006. From 2006 through the present, approximately 382,000 patents have been filed containing the word “keyboard.” More than 75,000 were filed from December 1, 2015, after Apple’s launch.

Of these hundreds of thousands of patent applications, the examining attorney has cited only sixteen patents that contain the phrase “smart keyboard,” only eleven of which actually cover keyboards. Thirteen patents over a seven-year period hardly shows common usage. If “smart keyboard” were in fact a term of art for keyboard technology, the phrase would appear with much more frequency. [Applicant’s evidence showed] significantly more prevalent use of the phrases “wireless keyboard,” “Bluetooth keyboard,” “ergonomic keyboard,” “gaming keyboard,” and “wired keyboard” in patents.”

The Examining Attorney argues that “Applicant’s position runs contrary to past Board practice,” citing four non-precedential decisions in support of this contention, including *In re Fidelity Nat’l Info. Servs. Inc.*, App. No. 87006159, 18 TTABVUE, 2020 TTAB LEXIS 215 (TTAB May 6, 2020) (finding genericness refusal supported by third-party patents and patent application); *In re BioArray Solutions, Ltd.*, App. No. 78908764, 10 TTABVUE, 2008 TTAB LEXIS 814 (TTAB June 4, 2008) (finding genericness refusal supported by third-party patents and patent applications); *In re*

¹¹⁴ *Id.* Applicant also argues that because the ’836 Patent “was filed by a Korean inventor based on Korean patent application[s] ... and [a] PCT application, ... all of which are in Korean[,] [t]he resulting U.S. patent is therefore a technical translation from Korean, and not representative of a U.S. inventor’s understanding of industry terminology.” *Id.*

¹¹⁵ *Id.* at 14-15.

Sharp, App. No. 78765022, 2009 TTAB LEXIS 595 (TTAB August 31, 2009) (Aff’d. 404 Fed. Appx. 501 (Fed. Cir. 2010)) (finding genericness refusal supported by PCT patent application); and *In re General Kinematics Corp.*, App. No. 74366705, 1999 TTAB LEXIS 154 (TTAB April 12, 1999) (finding genericness refusal supported by patent evidence, and rejecting applicant’s argument that patent evidence is not competent for genericness purposes).¹¹⁶ He observes that “[g]enericness is the ultimate in descriptiveness,” citing *Weiss Noodle Co. v. Golden Cracknel and Specialty Co.*, 290 F.2d 845, 129 USPQ 411 (CCPA 1961) and *Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.3d 987, 989, 228 USPQ 528 (Fed. Cir. 2018).¹¹⁷ “Therefore,” he urges, “it stands to reason that patents and published patent applications are competent forms of evidence for evaluating genericness.”¹¹⁸

As noted by the Examining Attorney, the Board has considered patent evidence in past cases as part of its determination of whether a mark is generic. In addition to the non-precedential cases cited by the Examining Attorney, in *In re Empire Tech. Dev. LLC*, 123 USPQ2d 1544, 1546, 1551 (TTAB 2017), the Board relied in part on

¹¹⁶ 23 TTABVUE 12-13 (Examining Attorney’s Brief). Non-precedential decisions “are not binding on the Board, but may be cited for whatever persuasive weight to which they may be entitled.” TBMP § 101.03. “If a non-precedential decision does not appear in the United States Patents Quarterly or the USPTO’s public electronic databases, the citing party should append a copy of the decision to the motion or brief in which the decision is cited.” *Id.* (quoting Citation of Opinions to the Trademark Trial and Appeal Board, O.G. Notice (Jan. 23, 2007)). The *Fidelity Nat’l Information Servs.*, *BioArray Solutions*, and *Sharp* decisions appear in the USPTO’s public electronic database TTABVUE. In addition, the Examining Attorney provided copies of some of the decisions, including the *General Kinematics* decision with the denial of Applicant’s final request for reconsideration, 10 TTABVUE 7-14, 9 TTABVUE 2-8 (Parts 9 and 10).

¹¹⁷ *Id.* at 12.

¹¹⁸ *Id.*

the applicant's published U.S. patent application describing "coffee flour" in finding the term generic and affirming the Office's refusal to register the term COFFEE FLOUR on the Supplemental Register for flour as a dry ingredient in food and beverage products for consumer use.

The Board has also relied on patent evidence when adjudicating descriptiveness refusals. "[P]roof of mere descriptiveness may originate ... in U.S. patents obtained or patent applications filed by Applicant; and such proof also may be found in U.S. patents or patent applications of third parties." *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *14-15 (TTAB 2019) (finding descriptiveness refusal supported by patent evidence). *See also In re Tekdyne Inc.*, 33 USPQ2d 1949, 1951-52 (TTAB 1994) (numerous descriptive references of the designation MICRO-RETRACTOR in applicant's patent for its goods were relied on in part by the Board in affirming mere descriptiveness refusal to register term); *In re Int'l Game Tech. Inc.*, 1 USPQ2d 1587, 1588 (TTAB 1986) (excerpts from U.S. utility patents made of record to show that the term "on-demand," in the phrase ON-LINE, ON-DEMAND, had descriptive significance with respect to computers, computer-controlled equipment, or other automated equipment - merely descriptive refusal affirmed).

We agree with the Examining Attorney that patent evidence may be considered in determining genericness. Simply put, in making our determination, we must evaluate all of the evidence presented, including the patent evidence.

Applicant's statement that "[i]nventors and patent attorneys read patents; consumers do not" misses the point. The patent evidence in this case provides strong

corroboration to the wide variety of third-party generic use of the term “smart keyboard” already of record in this case. Patent applicants are required to provide written descriptions of their inventions, and the processes of making and using them, “in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.” Patent Act § 112, 35 U.S.C. § 112(a). Here, the patent evidence of record, which includes the thirteen patents and patent applications highlighted above that were issued or published between 2006 and 2019, provides a strong showing that the term “smart keyboard” has been widely used over the course of many years to describe various types of technologically advanced keyboards.

All of the sixteen patents and patent applications of record that refer to a “smart keyboard” identify a keyboard that incorporates some kind of digital electronics and is equipped with, uses, or contains some kind of electronic control device (see definition of “smart,” *supra*); and identify an electronic gadget that is able to connect, share and interact with its user and other smart devices (see definition of “smart device,” *supra*). That evidence includes Applicant’s own U.S. Patent No. 10234960B1 (Variable Response Key and Keyboard) (issued March 19, 2019), describing an invention generally relating to a “‘smart’ input device used in electronic devices,” which in the example embodiments may be comprised of a “**smart keyboard** providing a variable or adaptable output (or other response) in response to a force exerted on an input surface” and a “**smart keyboard system**” that includes “a key with an MR variable response material, magnetic field source, controller, and a key

cap configured to receive an input force on an input surface of the key cap.”¹¹⁹ Thus, even Applicant’s own patent makes generic use of the term “smart keyboard” to describe a technologically advanced keyboard.

Applicant’s contention that “the number of patents cited is far from sufficient to prove genericness” is misplaced, as well as constrained by its view of the genus as being limited to an “accessory [that] combines a tablet keyboard, cover, and stand” combined by a single unit.¹²⁰ As the evidence demonstrates, Applicant’s particular keyboard (and its feature of being foldable into a stand and cover) is but one of many technologically advanced keyboards that may be described as a smart keyboard. Moreover, it is not the quantity of patents that is relevant, but the quality of information provided therein that is important. *See In re Omniome, Inc.*, 2020 USPQ2d 3222, *31 (relying on four patents/patent applications owned by applicant, in addition to other evidence of record, to affirm descriptiveness refusal). *Cf. In re Int’l Game Tech. Inc.*, 1 USPQ2d 1587, 1588 (TTAB 1986) (excerpts from U.S. utility patents made of record to show that the term “on-demand,” in the phrase ON-LINE, ON-DEMAND, had descriptive significance with respect to computers, computer-controlled equipment, or other automated equipment -- merely descriptive refusal affirmed).

Applicant argues that “[e]ven if one assumed that some of these patents were relevant, they are infinitesimal in comparison to the overall number of patent

¹¹⁹ January 7, 2019 Denial of Final Request for Reconsideration, TSDR 62-83.

¹²⁰ 20 TTABVue 6 (Applicant’s Brief).

applications filed covering keyboard technology.” Notwithstanding, we do not rely on the patent evidence as being conclusive on the issue of genericness. Instead, we find that the patent evidence corroborates all of the other evidence in the record demonstrating that “smart keyboard” is a generic term to describe technologically advanced keyboards. The patent evidence in this case, which includes Applicant’s own patent, shows use of the term “smart keyboard” to describe a variety of technologically advanced keyboards and suggests that the patent examiners in those patents considered the term to be a full, clear, concise, and exact term to describe such devices, thus further supporting the genericness of “smart keyboard.”

4. “The Trademark Office Has Failed to Demonstrate that SMART KEYBOARD Was Generic Prior to November 2015”

According to Applicant, “[t]he refusal is premised on the notion that SMART KEYBOARD was generic before Apple adopted the mark”:¹²¹

The theory is that the industry used SMART KEYBOARD generically before Apple adopted it, but that Apple’s use has discouraged others in the industry from continuing to use the phrase. If this were true, then the evidence of genericness prior to November 2015 would be far more extensive than afterwards. However, the evidence from before November 2015 is slim.

We do not agree that the evidence showing use of “smart keyboard” to describe technologically advanced keyboards prior to Applicant’s launch of its product in November 2015 is “slim.” Indeed, one could only come to that conclusion if viewed through the skewed lens of Applicant’s genus restriction. To the contrary, there is ample evidence in the record of use of the term “smart keyboard” by multiple third

¹²¹ *Id.* at 15.

parties, in articles, publications, reviews, advertisements for third-party comparable products, and in patents, both before and after Applicant began using that designation for its product, to demonstrate that the term is viewed by the relevant public as being generic. Although Applicant, understandably, attempts to show that individual portions of evidence are not, in and of themselves, demonstrative of genericness, we view the evidence in its totality and find it provides substantial support to the Examining Attorney's argument that SMART KEYBOARD is generic.

5. "The Evidence of Current Use on Retail Sites Does Not Demonstrate Genericness"

Applicant contends that "[t]he keyboard product categories on current retail sites are consistent with those in the past. Apple's introduction of SMART KEYBOARD did not motivate any of the leading retailers to add the phrase as a generic category of keyboard."¹²² Referring to the Examining Attorney's retail evidence as being "a handful of pages from retail sites purporting to show that others use SMART KEYBOARD to refer to their product," Applicant asserts that "[m]ost of these can be discounted as irrelevant, because they either do not use the phrase "smart keyboard" or the phrase refers to Apple's own product."¹²³ Moreover, it urges, "none of these are the websites of major national retailers, who sell the largest share of consumer electronics. All but one are independent Amazon storefronts, and one can't conclude that these small sellers have an appreciable impact on the marketplace or consumer perception. In fact, one can't necessarily assume that they have genuine merchandise

¹²² *Id.* at 16.

¹²³ *Id.* at 16-17.

at all.”¹²⁴ Applicant provides several examples:¹²⁵

- Amazon - ONHI Wireless Keyboard Case for iPad Smart Folio Case. The product is a “Smart Folio Case,” not a “Smart Keyboard.”
- Amazon - Das Keyboard X50Q Soft Tactile RGB Mechanical Keyboard. The product is described as being used for “Smart Gaming,” not a “Smart Keyboard.”
- Amazon – Smart Keyboard for iPad. This is [Respondent’s] own product.

The Examining Attorney asserts, in response, that Applicant’s argument “is unpersuasive for the same reasons in that as long as the evidence shows non-source identifying use, the evidence is relevant to assessing consumer perception. There is no per se rule that only evidence from a large nationwide retailer can be acceptable evidence in a genericness case.”¹²⁶

We are unpersuaded by Applicant’s characterization of the retail use evidence, which does not address the evidence overall but instead focuses on what Applicant contends are weak references. However, even the listed examples do not support Applicant’s position. The Amazon.com ONHI listing describes the goods in at least seven different ways: “ipad Pro 10.5 Keyboard case,” “ipad pro 10.5 keyboard,” “ONHI Wireless Bluetooth Keyboard Case,” “shell Smart Folio Case,” “7 Colors Backlit Ipad Smart Keyboard,” “keyboard case for ipad,” “keyboard ipad pro 10.5,” and “smart keyboard ipad 10.5,”¹²⁷ thus demonstrating, similar to Applicant’s closely related

¹²⁴ *Id.* at 17.

¹²⁵ *Id.*

¹²⁶ 18 TTABVUE 24 (Examining Attorney’s Brief).

¹²⁷ February 5, 2018 Final Office Action, TSDR 197-198.

product, that the same goods can be described in various ways. The product touts that “a single charge can make the keyboard standby for 60 days,” and that “[o]pening or closing the ipad pro 10.5 keyboard 10.5 triggers Keyboard sleep or wake mode to preserve battery life,” which “can be used for 180 hours” without the backlight, amongst other features. The product thus fits within the genus of technologically advance keyboards.

Similarly, with respect to the Das keyboard example, the Amazon.com listing identifies the product as a “Das Keyboard X50Q Soft Tactile Smart Mechanical Gaming Keyboard,” the “Ultimate Smart RGB Keyboard,” and “the ultimate RGB keyboard for professionals who like to game: no interruptions, fully programmable,” with “Q software ... to send notifications to your keyboard and manage RGB lighting, ... pre-built Q applets ... advanced mechanical switches 100 million keystrokes ... dedicated media controls,” and other features.¹²⁸ That the product targets gamers does not mean it is simply for “smart gaming,” as Applicant suggests. Rather, this specific type of keyboard, a gaming keyboard purportedly “named best crossover (work/play) keyboard by washable” is clearly a technologically advanced keyboard to which the “smart” moniker is being applied.¹²⁹ Das keyboards have been referred to as “smart keyboards” in product reviews also in the record.¹³⁰

¹²⁸ May 9, 2019 Final Office Action, TSDR 34.

¹²⁹ *Id.* at 35.

¹³⁰ June 28, 2017 Office Action, TSDR 21; February 5, 2018 Final Office Action, TSDR 97-98; October 2, 2018 Office Action, TSDR 34-41.

The third example Applicant provides regarding the Amazon.com list of Applicant's own product was not provided by the Examining Attorney to show another "smart keyboard" use, but rather to show that competitors of Applicant that use "smart keyboard" to describe their product have received more customer reviews than Applicant:

In fact the evidence also suggests that competitors have been using the SMART KEYBOARD with similar keyboard case goods in the same trade channels, (e.g. Amazon.com), and that competitors have garnered significantly more consumer reviews than applicant's. (See, e.g.: [Satechi Amazon.com listing] (of not [sic] is that this product using the mark wording has substantially more customer reviews on Amazon than applicant's product, (see: [Applicant's smart keyboard listing]. See also: ONHI smart keyboard case having a greater number of consumer reviews than applicant, [ONHI Amazon.com listing]. The evidence shows that consumers are purchasing other brands using the "smart keyboard" terminology and that they may recognize the wording in a non-source indicating manner.¹³¹

Contrary to Applicant's contention, we find that most of the retail evidence of record does use the phrase "smart keyboard" (or some close derivative thereof that may include one or more adjective to provide more detail about the features of the keyboard. e.g., "smart mechanical keyboard," or "smart wireless keyboard). Based on our careful and thorough review of the record, we find a generous amount of evidence of retail use that is probative in our evaluation of the public perception of the alleged mark.

Applicant urges, without support that "keyboard product categories on current retail sites are consistent with those in the past," and asserts that "[it's] introduction

¹³¹ February 5, 2018 Office Final Action, 175-198.

of SMART KEYBOARD did not motivate any of the leading retailers to add the phrase as a generic category of keyboard.”¹³² Even if these statements are true, they do not bear on whether SMART KEYBOARD is generic because there is significant evidence in the record showing use of that term by competitors and the relevant public. Even if that were not the case, “[t]he absence of examples of competitor or public use of this exact set of words in the record [would] not obviate the refusal. The fact that an applicant may be the first and only user of a term in connection with its specific goods does not justify registration if the only significance conveyed by the term is that of the category of goods.” *In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1084 (TTAB 2010). “[T]he USPTO must show that the relevant public would understand the applied-for mark as a whole to have generic significance, not that they use it in that manner.” *In re 1800Mattress.com IP LLC*, 586 F.3d 1359, 92 USPQ2d 1682, 1685.

Applicant’s suggestion that the retail evidence should be discounted because it does not come from “major national retailers, who sell the largest share of consumer electronics” is also unavailing. As the Examining Attorney notes, there is no per se rule that evidence of relevant public understanding of a term must come from “major” retailers. In the age of the Internet, even smaller retailers have access to consumers worldwide.

¹³² *Id.* at 16.

6. “SMART” is Not *Per Se* Descriptive or Generic”

Applicant argues that “[t]here is no per se rule that the term SMART is generic, or even descriptive,” asserting that “categorizing “smart” as generic is the rare exception rather than the rule.”¹³³ Applicant provides three sets of data in support of that assertion, including

- Several excerpts of three searches from the USPTO’s Trademark Electronic Search System (TESS) simply identifying that there are (a) 3815 live applications or registrations for marks that include the word “smart” for goods in Class 9, along with a Corsearch printout indicating that 3431 of the marks are published or registered; (b) 663 live applications or registrations for marks that include and disclaim the word “smart” for goods in Class 9; (c) 334 live applications or registration for/on the Supplemental Register that include the word “smart” for goods in Class 9;¹³⁴
- An excerpt of a Corsearch printout indicating that there 110 marks that include the word “smart” in Class 9 that have been registered with a Section 2(f) claim of acquired distinctiveness;¹³⁵ and
- Printouts of thirty-four third-party registrations on the Supplemental Register for marks that include the word “smart” and purportedly “have the same construction as SMART KEYBOARD – the term SMART prefacing a descriptive or generic term for goods in Class 9.”¹³⁶

The Examining Attorney does not dispute Applicant’s contention that the term ‘smart’ is not per se descriptive or generic. Asserting that he “never argued such a position. Rather, the term ‘SMART’ in the context of the goods in the application are [sic] generic.”¹³⁷ He argues that the statistics and examples provided by Applicant

¹³³ 20 TTABVUE 18 (Applicant’s Brief).

¹³⁴ November 12, 2019 Third Request for Reconsideration, TSDR 43-44 (Exhibit H).

¹³⁵ *Id.* at 45 (Exhibit I).

¹³⁶ *Id.* at 46-160 (Exhibit J).

¹³⁷ 23 TTABVUE 19 (Examining Attorney’s Brief).

“establish[] nothing about ‘SMART KEYBOARD.’” Instead, the evidence “addresses other types of goods, and in the case of applicant’s database evidence, provides no context as to what the underlying goods are for those marks.”

In reply, Applicant asserts that the Examining Attorney contradicts this argument by submitting “evidence of computer peripheral devices paired with the term ‘SMART’ to demonstrate that such goods are understood by consumers to refer to a technologically advanced genus of the basic peripheral.”¹³⁸

We agree with both Applicant and the Examining Attorney that there is no per se rule that the word “smart” is descriptive or generic, since such legal conclusions must be based on an evaluation of alleged marks in their entireties in view of the goods or services at issue, and in relation to the relevant purchasing public’s understanding thereof, not in a vacuum. *Cf. Capital Project Management, Inc. v. IMDISI, Inc.*, 70 USPQ2d 1172 (TTAB 2003) (mere descriptiveness “is not determined in a vacuum, but rather ... is analyzed as the mark is used in connection with the goods and/or services.”).

The Examining Attorney referred to the relevant consumer understanding of “smart” in relation to “computer device peripherals,” not to all good and services. Nevertheless, as he argued in an office action, “inferences may still be drawn from the evidence that the term ‘SMART’ has a commonly known definition in the world of computers and that it is recognized by consumers for the communicative processing

¹³⁸ 24 TTABVue 11 (Applicant’s Reply Brief).

technology in the goods.”¹³⁹

While “[w]e must look at these definitions within the context of the goods for which registration is sought,” *In re Finisar Corp.*, 78 USPQ2d 1618, 1622-23 (TTAB 2006), at least as early as 1994, the Board recognized that “[it is undeniable that computers have become pervasive in American daily life” and that “[t]he ‘computer’ meaning of the term ‘smart,’ as is the case with many ‘computer’ words, is making its way into the general language.” *In re Cryomedical Sciences, Inc.* 32 USPQ2d 1377, 1378 (1994). The takeaway from the evidence related to “smart” devices, generally, which corroborates the definition of “smart device” as “an electronic gadget that is able to connect, share and interact with its user and other smart devices,” is that consumers are predisposed to view the term “smart” as an indicator of what the Examining Attorney refers to as a device with “communicative processing technology.” The end determination of whether an alleged mark having the term “smart” is generic depends on whether there is evidence in the record that the term, when combined with “keyboard” as SMART KEYBOARD, identifies the genus of the goods.

The statistics Applicant provided regarding third-party registrations of “smart” marks obtained from select USPTO database searches are irrelevant given the absence of context, and are misleading. Specifically, the statistics showing that there are X number of “live applications or registrations” or marks that are “published or registered” do not distinguish between the two statuses. Thus, we have no information about the number of applications that have been refused registration (or

¹³⁹ February 5, 2018 Final Office Action, TSDR 8.

that have been cancelled) due to descriptiveness or genericness. Moreover, [a]n application is not evidence of anything except that the application was filed on a certain date” *In re Ala. Tourism Dep’t.*, 2020 USPQ2d 10485, at *30 n.27 (TTAB 2020) (citing *Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1634 n.11 (TTAB 2007)). Additionally, the Corsearch results indicating that there are 110 registered marks that include the word ‘smart’ for goods in Class 9 with a Section 2(f) claim of acquired distinctiveness shows nothing about descriptiveness without contextual information about the relevant goods or services.

The third-party Supplemental Registration evidence of marks that include the word “smart” with the purported same construction as SMART KEYBOARD” are also not probative. Of the thirty-three active registrations provided, thirty-one are for goods and services unrelated to computer peripherals, and none are for keyboards. The remaining two, SMART CHARGER for “an electronic device power source for cell phones and tablet computers comprised of a wall power supply with integrated rechargeable battery and charge” and “SMART RECIPE” for goods inter alia “computers,” do not demonstrate that “SMART” is merely descriptive, and not generic, when combined with “KEYBOARD.”

We find the marks in those third-party registrations are readily distinguishable from the mark herein and they do not compel a finding that applicant’s mark is not generic. In any event, regardless of what these third-party registrations may show, and even to the extent the marks in these registrations “have some characteristics similar” to the mark herein, as the Federal Circuit has stated, “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). It is well settled that each case must be decided on its own facts, based on the particular mark, the particular goods or services, and the particular record in each application. Accordingly, there is “little persuasive value in the registrations” applicant has submitted. *Id.* Nor do these third-party registrations establish that there is an Office practice holding such marks are generally registrable. *See In re First Draft, Inc.*, 76 USPQ2d 1183, 1188 (TTAB 2005) (“[P]roof that various examining attorneys have registered a particular type of mark in the past does not establish that there is an Office practice holding such marks are generally registrable.”).

7. If SMART KEYBOARD Were Generic, It Would Be In Dictionaries

Applicant argues that “[i]f SMART KEYBOARD were commonly used as a generic term, then one would expect the phrase to appear in major online reference databases such as Wikipedia and The Free Dictionary, which contain literally millions of definitions and draw billions of visitors.”¹⁴⁰ Applicant asserts that “both of [those] sites include definitions of ‘smartphone’ and ‘smartwatch’, but neither offers a definition of “smart keyboard” – each lists the generic as “computer keyboard.”¹⁴¹ Applicant further asserts that “[t]he same is true of the USPTO Trademark ID Manual and the Nice Classification. In contrast, a search for “smart keyboard” on Wikipedia yields a reference to Apple’s iPad Pro accessory.”¹⁴²

¹⁴⁰ 20 TTABVue 21 (Applicant’s Brief).

¹⁴¹ *Id.*

¹⁴² *Id.*

However, as the Examining Attorney points out, “the fact that a word or term is not found in the dictionary is not controlling on the question of registrability.”¹⁴³ See, e.g., *In re Hikari Sales USA, Inc.*, 2019 USPQ2d 111514, *31 (TTAB 2019) (“The presence or absence of ‘Algae Wafers’ in dictionaries is not controlling on the question of whether a term is generic); *In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1603 (TTAB 2014) (presence or absence of a term in dictionaries not controlling on question of whether term is generic); *In re Dairimetics, Ltd.*, 169 USPQ 572, 573 (TTAB 1971) (ROSE MILK refused registration on the Supplemental Register even though there was no dictionary definition of ROSE MILK). Cf. *Gould Paper Corp.*, 5 USPQ2d at 1112 (SCREENWIPE found to be generic term based on dictionary definitions of the individual terms “Screen” and “Wipe” and the applicant’s own description of the product on its specimen).

Nor is it controlling that a word or term is not listed in the USPTO’s ID Manual. “The manual’s ‘listing is not exhaustive’ and the Office acknowledges that, ‘No listing could include all possible identifications for the multitude of products and services for which marks may be registered.’” *In re Paper Doll Promotions, Inc.* 84 USPQ2d 1660 (TTAB 2007) (citing TMEP § 1402.04). “Therefore, a primary use of the ID Manual’s listings, in addition to indicating precise identifications that will be accepted, is to indicate by analogy and example the kinds of identifications that will be acceptable

¹⁴³ 23 TTABVue 22 (Examining Attorney’s Brief).

for products and services not covered by the existing listings.” TMEP § 1402.04 (Oct. 2018).¹⁴⁴

8. “[Applicant’s] Evidence Refutes Genericness”¹⁴⁵

Applicant provides a substantial amount of evidence in support of its argument that “the public recognizes SMART KEYBOARD as its trademark for the identified goods.” According to Applicant, this evidence shows the following (internal citations omitted):

- [Applicant’s] iPad device has been ... remarkably innovative and successful ... with sales of more than 130 million units since [it] was introduced in 2015.¹⁴⁶
- ... SMART KEYBOARD is used to identify an accessory for [Applicant’s] iPad device.¹⁴⁷
- [Applicant’s] SMART KEYBOARD product has received extensive media attention since it first hit the market.¹⁴⁸
- [Applicant] has heavily promoted the SMART KEYBOARD device, including on its website and in high-profile television commercials.¹⁴⁹

¹⁴⁴ As to the Wikipedia evidence, although it is admissible, “[t]here are inherent problems regarding the reliability of Wikipedia entries because Wikipedia is a collaborative website that permits anyone [including Applicant] to edit the entries. ... In fact, the “About Wikipedia” section of wikipedia.org warns users that articles can be edited by anyone with access to the Internet. That section further explains that editors do not need any specialized qualifications to contribute. As a result, entries, especially newer entries and recent edits, may contain significant misinformation, false or debatable information, “unencyclopedic” content, unexpected oversights and omissions, vandalism, or unchecked information that requires removal. At any given time an article may be in the middle of an edit or controversial rewrite.” *In re IP Carrier Consulting Group*, 84 USPQ2d 1028 (TTAB 2007).

¹⁴⁵ *Id.* at 19.

¹⁴⁶ August 6, 2018 Response to Office Action, TSDR 21-72 (Exhibit A).

¹⁴⁷ May 16, 2017 Request for Reconsideration, TSDR 21-22 (Exhibit A).

¹⁴⁸ *Id.* at 25-48 (Exhibits C-D).

¹⁴⁹ *Id.* at 49-57 (Exhibits E-G). The evidence of high-profile television commercials appears to be one video on Applicant’s YouTube.com page. *Id.* at 57 (Exhibit G).

- The SMART KEYBOARD device is sold through major national retailers, including [Applicant's] own retail stores and website and chains such as Best Buy, Target, and Staples, and ranks as one of the top-selling products in the case/cover/keyboard folio category.¹⁵⁰
- ... SMART KEYBOARD ... is part of a family of SMART-formative marks that [Applicant] uses for closely related iPad accessories, and consumers encounter the SMART KEYBOARD product in the marketplace together with the other SMART products for iPad accessories. [Applicant] previously made of record its own Principal Register registrations of SMART COVER and SMART CASE (for similar iPad accessories) and of SMART CONNECTOR (for the interface between the Smart Keyboard and the iPad Pro).¹⁵¹
- All of the top hits in a Google search for “smart keyboard” are references to [Applicant's] product, and searches for the hashtag #smartkeyboard on social media sites almost exclusively retrieve references to [Applicant].¹⁵²
- Major electronics retailers including BestBuy, Amazon, CDW, and Staples do not use the phrase “smart keyboard” as a generic for a category of keyboard.¹⁵³
- A search for “Smart Keyboard” on the sites of [Applicant's] competitors like Lenovo and HP yielded no results, indicating that Apple's competitors do not use the term to refer to their own goods.¹⁵⁴

In response to Applicant's suggestion that the success of its iPad device is evidence that SMART KEYBOARD is not generic, the Examining Attorney asserts such evidence “is immaterial for genericness purposes, and is speculative in nature as it focuses on consumer perception of a different mark for different goods than those

¹⁵⁰ October 4, 2016 Response to Office Action, TSDR 70-72 (Exhibit F).

¹⁵¹ *Id.* at 9-15 (Exhibit A).

¹⁵² May 16, 2017 Request for Reconsideration, TSDR 63-66 (Exhibit I).

¹⁵³ August 6, 2018 Request for Reconsideration, TSDR 104-111 (Exhibit E).

¹⁵⁴ *Id.* at 112-114. (Exhibit F).

subject to this application. Applicant has never explained how its ‘IPAD’ mark on its tablets impacts the way consumers view and understand “SMART KEYBOARD.”¹⁵⁵ The Examining Attorney refers to the advertising and marketing evidence as “Applicant’s Market Saturation Argument,” which he argues “is not persuasive as it is axiomatic that generic terms cannot be transformed into non-generic ones saturating the marketplace with advertising.”¹⁵⁶ The Examining Attorney also argues that Applicant’s reference to a “‘SMART’ family of marks” is “not probative for genericness purposes.”¹⁵⁷

There seems little doubt from the evidence, or in common knowledge, that Applicant is a market leader in the field of computers, tablets, smartphones, and related goods and accessories; that Applicant has the apparent ability to dominate the market with its products from the moment it launches such products through advertising and promotion; that nationally recognized publications are likely eager to review each such product launches; and that Applicant’s product at issue here enjoys success, either through Applicant directly and/or through major retailers. Nor do we doubt that, due to the foregoing conditions and Applicant’s market dominance, that millions of people may have been exposed to Applicant’s goods, including the goods at issue here.

¹⁵⁵ 23 TTABVUE 21 (Examining Attorney’s Brief).

¹⁵⁶ *Id.* at 20.

¹⁵⁷ *Id.* at 23. Applicant, in reply, clarifies that the evidence relating to the success of its iPad “simply notes that hundreds of millions of people have iPads, and many of them will inevitably look for accessories on Applicant’s website, where they will encounter the SMART family of accessories – including the SMART KEYBOARD device. 24 TTABVUE 10 n. 2 (Applicant’s Brief).

However, successful marketing campaigns, what the Examining Attorney refers to as “market saturation[s],” do not transform a generic term into a mark. *See, e.g., In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206, 1211 (TTAB 1999) (expenditures of \$4,000,000 per year “simply insufficient to demonstrate the “log cabin homes” has come to be associated with services emanating from applicant.”). Indeed, no amount of evidence can transform a generic term into a registrable trademark. *See In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219, 222 (TTAB 1984). *See also Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 195 USPQ 281 (7th Cir. 1977).

Notably, some of the media attention of Applicant’s goods which Applicant highlights seems to refer to Applicant’s goods generically, such as by highlighting the wording in quotes or referred to generically, for example:

- **Typing on the accessory keyboard:** A good but not perfect experience. [Applicant’s] fold-away “Smart Keyboard” accessory, which is made of a custom woven fabric and also serves as a cover for iPad Pro, magnetically attaches to the tablet.... (usatoday.com) (emphasis in original);¹⁵⁸
- The iPad Pro can have a “smart keyboard” attached to it thanks to magnets in the side of the device. (newsday.com)¹⁵⁹
- [Applicant] unveiled the new iPad Pro complete with a Smart Keyboard at an event on September 9, 2015. (nydailynews.com)¹⁶⁰
- For many buyers, picking which iPad Pro you want is just the start. What sets it apart from its predecessor are the new “Smart Keyboard” and the stylus – which [Applicant] calls the Pencil.” Without them, the

¹⁵⁸ May 16, 2016 Request for Reconsideration, TSDR 30.

¹⁵⁹ *Id.* at 38.

¹⁶⁰

iPad Pro is just a tablet. (computerworld.com)¹⁶¹

We are also unmoved by Applicant's evidence showing that the "top hits" on Google or other social media would list Applicant's product first. Given Applicant's marketplace dominance, it may well be that Applicant's SMART KEYBOARD is the most well-known technologically advanced keyboard on the market, but that does not speak to the issue of what the public understands a "smart keyboard" to represent. It is fairly common knowledge that one can take steps to manipulate listings on Google, either through paid advertising or other methods, so as to appear higher up in search results. But that does not mean consumers are not otherwise exposed to the term "smart keyboard," as we have seen through the evidence.

Nor do we find compelling that "major electronic retailers including BestBuy, Amazon, CDW, and Staples do not use the phrase 'smart keyboard' as a generic for a category of keyboard." If SMART KEYBOARD is generic for the genus of technologically advanced keyboards, it would make no sense to list that as a category on such retailer's websites, since that term would encompass most of the categories of keyboards listed on those websites, such as the ergonomic, gaming, specialty, and wireless & Bluetooth, categories listed on BestBuy.com. The categories on those retailers' websites allow one to narrow smart keyboards by feature.

Applicant also asserted that searching the term "smart keyboard" on competitor websites "like Lenova and HP yielded no results" (providing searches for just those two companies). Due to its ubiquitous presence, Applicant may not consider smaller

¹⁶¹ *Id.* at 47.

“smart keyboard” providers such as OneBoard, Satechi, Viboton, Belkin, Logitech or Samsung in evidence here, to be competitors, but they are. Notwithstanding, as stated earlier, a term may be found generic if the relevant public would understand it to have such significance, even if it is not used by others in that manner. *1800Mattress.com*, 92 USPQ2d at 1685.

Finally, Applicant relies on *Merrill Lynch*, where the record, like here, was voluminous, and included use of the term CASH MANAGEMENT ACCOUNT used in various financial publications following Merrill Lynch’s introduction of its financial system. *Merrill Lynch*, 4 USPQ2d at 1143. The Court there found that the evidence “showed recognition in a substantial number of publications that the source of the CASH MANAGEMENT ACCOUNT was [Merrill Lynch]” and, thus, held that such an evidentiary showing does not make CASH MANAGEMENT ACCOUNT generic. *Id.* at 1143-44.

Applicant’s response in this case to the Examining Attorney’s evidentiary showing is fairly impressive, as was the applicant’s in *Merrill Lynch*. However, unlike the record in *Merrill Lynch*, in this appeal, we have unrebutted and unexplained generic use of the term SMART KEYBOARD or other more specific wording (e.g, smart wireless keyboard), both before and subsequent to Applicant’s adoption of that term as its trademark, by no less than ten other companies (e.g., Always Innovating, Das, OneBoard, Samsung, Belkin, Satchi, ONHI, Logitech, Viboton, Nums, Zagg Rugged, and Raydem) to describe their products; numerous reviews of technologically advanced third-party keyboards described as “smart keyboards,” many of which

include references or comparisons to Applicant's product; scores of articles and publications discussing existing or anticipated technologically advanced keyboards as "smart keyboards"; and more than a dozen patents that use "smart keyboard" as a term of art to describe a variety of technologically advanced functioning keyboards. Thus, numerous keyboard users, other than Applicant's customers encounter SMART KEYBOARD used in a generic manner.¹⁶²

The Federal Circuit has "made it clear that the way an applicant uses an alleged mark ..., or the goods or services in connection with which it uses the alleged mark, in promotional materials or packaging, is relevant to whether consumers will perceive the mark as an indicator of source or instead as descriptive or generic." *Empire Tech. Dev. LLC*, 123 USPQ2d at 1549 (quoting *ActiveVideo Networks, Inc.* 111 USPQ2d 1581, 1590 n.22 (citations omitted)); *see also Gould Paper Corp.*, 5 USPQ2d at 1112. Perhaps the most compelling evidence in this case is the way Applicant itself uses SMART KEYBOARD, as in the below repeated example, showing Applicant's touting of the SMART KEYBOARD as being a technologically advanced keyboard:

¹⁶² Notably, two of the seven reviews of Applicant's product that Applicant provided in evidence appear to use "smart keyboard" generically: "**Recommend this over Logi Smart Keyboard**[.] I purchased this Smart Keyboard and the one made by Logitech. I prefer this one – more "pro" feel and trust that it'll protect the screen" (April 6, 2017); and "**... no issue transitioning from a Bluetooth keyboard to this Smart Keyboard with regards to key size** (July 27, 2016) . May 16, 2017 Request for Reconsideration, TSDR 84 (emphasis in original).



V. Conclusion

As noted by Professor McCarthy, “[t]here is usually no one, single and exclusive generic name for a product. Any product may have many generic designations. Any one of those is incapable of trademark significance.” 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:9 (5th ed. 2020). After carefully considering all of the arguments and evidence of record, we find that the evidence including dictionaries, third-party Internet webpages and publications in the nature of articles, reviews, and retail promotions, and a variety of patents and patent applications support a finding that purchasers and prospective purchasers understand the term SMART KEYBOARD as referring to technologically advanced

¹⁶³ May 16, 2017 Request for Reconsideration, TSDR 50.

keyboards for mobile digital devices, the genus of goods that includes Applicant's goods identified as an "accessory for a handheld mobile digital device, namely, a protective and decorative cover for a tablet computer that functions as a computer stand and incorporates a keyboard," a subcategory of such genus.¹⁶⁴ Hence, we find that SMART KEYBOARD is generic for those goods and is therefore incapable of registration on the Supplemental Register.

Decision: The refusal to register is affirmed.

¹⁶⁴ Moreover, "a term can be generic for a genus of goods or services if the relevant public ... understands the term to refer to a key aspect of that genus." *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1046 (Fed. Cir. 2018) (quoting *Cordua Rests.*, 118 USPQ2d at 1637. "[A] term is generic if the relevant public understands the term to refer to **part** of the claimed genus of goods or services, even if the public does not understand the term to refer to the broad genus as a whole." *Id.* (citing *Cordua Rests.*, 188 USPQ2d at 1638 (emphasis added). Thus, even if we had construed the genus at issue in this case to the description of goods set forth in the application, which Applicant refers to as an accessory that "combines a tablet keyboard, cover, and stand into a single unit," we still find genericness, since purchasers and prospective purchasers will understand SMART KEYBOARD as referring to a key aspect of the goods.