



Trademark Law Alert: Trademark Trial and Appeal Board Finds SMART KEYBOARD to Be Generic

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In a nonprecedential opinion issued on January 12, 2021, the US Patent & Trademark Office's ("PTO") Trademark Trial and Appeal Board ("TTAB") found the proposed trademark SMART KEYBOARD to be generic. See *In re Apple Inc.*, US Trademark App. Ser. No. 86/857,587 (TTAB decision issued on Jan. 12, 2021).

Unless this decision is appealed, as it may be either to a U.S. District Court or to the U.S. Court of Appeals for the Federal Circuit, it marks the end of Apple Inc.'s six-year quest to register the term as a federal trademark. Competitors of Apple who feared that the tech giant would seek to use its registration to prevent others from using the term to describe their keyboards (such as Logitech, Belkin and Samsung), may now breathe a bit easier.

Apple's 2015 application to register SMART KEYBOARD initially met with a descriptiveness objection under Section 2(e)(1) of the Lanham Act. Apple then filed a claim, under Section 2(f) of the Lanham Act, that the term SMART KEYBOARD was registrable because it had acquired distinctiveness by virtue its exclusive and continuous use in the marketplace by Apple. Then, not only was Apple's Section 2(f) claim found to be insufficient, but the PTO also issued a new refusal of the application on the grounds of genericness. In response, Apple amended the application to the Supplemental Register and argued against the finding of genericness. The current appeal was filed when Apple's argument against genericness was rejected.

The TTAB's decision here addressed two issues. First, the decision rejected Apple's last minute "Hail Mary" motion to suspend the appeal and remand the application to the PTO to consider Apple's request that the application be amended back to the Principal Register and reconsider its Section 2(f) showing. The decision notes that such requests must be supported by good cause. Here, where the request was filed one month after oral argument, three and a half years after the appeal was filed, and more than five years after the application was filed, the request was denied. This underscores the TTAB's policy that 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." TBMP § 1207.02.

Second, the decision addressed, under the test set forth in *H. Marvin Ginn Corp. v. Int'l Assn.*



of Fire Chiefs, Inc., 228 USPQ 528 (Fed. Cir. 1986), Apple's argument that the term SMART KEYBOARD is not generic. Under that test, the PTO can prove the genericness of a term by establishing (1) the genus of goods or services at issue and (2) that the relevant public will understand the term primarily to identify that genus of goods or services. Marvin Ginn, 228 USPQ at 530. The TTAB found that the PTO met both prongs of the test.

With respect to the first prong of the test, the PTO argued that the genus at issue was "technologically advanced keyboards" while Apple argued that the proper genus was instead the goods set forth in the specification, i.e., "a protective and decorative cover for a tablet computer that functions as a computer stand and incorporates a keyboard." The TTAB agreed with the PTO. Noting that "we need not turn a blind eye to the reality of what is offered," the TTAB found that Apple's argument "elevates form over substance" and that "[j]ust 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 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." *Id.* at 22, 13, 20-21.

With respect to the second prong of the test, the PTO argued that the evidence it presented in the form of articles, point-of-sale displays, blog posts, computer hardware publications, patents, and public patent applications showed generic use of the term SMART KEYBOARD "as a label for technologically advanced keyboards in the years prior to [Apple's] launch of its product, and ongoing to this day." *Id.* at 24.

In contrast, Apple argued that such evidence was insufficient to meet the legal standard and there is no evidence of widespread third-party use of the term as applied to "a protective and decorative cover for a tablet computer that functions as a computer stand and incorporates a keyboard." Here again, the TTAB agreed with the PTO, largely because Apple's attempt to knock out the bulk of the PTO's evidence regarding keyboards that did not also function as covers and stands failed. That said, the Board also dismissed Apple's subsidiary arguments that the PTO's sources were obscure or should not have been considered because they were from foreign sources or regarded patents, that the term SMART KEYBOARD would be included in dictionaries if it were generic, etc. In short, once Apple lost its the first prong of the test, it also lost its strongest argument with respect to the second prong of the test, aside from



minor quibbles on the quality of the evidence.

It remains to be seen if Apple will appeal this decision further. On the one hand, the TTAB decision definitively addresses the issues at stake and Apple already owns a U.S. Trademark Registration for IPAD PRO SMART KEYBOARD (disclaiming SMART KEYBOARD), which it may decide to rely on instead of SMART KEYBOARD alone. On the other hand, Apple has deep pockets, and a pending application for SMART KEYBOARD FOLIO (which was suspended during the present appeal) as well as for SMART KEYBOARD, so another round of appeals would not be surprising.

We will continue to follow and report on this and other trademark matters at the TTAB that may affect our clients. If you have questions about how this decision may impact your rights, and especially if you are contemplating a mark for a computer peripheral that incorporates the term SMART, please feel free to contact us.

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