

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Case Summary: Opp. No. 91239006

Gang Cao v. Apple Inc.

Frances Wolfson, Administrative Judge, TTAB
June 17, 2021

USPTO Dallas Regional Office & the State Bar of Texas
IP Law Section - 75th Anniversary of the Lanham Act

UNITED STATES
PATENT AND TRADEMARK OFFICE



Apple Inc.

Serial No. 86868731

LIVE PHOTOS



Computer software for recording and displaying images, video and sound, in International Class 9

“The mark is in standard characters, without claim to any particular font style, size or color”

“The exclusive right to use PHOTOS is disclaimed apart from the mark as shown.”

First Use: September 9, 2015

In Commerce: September 25, 2015

Priority Date: July 9, 2015 from Jamaican application under Section 44(d)

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CLAIM OF OWNERSHIP - Applicant is the owner of U.S. Registration No. 3026497

- LIVETYPE**
- Register: Principal**
- Reg. Date: 12/13/2005**
- Goods: computer software for use in video editing; computer software for use in creating fonts and titles for film, video and multimedia content**



CLAIM OF OWNERSHIP - Applicant is the owner of U.S. Registration No. 4725467

- LIVE LISTEN**
- Register: Principal**
- Reg. Date: 04/21/2015**
- Goods: computer software for sound reproduction and transmission; computer software interface for use in connecting a mobile telephone or tablet computer with a hearing aid**



Applicant's Specimen of Use

iPhone 6 

3D Touch

Design

Cameras

Technology

iOS 9

Tech Specs

Buy



Introducing Live Photos.

A still photo captures an instant frozen in time. With Live Photos, you can turn those instants into unforgettable living memories. At the heart of a Live Photo is a beautiful 12-megapixel photo. But together with that photo are the moments just before and after it was taken, captured with movement and sound.

You can bring those moments to life anytime simply by pressing anywhere on the photo. You can even set your favorite Live Photo as your Lock screen wallpaper, so you can relive a moment anytime you take your iPhone 6s out of your pocket. And you can view Live Photos on your other Apple devices, too.



Grounds for Opposition

1. Opposer owns the domain name LIVEPHOTO.COM
2. Opposer plans to use the website to sell interactive software that brings life to still image photos
3. The term LIVE PHOTOS is commonly understood to refer to goods for recording and displaying images, video and sound.
4. Therefore, the proposed mark is generic or merely descriptive of the goods.
5. Opposer will be damaged by the registration of LIVE PHOTOS because it would give Applicant the right to prevent Opposer from using LIVE PHOTO

Affirmative defenses

This domain is for sale

www.livephoto.com

www.livephoto.ca



Spin Explorer 2 4.2

Interactive Video Player
SpinFun Technology Inc.

Free

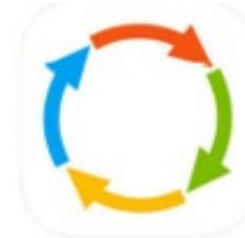
Screenshots [iPhone](#) [iPad](#)



Spin Explorer 6.2

Interactive Video Player
SpinFun Technology Inc.

¥ 1,100.00



SpinFun 4.2

Interactive Photos Browser
SpinFun Technology Inc.

¥ 350.00

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Descriptive Terms

- A mark is merely descriptive "if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used."
 - *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 1377-1378, 101 USPQ2d 1713, 1728 (Fed. Cir. 2012)

Acquired distinctiveness

- A descriptive mark can be registered if it has come to serve a trademark function of identifying a particular source of goods or services.
- To establish that a term has acquired distinctiveness, "an applicant must show that in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself."
 - *Coach Servs.*, 102 USPQ2d at 1219

Generic Terms

- A generic term "is the common descriptive name of a class of goods or services." *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1366, 127 USPQ2d 1041, 1045-1046 (Fed. Cir. 2018) (quoting *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986)).

Descriptive Terms - Evidence

- Evidence that a term is merely descriptive "may be obtained from **any competent source**, such as dictionaries, newspapers, or surveys."

Coach Servs., 101 USPQ2d at 1728

Generic Terms - Evidence

- "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."
 - *Royal Crown*, 127 USPQ2d at 1046 (citing *Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1570, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987)).

Opposer's Main Trial Evidence – Notices of Reliance on:

- Dictionary definitions: LIVE, LIFE, PHOTOGRAPH
- Printed internet publications
- Publication notice for U.S. patent application for a "Cross-Asset Media Analysis and Processing," listing Apple, Inc. as Applicant and a publication date of April 20, 2017

Opposer's Main Trial Evidence - Witness Testimony

- Direct Testimony Declaration of Gang Cao
 - Pursuant to 37 CFR § 2.123(a)(1)
 - Attests to development of technology, including computer software, in the field of adding animation to still images since at least as early as 2015
 - Attests to observations of allegedly generic, third-party use of LIVE PHOTOS as well as such use by Applicant.

Third-party Use of LIVE PHOTOS



Live Photo

Live Animations Entertainment

Everyone

How to get iPhone's Live Photos on Android with Google Motion Stills (and other apps)



Live Motion Picture - Live Photo & Video Animation

Jose Barlow Photography

43

Everyone

Contains Ads

Lumia Cinemagraph lets you capture live photo from Windows Phone

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Third-party Use of LIVE PHOTOS

Want to show the world your awesome live photo?

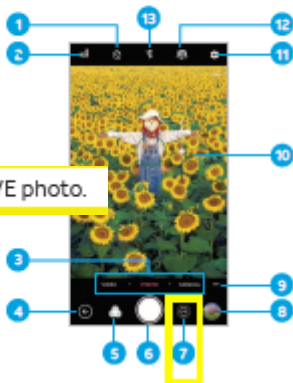
Missing live photos on your phone? Go With This Live Photos Android Guide!

Graphica Live Photo Maker

ZTE | AXON M

<https://www.att.com/eoms/dam/att/devicesupport/5000-5499/5191/ZT12/15/2020>

Actions Shots: To ensure that your photos don't come out blurry, using either the live photo mode or the burst mode



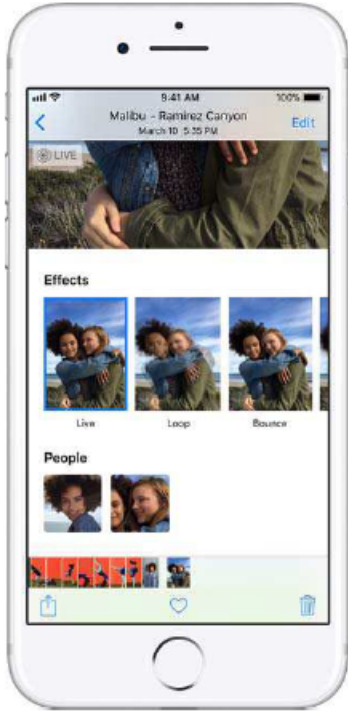
7 Capture a LIVE photo.

United States Patent Application Publication

In the live photo asset and burst photo asset examples, asset subcomponents typically are captured as part of a common capture transaction....



Applicant's use of LIVE PHOTOS



Add Live Photo effects

With Live Photo effects in iOS 11 and later, your photos can be even more expressive, creative, and just plain fun.

1. Open the Live Photo.
2. Swipe up until you see Effects.
3. Choose Loop, Bounce, or Long Exposure.

Loop: Turn a Live Photo you love into a video loop. Choose an image yourself, or let Photos suggest which ones would make great loops.

Bounce: Make your Live Photo rock back and forth. Watch your Live Photo as it happened, then instantly play in reverse.


Long Exposure: Capture the elements of time and movement. Create a beautiful effect that used to be possible only with a DSLR camera. Fireworks become bright streaks across the night sky. A waterfall, a magical blur.


Take and edit Live Photos

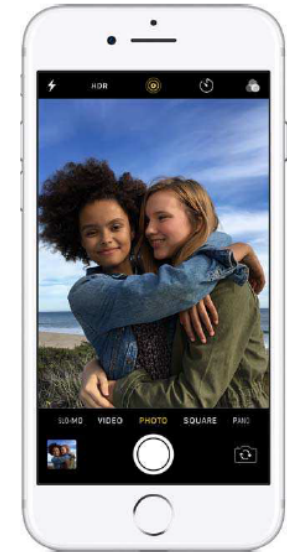
Capture photos that come alive when you touch them. Then you can pick a different key photo, add a fun effect, edit your Live Photo, and share with your family and friends. All from your iPhone 6s and later.

Take a Live Photo

Live Photos records what happens 1.5 seconds before and after you take a picture. What you get is more than a great photo: a moment captured with movement and sound. You take a Live Photo just like you do a traditional photo.

1. Open the Camera app.
2. Make sure that your Camera is set to photo mode and Live Photos is turned on.
3. Hold your iPhone still.
4. Tap .

Live Photos is on by default on your iPhone 6s and later. If you want to **take a still image instead**, tap  to turn off Live Photos. You can preserve your Camera settings so that Live Photos is always on or off. Go to Settings > Camera > Preserve Settings.



Edit your Live Photos

Share any way you like

See your photos come to life



Applicant's Evidence – Witness Testimony

- Testimony of Gang Cao -- **Cross Examination**
by Written Questions
 - 37 CFR § 2.123(a)(1) provides for cross-examination by written questions because Cao is located outside the U.S.
 - Per 37 CFR § 2.124(d)(2), proceedings were suspended pending completion

Applicant's Evidence – Notice of Reliance on:

- Exhibits previously submitted with the Cross Examination by Written Questions of Gang Cao
- Printouts from Applicant's website showing its use of LIVE PHOTOS; Applicant's 10-K filings
- Printouts from third-party websites, including the Wayback Machine
- Copies of press releases and news articles, media
- Excerpts from Opposer's discovery responses

Applicant's Evidence – Witness Testimony

- Direct Testimony Declaration of ERIKA DILLON
 - Senior Paralegal at Kirkland & Ellis LLP
 - Confirms that all of the articles attached as Exhibits 55 and 99 through 154 of Apple's Notice of Reliance come from the LexisNexis database of published articles and news stories.

Applicant's Evidence - Witness Testimony

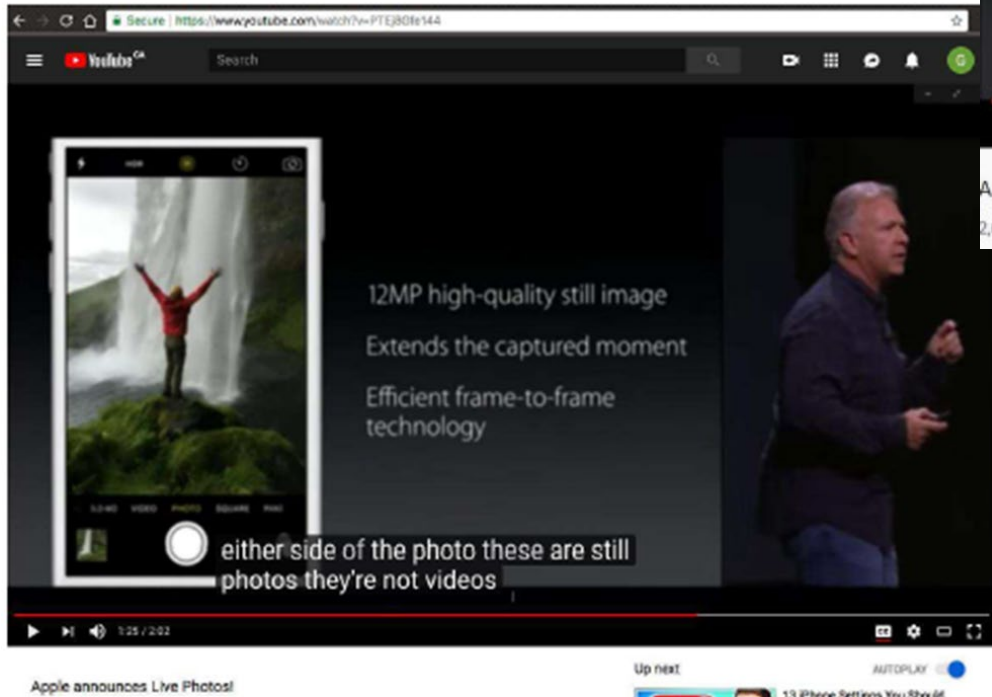
- Affidavit of ELIZABETH ROSENBERG
 - Records Request Processor at the Internet Archive
 - Explains how the Wayback Machine works
 - Authenticates exhibits that are browser printouts of the Internet Archive's records of files archived by the Wayback Machine.

Applicant's Evidence – Witness Testimony

Testimony **Declaration** of THOMAS R. LA PERLE –
Senior Director, Apple Inc.'s Legal Department:

- Applicant's use of its LIVE PHOTOS software feature.
- Evidence, such as dictionary, press excerpts show that the LIVE PHOTOS mark is not generic.
- Evidence showing widespread consumer association, or secondary meaning, of the LIVE PHOTOS mark with Apple.
- Opposer's alleged lack of use of the phrase "Live Photos"

Launched 2015



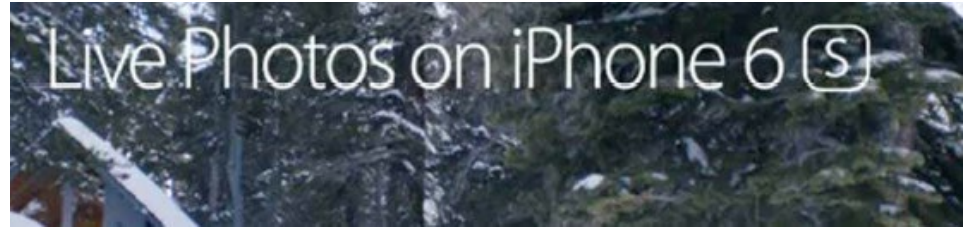
The screenshot shows a YouTube video player with a presentation slide for Live Photos. The slide features a photo of a person standing on a rock in front of a waterfall. To the right of the photo, the text reads: "12MP high-quality still image", "Extends the captured moment", and "Efficient frame-to-frame technology". Below the photo, there is a circular icon with a play button and the text: "either side of the photo these are still photos they're not videos". The video player interface includes a search bar, navigation icons, and a progress bar at the bottom.



The screenshot shows a YouTube video player with a presentation slide for Live Photos. The slide features a photo of a person standing on a rock in front of a waterfall. To the right of the photo, the text reads: "12MP high-quality still image", "Extends the captured moment", and "Efficient frame-to-frame technology". Below the photo, there is a circular icon with a play button and the text: "either side of the photo these are still photos they're not videos". The video player interface includes a search bar, navigation icons, and a progress bar at the bottom.



Applicant's Promotional Efforts



Live Photos. Livelier than ever.

Now your Live Photos can be even more expressive, creative, and just plain fun.

Learn more about Photos >

[Loop](#) [Bounce](#) [Long Exposure](#)

Turn a Live Photo you love into a fun video loop. Choose an image yourself, or let Photos suggest which ones would make great loops.



Introducing Live Photos.

A still photo captures an instant frozen in time. With Live Photos, you can turn those instants into unforgettable living memories. At the heart of a Live Photo is a beautiful 10-megapixel photo. But together with that photo are the moments just before and after it was taken, captured with movement and sound.

You can bring those moments to life anytime simply by pressing anywhere on the photo. You can even set your favorite Live Photo as your Lock screen wallpaper, so you can relive a moment any time you take your iPhone 6s out of your pocket. And you can view Live Photos on your other Apple devices, too.

Additional Evidence

“Sorry, no dictionaries indexed in the selected category contain the exact phrase *live photos*.”

Live Photos An iPhone camera feature starting with the iPhone 6s that records three seconds of video (MOV) along with the still JPEG photo. When the picture is taken, the previous 1.5 seconds of the continuously recorded video are retained along with the subsequent 1.5 seconds. The files are double the size of the normal 2MB JPEG.

...from The Free Dictionary



Live Photos

Live Photos is an iPhone camera feature that brings photos to life by creating a moving image. Instead of freezing a moment in time, you can now capture a photo with movement and sound.

[Live Photos: How To Use This iPhone Camera Feature](#)

iPhone Photography School

Opposer's Rebuttal Evidence

- Oral **cross-examination** of Thomas R. La Perle
- Notices of Reliance on
 - EUIPO's 2018 decision relating to Applicant's European Union application for LIVE PHOTOS
 - 10 Canadian applications filed by Applicant for LIVE PHOTOS and one for LIVEPHOTOKIT
 - Internet printouts from third-party cell phone and tablet manufacturers, and wireless phone carriers
 - Opposer's three patent applications (filed under seal)

Arguments at Trial – Opposer’s Brief

- Applicant’s computer software creates live photos
- LIVE PHOTOS is generic for animated photos
- Alternatively, the term is merely descriptive without having acquired distinctiveness
- Prior to Applicant’s adoption of the term, others were using, and continue to use, LIVE PHOTOS to refer to the same technology

Arguments at Trial – Applicant’s Brief

- Opposer lacks entitlement (standing)
- Evidentiary Objections to Opposer’s rebuttal evidence (improper rebuttal; foreign TMA’s)
- LIVE PHOTOS is suggestive; a still image is not “live”
- LIVE PHOTOS has acquired distinctiveness as a feature on Applicant’s iPhones and iPads based on substantially exclusive use since 2015

Arguments at Trial – Opposer’s Reply

- LIVE PHOTOS names the category of photo made by Applicant’s software – it is generic
- LIVE PHOTOS describes a key aspect of the software – it is merely descriptive
- Consumers do not perceive LIVE PHOTOS as identifying a product of Applicant’s – there is no secondary meaning attached to it
- Evidence – admissible; Board can determine weight

