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Oral Hearing: September 12, 2006

Mailed: December 19, 2006

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Fuji Photo Film Co., Ltd.

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Serial No. 75580709

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David H. Deits of Davis Wright Tremaine LLP for Fuji Photo Film Co., Ltd.

Michael W. Baird, Senior Trademark Examining Attorney, Law Office 116 (M. L. Hershkowitz, Managing Attorney).<sup>1</sup>

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Before Hohein, Bucher and Cataldo,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Fuji Photo Film Co., Ltd., a Japanese corporation, filed an application to register on the Principal Register the mark DPOF in standard character form for, as amended, the following goods:<sup>2</sup>

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<sup>1</sup> The application at issue herein was examined by a series of examining attorneys, and ultimately was assigned to the examining attorney whose name is shown above.

<sup>2</sup> Application Serial No. 75580709 was filed on October 29, 1998, based upon applicant's assertion of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), and upon applicant's assertion of a bona fide intention to use the mark in commerce with a claim of priority

digital cameras, printers for recording digital images on unexposed photographic paper and other recording paper; photofinishing apparatus and instruments, namely, photofinishing machines for developing, fixing, washing, drying, printing and selectively enlarging photographic images; computer software for creating, scanning, displaying, analyzing, editing, processing, recording, transmitting and printing digital images for use in the field of photofinishing and video image processing; video cameras; video image processing apparatus, namely, multi-function video image processing machines for creating, scanning, displaying, analyzing, editing, processing, recording and transmitting and printing digital video images,

in International Class 9.

The original examining attorney issued a refusal to register based on mere descriptiveness under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1). In response thereto applicant, *inter alia*, proposed to amend the involved application to seek registration on the Supplemental Register. The original examining attorney deferred consideration of applicant's amendment until applicant submitted a certified copy of its Japanese Registration No. 4340869. Upon receipt thereof, a succeeding examining attorney considered applicant's amendment to the Supplemental Register and issued a refusal

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under Section 44(d) of the Trademark Act, 15 U.S.C. §1126(d). Applicant subsequently deleted Section 1(b) as a basis for registration and relied upon ownership of its resulting Japanese Registration No. 4340869 under Section 44(e) of the Trademark Act, 15 U.S.C. §1126(e), as its sole basis for application.

to register under Trademark Act Section 23, 15 U.S.C. §1091 based upon genericness. These refusals subsequently were withdrawn by the present examining attorney prior to this appeal.

The present examining attorney has refused registration on the ground that the mark is incapable of functioning as a trademark within the meaning of Sections 1, 2, 23 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1091 and 1127. When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs, and applicant has filed a reply brief. At applicant's request, an oral hearing was held on September 12, 2006.

Applicant asserts that it, along with its business partners Eastman Kodak Co., Canon, Inc. and Matsushita Electric Industrial Co., Ltd., developed a proprietary technical specification "which relates to a wide variety of digital imaging products such as digital cameras and printers and photo finishing services related to images produced or reproduced by such products" (brief p. 6); that the specification utilizes technology developed by applicant and its partners and licensed from others, which is the subject of patent, copyright, trade secret and other protections; that the DPOF mark identifies both the above

technical specification and the goods of applicant and its licensees which are compliant with that standard; and that its DPOF mark is similar to other registered marks that identify both a proprietary standard and a feature of conforming goods. Applicant explains that it and its partners grant non-exclusive licenses "to parties who provide products which conform to the Specification in accordance with the terms of the 'DPOF Specification Agreement'" (brief p. 9) allowing such parties to "manufacture, have manufactured, and sell products" (*id.*) that comply therewith; that such parties may use the DPOF mark in association with licensed products to signify to purchasers and potential purchasers that the products conform to the DPOF specification; that over 140 companies have entered into DPOF Specification Agreements; that "while there is widespread use of the term 'DPOF' in association with products and services conforming to the Specification, such use reflects licensed use of the trademark and does not reflect use of the mark in association with any specification other than the proprietary Specification described above" (*id.*); and that while applicant does not control all qualities of the goods bearing the DPOF mark, it does control the relevant quality associated with the DPOF designation. Applicant argues

that the examining attorney takes the position that DPOF solely denotes products fully complying with a certain specification; that, however, the examining attorney fails to state "why such a function would not be considered a trademark function since it 'relates to the nature and quality of the goods with which it might be used'" (brief p. 12); that even if such a function is not trademark use, applicant or its licensees may place the DPOF mark on goods and thus may perform a trademark function in the future; and that, as a result, DPOF is capable of performing a trademark function and is registrable on the Supplemental Register. Applicant argues in addition that applicant itself uses the mark as an indicator of origin; and that, as a result, DPOF cannot be a certification mark.

Applicant further argues that the examining attorney has failed to point to any authority to support the instant refusal to register. In support of its position, applicant has submitted a redacted copy of the written agreement between applicant and its partners relating to licensed use of the DPOF mark; a written summary of the specifications for DPOF branded goods; and printed copies from the Office's Trademark Applications and Registrations Retrieval (TARR) website of applicant's prior registration for the mark DPOF as well as registrations for marks owned by third

parties. In addition, applicant submitted with the declaration of Mr. Shoei Imai, the Engineering Manager of the Intellectual Property Division of applicant, a copy of an October 26, 1998 press release from applicant's Internet web-site describing the introduction of Version 1.00 the DPOF specification; a copy of a July 17, 2000 press release from applicant's web-site describing the introduction of the revised Version 1.10 of the DPOF specification; a complete copy of the July 17, 2000 DPOF specification; and a copy of the DPOF specification agreement granting license to parties, *inter alia*, to use the DPOF mark on conforming goods. The following excerpt is taken from applicant's July 17, 2000 DPOF Version 1.10 Specification:

3-1. Definitions of Files and Devices

DPOF File: A file group that may include four text files; three control files (Auto Print File, Auto Transfer File and Auto Play file) and a Unicode Text Description File that describes user information in Unicode character string.

DPOF Writer: A device that sets Auto Print information, Auto Transfer information, Auto Play information and/or Unicode character string information using a DPOF File.

DPOF Reader: A device which makes print, transfer and/or auto play based on the Auto Print information, Auto Transfer information, Auto Play information and Unicode text. A DPOF Reader that can edit DPOF File is also a DPOF Writer.

DPOF Printer: A printer or print service that makes prints based on Auto Print information in

Auto Print file. A DPOF Printer is a DPOF Reader as well.

DPOF compliant device: A DPOF Writer and a DPOF Reader which supports either of Auto Print, Auto Transfer or Auto Play including all the mandatory parameters specified in this specification. Supported functions shall be specified in a product brochure, an operational manual etc. so that a user can recognize them.

In addition, the following excerpt is taken from applicant's DPOF Specification Agreement:

**Exhibit A**

Terms and Conditions for Using the DPOF Trademark

This Exhibit A To the DPOF Specification Agreement sets forth the terms and condition of the license ("Trademark License") of the trademark "DPOF" and its logo (Shown in "The Logo Usage" which is recorded in the attached CD) (collectively "Trademark") granted to the Company under Paragraph 2-(3) of the DPOF Specification Agreement. Those terms and conditions shall be applied if the Company uses any of the Trademark.

Section 1 - USE

- 1-1 The use of the Trademark shall be limited solely to:
- i) the use of the Trademark on any Licensed Product;
  - ii) the use of the Trademark on packaging and documentation for the Licensed Products; and
  - iii) the use of the Trademark on advertising and promotional materials relating to the Licensed Products
- The Company shall not use any of the Trademark for any other use than the above.

Section 2 - GUIDELINES FOR USAGE

2-1 The usage of the Trademark shall comply with the "Guidelines for Using the DPOF Trademark" ("Guideline") which is also attached to the DPOF Specification Agreement as Exhibit B.

The examining attorney argues that applicant and its partners developed a digital print order format for direct printing from digital cameras; that, however, neither applicant nor its partners "created any specific device or software in connection with the format" (brief, unnumbered p. 4); that digital print order format "is simply a standardization of file organization" (brief, unnumbered 9.5); that the DPOF designation is used by licensees to indicate compatibility not only with applicant's products, but also with all other compatible goods; that the sole requirement for using DPOF on any product is that the product conform to the standards established by applicant and its partners; but that applicant, however, provides neither guidelines regarding the overall quality of the products bearing the DPOF initialism nor "any specific technology, hardware, software, or proprietary algorithms necessary to the operation of such goods" (brief, unnumbered p. 7). The examining attorney concedes that applicant and its partners coined the proposed mark, DPOF; and that applicant controls use thereof in commerce in the United States. However, the examining attorney goes on to

argue that "Applicant's use of the proposed mark in commerce has defined the nature of the proposed mark in such a way that it has become incapable of either 1) distinguishing the goods of Applicant from those of others, or 2) indicating the source of the claimed goods" (*id.*); that the designation DPOF is applied to goods over which applicant has no control, other than verifying compliance with its specification; that applicant's own license agreement states that the purpose of the DPOF designation "is to indicate goods bearing the term DPOF conform to the published DPOF specifications" (brief, unnumbered p. 8); that goods so marked indicate that they are "DPOF compatible"; that "such usage instantly alerts consumers to the fact that DPOF does not function as an indicator of source, but rather is intended to indicate compliant [sic] with some sort of industry-wide standard" (*id.*); and that such widespread use by applicant and its partners informs consumers that DPOF "is an industry standard, and not an indicator of source" (brief, unnumbered p. 9).

The examining attorney argues in addition that goods bearing the DPOF designation "merely embody a particular protocol for storing, transferring and printing digital photographs" (*id.*); that prior to applicant's use in commerce, DPOF might have been found to be inherently

distinctive; that, however, applicant's own use of DPOF, as well of that of its licensees, "has permanently changed the nature and meaning of the DPOF acronym" (brief, unnumbered p. 10); that applicant sought to create an industry standard for formatting and ordering digital photographs; that DPOF is such an industry standard; but that "DPOF is not a trademark, and will never become capable of functioning as one" (brief, unnumbered p. 11). The examining attorney further argues that applicant presents no evidence in support of its claim that the third party registrations it made of record are used in a manner similar to the DPOF designation; that the facts leading to the registrations of such marks are not of record; and that, as a result, such third party registrations are of limited probative value.

In support of the refusal, the examining attorney and his predecessors have submitted articles from the Lexis/Nexis computer database and Internet web-sites relating to the use of DPOF by applicant, its partners and licensees.<sup>3</sup> Excerpts from these articles and web pages follow (emphasis added):

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<sup>3</sup> We note that evidence made of record by previous examining attorneys assigned to this case was submitted in support of refusals to register that subsequently were withdrawn. Nonetheless, we will consider this evidence for such probative

Eastman Kodak Co., Canon Inc., Fuji Photo Film Co. and Matsushita Electric Industrial Co. Ltd. last month got together and jointly developed DPOF, a format for direct printing from digital cameras...The companies plan to propose DPOF to the digital camera industry within the next few months...If adopted, DPOF will let users order prints of specific pictures from every file on a digital camera's storage card, whatever the card's configuration... DPOF would then record information for each of the images a user wanted to print in a recognizable format...Specification for DPOF Version 1.0 are [sic] available free to licensees. The companies hope to make the format widely available by next spring.  
(*PC Week*, November 9, 1998)

...The second, more economical method is to choose your pictures while they're still in the camera. Most modern digicams offer a feature called DPOF (digital print order format), a system of flagging pictures on the camera's screen. Then, when you transfer the memory card to the printer, you'll get just the shots you requested...  
(*The New York Times*, January 17, 2002)

Digital Print Order Format - or DPOF - allows cameras to plug directly into a printer for immediate photo publishing. The standard was developed in 1999 by Canon Inc., Eastman Kodak Co., Fuji Photo Film Co. and Matsushita Electric Industrial Co. It prints multiple images on one sheet, offers various print sizes and allows images to be annotated in different languages. Available in some cameras for nearly two years, DPOF has only recently been integrated into printers...Chute sees DPOF as a future technology. Consumers may one day take their digital photos to a kiosk at the store and not bother with setting up the printer or the cost of photo paper and printer ink. Canon, which launched its first DPOF bubble jet printer last week, is targeting consumers who may not be professionals but have

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value as it may have in relation to the issue currently on appeal.

an interest in photography. The whole purpose of **DPOF** is to allow consumers who aren't interested in working with a PC to easily review images, crop and size them, select the ones they want to print and be able to push a button to make the process simple...

*(The Orange County Register, October 8, 2001)*

If you have a computer with an older operating system, you can use the software included with the camera for uploading photos, or a third-party solution like a PC card adapter or card reader to transfer images from the camera's SmartMedia. The unit also supports Digital Print Order Format for adding date to photos or tagging them for printing on a **DPOF** printer.

*(The Boston Globe, August 9, 2001)*

Sony's new printer has built-in intelligence, allowing digital photo processing with or without the use of a PC. An enhanced on-screen display helps consumers navigate and view their images on a television monitor to select photos for printing, crop and rotate images, and even display a slideshow. The **Digital Print Order Format** (DPOF) function automatically prints photos that have been marked for print in-camera by supporting cameras.

*(PC Business Products, January 2001)*

...The new version of DPOF offers a variety of new functions:

- Multiple Image Print-so that multiple pictures can be printed on the same sheet
- Specific Size Print-so that the user can select different sizes for their printed images
- Automatic Transfer-so that image files can be electronically transmitted to selected e-mail addresses or fax numbers.
- Automatic Play-so that the user can create "slide shows" of still pictures, audio files, and movies files that can be displayed using a digital camera, computer, or electronic display device.
- Unicode\*-so that images can be annotated in many different languages (Note: this is a 2-

byte character code that supports most of the world's languages).  
([www.canon.com.au/news/story](http://www.canon.com.au/news/story))

The DPOF format was made compact so that it can be easily implemented in a compact camera. The minimum requirement for DPOF printers is to make standard prints and index prints based on the DPOF information...As [sic] DPOF file does not specify which printer is to be used. Detailed specifications such as the size of margins around pictures and layout of the index print are left to each printer. To implement DPOF, no specific hardware is needed, only a change of programming. But cameras need to have user interfaces that reflect DPOF functions.  
(*Electronic Engineering Times*, November 2, 1998)

Applicant argues in reply that the technology underlying the DPOF specification is proprietary; that the right to use the technology thus may only be secured by entering into a license agreement therefor; that to the extent the underlying technology has been widely and successfully licensed, it has become an industry standard; but that, however, widespread licensing does not adversely affect the function of DPOF as a trademark. Applicant further argues that it, along with its business partners, established and control use of the proprietary technology created by them and licensed to others; that applicant controls the relevant quality of goods bearing the DPOF mark by requiring that they be compatible with other goods meeting that specification; that such requirement is imposed upon all users of the DPOF mark; and that use of

the DPOF mark by licensees conveys to consumers that applicant "controls an aspect of the listed goods and tells them that the goods have a particular quality, namely that they utilize the proprietary technology, and that they are compatible with other products bearing the DPOF mark" (reply brief, p. 4). Applicant also argues that the examining attorney provides no support for his requirement that applicant must control other qualities of the goods bearing the DPOF mark; that those qualities "relevant to consumers' perception relating to the DPOF mark" (*id.*) are controlled; and that by indicating that goods so marked have certain qualities and features, namely, compatibility with other such products, DPOF performs a trademark function.

Applicant amended its involved application to seek registration of the proposed mark DPOF on the Supplemental Register, based solely upon Section 44(e) of the Trademark Act. Section 44(e) provides as follows:

A mark duly registered in the country of origin of the foreign applicant may be registered on the principal register if eligible, otherwise on the supplemental register herein provided. Such applicant shall submit, within such time period as may be prescribed by the Director, a true copy, a photocopy, a certification, or a certified copy of the registration in the country of origin of the applicant. The application must state the applicant's bona fide intention to use

the mark in commerce, but use in commerce shall not be required prior to registration.

By pleading ownership of its Japanese Registration No. 4340869 and asserting a bona fide intent to use the mark in commerce, applicant perfected its filing basis for the involved application without the need to allege lawful use in commerce or use anywhere in the world prior to registration on the Principal or Supplemental Register. See *Id.* See also Trademark Rule 2.47(b). Registration on the Supplemental Register is provided under Section 23, which states, in part, as follows:

(c) For the purposes of registration on the supplemental register, a mark may consist of any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, device, any matter that as a whole is not functional, or any combination of any of the foregoing, but such mark must be capable of distinguishing the applicant's goods or services.

Thus, we need not determine whether applicant has made use of the proposed mark, DPOF, in commerce as a trademark on or in connection with its identified goods. Rather, the issue before us is whether the proposed mark is capable of distinguishing applicant's goods under Sections 23(c) and 45 of the Trademark Act, that is, whether DPOF is capable of functioning as a trademark. See 15 U.S.C. §1091(c),

*supra*, and §1127. See also *In re Controls Corp. of America*, 46 USPQ2d 1308, 1309 n. 2 (TTAB 1998).

In the Definitions of Files and Devices in its July 17, 2000 specification, excerpted above, applicant defines the following devices under the DPOF designation: DPOF Writer; DPOF Reader; and DPOF Printer. As defined, these devices perform various functions related to the transfer, display and printing of digital images. Applicant further defines a DPOF Compliant Device as a DPOF Writer or Reader that supports the functions of those devices. Finally, applicant defines a DPOF File as one of several text files that controls functions in the defined devices and identifies user information therefor. Thus, in its literature applicant does not use DPOF merely to designate a technical specification or protocol for the transfer of digital images, but rather to identify goods or features thereof including at least a digital image writer, reader, printer, and computer program files associated therewith. Further, applicant's excerpted Exhibit A to its DPOF Specification Agreement sets forth terms and conditions for use of the DPOF trademark, which manifests at least its intention that DPOF function as a mark and not merely as a technical specification. In addition, the above-excerpted Nexis and Internet evidence made of record by previous

examining attorneys suggests that DPOF is recognized by consumers as denoting at least a function or feature of goods, namely, that goods so denoted use digital print order format for transferring and printing digital images. Such evidence further suggests that these goods include computer software, digital cameras and photo printers, which goods are included among those identified in the application at issue. In short, the evidence in this case supports a finding that DPOF is capable of distinguishing goods utilizing digital print order format from goods that do not. As such, we cannot find on the record in this case that DPOF is incapable of functioning as a trademark. We note that the evidence of record indicates that DPOF serves both as an initialism for a method of transferring digital images known as "digital print order format" and also as a mark used to identify goods conforming with that standard. Nonetheless, the examining attorney has cited to no authority to support a finding that a term used to denote such a method is incapable of distinguishing applicant's goods from those of others.

We further find unpersuasive the examining attorney's argument that DPOF is actually a certification mark as opposed to a trademark. In that regard, we note that Section 4 of the Trademark Act provides for the

registration of "certification marks, including indications of regional origin." 15 U.S.C. §1054. See also Trademark Rule 2.45. Certification marks differ from trademarks or service marks in that a certification mark is not used by its owner and, in addition, does not indicate commercial source or distinguish the goods or services of one person from those of another person. See TBMP §1306.01. In this case, and as noted above, DPOF is used by applicant as well as its licensees. Use of a mark by its owner is antithetical to its capacity to function as a certification mark. In addition, we have determined above that DPOF is capable of distinguishing the goods of applicant from those of others. As such, the record in this case does not support a finding that DPOF is a certification mark.

We also find unpersuasive the examining attorney's argument that DPOF fails to function as a mark because the designation is used to identify not only applicant's goods but also goods that conform with the digital print order format standard that are produced by third parties. Applicant has argued and submitted supporting evidence that use of DPOF is available only to applicant and its licensees. It is settled that ownership rights in a trademark or service mark may be acquired and maintained through the use of the mark by licensees even when the only

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use of the mark has been made, and is being made, by those licensees. See *Turner v. HMH Publishing Co., Inc.*, 380 F.2d 224, 154 USPQ 330, 334 (5<sup>th</sup> Cir. 1967), *cert. denied*, 389 U.S. 1006, 156 USPQ 720 (1967); and *Central Fidelity Banks, Inc. v. First Bankers Corp. of Florida*, 225 USPQ 438, 440 (TTAB 1984). Thus, to the extent that applicant may use DPOF to denote its goods as well as those produced by third party licensees, such use does not preclude a finding that the proposed mark is capable of functioning as a trademark.

*Decision:* The refusal to register is reversed.