

**This Opinion is Not a  
Precedent of the TTAB**

Hearing: October 7, 2015

Mailed: October 9, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

—  
Trademark Trial and Appeal Board  
—

*In re Apple Inc.*  
—

Serial No. 77078496  
—

Jason Vogel, Theodore H. Davis, Jr., and Phillip A. Rosenberg of Kilpatrick  
Townsend & Stockton LLP for Apple Inc.

Linda Estrada, Trademark Examining Attorney, Law Office 104,  
Chris Doninger, Managing Attorney.

—  
Before Bergsman, Gorowitz and Lynch,  
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Apple Inc. (“Applicant”) has filed an application to register, on the Principal Register, the mark IPHONE (in standard character form) for services ultimately recited as set forth below:

Entertainment services, namely, providing online computer databases featuring information in the fields of music, video, film, books, television entertainment, games and sports; and providing consultation services relating to all the aforesaid, in Class 41; and

computer hardware and software consulting services; multimedia and audio-visual software consulting services; providing technical troubleshooting support for computer systems, databases and applications; providing consultation services for developing computer systems, databases and applications; information relating to computer technology provided on-line from a global computer network or the Internet; providing search engines for obtaining data via communications networks; providing search engines for obtaining data on a global computer network; computer services, namely, creating indexes of information, and other resources available on global computer networks for others; customized searching at the specific request of end users, allowing the end user to browse and retrieve information, sites, and other resources available on global computer networks; and consultation services relating to all the aforesaid, in Class 42.

The application was filed on January 8, 2007, based upon an allegation of a *bona fide* intention to use the mark in commerce. The application was published for opposition on June 15, 2010, and a notice of allowance subsequently issued on August 10, 2010. Applicant filed its statement of use and a specimen on August 12, 2013, alleging first use anywhere and in commerce for both classes of services as of June 29, 2007. Applicant submitted substitute specimens on October 23, 2014. The Examining Attorney issued a final refusal to register under Sections 1 and 45 of the Trademark Act of 1946, 15 U.S.C. §§1051 and 1127, on the ground that “Applicant’s specimens of use do not show use of the applied-for mark in connection with any of the services specified in the Statement of Use.”<sup>1</sup>

---

<sup>1</sup> 16 TTABVUE 2-3.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register with respect to the specimens for the Class 41 services and reverse the refusal to register with respect to the specimens for the Class 42 services.<sup>2</sup>

### I. Applicable Law

A Statement of Use must include a specimen showing the applied-for mark in use in commerce for each class of goods and/or services specified in the Statement of Use. Trademark Act Section 1 and 45, 15 U.S.C. §§ 1051, 1127; 37 C.F.R. §§ 2.56(a), 2.88(b)(2). To show service mark usage, the specimen must show use of the mark in a manner that would be perceived by potential purchasers as identifying the applicant's services and indicating their source. *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973) ("The requirement that a mark must be 'used in the sale or advertising of services' to be registered as a service mark is clear and specific."); *In re DSM Pharmaceuticals, Inc.*, 87 USPQ2d 1623, 1625 (TTAB 2008) (term that merely identifies computer software used in rendering services does not function as a mark to identify custom manufacturing of pharmaceuticals). The mark must show an association between the mark and the services for which registration is sought. A specimen that shows only the mark,

---

<sup>2</sup> A multiple-class application may be viewed as a group of applications for registration of one mark in connection with goods or combined into one application. Generally an applicant is in the same position that he or she would have been if they had filed several single-class applications instead. *G&W Labs., Inc. v. G W Pharma Ltd.*, 89 USPQ2d 1571, 1574 (TTAB 2009). See also TMEP § 1403 (July 2015).

with no reference to the services, does not show service mark usage. *In re Adair*, 45 USPQ2d 1211, 1214 (TTAB 1997). There must be sufficient reference to the services in the specimen to create an association between the mark and the activity or activities comprising the service. *In re Monograms Am., Inc.*, 51 USPQ2d 1317, 1318 (TTAB 1999).

A term that identifies mobile phones and devices does not become a service mark, unless it is also used to identify and distinguish services. *Cf. In re Walker Research, Inc.*, 228 USPQ 691 (TTAB 1986) (“[A]s used in the specimens, [the mark] refers only to the software used in the performance of the services and does not identify and distinguish the services themselves”). The question then is whether the specimen shows the term used as a mark for only the mobile device or also to identify the Class 41 entertainment and consultation services and the Class 42 computer-related services? To answer that question we must “review all the information in the record to understand both how the mark is used and how it will be perceived by potential customers.” *Ancor Holdings*, 79 USPQ2d 1218, 1221 (TTAB 2006).

For each specimen Applicant submitted, the Examining Attorney maintained her position that “the specimens consist of advertising materials for goods, which do not show use of the proposed mark in the sale, advertising, performance or rendering of any services identified in the Statement of Use. Instead, the specimens indicate that the proposed mark IPHONE is solely used as the source identifier for applicant’s computer hardware, more specifically, for its specific brand of

smartphone.”<sup>3</sup> The Examining Attorney further expounded on the basis of the refusal as follows:

There is no information or manner of use of the proposed mark IPHONE on the specimens, which would create the necessary mark-services association in the mind of consumers with respect to the identified services. *See* TMEP §1301.04(g)(i). While applicant’s IPHONE computer hardware device is clearly used by consumers to access software applications, which in turn may be further used to facilitate activities of the kind identified in this application, the specimens do not show use of the proposed mark IPHONE directly as a service mark for the separable services identified in International Classes 41 and 42.<sup>4</sup>

## II. Class 41

Applicant describes the original specimen for the Class 41 services as “a screenshot from Applicant’s website showing use of the applied-for mark in the advertising of the applied-for services.”<sup>5</sup> For purposes of our analysis, we present below the specimen as Applicant excerpted and annotated it in its brief.<sup>6</sup> Applicant describes the specimen as follows:

[T]he IPHONE mark is presented in a large font at the top of the webpage and is repeated numerous times throughout the text of the page. The webpage lists many features, software apps and services that come pre-bundled with the iPhone device, including, as shown [below], a number of the Class 41 services recited in the application.<sup>7</sup>

---

<sup>3</sup> 16 TTABVUE 5.

<sup>4</sup> 16 TTABVUE 6.

<sup>5</sup> Applicant’s Statement of Use filed August 12, 2013.

<sup>6</sup> 16 TTABVUE 10.

<sup>7</sup> 14 TTABVUE 12. The word “app” is defined as “an application, typically a small, specialized program downloaded onto mobile devices: *the best GPS app for your iPhone.*”



The Mark

Hundreds of thousands of endless



iBooks

More than 1.8 million books on the iBookstore — many of them free —

m/iphonesfrom-the-app-store[7/30/2013 9:21:44 AM]

.com about apps from the App Store.

can turn your iPhone into a pocket-size library. Text is sharp and crystal clear. Pages turn with a flick. And no matter where you go, you'll always have a good book. [Learn more about iBooks.](#)

The services “providing online computer databases featuring information in the field[] of ... books”.

The Mark



Remote

The Mark

With Remote on iPhone you can control iTunes and Apple TV from anywhere in your home over Wi-Fi. Browse your iTunes library, pick a song or playlist, and tap to play. Or find and play the latest movies and TV shows on Apple TV. [Learn more about Remote](#)

The services “providing online computer databases featuring information in the fields of music, video, film, ... television entertainment”.

/ game or a new recipe. Something to help you stay on top of world affairs or something you stay on top of your finances. For all the incredible things your iPhone already does, there are thousands more, waiting for you at the App Store. [Visit the App Store](#)

The services “providing online computer databases featuring information in the field[] of ... games”.

The Mark



Games

The world's best phone is also the world's best portable gaming device. From first-person shooters to strategy, iPhone knows how to have a good time. [View games in the App Store](#)

Dictionary.com based on the **RANDOM HOUSE DICTIONARY** (2015). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

Applicant argues that the specimen is acceptable for the following reasons:

Contrary to the Examining Attorney's assertions, there is a clear mark-services association shown in the specimen due to the prominent usage of the mark at the top of the page, and due to the consistent textual use of the IPHONE mark throughout the specimen in statements describing the services.<sup>8</sup>

The IPHONE mark displayed at the top of the webpage identifies the IPHONE smartphone, a photograph of which appears immediately below the mark. The IPHONE mark also appears at the top center of the webpage in a menu of options next to other hardware devices, such as "iPod" and "iPad." Additional text that does not appear on the above-noted excerpt but appears in a subsequent excerpt referenced by Applicant in its brief invites the reader to explore the App Store to find applications "designed exclusively for the iPhone – by Apple and by third-party developers."<sup>9</sup> Applicant contends that this excerpt shows IPHONE used to identify the providing of online computer databases. However, we find that the IPHONE reference identifies Applicant's smartphone, not a service.

In another excerpt that Applicant did not annotate and include in its brief, Applicant references "iPhone apps."

The App Store has the world's largest collection of mobile apps. But it's not just the number that's impressive. It's the kind of apps you'll find. iPhone apps offer a better experience because they take advantage of the technologies built into the device. And all those apps are in one place, so they're easy to access, easy to search, and easy to download – using the same Apple ID account you use on iTunes.

---

<sup>8</sup> *Id.*

<sup>9</sup> 14 TTABVUE 18.

The reference to “iPhone apps” refers to downloadable programs that function on an IPHONE device.<sup>10</sup> The above-noted use of “iPhone apps” is the only reference to “iPhone apps.” Applicant otherwise uses “Apple Apps” to identify its apps. *See e.g.*,

## Apple Apps on the App Store

Make a picture perfect. Edit an HD movie. Read a novel or write one. Present your big idea. Or create and send a card. Apple apps from the App Store are designed specifically for iPhone. Which means they give you the power and versatility to do more than you ever thought possible.

The IPHONE display at the top of the webpage does not alter that perception.

The iBooks icon excerpt states that there are “[m]ore than 1.8 million books on the iBookstore – many of them free- can turn your iPhone into a pocket-size library. Text is sharp and crystal clear. Pages turn with a flick. And no matter where you go, you’ll always have a good book. Learn more about iBooks.” In this excerpt, IPHONE identifies the mobile device on which the iBooks app is displayed. iBooks appears to identify the service of providing an online computer database featuring information in the field of books. Contrary to Applicant’s assertion, the excerpt does not show IPHONE used to identify providing an online database in the field of books. There is nothing in the website from which we could infer that potential consumers would perceive an IPHONE brand database in the field of books and, therefore, there is nothing that creates an association between the IPHONE mark and the purported services.

---

<sup>10</sup> *See* note 7.

The “Remote” icon excerpt describes a remote control application that permits the user to use his/her IPHONE to control his/her iTunes and Apple TV applications over the user’s Wi-Fi network. In this excerpt, IPHONE identifies the mobile device on which the Remote app is displayed. Contrary to Applicant’s assertion, the excerpt does not show IPHONE used to identify the providing of an online database in the field of music, video, film and television. There is nothing in the excerpt from which we may infer that consumers would associate the IPHONE mark with an IPHONE brand database in the field of music, video, film and television and, therefore, there is nothing that creates an association between the IPHONE mark and the purported services.

Applicant presented in its brief a part of the webpage which, if complete, reads as follows:

More Apps on the App Store

A new game or a new recipe. Something to help you stay on top of world affairs or something to help you stay on top of your finances. For all the incredible things your iPhone already does, there are thousands more, waiting for you at the App Store.

Applicant asserts that this excerpt shows the IPHONE mark used for providing online computer databases featuring information in the field of games. We disagree. The section of the webpage noted above, identifies IPHONE as a mobile device for which the user may purchase applications at the Apple App Store to increase the utility of the mobile device. There is no direct or indirect reference or association with any activity that may be interpreted as a registrable service.

Likewise, the “Games” icon excerpt advertises that “[t]he world’s best phone is also the world’s best portable gaming device.” The mark IPHONE is used to identify a mobile device on which computer games may be loaded and played. There is no direct or indirect reference or association between the IPHONE mark and providing an online database in the field of computer games.

With respect to the substitute specimen, Applicant describes it as consisting of “two television advertisements featuring successive frames showing various of the recited Class 41 services rendered through the IPHONE device. The final frame prominently depicts the IPHONE mark thereby associating the mark with the services.”<sup>11</sup> However, the “various services” referenced by Applicant consist of frames showing IPHONE users playing games, watching movies, reading books, and listening to music. The advertisements display an IPHONE in use for various activities. The IPHONE mark identifies a mobile device. There is no direct or indirect reference or association to any IPHONE brand online games, movies, books or music and, therefore, there is nothing in the specimen that creates an association between the IPHONE mark and the purported services.

Applicant argues, in essence, that mobile devices and the activities that may be performed on them are now one and the same: that is, the technology has merged products and services such that a mark that identifies a mobile device, such as

---

<sup>11</sup> 14 TTABVUE 11.

Applicant's IPHONE, also identifies the activities performed on or through the mobile device.<sup>12</sup>

Thus, from its inception, Apple's revolutionary iPhone device has been at the forefront of the phenomenon known as "technology convergence," or the unification of media, technologies and services into a single, common device and platform.

Technology convergence has blurred the line between goods and services. In order to make the iPhone device function, Apple not only provides hardware and software, but is also rendering a broad range of services to its customers delivered through hardware and software under the IPHONE mark. Apple's customers have therefore come to understand and expect that when purchasing an iPhone device from Apple, they are also receiving a suite of services that are provided through the device. By the time Apple filed its Statement of Use with the USPTO—six years after the launch of IPHONE—Apple had created a new commercial reality. Consumers, due in no small part to the advent of IPHONE, now rely on their mobile devices for many aspects of their lives. Consumers do not just simply access software and perform their own operations on their devices; they also access a suite of services delivered by technology companies through mobile devices and their built-in software.<sup>13</sup>

In support of that argument, Applicant references "representative articles from national publications such as *Time*, *The New York Times*, *The Chicago Tribune*, *Los Angeles Times*, and *Baltimore Sun*, which describe today's commercial context of digital electronic devices rendering services by way of their installed software."<sup>14</sup> However, none of these articles support Applicant's contentions that the line

---

<sup>12</sup> 14 TTABVUE 5.

<sup>13</sup> *Id.*

<sup>14</sup> *Id.*

between goods and services has been blurred or that consumers identify the mark for the mobile device with the mark for the services rendered through the mobile device. In each of the articles, the smartphone is identified as a device through which an ever-growing group of activities are conducted; not as the source of activities or services rendered by using a mobile device.

1. *Time* (January 14, 2013)<sup>15</sup>

Your Smartphone Will Become the Hub of Your Digital Lifestyle

Over the next two to three years, I believe we will see thousands of sensor-based products tied to apps on our smartphones.

The gist of this article is that smartphones will become “the center of our lives.” Smartphones will become the hub around which users react to the world because they are remote control devices through which users will control their home thermostats, cars, healthcare monitoring, etc. The author referenced the IPHONE as a mobile device; he did not reference any IPHONE brand services.

Over the next two or three years, I believe that we will see thousands of sensor-based products tied to our apps on our smartphones, making it even clearer that the real hub of our digital lifestyle may actually be our smartphones. It is the one device that we have with us at all times; given its increasing power and capabilities, it could emerge as the command center of our digital activities, become even more indispensable than it is today.<sup>16</sup>

---

<sup>15</sup> 9 TTABVUE 31.

<sup>16</sup> *Id.*

2. *New York Times*, “The Next Step in Money. Maybe.” (October 21, 2014).<sup>17</sup>

This article is about the emergence of APPLE PAY, Applicant’s e-commerce product which permits the smartphone to act as a credit card. The author of this article distinguished the IPHONE mark as identifying the mobile device and APPLE PAY as identifying the payment service and never referenced an IPHONE e-commerce payment service.

3. *The Baltimore Sun*, “Wireless technology takes the hassle out of home automation” (October 21, 2014).<sup>18</sup>

This article is about advances in wireless technology. The author never conflated the mobile device with a service. For example, the author referenced a user controlling his SONOS music system and accessing an Internet music station through a mobile device but did not reference the service of providing music through a mobile device brand name service.

4. *Chicago Tribune*, “It’s time to talk to your fridge. Connected home technology links appliances, devices, energy and security,” (January 12, 2012).<sup>19</sup>

This article is about how increased Wi-Fi capability and smartphone and tablet computer accessibility are driving advancements in remote, portable control for a

---

<sup>17</sup> 9 TTABVUE 35. *The New York Times* article “What Your Phone Might Do for You Two Years from Now” (November 5, 2009) is about advancements in smartphone hardware technology to handle additional applications. 9 TTABVUE 38. *The New York Times* article “Pay by Voice? So Long, Wallet” (July 19, 2012) is about an application that converts a smartphone into a credit card reader and other wireless methods of payment. 9 TTABVUE 49. In these articles, the mobile device is referenced as the means through which activities are conducted or services rendered and not as the provider of the activities or services.

<sup>18</sup> 9 TTABVUE 42.

<sup>19</sup> 9 TTABVUE 45.

wide range of applications. There is no indication that the perception of consumers is moving to the point of merging a mobile device with the activities that may be conducted through those devices. However, the author did note that “consumers will embrace new services [offered by Comcast and Verizon Wireless] if they come bundled with existing subscriptions because they can sign up for one package.”<sup>20</sup> This implies that the services would be advertised and rendered, for example, as COMCAST security services rendered through COMCAST cable services.

5. *Los Angeles Times*, “Review: Apple’s CarPlay headed in right direction” (May 27, 2014).<sup>21</sup>

This article is about an application called CarPlay for “iPhone owners” by which Applicant “implants some of the iPhone’s main applications in automobiles so drivers can control them with voice commands, a touch on the steering wheel or swipe on a display screen in the dashboard.”<sup>22</sup>

Pioneer’s top-of-the-line CarPlay radio features a 7-inch screen that shows the iPhone apps for calls, contacts, music, maps, and messaging when the devices is plugged in with a cable.

Other mobile music apps – including Spotify, Beats Music and iHeartRadio – are supposed to be eventually available on CarPlay too. Facebooks, YouTube and other apps that show a lot of photos and videos won’t be available for safety and legal reasons.<sup>23</sup>

---

<sup>20</sup> 9 TTABVUE 46.

<sup>21</sup> 9 TTABVUE 51.

<sup>22</sup> *Id.*

<sup>23</sup> *Id.*

This article notes that CarPlay requires the use of certain models of the IPHONE device and that there are IPHONE apps for calls, contacts, music, maps and messaging. This is a reference to software programs for processing calls, contacts, music and messaging. However, there is no issue about whether these programs can be run on Applicant's mobile device. The issue is whether consumers identify programs and activities conducted through or services rendered by these programs as IPHONE brand activities or services. Nowhere in this record is there any written material demonstrating an association between the IPHONE mark and providing online computer databases or consultation services in the fields of music, video, film, books, television entertainment, games and sports. Every reference to the IPHONE mark is used to identify Applicant's mobile device.

With respect to Applicant's argument that in the "context of technology convergence, consumers for technology products and services like the products of and services of Apple and these other companies are likely to associate a devices manufacturer's product mark with the services rendered by the products,"<sup>24</sup> the record does not support such a finding of fact. For example, the marks Spotify, Beats Music and iHeartRadio are trademarks that identify music applications that may appear on a smartphone presumably including Applicant's IPHONE. This demonstrates that consumers have been conditioned to look for trademarks identifying applications that may be used on mobile devices for, *inter alia*, calls, contacts, music and messaging.

---

<sup>24</sup> 14 TTABVUE 19.

At the oral hearing, Applicant analogized its specimens to Example 2 in TMEP § 1301.04(i) (“Examples of Acceptable Service-Mark Specimens”). The relevant substitute specimen in Example 2 is displayed below:



The mark at issue is PARSE for “platform as a service (PAAS) featuring computer software platforms offering server-side functionality to provide backend services, namely, data storage, push notification and user management, all for mobile applications,” in Class 42.

Substitute specimen is acceptable due to the following statements referencing the services and the following indicia of the context in which the services are rendered:

The wording “The mobile app platform for developers” and “Add a powerful and scalable backend in minutes for your Marketing App” describes the nature of the services.

The “Manage your apps” button indicating that the services are accessed by clicking on the button.

Mark-services association is present because it is customary to display service marks near the top of the webpages on which the services are advertised or through

which they are accessed, rendered, and experienced. Here, the mark is in close proximity to explicit textual references to the services and the “Manage your apps” button, thus creating the mark-services connection.

The issue with the PARSE mark and specimen is whether PARSE identifies software in the field of data storage, push notifications and user management or the service of providing software platforms providing data storage, push notifications and user management, or both. The TMEP points out the explicit references to the services in close association with the mark, and there is no suggestion in the specimen or the TMEP that PARSE refers to goods rather than services.

In Applicant’s specimens, however, while IPHONE clearly identifies a mobile device, it does not identify the services of providing online computer databases. Applicant argues that its “App Store service,” bundled into the IPHONE device, “allows consumers to access the very databases for which registration is sought in Class 41.”<sup>25</sup> However, just because apps may be accessed through an IPHONE does not *ipso facto* mean that the apps that function or are accessible through an IPHONE are identified by that mark. With respect to Applicant’s specimens, consumers will not perceive IPHONE as a service mark for a database of apps or for apps.

At oral argument, Applicant also referenced *In re Epiq Systems, Inc.*, (Serial Nos. 85978692 and 85979129, TTAB 2015) (non-precedential) as offering support for the registration of IPHONE for the services in Class 41. In that case, applicant

---

<sup>25</sup> 17 TTABVUE 7.

sought to register the marks DOCUMATRIX MOBILE and DMX MOBILE for the following services:

Consulting in the field of technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems; leasing of computer software that stores and manages documents, digital media, text, sound and images in the fields of electronic discovery, internal corporate matters, compliance, second requests, litigation, investigations and document management in International Class 42; and

Litigation support services, namely, conducting electronic discovery and document review of electronically stored information that could be relevant in legal proceedings; legal consultation services in International Class 45.

The specimen providing the following information:

#### DMX SOLUTION

DocuMatrix Mobile (DMX MOBILE) provides law firms and corporations the ability to perform on-site document review in a self contained portable environment behind and in conjunction with a corporation's IT infrastructure. The hardware and software solution, coupled with Epiq's on-site support team, allows legal teams to abide by local data protection and privacy laws and security concerns, and respond to litigation events, regulatory investigations, and compliance issues. Combining DMX Mobile with Epiq's Document Review Services provides attorney review services on a global scale, wherever the investigations occur.

#### Key Feature of DMX Mobile"

- Complete hardware and software solution delivered rapidly, on-site, anywhere in the world.

The Examining Attorney refused registration on the ground that the specimens do not show either of the applied-for marks used in connection with any of Applicant's services identified in Class 42 and 45 but rather identify computer

software and hardware, Class 9 goods. The Board considered explanatory declaration evidence about the services and relevant consumers and reversed the refusal. The Board found that the above-noted language in the specimen of use creates in the mind of the prospective consumer an association between the mark and document review services, as well as the services of “leasing of computer software that stores and manages documents, digital media, text, sound and images in the fields of electronic discovery, internal corporate matters, compliance, second requests, litigation, investigations and document management.” In this case, Applicant’s specimens display IPHONE, which identifies a mobile device on which various apps may be loaded to increase functionality. However, consumers will not perceive the IPHONE mark as identifying the database of those apps or the apps themselves just because they may be loaded onto the IPHONE.

Finally, Applicant argues that “the USPTO has routinely accepted similar specimens that depict use of a device or software mark also as a mark for the services rendered via its products.”<sup>26</sup> In support, Applicant submitted copies of third-party applications/registrations and their respective specimens, which do not change the conclusion reached by us, that the specimens of record do not show use of the IPHONE mark in connection with providing online computer databases or consultation services in the fields of music, video, film, books, television entertainment, games and sports. The Board must decide each case on its own merits. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir.

---

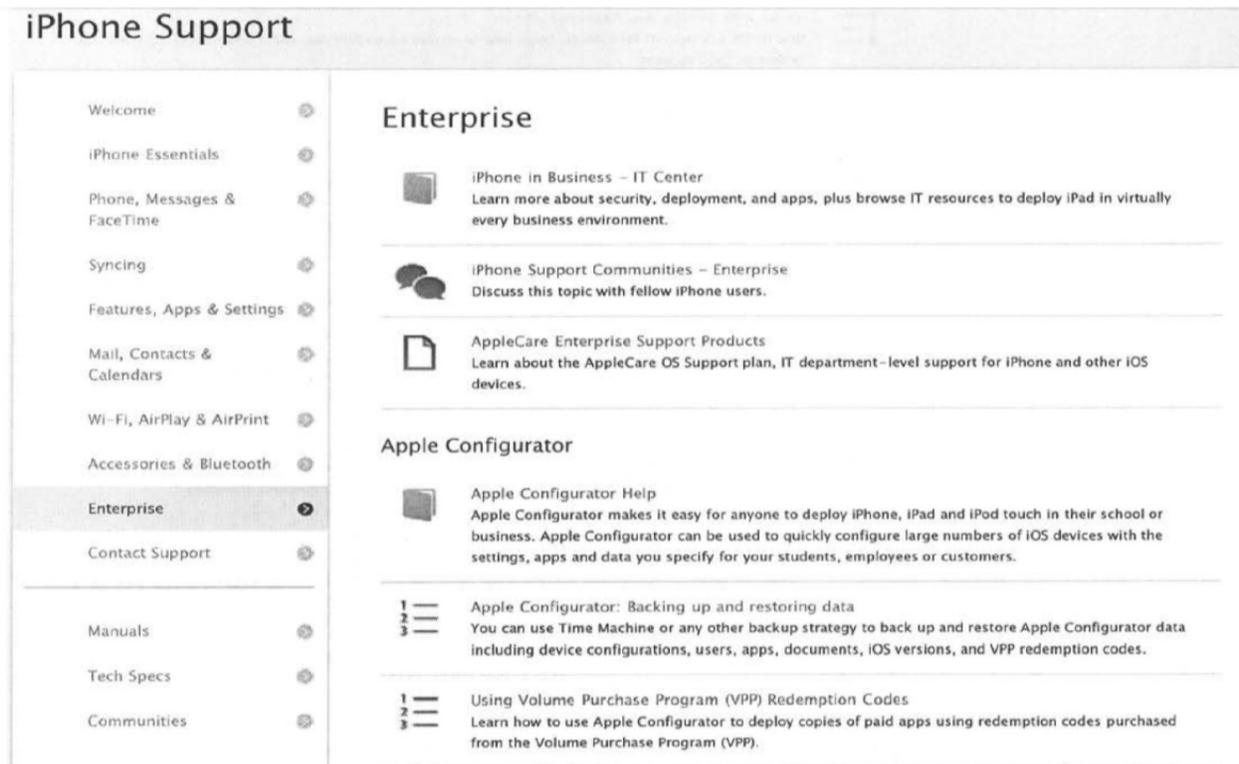
<sup>26</sup> 14 TTABVUE 18-19.

2001); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1127, 227 USPQ 417, 424 (Fed. Cir. 1985). Even if some prior registrations had some characteristics similar to Applicant’s specimens, application, the PTO's allowance of such prior registrations is not binding on us.

In view of the foregoing, we find that the specimens of record do not show use of the mark IPHONE used in connection with “entertainment services, namely, providing online computer databases featuring information in the fields of music, video, film, books, television entertainment, games and sports; and providing consultation services relating to all the aforesaid.”

### III. Class 42

On October 23, 2014, Applicant submitted the substitute specimen shown below in support of the services recited in Class 42.





This specimen shows use of the IPHONE mark in connection with “providing technical troubleshooting support for computer systems, databases and applications.”<sup>27</sup> For example, among other support-related references, the menu on the left side of the webpage provides links to Contact Support. Unlike with the Class 41 specimens, the IPHONE mark here appears directly in connection with the support services, and not merely as a reference to the device. Because the specimen shows use of the mark in connection with at least one of the activities recited in the application, the specimen is sufficient to support the registration for the entire class. *See* TMEP § 904.01(a) (“Generally, if more than one item of goods, or more

---

<sup>27</sup> We note that original specimen displays IPHONE with additional wording as **iPhone in Business**, and that the substitute specimens display IPHONE with additional wording as **iPhone Support** and **iPhone Assistant**. According to TMEP § 807.12(a), “the drawing must always be compared to the specimen of record to determine whether they match” because “the drawing of the mark must be a substantially exact representation of the mark shown on the specimen.” When the panel raised this point at the oral hearing, neither Applicant nor the Examining Attorney conceded that the IPHONE mark was not properly displayed in the specimens. Both noted that in the context of support services, the “Support” wording in iPhone Support would be considered generic.

We also note that whether providing support for the use of its mobile device is sufficiently separate from Applicant’s principal activity of manufacturing and selling mobile devices to constitute a separate service was not an issue raised during the prosecution of this application. A determination in this regard involves “whether the activity identified in the application is in any material way a different kind of economic activity than what any other provider of that particular product or service normally provides.” TMEP § 1301(a)(iii).

than one service, is specified in one class in an application, it is usually not necessary to have a specimen for each product or service.”).<sup>28</sup>

**Decision:** The refusal to register Applicant’s mark IPHONE is affirmed in connection with the Class 41 services.

The refusal to register Applicant’s mark IPHONE is reversed in connection with the Class 42 services.

---

<sup>28</sup> We do not make any finding of fact as to whether any of the other purported specimens or explanatory documentation show use of Applicant’s mark in connection with any of the other activities recited in the Class 42 identification of services.