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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Heartify LLC

Serial No. 97768868

Ilya R. Lapshin of IRL Legal Services, LLC, for Heartify LLC.

Marco Wright, Trademark Examining Attorney, Law Office 120,
David Miller, Managing Attorney.

Before Larkin, Thurmon and Elgin, Administrative Trademark Judges.

Opinion by Thurmon, Administrative Trademark Judge:

Heartify LLC ("Applicant") seeks registration on the Principal Register of the mark 

for "Software as a service (SAAS) services featuring software for use in measurements of heart rate, heart rate variability, physiological stress, and physiological markers; Software as a service (SAAS) services featuring software for

providing information relating to heart health, health, wellness, and well-being," in International Class 42.[1]

The Examining Attorney finally refused registration under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1127, because the specimens submitted by Applicant did not "show the applied-for mark as actually used in commerce in connection with any of the services specified in International Class 42." Applicant and the Examining Attorney have filed briefs and this appeal is ready for decision. We affirm the refusal to register.

I. Analysis

"To ensure that the applicant uses the mark in commerce …, the PTO requires the applicant to submit a specimen of use 'showing the mark as used on or in connection with the goods [or services].'" *In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1120 (Fed. Cir. 2009) (quoting 37 C.F.R. § 2.56(a) (2009)). A service mark is used in commerce

> when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

15 U.S.C. § 1127; *see also* Trademark Rule 2.56(b)(2), 37 C.F.R. § 2.56(b)(2).

[1] Application Serial No. 97768868 was filed on January 26, 2023, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). The mark is described as follows: "The mark consists of the word 'HEARTIFY' appearing to the right of heart enclosing a stylized letter 'H' depicted as an electrocardiogram electrical signal." The application also identifies downloadable software goods in International Class 9. This appeal involves only the International Class 42 services, a point we explain below.

As the TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) states:

> To be acceptable, a service-mark specimen must show the mark sought to be registered used in a manner that demonstrates a direct association between the mark and the services. 37 C.F.R. §2.56(b)(2). Specimens need not explicitly refer to the services to establish the requisite direct association between the mark and the services, but "there must be something which creates in the mind of the purchaser an association between the mark and the service activity."

TMEP § 1301.04(f) (see also cases cited therein); *see also In re Universal Oil Prods. Co.*, 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973) ("The minimum requirement is some direct association between the offer of services and the mark sought to be registered therefor.").

In this case, Applicant identified downloadable software goods in International Class 9 and the SAAS services recited above in International Class 42. From the start of the examination, Applicant struggled to satisfy the specimen requirements. In the first Office Action, the Examining Attorney refused registration because the specimen failed to show use of the mark, for the goods or services, for a number of reasons.[2] Applicant did not present any arguments against this refusal, but submitted a substitute specimen.[3]

In the final Office Action, the Examining Attorney found the substitute specimen showed use in commerce with the International Class 9 downloadable software goods, but not with the International Class 42 SAAS services.[4] Applicant requested

[2] Office Action dated October 3, 2023, at 2-4. Neither the Examining Attorney nor Applicant submitted any evidence in connection with the examination of this application.

[3] Response to Office Action at 3, and Specimen, both dated October 12, 2023.

[4] Final Office Action dated November 16, 2023, at 2-4. Registration was refused as to the International Class 9 goods because of other issues with the substitute specimen.

reconsideration and submitted another substitute specimen, this time explaining that the specimens were not Internet screenshots, but mobile phone screenshots.[5] The Examining Attorney denied the request, but found the newly-filed substitute specimen met all requirements as to the International Class 9 goods, but did not show use of the mark in connection with the International Class 42 services.[6]

The sole issue before us is whether the specimen shows use of the 

mark with the SAAS services. As we noted above, a service mark is used "when it is used or displayed in the sale or advertising of services and the services are rendered in commerce." 15 U.S.C. § 1127. The issue here is not whether the SAAS services are rendered, but whether the specimen shows use or display of the mark in connection with the SAAS services.

Applicant and the Examining Attorney agree that SAAS refers to "a method of software delivery and licensing in which software is accessed online via a subscription, rather than bought and installed on individual computers."[7] This type of service may be somewhat similar to downloadable software in International Class 9, but for SAAS, the software resides on the service provider's system. Applicant submitted specimens showing mobile phone applications, but not SAAS services.

Indeed, the sole argument Applicant makes in support of this appeal is that one of the mobile phone screenshots shows a tab for account information. Applicant

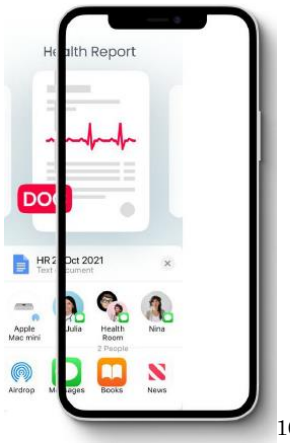
[5] Request for Reconsideration at 3-4, and Specimen, both dated February 16, 2024.

[6] Denial of Request for Reconsideration dated February 21, 2024, at 2.

[7] 10 TTABVUE 5 (citing Request for Reconsideration dated February 16, 2024).

argues that this tab, if used, would direct a user to Applicant's Internet site, where the user would then receive SAAS services relating to the user's account.[8] The statutory definition of service mark use does not allow for the indirect "chain-of-events" type of use Applicant argues for here. The mobile phone screenshots show use of downloadable mobile phone applications, just as the Examining Attorney explained to Applicant.[9] If the sequence Applicant describes happens, then the relevant service mark use with the SAAS services would appear on Applicant's website when the user reaches that site for information on her/his account. But we have no specimen showing such use of the mark.

The original specimen was a forty-six-page document. The first nineteen pages show something like screenshots, but most of these are misaligned, raising questions about what is really shown. Examples appear below:



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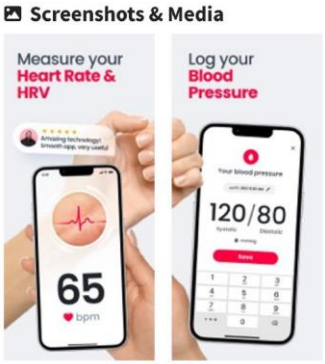
[8] Request for Reconsideration dated February 16, 2024, at 3-4.

[9] Office Action dated October 3, 2023, at 3.

[10] Specimen dated January 26, 2023 at 14.

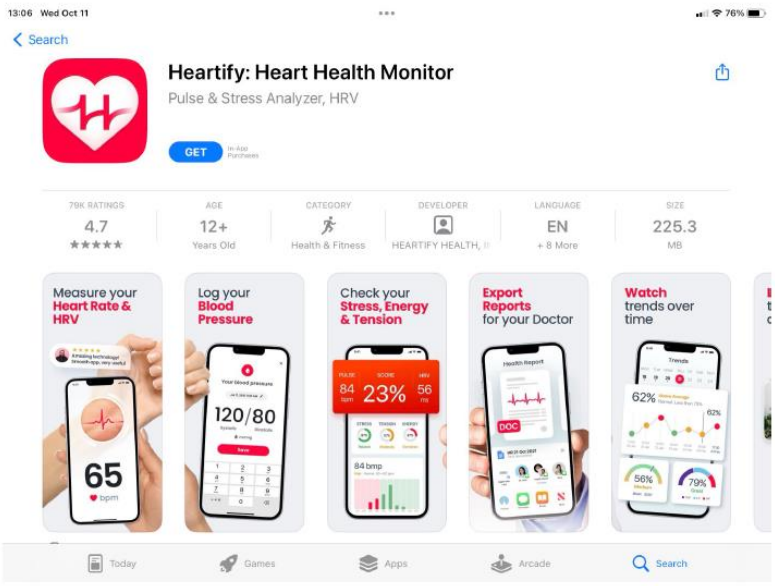
[11] *Id.* at 6. This partial image appears a number of times in the specimen. Applicant provided no explanation for these images.

There are also images in the original specimen apparently from the Apple app store that show what are identified as screenshots of the application in use. A sample is provided below, showing two such screenshots:



[12]

The original specimen did not show use of the mark with SAAS services. The first substitute specimen is a two-page document that shows more screenshots of a mobile phone application, as seen below:



[13]

[12] *Id.* at 21.

[13] Specimen dated October 12, 2023, at 1. The other page of this specimen appears to be identical to the one shown above.

The second substitute specimen, filed with Applicant's request for reconsideration, is a four-page document. This specimen shows images that resemble mobile phone screenshots, except there is no phone visible, only the content that apparently would be seen on a mobile phone, as the samples below show:

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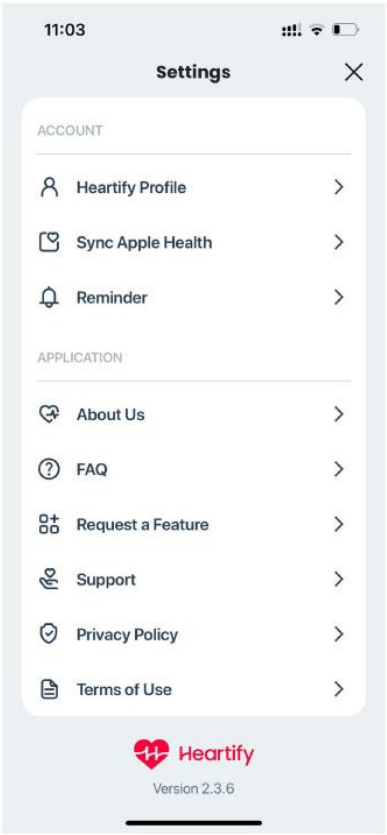

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It is not clear what the last specimen is, given the lack of a mobile phone in the images. Applicant asserted the "submitted specimens are mobile device screenshots showing the appearance of the screens of mobile devices running Applicant's mobile

[14] Specimen dated February 16, 2024, at 1.

[15] *Id.* at 2.

applications."[16] Even taking Applicant at its word, the specimens do not show any use of SAAS services. We have provided representative samples from each of the three specimens Applicant submitted. None show anything resembling SAAS services. Every specimen shows or provides information about Applicant's mobile phone application. We agree with the Examining Attorney that these specimens fail to show use of Applicant's mark in connection with the SAAS services in International Class 42. The specimen refusal was proper.

Decision: The Section 1 and 45 specimen refusal is **affirmed**.

[16] Request for Reconsideration dated February 16, 2024, at 3. These samples are from the specimen that Applicant argued showed an account tab that allegedly allows a user to access Applicant's Internet site where the SAAS services would be provided. *Id.* But there is no "account" tab in any of the images in this specimen. There is a "support" tab, as seen in the image on the right just above, and perhaps that tab would also direct a user to Applicant's Internet site. But even if this speculation is correct, the image of a mobile phone screen running a downloaded application does not constitute SAAS services, as we explained above. Indeed, we have reviewed all three specimens carefully and do not see any "account" tab in the specimens, yet another reason Applicant's arguments fail.