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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85914469

MARK: VALUE SHOPPER



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

**APPLICANT:** Graystone Consulting Associates, Inc.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

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## **EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant, Graystone Consulting Associates, Inc., has appealed the trademark examining attorney's refusal to accept the specimens on the bases that they do not show use of the mark in commerce in connection with the identified services and/or fail to function. Trademark Act §§1 and 45, 15 U.S.C. §§1051 and 1127; 37 C.F.R. §§2.34(a)(1)(iv) and 2.56; TMEP §§904 and 1301.04.]

## FACTS

On April 25, 2013, Graystone Consulting Associates, Inc. (hereafter “Applicant”) filed a use-based service mark application seeking registration on the Principal Register of the mark VALUE SHOPPER for “business training consultancy services” in International Class 041.

In an Office Action dated August 22, 2013, the examining attorney refused registration of the mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), because the mark merely described a feature of the identified services. The examining attorney also required that Applicant submit a substitute specimen that matched the applied-for mark and that showed the mark being used in connection with the identified services.

On February 21, 2014, Applicant responded by submitting that the mark at issue was not merely descriptive because it created a separate and distinct commercial impression. The applicant also submitted a substitute specimen, which addressed the matching issue.

The examining attorney then issued a Final Office Action on March 13, 2014, maintaining the mere descriptiveness refusal and requiring that applicant submit a new specimen showing trademark use of the mark in commerce with the applied-for services.

Applicant responded on July 9, 2014 with a Request for Reconsideration after Final Action, presenting arguments against the refusal under Trademark Act Section 2(e)(1) and submitting additional substitute specimens. A Denial of this Request for Reconsideration was issued on July 24, 2014. On August 29, 2014, applicant filed a second Request for Reconsideration, amending the application to the Supplemental Register and submitting another substitute specimen. On September 15, 2014, applicant filed a Notice of Appeal with the Trademark Trial and Appeal Board (hereafter “the Board”). Further to applicant’s November 14, 2014 request for remand, the second Request for Reconsideration was

forwarded to the examiner for consideration on November 19, 2014; a denial of this request was issued on December 2, 2014, noting that the mere descriptiveness had been rendered moot by the amendment to the Supplemental Register in applicant's August 29, 2014 Request for Reconsideration and maintaining the refusal based on the specimen.

On February 2, 2015, Applicant moved to consolidate numerous proceedings; on March 2, 2015, the Board granted its decision relative to same, in which the appeal relative to the present application was consolidated with those relative to U.S. Application Serial Nos. 85914457 and 85914478.

Applicant filed its appeal brief on April 1, 2015, which was then forwarded to the examining attorney for briefing on April 7, 2015.

#### **ISSUE**

The only issue on appeal is whether the specimens submitted are acceptable, specifically whether any of the specimens of record function as a service mark and/or show use of the mark in commerce in connection with the identified services. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

#### **ARGUMENT**

The specimens submitted by Applicant throughout the prosecution of the application do not show use of the mark in commerce in connection with "business training consultancy services" in International Class 041 and/or fail to function as a service mark.

I. THE SPECIMEN SUBMITTED ON APRIL 25, 2013 DOES NOT MATCH THE DRAWING AND DOES NOT SHOW USE OF THE MARK IN CONNECTION WITH THE IDENTIFIED SERVICES

The April 25, 2013 specimen of record is not acceptable, because it does not show use of the mark in connection with the identified services: “business training consultancy services” in International Class 041. Generally, a service mark specimen must show use of the mark “in the sale or advertising of services.” 15 U.S.C. §1127; 37 C.F.R. §2.56. However, “[a] specimen that shows the mark as used in the course of rendering or performing the services is generally acceptable” as well. TMEP§1301.04(b). Ultimately, “[w]hile the nature of the services does not need to be specified in the specimens, there must be something which creates in the mind of the purchaser an association between the mark and the service activity.” *In re Adair*, 45 USPQ2d 1211, 1215 (TTAB 1997) (quoting *In re Johnson Controls Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994)).

Applicant’s specimen submitted with the application on April 25, 2013 appears to be a worksheet for employees in dealing with potential shoppers who walk-in to Applicant’s business establishment. Applicant has labeled the specimen as a “Printed hand out on Value Shopper documentation” in the Application. The mark in this specimen differs from the drawing. The mark that appears on the specimen is VALUE SHOPPERS and differs from the applied-for drawing because there is an additional “S” at the end of the word SHOPPER. Thus, the mark shown on the specimen fails to match the applied-for mark in the Application.

The drawing shows the mark sought to be registered, and must be a substantially exact representation of the mark as used on or in connection with the services, as shown by the specimen. 37 C.F.R. §2.51(a); TMEP §807.12(a). Because the mark in the drawing is not a substantially exact representation of the mark on the specimen, Applicant has failed to provide the required evidence of use of the applied-for mark in commerce on or in connection with Applicant’s services. See TMEP §807.12(a). Applicant was given the option to submit a new drawing of the mark that agreed with the

mark on the specimen; subsequent specimens do show the wording VALUE SHOPPER, as depicted in the trademark drawing.

Furthermore as will be discussed in greater detail below, this specimen does not show the mark in connection with business training consultancy services. In particular, nothing in the specimen mentions training or consulting services. In fact, the nature of the services is unclear and cannot be determined based on this specimen. An Application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for the services identified in the Application. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a). As such, this specimen is unacceptable.

## II. THE SPECIMENS SUBMITTED FAIL TO FUNCTION AS A SERVICE MARK SHOWING USE WITH THE RELEVANT SERVICES

To show service mark usage, the specimens 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 (C.C.P.A. 1973) (term that identified only a process held not registrable as service mark, even though applicant was rendering services and the services were advertised in the same brochure in which the name of the process was used); *In re McDonald's Corp.*, 229 USPQ 555 (TTAB 1985) (APPLE PIE TREE did not function as mark for restaurant services, where the specimens showed use of mark only to identify one character in a procession of characters, and the proposed mark was no more prominent than anything else on specimens); *In re Signal Companies, Inc.*, 228 USPQ 956 (TTAB 1986) (journal advertisement submitted as specimen showed use of ONE OF THE SIGNAL COMPANIES merely as an informational slogan, where the words appeared only in small, subdued typeface underneath the address and telephone number of

applicant's subsidiary); *Intermed Communications, Inc. v. Chaney*, 197 USPQ 501 (TTAB 1977) (business progress reports directed to potential investors do not show service mark use for medical services).

In this case, none of the specimens submitted function as a service mark for the listed training consulting services. As noted above, applicant's April 25, 2013 specimen does not show the mark in a source identifying manner but shows the mark as indicating the subject matter of the topic of the worksheet.

The substitute specimen submitted with Applicant's February 21, 2014 Response to Office Action, and identified as "screenshot of website", appears to be a list of talking points from a presentation in the field of consumer research. The sole reference to the mark here is the line in the middle of the page stating, "May be most "price sensitive" (Value Shopper)." Once again, the specimen contains no reference to consulting services, and creates no clear association between the wording VALUE SHOPPER and the applied-for business training consultancy services. At best, the "Value Shopper" is a type of shopper discussed in passing at a presentation.

The substitute specimens submitted with the July 9, 2014 Request for Reconsideration, identified as "training materials", only uses the VALUE SHOPPER mark in a list of three types of shoppers. This specimen once again indicates that the "Value Shopper" is merely the topic of discussion within a larger program. This specimen makes no reference to business training consultancy services at all. Even more importantly, there is no indication that such services are being rendered under the applied-for mark.

The same is true of the final specimen provided by applicant in its August 29, 2014 Request for Reconsideration, identified as "Flyer displaying services and tm". This specimen merely describes a type of consumer labeled as a "Value Shopper", discussed in the rendering of business consultancy training services rendered under the GRAYSTONE ASSOCIATES, INC. trademark.

In sum, while the mark appears on the substitute specimens, it is clear from the text of the specimens that the mark is a topic of applicant's consulting and training services and is not being used as a source indicator for the applied-for services. As used in these specimens, the mark does not identify the consulting services or their source. The relevant public would only likely view the mark as referring to the category of discussion at applicant's consulting services, not as the source of the consulting services.

In *In re Osmotica Holdings Corp.*, the Trademark Trial and Appeal Board addressed the similar issue of whether a mark, which identified drug delivery technologies, functioned as a service mark to identify applicant's consulting services. 95 USPQ2d 1666. In concluding that the evidence only showed "use of the mark as the name of a process," the Board stated:

In order to show service mark use, the specimen must show use of the mark in a manner that would be perceived by the relevant public as identifying the specified services and indicating their source. See Section 45 of the Act; and *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (CCPA 1973). See also *In re DSM Pharmaceuticals Inc.*, 87 USPQ2d 1623 (TTAB 2008) and cases cited therein. At a minimum, the specimen must show a direct association between the services and the mark sought to be registered. See *In re Advertising & Marketing Development*, 821 F.2d 614, 2 USPQ2d 2010, 2014 (Fed. Cir. 1987).

It is not enough that the mark and a reference to the services both appear in the same specimen. In order to create the required "direct association," the specimen must not only contain a reference to the service, but also the mark must be used on the specimen to identify the service and its source. See *In re Aerospace Optics Inc.*, 78 USPQ2d, 1861, 1862 (TTAB 2006).

Id. at 1668. As in the *Osmotica Holdings Corp.* case, Applicant's specimens fails to show the minimum required "direct association" between the services and the mark sought to be registered. As stated above, the mark must be used to identify consulting services and its source. Thus, the mere reference to the services appearing on the specimen with the mark is insufficient, without a direct association

between the two, to identify the source of the services. In this case, the mark is used only to indicate a topic discussed in the rendering of consulting services.

Finally, while not precedential, the Board has recently affirmed a similar refusal for one of applicant's other marks, WALK-IN SHOPPER, for use with identical services. *In re Graystone Consulting Associates, Inc.*, Serial No. 85913509 (May 12, 2015). In that case, the Board agreed with the examining attorney that the specimens of record did not show the required connection between the mark and the applied-for services, and that the wording associated with the mark on the specimen made it clear that the applied-for mark is not being used to indicate the source of the identified services.

In conclusion, the VALUE SHOPPER mark, as shown in the specimens of record, fails to function as a service mark for the identified services because they provide no indication that applicant is providing business training consulting services under the mark.

#### **CONCLUSION**

For the foregoing reasons, the refusal to register the mark on the basis of Trademark Act Sections 1 and 45, 15 U.S.C. §§1051 and 1127, on the ground that the applicant has failed to submit an acceptable specimen should be affirmed.

Respectfully submitted,

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