

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

Mailed: September 9, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Graystone Consulting Associates, Inc.
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Serial Nos. 85914457, 85914469, and 85914478
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Matthew H. Swyers of The Trademark Company PLLC,
for Graystone Consulting Associates, Inc.

Laura Golden, Trademark Examining Attorney, Law Office 103,
Michael Hamilton, Managing Attorney.

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Before Seeherman, Wolfson and Masiello,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

This is a consolidated appeal involving three applications filed by Graystone Consulting Associates, Inc. (“Applicant”) on April 25, 2013 for the standard character marks QUALITY SHOPPER,¹ VALUE SHOPPER,² and PRICE SENSITIVE SHOPPER.³ The services in each application are identified as “business training consultancy services.” The applications originally sought

¹ Serial No. 85914457. Applicant has disclaimed exclusive rights to the term “Shopper.”

² Serial No. 85914469.

³ Serial No. 85914478.

registration on the Principal Register, and were based on Section 1(a) of the Trademark Act, each claiming first use and first use in commerce on February 1, 2010. The application for the mark VALUE SHOPPER was amended to the Supplemental Register on August 29, 2014, and the application for the mark PRICE SENSITIVE SHOPPER was amended to the Supplemental Register on August 28, 2014.

In all three cases, registration has been refused under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051 and 1127, and Trademark Rules 2.34(a)(1)(iv) and 2.56(a), on the ground that none of the specimens filed therein shows use of the involved mark in association with the recited services.

Background

A. QUALITY SHOPPER (Serial No. 85914457)

Applicant submitted five different specimens in this case: one with the initial application; another with its February 21, 2014 response to the first Office Action; and two more with requests for reconsideration (filed July 9, 2104 and August 29, 2014).⁴ The appeal was filed on September 15, 2014, while the August 29, 2014 request for reconsideration was still pending, and on November 14, 2014 (the date its appeal brief was due), Applicant filed a request for remand together with the fifth specimen filed herein.⁵ On November 19, 2014, the Board granted Applicant's

⁴ The two requests for reconsideration were filed prior to appeal and within 6 months of the date of the final Office Action.

⁵ Applicant filed the notice of appeal through the Board's ESTTA electronic system. In doing so, Applicant should have checked the box stating that a request for reconsideration had been filed, but Applicant did not. See TBMP § 1205.01 ("If filing the notice of appeal through the Board's ESTTA electronic system, the applicant should check the box

request for remand, suspended action on the appeal and returned jurisdiction to the Examining Attorney to consider the additional specimen. On December 2, 2014, the Examining Attorney determined that neither specimen shows proper use of the mark, denied Applicant's second request for reconsideration and returned the file to the Board. The appeal was resumed.

B. VALUE SHOPPER (Serial No. 85914469)

In this case, registration was refused pursuant to Section 2(e)(1) on the ground of mere descriptiveness, as well as pursuant to Sections 1 and 45 (and Rules 2.34(a)(1)(iv) and 2.56(a)) because the specimen failed to show proper use of the mark. Applicant also filed five specimens during the course of the prosecution of this application, some of them identical to those filed in the other cases.⁶ Applicant also argued against the descriptiveness refusal, but in its second request for reconsideration (filed August 29, 2014), Applicant amended the application to seek registration on the Supplemental Register. Applicant then, while its request for reconsideration was still pending, filed an appeal on September 15, 2014, and on

indicating that it has filed a request for reconsideration.") The Board's order of the same date, acknowledging receipt of the notice of appeal, advised Applicant that the Board should be contacted if there were a pending request for reconsideration, but Applicant did not do so. Had Applicant done so, or had Applicant checked the appropriate box in ESTTA, the Board would have acknowledged receipt of the appeal and of the request, instituted the appeal, suspended further proceedings with respect to the appeal (including Applicant's time for filing its appeal brief), and remanded the application to the Examining Attorney for consideration of the request. *Id.*; see also TBMP § 1204. Applicant's failure to follow proper procedure has caused additional and needless work for the Office.

⁶ Applicant filed one specimen with its initial application; a second with its February 21, 2014 response to the first Office Action; and two more with its requests for reconsideration, on July 9, 2014 and August 29, 2014; the fifth was filed with its November 14, 2014 request for remand.

November 14, 2014 filed a request for remand so that the Examining Attorney could consider the fifth specimen.⁷

On December 2, 2014, the Examining Attorney accepted Applicant's amendment to the Supplemental Register, noting that "applicant's August 29, 2014 Request for Reconsideration requested amendment to the Supplemental Register and thereby rendered moot the refusal under Trademark Act Section 2(e)(1)." The Examining Attorney also determined that the newly submitted specimen did not show use of the mark in association with the services and denied Applicant's second request for reconsideration.

C. PRICE SENSITIVE SHOPPER (Serial No. 85914478)

Registration in this case, as in VALUE SHOPPER, was initially refused pursuant to Section 2(e)(1) on the ground of mere descriptiveness, as well as on the basis that the specimen did not show the applied-for mark in use in commerce as a mark for the identified services.

Likewise, Applicant filed two requests for reconsideration seeking reversal of the refusals and submitting substitute specimens. On July 24, 2014, the Examining Attorney denied Applicant's first request for reconsideration, maintaining the descriptiveness refusal and the requirement for a proper specimen. In the second request for reconsideration (filed August 28, 2014), Applicant submitted another specimen and also amended the application to the Supplemental Register. As in the other applications, while the request for reconsideration was pending, Applicant

⁷ Again, Applicant failed to follow proper procedures by not notifying the Board that its second request for reconsideration was pending at the time it filed its appeal.

filed the appeal in this case on September 15, 2014.⁸ On November 14, 2014, Applicant filed a request for remand. On November 20, 2014 the Board remanded the application to the Examining Attorney who, on December 2, 2014, accepted the amendment to the Supplemental Register, which rendered moot the descriptiveness refusal. The Examining Attorney denied the request for reconsideration with respect to the requirement for a proper specimen. She then returned the file to the Board to resume the appeal.

On February 2, 2015, Applicant filed a motion to consolidate eight appeals of its various marks. On March 2, 2015, the Board granted the motion in part, as a result of which the appeals in the above-captioned applications were consolidated, and Applicant and the Examining Attorney filed their briefs.

Applicant's Pending Requests for Remand

Briefing in the consolidated appeals was completed on June 30, 2015. On August 18, 2015, Applicant filed requests for remand of both the VALUE SHOPPER and PRICE SENSITIVE SHOPPER applications, which we now decide. Applicant seeks to have these applications returned to the Examining Attorney so that Applicant can amend the filing basis in each application from Section 1(a) to Section 1(b) (intent-to-use) in order to obviate the requirement for acceptable specimens. The requests for remand are denied as no good cause therefor has been shown.⁹

⁸ Again, Applicant did not follow proper procedure and failed to notify the Board of its pending request for reconsideration at the time it filed the appeal.

⁹ We also note that Applicant has not actually submitted the proposed amendments with its requests for remand, but merely seeks permission to submit an amendment after the application is remanded. A request for remand should be accompanied by the proposed amendment that the applicant wishes to have the Examining Attorney consider. *Cf.* TBMP

A request for remand must include a showing of good cause. TBMP § 1209.04. In determining whether good cause has been shown, the Board will consider both the reason given and the point in the appeal at which the request for remand is made. *Id.* As noted, the requests for remand were filed several months after briefing had been completed. Thus, the reason for granting remand at this stage of the appeal must be strong indeed.

Here, the requests would serve no purpose because the applications are on the Supplemental Register. The Section 1(b) basis, intent-to-use, pertains to applications for registration on the Principal Register. Applications for registration on the Supplemental Register must be based on use of the mark in commerce. Trademark Act Section 23(a); 15 U.S.C. § 1091(a). Therefore, Applicant cannot amend the filing basis of these Supplemental Register applications to Section 1(b).¹⁰

Accordingly, we find that Applicant has not shown good cause for its August 18, 2015 requests for remand, and we hereby deny the requests.

Whether Applicant's Specimens Show Use of Applicant's Marks in Association with the Recited Services

We now turn to the issue that is the subject of this consolidated appeal, i.e., whether the specimens submitted by Applicant show use of its applied-for marks for its identified services.

§ 1207.02 (request for remand to introduce evidence must be accompanied by the additional evidence sought to be introduced).

¹⁰ We also point out that Applicant would not be able to amend the applications back to the Principal Register in order to assert a Section 1(b) basis. It was because Applicant amended its applications to the Supplemental Register that the Section 2(e)(1) refusals on the ground of mere descriptiveness were deemed moot. Amending the applications back to the Principal Register would result in a reinstatement of the refusals under Section 2(e)(1).

A service mark is “any word, name, symbol, or device, or any combination thereof ... [used] to identify and distinguish the services of one person ... from the services of others and to indicate the source of the services, even if that source is unknown.” Trademark Act Section 45, 15 U.S.C. § 1127. A service mark must be “used in such a manner that it would be readily perceived as identifying” the services, which is “determined by examining the specimens of record in the application.” *In re Graystone Consulting Assocs.*, Serial No. 85913509, ___ USPQ2d ___ (TTAB May 12, 2015) (citing *In re Moody’s Investors Service Inc.*, 13 USPQ2d 2043, 2047 (TTAB 1989)); see also *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, 1458 (TTAB 1998) (a mark “must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin” for the services, but mere intent that it function as a mark is not sufficient); *In re Duratech Industries Inc.*, 13 USPQ2d 2052 (TTAB 1989). “At a minimum, the specimen must show a direct association between the services and the mark sought to be registered.” *In re Osmotica Holdings Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010). “A specimen that shows only the mark with no reference to, or association with, the services does not show service mark usage.” *In re DSM Pharmaceuticals, Inc.*, 87 USPQ2d 1623, 1624 (TTAB 2008).

We now consider the various specimens of use, starting with the original specimen included with each of the three consolidated applications. The same specimen, shown below, was submitted in each case.

Shoppers & Recommenders

Understanding the Value Shopper

Quality Shoppers

Value Shoppers –

Price Sensitive Shoppers –

Advocates –

Appliances –

Assassins –

Silent Assassins

As can be seen, this specimen does not show the marks as they appear on the drawings. Specifically, the drawings of the marks depict the second term in each mark as SHOPPER (singular) whereas in the specimen, the word is shown in the plural form. Accordingly, the initial specimen filed with the applications (as noted, it is the same in each case) does not exhibit the applied-for marks and is unacceptable for this reason. The specimen is further unacceptable because it does not identify any services, let alone the consultancy services recited in the applications.

The second specimen differs in each application. For the QUALITY SHOPPER mark, the specimen that was submitted with Applicant's response to the first Office Action was virtually the same specimen as shown above, with the only differences being that the mark matched the drawing (i.e., the word "Shopper" was depicted in singular form) and a TM symbol was inserted following "Shopper."¹¹



There is still no indication of the services being provided under the mark, such that an association could be made between the mark and "business training consultancy services." This specimen is also unacceptable.

The second specimen submitted in the VALUE SHOPPER application displays the purported mark in the following manner.

¹¹ The yellow shading highlighting "Quality Shopper" in this specimen, and the blue shading highlighting "Value Shopper" in the next specimen, appear in the specimens as submitted. Applicant has provided no explanation as to whether this highlighting was somehow added by Applicant in connection with its transmission thereof to the Office or whether the actual specimens include such highlighting.

Consumer Research

➤ **“3rd Party Providers”**

3rd party providers who replace funeral director & funeral home functions.

» *Hospice*

» *Church*

» *Community organizations*

May be most “price sensitive” (Value Shopper)

Often price-motivated alternative to funeral home services.

Recap -

When you shift from defining cremation families based on service mix and consider them within market segments,

there are 5 different identifiable markets of cremation families -

- Traditionalists

- Memorialists

- Minimalists -

• Cremation Only

• 3rd Party Provider

We agree with the Examining Attorney that this use of the term “Value Shopper” does not show a direct association between the mark and the services for which registration is sought. Instead, Applicant uses the term here to describe an entity that is sensitive to the price or cost of funeral home services. Applicant calls such entity a “value shopper.” There is no association created between the mark and Applicant’s identified services. The specimen is unacceptable.

The next specimen we consider was submitted in all three applications. It is the second submitted specimen in the PRICE SENSITIVE SHOPPER application, and it is the specimen submitted with Applicant’s first request for reconsideration in the other two applications. As shown below, the marks are listed under the text, “There are three types of shoppers,” and they are followed by a TM symbol:

Graystone Associates

Value Shoppers

In order to understand how you can provide your customer with the best level of service, it is very helpful to understand the type of *SHOPPER* they are. Knowing this, you can determine the offerings of services and products that you offer that best fit their needs.

By understanding the differences between these shopper types, you are able to present your business offerings in a *customized and favorable position* compared to your competitors.

There are three types of shoppers:

- **Quality Shopper™**
- **Value Shopper™**
- **Price Sensitive Shopper™**

Master the knowledge of these three segments of shoppers and place yourself in a position to capture this business.



Despite Applicant's use of the ™ symbol, we agree with the Examining Attorney that this specimen only uses the terms QUALITY SHOPPER, VALUE SHOPPER, and PRICE SENSITIVE SHOPPER to refer to three types, or "segments," of shoppers who make up Applicant's clients' customer base. Although the specimen tells Applicant's clients how to provide good customer service, the manner in which these terms are used is as a description of the customer him or herself, rather than as identifying the source of origin of Applicant's business training consultancy services. Indeed, there is nothing in the specimen that associates Applicant's recited services with the applied-for marks or indicates that such services are being rendered under the marks.

The next set of specimens submitted by Applicant are similar in overall look, although the text varies somewhat between the specimen for PRICE SENSITIVE SHOPPER and the specimen submitted in connection with the other two marks.

Applicant's specimen, submitted on August 28, 2014, for PRICE SENSITIVE SHOPPER is shown below:



Graystone Associates Presents

Graystone Associates offers business strategies and tools for your firm to become a premier Funeral Service Provider through training and consulting.

Price-Sensitive Shopper™

With Graystone's training, funeral professionals learn what type of shopper they are encountering. The **Price-Sensitive Shopper™** values the price paid over the value or quality of services provided. Using the Graystone concepts, paraphrasing and listening skills, funeral professionals can pin-point this type of shopper and direct responses to their needs.

Here, the specimen discusses "business strategies and tools" offered by Graystone Associates, and therefore at least refers to the "business training consultancy services" recited in the application. However, in order to create a "direct association" between the applied-for mark and the services, "[i]t is not enough that the mark and a reference to the services both appear in the same specimen." *In re Osmotica Holdings Corp.*, 95 USPQ2d at 1668 (citing *In re Aerospace Optics Inc.*, 78 USPQ2d 1861, 1862 (TTAB 2006)). The specimen must not only contain a reference to the services somewhere in the specimen, but the mark must be used in such a manner that it would be understood as the source of the service.

The designation "Price Sensitive Shopper" would not be viewed as a source indicator for business training consultancy services. Instead, as used in the specimen, the wording refers only to "a type of shopper" labeled as a "Price

Sensitive Shopper.” We agree with the Examining Attorney that as used in the specimen the term is not being used as a source indicator for the recited services.

On August 29, 2014, Applicant submitted the following specimen for the marks VALUE SHOPPER and QUALITY SHOPPER:



Graystone Associates Presents

Graystone Associates offers business strategies and tools for your firm to become a premier Funeral Service Provider through training and consulting.

Shoppers – Price-Sensitive, Quality and Value

With Graystone's training, funeral professionals learn what type of shopper they are encountering. The **Price-Sensitive Shopper™** values the price paid over the value or quality of services provided. The **Value Shopper™** shops services based on the overall value provided for services rendered. The **Quality Shopper™** seeks quality services no matter the cost to receive such services. Using the Graystone concepts, paraphrasing and listening skills, funeral professionals can pin-point the type of shopper encountered and direct responses to either price, value or quality.

832-864-2833 or graystoneassociates.com

The first half of this specimen is the same as the one for PRICE SENSITIVE SHOPPER and, as with that specimen, it discusses “business strategies and tools” offered by Graystone Associates. However, the marks at issue, VALUE SHOPPER and QUALITY SHOPPER, do not identify Applicant as the provider of such services. Instead, as used in the specimen, the wording refers only to “a type of

shopper” labeled as a “Value Shopper or “Quality Shopper.” We agree with the Examining Attorney that as used in the specimen neither term is being used as a source indicator for business training consultancy services. The specimen is unacceptable.

The last set of specimens were submitted by Applicant with its November 14, 2014 requests for remand, and are shown below.

I. QUALITY SHOPPER:



Graystone Associates Presents

Graystone Associates offers business strategies and tools for your firm to become a premier Funeral Service Provider through training and consulting.

Quality Shopper™

With Graystone's training, funeral professionals learn what type of shopper they are encountering. The Quality Shopper™ values the quality of services provided over price. This type of shopper may be long-term due to the service received for years. Using the Graystone concepts, paraphrasing and listening skills, funeral professionals can pin-point this type of shopper and direct responses to their needs.

II. VALUE SHOPPER:



Graystone Associates Presents

Graystone Associates offers business strategies and tools for your firm to become a premier Funeral Service Provider through training and consulting.

Value Shopper™

With Graystone's training, funeral professionals learn what type of shopper they are encountering. The Value Shopper™ wants the best value for the price paid. This type of shopper may be long-term due to the service received for years. Using the Graystone concepts, paraphrasing and listening skills, funeral professionals can pin-point this type of shopper and direct responses to their needs.

III. PRICE SENSITIVE SHOPPER:



Graystone Associates Presents

Graystone Associates offers business strategies and tools for your firm to become a premier Funeral Service Provider through training and consulting.

Price Sensitive Shopper™

With Graystone's training, funeral professionals learn what type of shopper they are encountering. The Price Sensitive Shopper™ values the price paid over the value or quality of services provided. Using the Graystone concepts, paraphrasing and listening skills, funeral professionals can pin-point this type of shopper and direct responses to their needs.

These specimens suffer from the same infirmities as the previous specimens; Applicant is using the terms "QUALITY SHOPPER," "VALUE SHOPPER," and

“PRICE SENSITIVE SHOPPER” to describe the type of shoppers Applicant’s clients will encounter, namely, one who “values the quality of services provided over price,” one who “wants the best value for the price paid,” or one who values “the price paid over the value or quality of services provided.” Because of this usage, there is no direct association between the applied-for marks and Applicant’s identified business training consultancy services. Potential consumers will not view the marks as indicating the source of the identified services, but merely as labels for different categories of potential customers. The Examining Attorney is correct that the specimens merely show the terms being used in the discussion of the topic of “shopper types,” and not as marks for business training consultancy services. The specimens are unacceptable.

We are not persuaded by Applicant’s argument that the marks are “each components of the training method the Applicant sells to interested individuals.”

When an interested individual purchases services from the Applicant, the individual is also purchasing training in the skill of identifying how best to relate to various types of customers. Training in this skill, the identification of a customer’s needs, and the companion skill of responding appropriately, is a key component of the service offered by the Applicant. As such, there is a direct link between the terms appearing in the advertisement and the services advertised, making the specimens sufficient for the purpose of demonstrating the use of the mark in commerce.¹²

¹² 11 TTABVue 11.

Applicant's statement that it provides training in the "skill of identifying how best to relate to various types of customers," and that this skill is just one of several "key component[s] of the service" offered under the marks, does not support a conclusion that the marks identify the source of such training service. Although the specimens indicate that Applicant provides training in the "skill of identifying how best to relate to various types of customers," they do not show that the terms "Value Shopper," "Quality Shopper," and "Price Sensitive Shopper" are marks that identify the source of the business training consultancy services, as opposed to merely labels given to distinguish among categories of customers. Accordingly, the specimens do not show the requisite direct association between the designations and Applicant's "business training consultancy services."

Decision: The refusals to register Applicant's marks "QUALITY SHOPPER," "VALUE SHOPPER," and "PRICE SENSITIVE SHOPPER" because the specimens do not show use of the applied-for marks in connection with the services specified in the applications are affirmed.