

This Opinion Is Not
a Precedent of
the TTAB

Mailed: June 10, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re On the way LLC

Serial No. 87037256


Lisa R. Hemphill of Foley & Lardner LLP,
for On the way LLC.

Martha L. Fromm, Trademark Examining Attorney,
Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Zervas, Wellington and Heasley, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On the way LLC (“Applicant”) seeks registration on the Principal Register of the

mark  for “advertising, marketing and promotional services” in International Class 35.¹ The mark is described as consisting of the letter “S” formed by two incomplete rectangles.

¹ Application Serial No. 87037256 was filed on May 14, 2016 based on Applicant’s allegation 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); subsequently Applicant filed a Statement of Use along with two specimens of use, alleging March 21, 2017 as the date of first use and first use in commerce of the mark.

The Examining Attorney issued a final Office Action finding Applicant's specimens of use unacceptable under Trademark Act §§ 1 and 45, 15 U.S.C. §§ 1051 and 1127, and Trademark Rules 2.34(a)(1)(iv) and 2.56(a), 37 C.F.R. §§ 2.34(a)(1)(iv) and 2.56(a), because they do not show the applied-for mark in use in commerce in connection with the services specified in the application. Applicant filed a notice of appeal with the Board and a request for reconsideration. The Examining Attorney was not persuaded by Applicant's arguments and continued the refusal. When the appeal resumed, Applicant and the Examining Attorney filed briefs. We affirm the refusal to register.

The sole issue in this appeal is whether the specimens submitted by Applicant with its Specimen of Use are acceptable specimens to show use of the mark in connection with the identified services.

I. Applicable Law

Section 1(d)(1) of the Trademark Act, 15 U.S.C. § 1051(d)(1), requires, *inter alia*, that an applicant, filing a trademark application under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), file specimens of a mark as used in commerce. Registration of the mark is subject to examination and acceptance of the specimens. *Id.* According to Section 45 of the Trademark Act, 15 U.S.C. § 1127, 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.” *See also* Trademark Rule 2.56(b)(2), 37 C.F.R. § 2.56(b)(2). “To determine whether a mark is used in connection with the services described in the [application], a key consideration is the perception of the user.” *In re JobDiva, Inc.*, 843 F.3d 936, 121 USPQ2d 1122, 1126 (Fed. Cir. 2016).

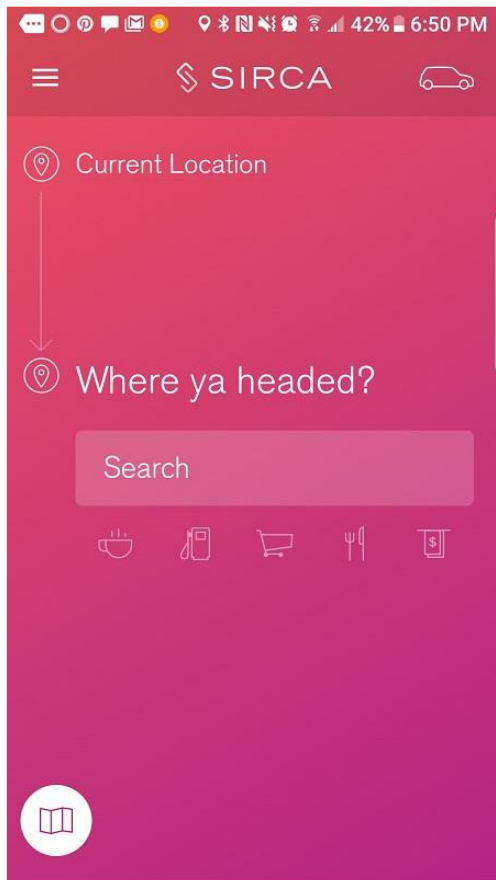
An acceptable specimen must show “some direct association between the offer of services and the mark sought to be registered therefor.” *In re Universal Oil Prods. Co.*, 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973). “Specimens showing the mark used in rendering the identified services need not explicitly refer to those services in order 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.’” *In re Way Media*, 118 USPQ2d 1697, 1698 (TTAB 2016) (quoting *In re Johnson Controls, Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994)); *accord JobDiva*, 121 USPQ2d at 1126 (“the question is whether the evidence of JobDiva’s use of its marks sufficiently creates in the minds of purchasers an association between the marks and JobDiva’s ... services”) (internal quotation marks, brackets, and citation omitted). Showing only the mark with no reference to, or association with, the services does not show service mark usage. *In re Adair*, 45 USPQ2d 1211, 1214-15 (TTAB 1997); *In re Duratech Indus. Inc.*, 13 USPQ2d 2052, 2054 (TTAB 1989). Thus, a specimen is unacceptable if it fails to convey a proper nexus between the mark and the services, or if the services are too attenuated from the proposed mark, either in terms of proximity or logical connection. *See, e.g., In re Metriplex, Inc.*, 23 USPQ2d 1315, 1316 (TTAB 1992); *In re Monograms Am., Inc.*, 51 USPQ2d 1317, 1319 (TTAB 1999).

An applicant may explain the nature of the mark’s use or the way the services are advertised or rendered. *See In re Metriplex, Inc.*, 23 USPQ2d at 1316 (finding the submitted specimens acceptable based, in part, on applicant’s explanation that the

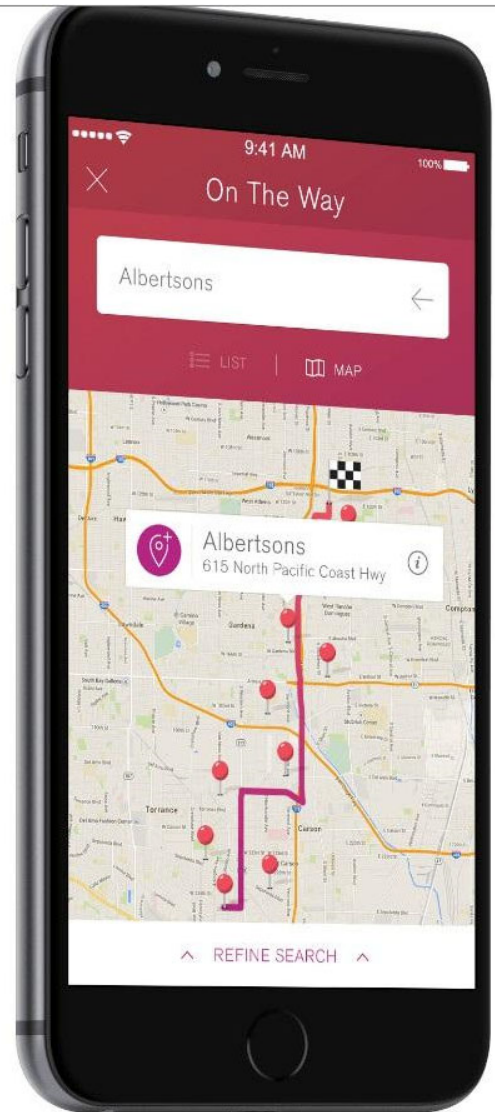
specimens showed the mark as it appeared on a computer terminal in the course of rendering the services). The TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1301.04(f)(ii) (Oct. 2018) allows that “[d]irect association may be indicated by the context or environment in which the services are rendered, or may be inferred based on the consumer’s general knowledge of how certain services are provided or from the consumer’s prior experience in receiving the services” (citing *In re Metriplex, Inc.*, 23 USPQ2d at 1316; *In re WAY Media, Inc.*, 118 USPQ2d at 1698)). TMEP § 1301.04(f)(ii) mentions that “it may ... be helpful for the applicant to provide an explanation regarding industry practice concerning the use of the mark during the rendering of such services and how the applicant’s use comports with such practice.”

II. Analysis

Applicant’s specimens filed with its Statement of Use, which Applicant identified as “screenshots of app advertising/marketing third party business,” are duplicated below:



and



The mark appears on the specimen on the left (“first screen”) but does not appear in the specimen on the right (“second screen”). Additionally, the services are not mentioned or referred to in either of the screenshots, and Applicant does not contend that they are. Rather, Applicant explains that the advertising appears as the user uses the app:

Applicant is providing a platform to promote the goods and services of others via computer and communications networks. In other words, Applicant is providing a means for advertising other

companies or organizations via Applicant's app for navigational services. Specifically, when users view Applicant's app and enter a destination address, Applicant's app has the ability to display the locations of the goods and services of others along the way, thereby promoting the goods and services of other companies to the users. For example, once a destination address is entered into the app, the user can request the app show the locations of grocery stores on the way to their destination, thereby actually promoting and advertising the grocery store.²

Applicant clarifies, "once a destination address is entered into the program, the user can say, for example, find a florist, or a grocery store, and the app will pull up the appropriate goods or services, thereby actually promoting and advertising the goods and services of other companies."³ We note too that icons appear on the first screen presumably representing links to coffee shops, gas stations, grocery stores, restaurants and banks on the way. Ostensibly, users may tap the icons on the first screen to learn where relevant goods and services can be found along the way, after entering a destination address. However, there is no indication from the first screen whether coffee shops, gas stations, grocery stores, restaurants and banks located by the app are actually advertised on the app or whether they appear simply as informational as determined by Applicant's algorithms as part of its navigational service. Although the mark is displayed at the top of the first screen, Applicant's services are not identified or referred to on that screen. The first screen by itself does

² Applicant's brief at pp. 4-5, 13 TTABVue 7-8.

³ June 4, 2018 Resp. to Office Action, TSDR 1.

not create a direct association of Applicant's mark with Applicant's identified services.

We consider then the second screen in conjunction with the first screen. A route is displayed on the second screen, as well as red dots, which presumably identify the goods or services of interest to the user along his or her chosen route. It is not clear whether the red dots represent customers of Applicant who have chosen to take advantage of Applicant's alleged advertising and promotional services, or appear there informationally for the user.

The second screen also contains a box with the term "Albertsons" next to an arrow, without any indication what Albertsons is or how Albertsons was placed in the box or what the arrow signifies. Because Applicant characterizes Albertsons as a grocery store – which is not apparent from the provided screenshots alone - it appears that the bubble with "Albertsons" along with its street address is the advertising Applicant alleges it provides.⁴ Applicant has not indicated when the Albertsons bubble appears on the screen, e.g., directly after the user has indicated that he or she would like to see grocery stores along the route, or as a pop-up when the user drives near Albertsons.

Applicant argues that the user would recognize its alleged service from the second screen:

This form of advertising [is] common in today's world. For example, while consumers commonly use internet search engines to find websites containing

⁴ The bubble includes a marker in the same coloring and shape as the marker displayed next to "Current Location" and "Where ya headed?" on the first screen, suggesting that it is intended to signal a specific location.

specific words, the search engine will also return advertisements selected by an algorithm based on the search terms. Users recognize these forms of advertisement and promotion and know that companies generally pay for this kind of advertisement. The same is true in navigation service apps. Users of navigation apps may search for generic terms, such as “restaurants,” and the app will return location-based results that may include businesses that are paying to be promoted. Therefore, when a user sees an ad or location called out in a navigation app, they understand that the app is providing a promotional or marketing service and advertising for another company. Certainly, potential purchasers interested in procuring these kinds of advertising services for themselves will understand that at least some of the information displayed on the app is paid promotion or advertising. With online sales and business extensively being conducted through mobile apps today, promotion and advertising on an app is a form of promotion for another party, which is at the core of advertising, i.e., the activity of producing advertisements for products or services. The specimen submitted shows this advertising service being rendered with Applicant’s mark used in connection with rendering that service. The Mark is associated with the advertising service both directly (showing the mark on the first screen of the app) and contextually (showing the advertisements on the app’s subsequent screens).⁵

Applicant adds that “it’s no different than a ‘pop[-]up’ ad or a banner running across a website.”⁶

We are not persuaded by Applicant’s arguments that its specimens demonstrate use of its mark in commerce. First, Applicant’s display only shows a name and an

⁵ Applicant’s brief at p. 5, 13 TTABVue 8.

⁶ June 4, 2018 Resp. to Office Action, TSDR 1.

address, which appears in the context of a navigational app. If a consumer requests information about grocery stores, and only the name of the grocery store and its address appears, it follows that the name and address appeared because of the request and not because the merchant had advertised through the app. On Applicant's app, the alleged Albertsons advertisement appears after the user has instructed the app to produce information – probably a name and an address - about a particular category of goods or services.

Second, Applicant's claim that "when a user sees an ad or location called out in a navigation app, they understand that the app is providing a promotional or marketing service and advertising for another company," is speculative and without evidentiary support.⁷ In addition, Applicant does not maintain that online advertisements only include the business name and address, and it appears unlikely that online advertisements contain such limited information, with no indication of the services or goods offered by the business.

Third, Applicant states, "potential purchasers interested in procuring these kinds of advertising services for themselves will understand that at least some of the

⁷ There is no sworn testimony in the record. *See In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002 (TTAB 2013) (disregarding outside counsel's conclusory unverified statements made without proper foundation regarding marketing of goods stating, "[p]utting aside whether a declaration from outside counsel could ever qualify as acceptable proof of these sort of facts, we have here no foundational information about counsel's investigation of, or understanding of, applicant's business, that would put him in a position to make statements regarding the marketing of the products at issue, which in this case is essential to our analysis of the registrability of the mark.").

information displayed on the app is paid promotion or advertising.”⁸ Applicant has not explained how businesses, as potential **consumers** of Applicant’s services, would view Applicant’s mark, as it is shown in the first screen, and associate this mark with Applicant’s identified services. Applicant largely discusses the perceptions of **users** of the app rather than the potential consumers of Applicant’s services.

In view of the foregoing, we agree with the Examining Attorney that the reference to Albertsons in the specimen appears to be informational, rather than an advertisement. Nothing “creates in the mind of the purchaser a direct association between the mark and the service activity.” *In re WAY Media*, 118 USPQ2d at 1698 (quoting *In re Johnson Controls*, 33 USPQ2d at 1320). The specimens do not demonstrate use of the applied-for mark for the identified services.

Decision: The refusal to register Applicant’s mark is affirmed.

⁸ By referring to some, but not all, of the information displayed on the app as paid promotion or advertising, Applicant allows that certain information is not paid promotion or advertising, but does not explain how a consumer would distinguish the two.