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TTAB

Mailed:
May 12, 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 No. 85913509

Matthew H. Swyers of The Trademark Company, PLLC for Graystone Consulting Associates, Inc.

W. Wendy Jun, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Zervas, Gorowitz and Hightower, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Graystone Consulting Associates, Inc. (“Applicant”) seeks registration on the Supplemental Register of the mark **Walk-In Shopper** (in standard character form) for “business training consultancy services” International Class 41.¹

The Examining Attorney issued a final Office Action in which, in relevant part, she found the original specimen filed with the application unacceptable under

¹ Application Serial No. 85913509 was filed on April 24, 2013, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), and claims first use and use in commerce on February 1, 2010.

Trademark Act §§ 1 and 45, 15 U.S.C. §§ 1051 and 1127, and 37 C.F.R. §§2.34(a)(1)(iv) and 2.56(a), because it was not a substantially exact representation of the applied-for mark.² Applicant filed a notice of appeal with the Board and a request for reconsideration. The request for reconsideration included a substitute specimen. The Examining Attorney did not accept the substitute specimen because it does not demonstrate use of the mark in commerce in connection with the subject services. When the appeal was resumed, Applicant and the Examining Attorney each filed a brief. We affirm the refusal to register.

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.” 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 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

² The final Office Action also included a refusal of the applied-for term under Section 2(e)(1) of the Trademark Act, 35 U.S.C. § 1052(e)(1). Applicant subsequently amended its application to seek registration on the Supplemental Register; therefore the Section 2(e)(1) refusal became moot.

We also note that Applicant’s recitation of the prosecution history at page 4 of its brief is not entirely accurate. The substitute specimen was not filed until after the issuance of the final Office Action.

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). That is, “[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 turn first to Applicant’s initial specimen filed with its application, which is depicted below:



Walk-In Shoppers

How do we react to those shoppers who just walk in or accept our invitation to visit us?

Remember, these shoppers haven't made the decision to use our business yet. We have a wonderful opportunity to build a relationship and add "value" in how they view our funeral home.

Things to Accomplish:

- Take on Tour of Facility _____

- Introduce Other Staff Members _____

- Build a Relationship _____

- Provide Information (such as GPL & CPL) and provide education _____

- Support their decisions and their visit _____

- Add Value to Offerings _____

- Seek Permission to Handle the Arrangements _____

The Examining Attorney is correct; the specimen does not exhibit the applied-for mark. It only identifies “shoppers” in the plural form, not the singular form as

depicted in the application drawing page. Applicant has not contended otherwise in its Brief, and in fact does not discuss the refusal of the original specimen at all.

We now turn to Applicant's substitute specimen, depicted 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.

Walk-In Shopper™

The funeral industry is not a "try before you buy" type business. However, many individuals will visit funeral homes in advance to determine which firm they will choose. A Walk-In Shopper differs from a telephone shopper. Graystone offers in-depth communication training targeting the walk-in shopper. This training not only consists of verbal communication, it includes body language as well as the visual aspect of having the consumer at the business location. There are variable considerations that must be addressed if there is a service in progress or a bereaved family there to make arrangements. Graystone has put together vast scenarios of possible situations and what can affect the buying decisions of a walk-in shopper.

Applicant argues that the substitute specimen is acceptable because it "show[s] the business training consultancy services identified in the ... sentence[] of the body of the flyer 'Graystone offers communication training regarding the Walk-In Shopper.'"³ The Examining Attorney disagrees, and states,

While the mark appears on the specimens and the specimens reference training and consulting services, it is clear from the text of the specimens that the mark is the topic of applicant's consulting

³ This sentence does not appear in the specimen. The specimen states, "Graystone offers in-depth communication training targeting the walk-in shopper."

and training services and is not being used as a source indicator for consulting services. For example, reading below the mark WALK-IN SHOPPER™, the advertisement claims to provide “training targeting the walk-in shopper” and that “Graystone has put together vast scenarios of possible situations and what can affect the buying decisions of a walk-in shopper.” ... As used in these specimens, the mark does not identify the consulting services and its source. The relevant public would only likely view the mark as referring to the topic or category of applicant’s consulting services, not as the source of the consulting services.

We agree with the Examining Attorney; the specimens do not show the requisite “direct association” between the applied-for mark and Applicant’s “business training consultancy services.” Applicant is using “Walk-In-Shopper” to identify a particular customer, i.e., one who “visit[s] a funeral home in advance to determine which firm they will choose.” This is evident from the use of the term in lower cases letters (“targeting the walk-in-shopper”) and from the content of the paragraph which is referring to an individual identified as a walk-in shopper (“Graystone has put together vast scenarios of possible situations and what can affect the buying decisions of a walk-in shopper.”) Nothing in the specimen associates the designation with “business training consultancy services.”

Further, the mere reference to “training and consulting” in the specimen is not sufficient to make the association. Even though this reference is followed by the term WALK-IN-SHOPPER with a “tm” designation, a direct association is not made between the two. The explanations that follow regarding the target customer for one of Applicant’s clients makes clear that the reference is not to any service mark for

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“business training consultancy services,” but to a particular customer. *See In re Osmotica Holdings Corp.*, 95 USPQ2d at 1668 (“It is not enough that the mark and a reference to the services both appear in the same specimen.”); *In re DSM Pharmaceuticals*, 87 USPQ2d at 1624 (“A specimen that shows only the mark with no reference to, or association with, the services does not show service mark usage.”).

Decision: The refusal to register Applicant's mark because the specimens do not show use of the applied-for mark in connection with any of the services specified in the application is affirmed.