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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85935508
Applicant	Outdoorlink, Inc.
Applied for Mark	SMART LINK SYSTEMS
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re: Application of

Outdoorlink, Inc.

For: SMART LINK SYSTEMS  
and Design

Serial No. 85/935508

Filed: May 17, 2013

Trademark Law Office: 110

Examining Attorney: Sara N. Benjamin

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

APPLICANT'S BRIEF ON APPEAL

## **FACTS**

On May 17, 2013, Applicant filed U.S. Serial No. 85/935508 for SMART LINK SYSTEMS and design (“Applicant’s Mark”). The description of services for Applicant’s Mark currently reads as follows: “Monitoring roadside billboards for business purposes, namely, using images of roadside billboards for assisting advertisers in confirming compliance with contractual terms related to advertising dates for roadside billboards.”

On October 23, 2017, Applicant filed a substitute specimen for Applicant’s Mark. Such substitute specimen is a copy of an electronic brochure for advertising a billboard monitoring service showing the mark in use.

On November 15, 2017, the Examiner mailed an Office Action finally refusing registration of Applicant’s Mark under Trademark Act on the grounds that the substitute specimen does not show the applied-for mark in use in commerce in connection with any of the services specified in International Class 35 in the statement of use.

On May 15, 2018, Applicant filed a Notice of Appeal and a Request for Reconsideration of the final refusal.

On May 30, 2018, the Examiner mailed an Office Action denying Applicant’s Request for Reconsideration.

## **ISSUE**

Whether Applicant’s substitute specimen filed on October 23, 2017, shows the applied-for-mark in use in commerce in connection with Applicant’s specified services in International Class 35.

## ARGUMENT

The basis of the Examiner's refusal appears to be that Applicant's customers, not Applicant, are performing the recited monitoring services. Specifically, the Examiner alleges that "the specimen shows use in connection with a digital camera system and software that allows customers themselves to monitor billboards, but it does not show that applicant actually provides monitoring services to or for the benefit of others." See Office Action of May 30, 2018. Applicant respectfully disagrees with the assertion that Applicant is not providing "monitoring" services to its customers.

In this regard, the specimen submitted by the Applicant states "The SmartLink TM DigitalView from Outdoorline, Inc.® will send images of the billboard copy at time intervals chosen by the user!" Thus, the user receives images of the billboard so that he or she can confirm that the appropriate advertisement is being displayed at the appropriate time. Capturing and sending images of billboards, as stated in the specimen, is part of a "monitoring" service that is provided to the user. The fact that the user is able to view images to confirm the advertisement does not change the fact that at least a portion of the monitoring is provided by Applicant's services. That is, the user himself or herself does not have to capture and send images of a billboard being monitored, and Applicant handles at least a portion of the monitoring process for its customers, which is all that is required for the substitute specimen to be acceptable in the instant case. Moreover, it is incorrect to state that the substitute specimen does not show the applied-for mark in use with any of the specified services.

Further, irrespective of the foregoing, it is important to note that transmission of images to the user at user-specified times is only a portion or a feature of the services advertised by the substitute specimen. The substitute specimen includes a drawing that shows the architecture of

the “SmartLink” system. Specifically, the substitute specimen shows a camera that captures an image of a billboard and a “Smartlink” 302 device that sends the image to a “SmartLink” server, which then provides the images through the Internet to devices connected to the Internet. The substitute specimen also states that there are “Stored images in the SmartLink™ System”. That is, the “SmartLink” server not only sends images to the user at times chosen by the user, but it also stores the images in the “SmartLink” server, thereby defining a history of the billboard over time. Moreover, the act of capturing and storing images over time to define a viewable billboard history is an act of “monitoring.” The term “monitoring” does not require an assessment of whether the appropriate ad is displayed but rather requires a system to watch or keep track of the roadside billboard. See Exhibit A of Applicants Request for Reconsideration filed on May 15, 2018, which defines “monitoring” as “to watch, keep track of, or check.” Indeed, the description of services does not include confirming compliance of contractual terms related to advertising dates but rather recites “assisting advertisers in confirming compliance with contractual terms related to advertising dates for roadside billboards,” which is clearly performed by the “SmartLink” system through the capturing, storing, transmitting, and rendering of billboard images as shown by Applicant’s specimen. (Emphasis added). Moreover, capturing and storing billboard images at a server to define a viewable history of a billboard over time is clearly a form of “watching” or “keeping track of,” and it is clearly Applicant, not Applicant’s customers, that is providing this service.

In refusing registration, the Examiner appears to allege that Applicant is providing a system, not a service. In this regard, the Examiner alleges that:

The specimen states “[a] proven product from OutdoorLink from OutdoorLink, Inc.” and “[f]or more information on the SmartLink applications contact.” These statements infer that the applicant is providing camera, hardware products, and software applications and not an actual service. Furthermore much of the

specimen expounds on the merits of the system including camera and application features.

The specimen clearly shows “SmartLink™ Servers” at the heart of the system between the user device and the equipment that is mounted on the billboard for capturing images, and these servers perform the “monitoring” service that is being provided to Applicant’s customers for a monthly subscription fee. The fact that Applicant uses products or applications in the course of providing its service does not change the fact that it is providing a “service” for which it is entitled to registration. As stated above, the substitute specimen clearly indicates that Applicant’s servers, not the customer’s servers, are performing the services that are recited by the instant application.

**Conclusion**

Applicant respectfully contends that the substitute specimen shows that Applicant is providing a “monitoring” service for which Applicant is entitled to registration.

Acceptance of the substitute specimen is respectfully requested.

Respectfully Submitted,

**Maynard, Cooper & Gale, P.C.**

/joneholland/

By \_\_\_\_\_

Jon E. Holland

Attorney for Applicant