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Subject: U.S. TRADEMARK APPLICATION NO. 85935508 - SMART LINK SYSTEMS - 14350-0025 -
EXAMINER BRIEF

Attachment Information:

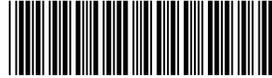
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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85935508

MARK: SMART LINK SYSTEMS



CORRESPONDENT ADDRESS:

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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: Outdoorlink, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

14350-0025

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's refusal to register the service mark SMART LINK SYSTEMS, on the ground that the specimen of use does not show the applied-for mark in use in commerce in connection with any of the services specified in the application. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a).

FACTS

The applicant Outdoorlink, Inc. filed a statement of use¹ for the stylized mark SMART LINK SYSTEMS used in connection with the following services “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”. The examining attorney refused registration because the specimen provided did not show use of the applied-for mark in connection with the specified services.² The applicant argued against the refusal and provided an additional substitute specimen.³ After consideration of the applicant’s arguments and review of the substitute specimen, the examining attorney issued a final refusal.⁴ Subsequently, the applicant filed a request for reconsideration⁵ which was denied by the examining attorney.⁶ In response, the applicant filed an appeal.⁷

ARGUMENT

SPECIMEN OF USE UNACCEPTABLE

Registration is refused because the 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. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); *In re Keep A Breast Found.*, 123 USPQ2d 1869, 1876-79 (TTAB 2017); *In re Graystone Consulting Assocs., Inc.*, 115 USPQ2d 2035, 2037-38 (TTAB 2015); TMEP §§904, 904.07(a), 1301.04(d), (g)(i). The applicant’s services involve the monitoring of billboards for business purposes. The specimens submitted show use in connection with a digital camera system and software that allows customers

¹ April 4, 2017.

² April 23, 2017.

³ October 23, 2017.

⁴ November 15, 2017.

⁵ May 15, 2018.

⁶ May 30, 2018. Please note that the application was reassigned to a new examining attorney.

⁷ June 6, 2018.

themselves to monitor billboards, however, it does not show that applicant actually provides monitoring services to and for the benefit of others.

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each international class of goods and/or services identified in the statement of use. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a); *see In re Gulf Coast Nutritionals, Inc.*, 106 USPQ2d 1243, 1247 (TTAB 2013).

APPLICANT'S ARGUMENTS

The applicant contends that the specimen supports services which involve third party users receiving images of billboards so that he or she can confirm that the appropriate advertisement is being displayed at the appropriate time. Furthermore, the applicant argues that the specimens demonstrate that the applicant is capturing, storing, and sending billboard images and such activities constitute the identified monitoring services. However, the specimen and substitute specimen simply do not support monitoring activities which involve the applicant actively watching, keeping track of, or checking billboards for the benefit of third parties.

The applicant further explains that the goods/services provided include a camera that captures a billboard image and sends the image to a server, and then provides the image through the internet to devices connected to the internet. The server sends and stores the images for the user. The applicant contends that the act of capturing and storing images over time constitutes monitoring. While the specimen does support the sending of images and image storage, such language does not encompass the Class 35 monitoring activities which should involve actively watching, keeping track of, or checking. Transmission of images is separate and distinct service classified in International Class 38 and

electronic data storage is in International Class 42. Regardless these services appear to be ancillary and merely part of the system sold by the applicant.

Lastly, the applicant disagrees with the examining attorney's determination that the applicant is providing a hardware/software system and not an actual service. The applicant contends that the user devices, equipment mounted on the billboards, and servers perform the monitoring service provided to their customers. However, the specimen states "[a] proven product from OutdoorLink, Inc." and "[f]or more information on the SmartLink applications, contact...". These statements infer that the applicant is providing cameras, 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 and not on an actual monitoring service.

CONCLUSION

The specimens do not show use of the applied-for mark in use in commerce with any of the services specified in International Class 35 in the statement of use. Accordingly, registration must be refused under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R.

§§2.34(a)(1)(iv), 2.56(a).

The examining attorney respectfully submits that the refusal of registration be affirmed.

Respectfully submitted,

/Tarah Hardy Ludlow/

Examining Attorney

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