This Opinion Is Not a
Precedent of the TTAB

Mailed: July 8, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Outdoorlink, Inc.

Serial Nos. 85935503 & 85935508[1]

Jon E. Holland of Maynard Cooper & Gale, PC
for Outdoorlink, Inc.

Tarah Hardy Ludlow, Trademark Examining Attorney, Law Office 110,
Chris A.F. Pedersen, Managing Attorney.

Before Taylor, Adlin, and Lynch,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

[1] Because the cases have common questions of fact and law, the appeals are hereby consolidated. *See, e.g., In re Anderson*, 101 USPQ2d 1912, 1915 (TTAB 2012) (The Board *sua sponte* consolidated two appeals). Citations to the TSDR and TTABVUE record are the same in each application, except where indicated as identified by the respective serial numbers of the applications.

I. Background

Outdoorlink, Inc. ("Applicant") seeks registration on the Principal Register of SMARTLINK in standard characters[2] for "Monitoring indoor and outdoor advertisements for business purposes" in International Class 35, and

[3] for:

> 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 in International Class 35.

Applicant initially based the applications on its allegation of a bona fide intent to use the mark in commerce. After the notices of allowance issued, Applicant filed statements of use with the identical specimen in each case,[4] described as "a print-out

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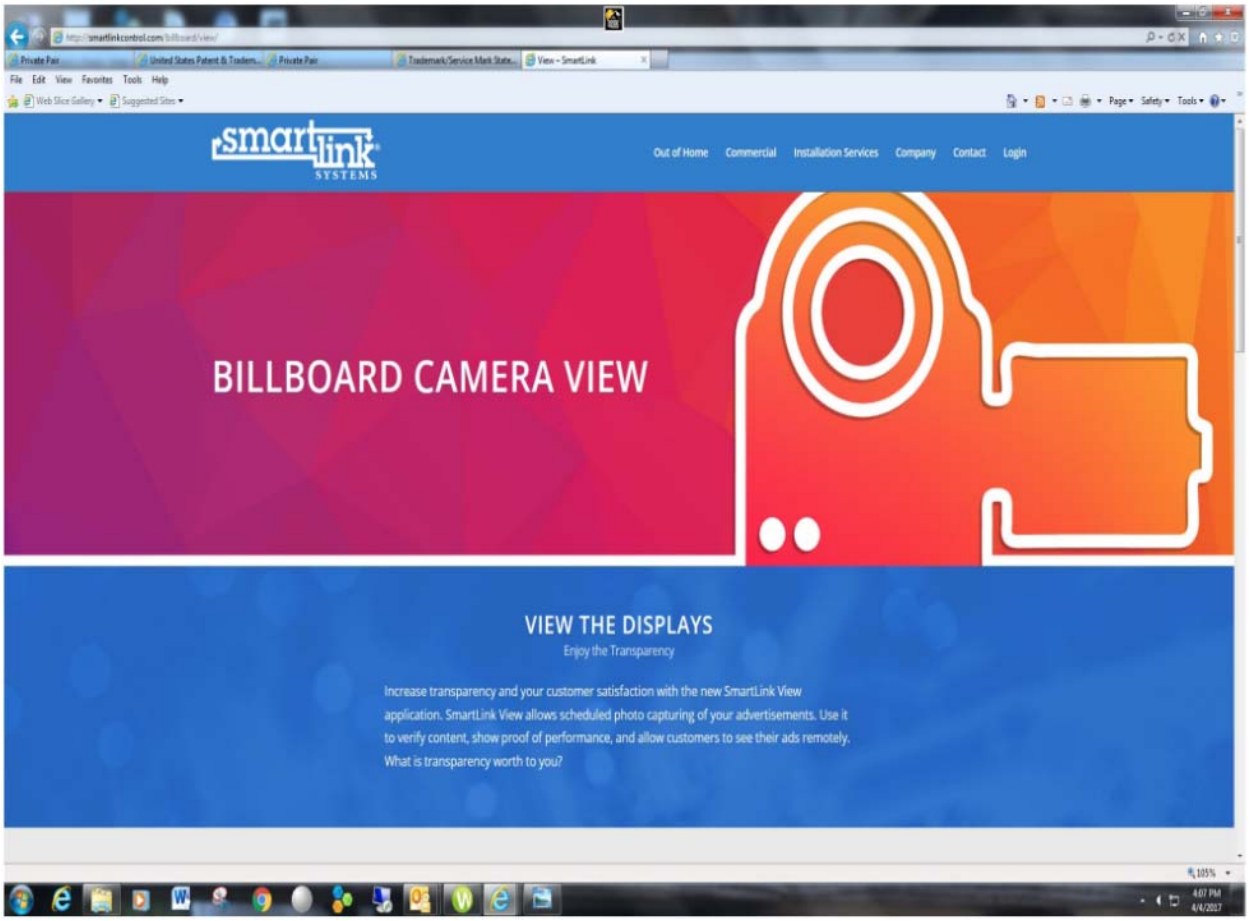
[2] Application Serial No. 85935503 was filed May 17, 2013, based on Applicant's assertion of a bona fide intent to use the mark under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

[3] Application Serial No. 85935508 was filed May 17, 2013, based on Applicant's assertion of a bona fide intent to use the mark under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The application includes a disclaimer of SMART and SYSTEMS. The mark is described as "the wording 'smartlink systems' where the word 'link' is offset vertically from the word 'smart' and where the word 'systems' appears in a smaller-size font below the word 'link.' The letters 'n' and 'k' in the word 'link' are joined at the base of such letters, and the letters 'l,' 'i,' and 'n' in the word 'link' are joined at the base of such letters. An arrow extends horizontally above the word 'link' from the letter 't,' and the end of such arrow points downward toward the end of the letter 'k.' Another arrow extends horizontally below the word 'smart' from the base of the word 'link' and points to the left side of the letter 's' in the word 'smart.'" Color is not claimed as a feature of the mark.

[4] April 4, 2017 Statement of Use at 5.

of a website showing the mark in use."[5] The specimen displayed below refers to the "new SmartLink View application" which "allows scheduled photo capturing of your advertisements. Use it to verify content, show proof of performance, and allow customers to see their ads remotely":



In each case, the Examining Attorney refused registration under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051 and 1127, on the ground that the specimen does not show Applicant's marks in use in connection with the recited services.[6] The Office Actions explained that "the specimen shows the mark in

[5] April 4, 2017 Statement of Use at 2.

[6] April 23, 2017 Office Action at 1.

connection with an application that 'allows scheduled photo capturing of your advertisements.' The specimen thus shows use in connection with a software application and now [sic] with a billboard monitoring service."[7] In the responses submitted and signed by Applicant's in-house counsel, Applicant submitted the same substitute specimen identified as "copy of an electronic brochure for advertising a billboard monitoring service showing the mark in use."[8] The substitute specimen[9] is reproduced below:

[7] *Id.*

[8] October 24, 2017 Response to Office Action at 1 (Serial No. 85935503); October 23, 2017 Response to Office Action at 1 (Serial No. 85935508).

[9] *Id.* at 2-3.

View the Ad. Enjoy Transparency.

The SmartLink™ DigitalView provides you Transparency over all your Static Billboards.

True wireless access from

smartlink™

Powered by OutdoorLink®

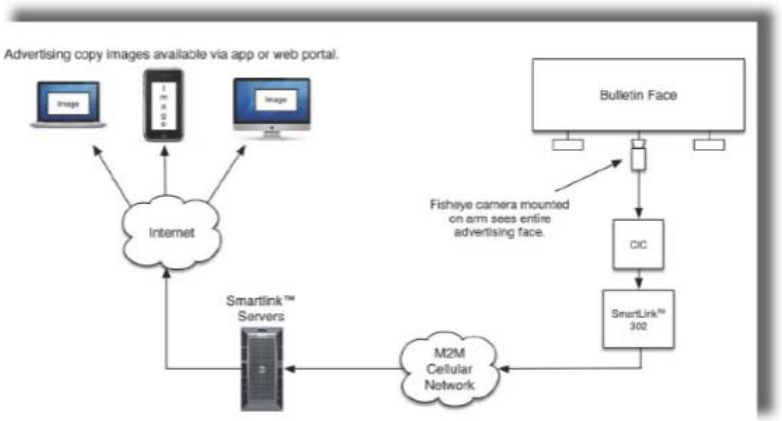
A proven product from OutdoorLink, Inc.®

SmartLink™ DigitalView

The SmartLink™ DigitalView from OutdoorLink, Inc.® will send images of the billboard copy at time intervals chosen by the user! The camera can be mounted off of the catwalk, usually 5 to 8 feet, or directly attached to the structure. Notifications will be sent in Real Time.

Pure Wireless Transparency

- Non-Intrusive
- Cameras offer TRANSPARENCY
- Custom Schedule for image capturing
- Resolution size of 720 x 480 jpeg
- Positions of Cameras customized per structure
- Stored images in SmartLink™ System
- Add-ons up to 6 cameras
- Installation performed by ODLS crews available
  *licensed & insured
- 24/7 Customer Support



For more information on the SmartLink™ applications, contact:
DJ Jennings | www.outdoorlinkinc.com | dj@outdoorlinkinc.com

Our proven SmartLink™ System is:
UL LISTED • cUL LISTED • CE Listed • PTCRB CERTIFIED • FCC CERTIFIED • AT&T CERTIFIED • VERIZON CERTIFIED

The Examining Attorney rejected the substitute specimen and maintained the refusals that the specimens do not show use of the marks in connection with the services. According to the Examining Attorney, "the [substitute] specimen shows use in connection with a system and software that allows customers themselves to

monitor billboards, but it does not show that applicant actually provides monitoring services."[10]

Applicant requested reconsideration, arguing that its software captures and sends images of billboards, which "is part of a 'monitoring' service that is provided to the user."[11] Applicant also stated that the reference in the substitute specimen to "stored images" in the system refers to Applicant storing images on its server, arguing that "the act of capturing and storing images over time is an act of 'monitoring.'"[12] Applicant specifically relied on a definition of "monitor" as "to watch, keep track of, or check usu. for a special purpose."[13]

The Examining Attorney denied the requests for reconsideration, finding that the substitute 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 and for the benefit of others."[14] Applicant appealed, and the appeals are fully briefed.

As explained below, we reverse the refusals to register because we find the substitute specimen acceptable.[15]

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[10] November 15, 2017 Office Action at 1.

[11] May 16, 2018 Request for Reconsideration at 1 (Serial No. 85935503); May 15, 2018 Request for Reconsideration at 1 (Serial No. 85935508).

[12] *Id.* at 1.

[13] *Id.* at 4 (Merriam-Webster's Collegiate Dictionary).

[14] August 13, 2018 Denial of Request for Reconsideration at 1 (Serial No. 85935503); May 30, 2018 Denial of Request for Reconsideration at 1 (Serial No. 85935508).

[15] The briefing focused on the substitute specimen and because we find it acceptable, there is no need to address the original specimen.

II. Use of the Mark for the Services

Under 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." *See also* Trademark Rule 2.56(b)(2), 37 C.F.R. § 2.56(b)(2) ("A service mark specimen must show the mark as used in the sale or advertising of the services"). "Relevant to Applicant's specimens in this case, the webpage [or e-brochure] must show the mark used or displayed as a service mark in advertising the services. Showing only the mark with no reference to, or association with, the services does not show service mark usage." *In re Pitney Bowes, Inc.*, 125 USPQ2d 1417 (TTAB 2018) (citations omitted). "For specimens showing the mark in advertising the services, '[i]n order to create the required 'direct association,' the specimen must not only contain a reference to the service, but also the mark must be used on the specimen to identify the service and its source.'" *In re WAY Media, Inc.*, 118 USPQ2d 1687 (TTAB 2016) (quoting *In re Osmotica Holdings Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010)). "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). The evidence is reviewed to determine whether use of the marks "'sufficiently creates in the minds of purchasers an association between the mark[s]'" and the applied-for services. *Id.* (quoting *In re Ancor Holdings LLC*, 79 USPQ2d 1218, 1221 (TTAB 2006)).

Applicant's services give customers the ability to remotely view the billboards they have contracted to use for their advertisements, to ensure that the billboards display

the appropriate content at the agreed-upon times. The Examining Attorney contends the specimen shows use in connection with a digital camera system and software for customers to monitor billboards, but it does "not support monitoring activities which involve the applicant actively watching, keeping track of, or checking billboards for the benefit of third parties."[16] Essentially, she maintains that Applicant provides a product or system by which customers do their own monitoring. In response to Applicant's argument that capturing and sending images of billboards is part of a monitoring service, the Examining Attorney concedes that the substitute specimen "does support the sending of images and image storage."[17] However, she contends that the transmission of images and image storage that Applicant provides are distinct services in other international classes and do not constitute monitoring, and, further, that the sending and storing of images "appear to be ancillary and merely part of the system sold by the applicant."[18] She points to references on the substitute specimen to a "proven product from OutdoorLink, Inc." and "the SmartLink applications" as implying that Applicant provides "cameras, hardware products, and software applications and not an actual service."[19]

Applicant asserts that it performs the recited services of "monitoring roadside billboards" by facilitating the capture and transmission of billboard images.

[16] 13 TTABVUE 4 (Examining Attorney's Brief).

[17] *Id.*

[18] *Id.* at 5; *see* August 13, 2018 Denial of Request for Reconsideration at 1 (Serial No. 85935503); May 30, 2018 Denial of Request for Reconsideration at 1 (Serial No. 85935508).

[19] 13 TTABVUE 5 (Examining Attorney's Brief).

Applicant points to references on the substitute specimen such as "Stored images in the SmartLink™ System" and "send images of the billboard" as a form of watching or keeping track, in accordance with the definition of monitoring. Applicant emphasizes that these activities in particular show that "it is clearly Applicant, not Applicant's customers, that is providing this service."[20] In its Reply Briefs, Applicant focuses on image storage, insisting that "Applicant fails to see how creating and maintaining such a history of stored images is not at least 'keeping track of' the billboard advertisements for the benefit of its customers."[21] Addressing the Examining Attorney's assertion that Applicant provides a product rather than a service, Applicant counters that its use of "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."[22] Applicant criticizes the Examining Attorney's lack of legal authority supporting the theory that any services are ancillary to the product, and argues that customers pay a monthly subscription fee for its services.[23]

Although neither Applicant nor the Examining Attorney cited or discussed the United States Court of Appeals for the Federal Circuit's decision in *In re JobDiva, Inc.*, 843 F.3d 936, 121 USPQ2d 1122 (Fed. Cir. 2016), it provides important guidance here. In *JobDiva*, the Court vacated a Board decision holding that JobDiva's mark

[20] 11 TTABVUE 5 (Applicant's Brief).

[21] 14 TTABVUE 3 (Serial No. 85935503, Applicant's Reply Brief); 15 TTABVUE 3 (Serial No. 85935508, Applicant's Reply Brief).

[22] 11 TTABVUE 6 (Applicant's Brief).

[23] 14 TTABVUE 4-5 (Serial No. 85935503, Applicant's Reply Brief); 15 TTABVUE 3 (Serial No. 85935508, Applicant's Reply Brief).

was not in use for personnel placement and recruitment services. *JobDiva,* 121 USPQ2d at 1122-23. JobDiva provided software that automatically performed recruitment and hiring functions such as finding, analyzing, and communicating with job candidates. *Id.* at 1124-25. The Board reviewed website screenshots and concluded that they contained no reference to the services "other than supplying [JobDiva's] software." *Id.* at 1124. The Board considered this an insufficient showing of use of the service mark "because JobDiva's software sales alone could not, in the Board's view, constitute personnel and recruitment services." *Id.* at 1123.

The Federal Circuit disagreed, holding that:

> The proper question is whether JobDiva, through its software, performed personnel placement and recruitment services and whether consumers would associate JobDiva's registered marks with personnel placement and recruitment services, regardless of whether the steps of the service were performed by software.

Id. The Federal Circuit further held that the fact-specific inquiry should include consideration of the "nature of the user's interaction with JobDiva when using JobDiva's software, as well as the location of the software host," noting that if a user perceives interaction with JobDiva during the operation of the software, a user would be more likely to associate the mark with personnel placement and recruitment services. *Id.* at 1126.

Ultimately, the crux of the dispute in the cases at hand centers on whether the substitute specimen sufficiently refers to the recited services of monitoring roadside

billboards for business purposes and associates the mark with such services.[24] We find that consumers would associate Applicant's marks with the recited services. The substitute specimen displays the marks in connection with wording that in its entirety indicates that Applicant's services send images of static billboards to customers who have wireless access to view them, facilitating "transparency." Applicant's customers may customize the intervals during which images are captured and sent, and "Notifications will be sent in Real Time." The graphic on the second page of the substitute specimen shows that images captured from the billboards are delivered to users through the "Smartlink™ Servers" and made available "via app or web portal." The references to "Stored images in the SmartLink™ System," and "send[ing] images of the billboard" further amplify the consumer perception of the marks associated with monitoring services. Applicant's customers interact with Applicant on an ongoing basis while using the software to view the images, and would be aware that billboard images, sent at designated intervals to the customer, are stored on Applicant's server and are made available either through Applicant's app or Applicant's website.

In addition, the Examining Attorney has not established that Applicant's activities are merely ancillary to hardware or software purchased by customers. While Applicant's specimen shows the involvement of some equipment such as

[24] Given the guidance in *JobDiva*, the Examining Attorney could have inquired about the functioning of Applicant's system and the nature of customers' interaction with Applicant while using the system. *See* Trademark Rule 2.61(b), 37 C.F.R. § 2.61(b) ("The Office may require the applicant to furnish such information, exhibits, affidavits or declarations, and such additional specimens as may be reasonably necessary to the proper examination of the application.").

cameras, and refers at one point to a "proven product," the specimen does not give the impression that the marks only – or even primarily – apply to cameras, hardware, software or other goods. Rather, the crucial inquiry is not whether hardware or software is used in connection with the services; it is how consumers perceive the goods or services with which the marks are associated. *JobDiva,* 121 USPQ2d at 1123.

In view of the above, we find that consumers would perceive Applicant as providing the recited monitoring services under the marks. *See JobDiva,* 121 USPQ2d at 1123.

Decision: Applicant's substitute specimen demonstrates use of the marks in a manner that creates in the minds of potential customers a direct association between the marks and the recited services. We therefore reverse the refusals to register.