

From: Hardy, Tarah

Sent: 5/30/2018 10:48:55 AM

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Subject: U.S. TRADEMARK APPLICATION NO. 85935508 - SMART LINK SYSTEMS - 14350-0025 - SU -
Request for Reconsideration Denied - Return to TTAB

Attachment Information:

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Files: 85935508.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 85935508

MARK: SMART LINK SYSTEMS



CORRESPONDENT ADDRESS:

JON E HOLLAND

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HUNTSVILLE, AL 35801-4936

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

[VIEW YOUR APPLICATION FILE](#)

APPLICANT: Outdoorlink, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

14350-0025

CORRESPONDENT E-MAIL ADDRESS:

ipdocket@maynardcooper.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 5/30/2018

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following requirement(s) and/or refusal(s) made final in the Office action dated November 15, 2017 are maintained and continue to be final: Refusal to register because the specimen of use does not identify the services. See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); see 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); see TMEP §§715.03, 715.03(a)(ii)(B), (c).

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 goods and/or services specified in International Class(es) 35 in the application or amendment to allege 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). Specifically, 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 and for the benefit of others.

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 actual monitoring activities which involve the applicant actually watching, keeping track of, or checking billboards for the benefit of third parties. While the specimen does support the sending of images and image storage such language does not encompass the Class 35 monitoring activities. 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. The specimen states "[a] proven product from OutdoorLink, Inc." and "[f]or more information on the SmarLink 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.

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 application or amendment to allege 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).

Examples of specimens for goods include tags, labels, instruction manuals, containers, photographs that show the mark on the actual goods or packaging, and displays associated with the actual goods at their point of sale. See TMEP §§904.03 *et seq.* Webpages may also be specimens for goods when they include a picture or textual description of the goods associated with the mark and the means to order the goods. TMEP §904.03(i). Examples of specimens for services include advertising and marketing materials, brochures, photographs of business signage and billboards, and webpages that show the mark used in the actual sale, rendering, or advertising of the services. See TMEP §1301.04(a), (h)(iv)(C). Specimens comprising advertising and promotional materials must show a direct association between the mark and the services. TMEP §1301.04(f)(ii).

Applicant may respond to this refusal by satisfying one of the following for each applicable international class:

- (1) Submit a different specimen (a verified [“substitute” specimen](#)) that (a) was in actual use in commerce at least as early as the filing date of the application or prior to the filing of an amendment to allege use and (b) shows the mark in actual use in commerce for the goods and/or services identified in the application or amendment to allege use. A “verified substitute specimen” is a specimen that is accompanied by the following statement made in a signed affidavit or supported by a declaration under 37 C.F.R. §2.20: “The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application or prior to the filing of the amendment to allege use.” The substitute specimen cannot be accepted without this statement.
- (2) Amend the filing basis to [intent to use under Section 1\(b\)](#), for which no specimen is required. This option will later necessitate additional fee(s) and filing requirements such as providing a specimen.

For an overview of *both* response options referenced above and instructions on how to satisfy either option online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/specimen.jsp>.

The application will now return to the Trademark Trial and Appeal Board for resumption of the appeal.

/Tarah Hardy Ludlow/

Examining Attorney

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