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

Proceeding	88079973
Applicant	Wilbur-Ellis Company LLC AKA Wilbur-Ellis
Applied for Mark	TANK TO TARGET
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EX PARTE APPEAL BRIEF

In re: Wilbur-Ellis Company LLC
In the Matter of Trademark Application Serial No. 88079973
For the Mark: TANK TO TARGET
By Applicant: Wilbur-Ellis Company LLC
Filed on August 15, 2018

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STATEMENT OF THE ISSUES

The sole issue before the Board is whether Applicant's specimen filed with the Statement of Use shows a direct association between the applied-for mark and the identified services.

RECITATION OF THE FACTS

A. Procedural History

Applicant filed Application Serial No. 88079973 on August 15, 2018 under §1(b) for registration on the Principal Register for the trademark TANK TO TARGET in International Class 44 covering "Agricultural advice; Horticultural services."

The mark was published on December 12, 2018. A Notice of Allowance issued on February 26, 2019.

On August 14, 2019, Applicant filed a Statement of Use submitting a webpage from Applicant's website to support the claim of use.

On August 28, 2019 the Examining Attorney issued an Office Action refusing registration, rejecting that specimen on grounds that "the specimen does not show use in commerce of the applied-for mark with the identified services in International Class 44."

In response, on September 14, 2019 Applicant (acknowledging its understanding that the initial specimen was deficient) mailed a paper submission which included a substitute specimen in .mpg video format on video disc.

On October 18, 2019, the Examining Attorney issued a Final Office Action stating that "[r]egistration remains refused because the substitute specimen does not show use in commerce of the applied-for mark with the identified services in International Class 44."

On February 26, 2020, Applicant filed its Notice of Appeal and Request for Reconsideration, respectfully traversing this rejection and requested reconsideration with the following five arguments:

1. *"Applicant submits that the video specimen does far more than merely discuss [per the Examining Attorney] "...the use of various products in order to "target" the needs of the consumer." The video begins with the following statements:*

a. "Decisions in agriculture are made every day and building an effective tank mix is complex." [prompting the customer to seek applicant's services for assistance with that process];

b. "TANK TO TARGET considers your intended target, specific delivery method, and in-tank chemistry" [advice which can stand on its own merit]. As this statement is spoken, the phrase TANK TO TARGET appears visually above what is clearly farmland (rows of crops), further strengthening the association between the mark and the services. ...

Thus, while the video specimen might discuss “the use of various products in order to “target” the needs of the consumer”, more accurately, it discusses the fact that applicant’s representatives, as part of the process of providing services, think carefully about the prospective customer’s needs (i.e., intended application/crop, specific delivery method, and in-tank chemistry), thereby creating an association between the phrase TANK TO TARGET and the services rendered.

2. *Applicant’s Response to the examiner’s statement that the specimen is “unclear ...whether the applied-for mark TANK TO TARGET refers to a specific good or formula used in the agricultural industry or an actual service rendered by the applicant.” As cited correctly by the examiner: “To show a direct association, specimens showing the mark used in rendering the identified services need not explicitly refer to those services, [emphasis added] but “there must be something which creates in the mind of the purchaser an association between the mark and the service activity.” In re WAY Media, Inc., 118 USPQ2d 1697, 1698 (TTAB 2016) (quoting In re Johnson Controls, Inc., 33 USPQ2d 1318, 1320 (TTAB 1994)).”*

3. *In addition to paragraphs 1.a. and b., supra, the body of the video contains significant advice in the agricultural and horticultural contexts [stands on its own as advisory services];*

It might be arguable whether specific services are referred to explicitly, but the video does conclude with the statement: “[c]onsult your Wilbur-Ellis representative to find out what works best for you.”, an obvious reference to services. The content of the video in its entirety clearly points to the rendering of agricultural and horticultural advice.

4. *Finally, the youtube.com webpage where the video is available clearly includes the mark TANK TO TARGET (... the initial specimen submitted). See also, [youtube citations omitted].*

5. *As cited by the examiner, “[a]specimen must show the mark used in a way that would create in the minds of potential consumers a sufficient nexus or direct association*

between the mark and the services being offered. In re Universal Oil Prods. Co., 476 F.2d at 655, 177 USPQ2d at 457; TMEP §1301.04(f)(ii); see also In re JobDiva, Inc., 843 F.3d at 942, 121 USPQ2d at 1126; In re Adver. & Mktg. Dev., Inc., 821 F.2d at 620, 2 USPQ2d at 2014. Addressing the complexity of applying agricultural chemicals, the viewer/purchaser is provided within the video presentation itself significant agricultural and horticultural advice. Consultation is in itself a service. But furthermore, as the videos encourage, consultation in many cases will result in the applicant providing additional agricultural and horticultural services as well.

Considerable effort and expense have gone into promoting applicant's TANK TO TARGET services. The mark is used in ways that unquestionably creates in the minds of potential consumers (those familiar with agribusiness) a sufficient nexus and direct association between the mark and the services being offered. Applicant submits that all requirements have been met and requests the application to proceed promptly to registration."

On March 19, 2020, the Examining Attorney filed her Reconsideration Letter, denying Applicant's Request for Reconsideration.

B. Evidence of Record

The original specimen, filed August 24, 2018, appears on the next page:



The substitute specimen, sent via Express Mail September 14, 2019 on video disc, is available for review at <https://www.youtube.com/watch?v=NLRPmBjAHhc>. (a 1 minute and 36 second video).

ARGUMENT

The Examining Attorney has refused to register Applicant's mark TANK TO TARGET for use in connection with Class 44 "Agricultural advice; Horticultural services", as filed, stating in her Reconsideration Letter that "Applicant's specimens merely show advertising and promotional methods to sell a particular product."

Applicant respectfully disagrees with the conclusion reached by the Examining Attorney. Applicant believes that the Examiner does not have a clear understanding of how Applicant conducts its business and therefore is not applying a proper standard of review in her determination as to whether there is a connection between the specimens as filed and services as enumerated. These promotional materials do refer to adjuvants in general, however there is no reference to any specific product.

A service-mark specimen must show the mark as actually used in the sale or advertising of the services recited in the application (TMEP 1301.04). Applicant's specimens show the mark as actually used in the sale or advertising of the services as recited in the application.

The specimen must demonstrate the mark serving as a source indicator for the identified services (TMEP 1301.04(d)). The video specimen clearly identifies Applicant as the source of agricultural advice and horticultural services as referenced in its substitute specimen.

CONCLUSION

In view of the foregoing, it is respectfully requested that the Trademark Trial and Appeal Board sustain this Appeal, reverse the Examining Attorney's refusal to register and pass the subject application to registration.

Respectfully submitted,

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