

From: Liebl, Alexandra

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Subject: U.S. Trademark Application Serial No. 88079973 - TANK TO TARGET - 834-900-1225 - EXAMINER BRIEF

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**United States Patent and Trademark Office (USPTO)**

**U.S. Application Serial No.** 88079973

**Mark:** TANK TO TARGET

**Correspondence Address:**

RANDY TROXEL

TRADEMARK-ASSOCIATES

611 GATEWAY BLVD FL 2

SOUTH SAN FRANCISCO, CA 94080

**Applicant:** Wilbur-Ellis Company LLC

**Reference/Docket No.** 834-900-1225

**Correspondence Email Address:**

rtroxel@tmassoc.com

**EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant has appealed the trademark examining attorney's refusal to register the trademark "TANK TO TARGET" for "Agricultural advice; Horticultural services" in International Class 44. The trademark examining attorney refused registration on the Principal Register under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127 on the ground that the specimens of record fail to show use in commerce of the applied-for mark with any of the services specified in the application.

**I. FACTS**

On August 15, 2018, applicant applied to register the mark “TANK TO TARGET” for “Agricultural advice; Horticultural services” in International Class 44. On December 12, 2018, the application was approved for publication. On February 26, 2019, a Notice of Allowance was issued.

On August 14, 2019, applicant filed a request for extension of time to file a Statement of Use, which was granted. Applicant also filed a Statement of Use on that date.

On August 28, 2019, the trademark examining attorney issued a non-final Office action refusing registration under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127 because the submitted specimen did not show the applied-for mark in use in commerce with the identified services.

On September 18, 2019, applicant filed a response with a substitute specimen.

On October 18, 2019, the trademark examining attorney issued a Final Office action refusing both the original and substitute specimens for failing to show a sufficient nexus or direct association between the mark and the identified services.

On February 26, 2020, applicant filed a Request for Reconsideration after the Final Office action and instituted this appeal.

On March 19, 2020, the trademark examining attorney denied applicant’s Request for Reconsideration and continued and maintained the refusal under the Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127.

On April 30, 2020, applicant filed its Appeal Brief.

## **II. ARGUMENTS**

Applicant has applied to register the mark “TANK TO TARGET” for “Agricultural advice; Horticultural services” in International Class 44. An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark as actually used in commerce for each international class of 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).

When determining whether a mark is used in connection with the services in the application, a key consideration is the perception of the user. *In re JobDiva, Inc.*, 843 F.3d 936, 942, 121 USPQ2d 1122, 1126 (Fed. Cir. 2016) (citing *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 F.3d 1376, 1381-82, 103 USPQ2d 1672, 1676 (Fed Cir. 2012)). 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. See 37 C.F.R. §2.56(b)(2); *In re Universal Oil Prods. Co.*, 476 F.2d 653, 655, 177 USPQ2d 456, 457 (C.C.P.A. 1973); TMEP §1301.04(f)(ii).

To show a direct association, specimens consisting of advertising or promotional materials must (1) explicitly reference the services and (2) show the mark used to identify the services and their source. *In re The Cardio Grp., LLC*, 2019 USPQ2d 227232, at \*2 (TTAB 2019) (quoting *In re WAY Media, LLC*, 118 USPQ2d 1697, 1698 (TTAB 2016)); TMEP §1301.04(f)(ii). Although the exact nature of the services does not need to be specified in the specimen, there must be something which creates in the mind of the purchaser an association between the mark and the services. *In re Adair*, 45 USPQ2d 1211, 1215 (TTAB 1997) (quoting *In re Johnson Controls Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994)).

In this case, applicant has submitted two specimens which do not make a direct association between the applied-for mark, “TANK TO TARGET,” and the applied-for services of “Agricultural advice; Horticultural services” in International Class 44.

The original specimen submitted with the Statement of Use on August 14, 2019, consists of a website screenshot of the third party website YOUTUBE®. The screenshot displays a still of a video where the applied-for mark “TANK TO TARGET” appears within the title and description of the video. Specifically, the title and description located below the video state “Wilbur-Ellis – Tank to Target” and “Tank to Target considers your intended target, specific delivery method, and in-tank chemistries.” The video itself displays the wording “Wilbur-Ellis Ideas to Grow With.” Despite use of the applied-for mark on the specimen, the specimen does not reference, whether explicitly or implicitly, applicant’s services of “Agricultural advice; Horticultural services.” Further, applicant does not contest that the original specimen was deficient. April 30, 2020, Applicant’s brief, TSDR p. 3. Therefore, the original specimen does not make a clear association between the applied-for mark and the applied-for services as there is no means to discern the contents of the video. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

The substitute specimen submitted in the Response to Office action on September 18, 2019, consists of an audio file captured from a physical CD. The audio file consists of the audio associated with the YouTube® video in the original specimen. The audio reveals that the YouTube® video is an advertisement for a product sold by the applicant. Specifically, the audio advertisement makes clear that applicant is not providing a service but rather a good in the nature of a customizable agricultural solution for tanks. The evidence attached in the Request for Reconsideration Denial includes screenshots of applicant’s advertisement on YOUTUBE® which uses the audio from the substitute specimen. *Please see* March 19, 2020 Request for Reconsideration Denial, TSDR pp. 2-6. The advertisement begins by displaying the mark “TANK TO TARGET.” *Please see* March 19, 2020 Request for Reconsideration Denial, TSDR p. 2. The first sentence, as heard in the audio of the advertisement, introduces applicant’s agricultural product by stating the following: “Decisions in agriculture are made every day and building an effective tank mix is complex.” (emphasis added). April 30, 2020, Applicant’s

brief, TSDR p. 3. The advertisement goes on to show an image of applicant's agricultural product within a container describing the functionality of the product. Specifically, applicant's product goes "in the tank" and "through the spray" and lastly "onto or into the target." The following image shows the same container of applicant's products being poured into a tank with wording explaining the advantages and purposes of applicant's products such as to "de-foam" or "clean the tank." *Please see* March 19, 2020 Request for Reconsideration Denial, TSDR p. 3-4. The images and audio demonstrate that the applicant is not directly involved in the various steps discussed in the advertisement, but rather that these are processes that take place automatically based on the chemical makeup of applicant's goods. The mere mention of the word "agriculture" or discussion of applicant's own products related to agriculture does not rise to the level of providing "Agricultural advice; Horticultural services" as suggested by the applicant. April 30, 2020, Applicant's brief, TSDR p. 3.

Applicant argues that the video "discusses the fact that applicant's representatives, as part of the process of providing services, think carefully about the prospective customer 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." April 30, 2020, Applicant's brief, TSDR p. 4. The Board should find this argument unpersuasive. Applicant's mere discussion of its own agricultural products and assisting customers with creating a custom-made tank mixture with its own agricultural products does not amount to the provision of agricultural advice. A term that is used only to identify a product, device, or instrument sold or used in the performance of a service rather than to identify the service itself does not function as a service mark. *See In re Moody's Investors Serv. Inc.*, 13 USPQ2d 2043 (TTAB 1989); *In re Niagara Frontier Servs., Inc.*, 221 USPQ 284 (TTAB 1983) (WE MAKE IT, YOU BAKE IT only identifies pizza, and does not function as a service mark to identify grocery store services); *In re British Caledonian Airways Ltd.*, 218 USPQ 737 (TTAB 1983); *In re Editel Prods., Inc.*, 189 USPQ 111 (TTAB 1975); *In re Oscar Mayer & Co.*, 171 USPQ 571 (TTAB 1971). In this case, the services to

which applicant refers are mere advertising and solicitation to purchase, or otherwise merely ancillary to the sale of applicant's own products.

Applicant argues that "the body of the video contains significant advice in the agricultural and horticultural contexts [stands on its own as advisory services]." April 30, 2020, Applicant's brief, TSDR p.

4. The Board should find this argument unpersuasive. As discussed above, the body of the video is an advertisement for applicant's own agricultural products. As seen in the evidence attached in the Request for Reconsideration Denial, applicant's products are shown poured from a container and into a tank. The video merely highlights the advantages and features of applicant's own product and does not provide separate agricultural or horticultural services. March 19, 2020 Request for Reconsideration Denial, TSDR pp. 2-6.

Applicant argues that the concluding statement of the advertisement in the substitute specimen, which states "Consult your Wilbur-Ellis representative to find out what works best for you" "is an obvious reference to services." April 30, 2020, Applicant's brief, TSDR p. 4. The Board should find this argument unpersuasive. Applicant is not providing a separate service of "Agricultural advice; Horticultural services" merely by discussing a good that is agricultural in nature. The invitation for consumers to consult a "Wilbur-Ellis" representative is for the purpose of discussing an effective "tank mix" for consumers as introduced in the beginning of the advertisement.

Applicant further argues 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" and that "these promotional materials do refer to adjuvants in general, however there is no reference to any specific product." April 30, 2020, Applicant's brief, TSDR p. 7. The Board should find this argument unpersuasive. The fact that a specific product is not referenced within the advertisement does not obviate the refusal. The audio makes clear that the advertisement is promoting and discussing a broad

category of goods, namely, tank mixes, which is explicitly referenced in the first line of the advertisement. April 30, 2020, Applicant's brief, TSDR p. 3. The advertisement makes no indication of any separable advisory service. Further, the advertising of one's own products is not a sufficiently separate and registrable service. A service is an activity that is sufficiently separate and qualitatively different from an applicant's principal activity, i.e., it cannot be an activity that is merely incidental or necessary to an applicant's larger business. TMEP §1301.01(a); see *In re Dr Pepper Co.*, 836 F.2d 508, 509-510, 5 USPQ2d 1207, 1208-1209 (Fed. Cir. 1987). In this case, a consumer's ability to discuss effective tank mixes with applicant's representatives is merely incidental to the selling of applicant's own agricultural goods and not a sufficiently separate activity. Therefore, the specimens of record fail to show use in commerce of the applied-for mark with any of the services specified in the application.

### **III. CONCLUSION**

The specimens of record show that the applicant is advertising for applicant's own agricultural goods, and does not show "TANK TO TARGET" as a service mark for "Agricultural advice; Horticultural services." Therefore, there is no direct association between the applied-for mark and the services. For the foregoing reasons, the trademark examining attorney requests that the Board affirm the refusal to register the proposed mark under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127.

Respectfully submitted,

Alexandra Liebl

/Alexandra Suarez Liebl/

Examining Attorney

Law Office 120



p) (571) 272-4845

e) [Alexandra.Suarez@uspto.gov](mailto:Alexandra.Suarez@uspto.gov)

David Miller

Managing Attorney

Law Office 120

571-272-8956

[David.Miller@uspto.gov](mailto:David.Miller@uspto.gov)