

This Opinion is not a
Precedent of the TTAB

Mailed: August 3, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Lermayer Outdoors, Inc.

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Serial No. 86128066

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William E. Anderson of Christensen Fonder PA for
Lermayer Outdoors, Inc.

Mary E. Crawford, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.

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Before Seeherman, Wolfson and Pologeorgis,
Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Lermayer Outdoors, Inc. has appealed from the refusal of the Trademark Examining Attorney to register TOON KICKER in standard characters on the Principal Register for “outboard motor mounts, namely, brackets specifically designed for connection to pontoon boats for mounting of secondary outboard motors.”¹ Registration has been refused pursuant to Section 2(e)(1) of the Trademark

¹ Application Serial No. 86128066, filed November 25, 2013, asserting first use and first use in commerce as early as January 1, 2012.

Act, 15 U.S.C. 1052(e)(1), on the ground that Applicant's mark is merely descriptive of the identified goods.

We reverse the refusal of registration.

I. Preliminary Issues

After the Examining Attorney issued a final refusal on October 3, 2014, Applicant filed a request for reconsideration along with a notice of appeal. The appeal was instituted, and the application was remanded to the Examining Attorney to consider the request for reconsideration. At page seven of this eight-page request, after arguing at length that its mark is not merely descriptive, Applicant included, in a paragraph asserting its mark is not merely descriptive, the sentence: "Further, evidence in the record further shows Applicant's goods are associated with the mark and has acquired distinctiveness." Although the TEAS sheet that forms the first page of the response makes no mention of an amendment to seek registration pursuant to Section 2(f), the Examining Attorney took note of the sentence, and treated the claim of acquired distinctiveness as an alternative claim to Applicant's position that its mark is not merely descriptive; that is, the Examining Attorney did not deem this sentence to be an admission that the mark is not inherently distinctive.

In its main brief, in a recital of the prosecution history, Applicant makes no mention of a claim for registration under Section 2(f). Applicant merely states that it submitted a request for reconsideration in which it "offered arguments against the refusal to register the mark under Trademark Act § 2(e)(1)"; that the Examining Attorney then issued a non-final Office action maintaining refusal of registration

under Trademark Act § 2(e)(1); and that Applicant submitted a response in which it offered arguments against the refusal, and that the Examining Attorney issued a final Office action. 7 TTABVUE 6.

In view of the foregoing, we do not treat Applicant's offhand mention of acquired distinctiveness as an actual amendment, even in the alternative, to seek registration pursuant to Section 2(f). Accordingly, we consider the sole issue on appeal to be whether the mark is inherently distinctive or whether it is merely descriptive of the identified goods.

We also note that in her brief the Examining Attorney objects to an argument made by Applicant (that the term "pontoon" is overwhelmingly used in reference to the flotation tubes of a boat) because Applicant failed to make any evidence of record to substantiate the argument. The Examining Attorney cites Trademark Rule 2.142(d), which provides that the record in an application should be complete prior to the filing of an appeal. In point of fact, Applicant is not attempting to submit untimely evidence, and therefore Trademark Rule 2.142(d) does not apply. However, we will consider the Examining Attorney's objection as going to the persuasive value of argument that is not supported by evidence.

II. Applicable Law

Section 2(e)(1) of the Trademark Act prohibits, *inter alia*, the registration of a mark which, when used on or in connection with the goods of the applicant, is merely descriptive of them. A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the goods or

services it identifies. See, e.g., *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Determining the descriptiveness of a mark is done in relation to an applicant's identified goods and/or services, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. See *In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219 (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). Descriptiveness of a mark is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 82 USPQ2d at 1831. In other words, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Medical Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012).

A mark is suggestive, and therefore registrable without resort to the provisions of Section 2(f) of the Act, if imagination, thought, or perception is required to reach a conclusion on the nature of the goods. *In re Gyulay*, 3 USPQ2d at 1009. See also *StonCor Group, Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1652 (Fed. Cir. 2014). Needless to say, Applicant contends that its mark is suggestive and not merely descriptive.

In support of her position that Applicant's mark is merely descriptive, the Examining Attorney has submitted evidence regarding the meaning of the individual elements of the mark, in an attempt to show that these elements are descriptive, and

that the combination of the terms results in a mark that is merely descriptive. With respect to the term “TOON,” the Examining Attorney has submitted evidence that this element is found in a number of trademarks, including the following:²

The Manitoo website, which features pontoon boats, has text referring to its “V-Toon® technology that makes our boats even more noticeable” and “the V-Toon® pontoon.”³

The JC pontoon website, which has a logo with the words TRI TOON superimposed on a seal with the words THE ORIGINAL and three stars, mentions how its “Tri Toon Classic models can achieve a maximum [speed] in the low to mid-40 mpg range” and that “Our SunToon TT and NepToon TT models generally see low to mid 30 mpg” and “[o]ur fastest models are the SportToon TT and the NepToon Sport TT....”⁴

The website for Mitey-Toon lists a Mitey-Toon Pontoon.⁵

There is an aluminum pontoon and aluminum boat cleaner sold under the trademark TOON-BRITE.⁶

² Among the evidence submitted by the Examining Attorney were pages that were retrieved by a search of google.com. March 12, 2014 Office action, pp. 7-25. Pages 7-11 of these pages consist primarily of photographs of pontoon boats, and for most of them their probative value is not readily apparent. However, there are a few photographs that show a trademark, e.g., TOON JACK on p. 7, a logo for V-TOON as an image without any goods on p. 9, a boat with the trademark POND TOON on p. 11. We discuss these third-party uses *infra*.

We note that much of the content on page 11, and all of the content for pages 12 through 25, is missing. The boxes on pages 11 through 15 each have an indicator in the top corner; it appears that when these pages are viewed online, one would “click” on a corner of each blank box in order for the image to appear. However, that did not seem to have been done, so the “screen grab” shows only the images that were actually downloaded, i.e., the images found on pages 7-11. Pages 16 through 25 have the “working” symbol that normally appears when the computer is in the process of downloading material. We can, of course, give omitted material no consideration. It must be remembered that the record stands complete at the time the Office action or the response is filed. A mere link to Internet materials is insufficient to make the materials of record. *In re Powermat Inc.*, 105 USPQ2d 1789, 1791 (TTAB 2013); TMEP § 701.01(b) (April 2016).

³ March 12, 2004 Office action, p. 3.

⁴ *Id.* at 5-6.

⁵ *Id.* at 26.

⁶ *Id.* at 28.

The website ToonBoat.com, which is apparently a blog for pontoon boaters: “A place for pontoon boat owners or anyone interested in the pontoon boating lifestyle. ... I created this site as a resource for all those owners of this great class of boat.”⁷

A posting on the Bowfishing Forum website, under the topic “Pontoon kicker bracket,” which consists of a photograph and text which reads, in its entirety, “I built this mostly out of 3 ½ inch aluminum channel to mount this kicker bracket on. will be putting my Honda bf 15 on to get out the creek where I launch an shoot fish. the last couple years they been keeping the water level down. after spending hours in my flatbottom I can,t wait to get out on my toon I been working on. [spelling and punctuation are in original].”⁸

As for “KICKER,” the Examining Attorney submitted the following:

Definitions of “kicker” from the Oxford Dictionaries (US English) that includes “*informal*, A small outboard motor.”⁹

A 2013 article from Woods-N-Water News entitled “Two Motor Trolling” that states: “the work horse of any trolling boat has been the gasoline kicker motor. A ‘kicker’ does an excellent job of trolling....” The rest of the article variously refers to “kicker” per se and “kicker motor”: “stopped putting a small gasoline kicker on the back of my boats. Instead of depending solely upon a kicker motor for trolling....”¹⁰

An article on the Walleyes Inc. website entitled “My Secret Weapon,” about fishing on the Great Lakes, that mentions “kicker motors” as being less than desirable for such fishing.¹¹

An article on the practical-fishing-tips website that discusses various motors used when trolling for fish: “If your main outboard motor is 100 HP or higher there are some advantages to having a small gasoline motor for trolling sometimes called a “Kicker” motor.”; “...the small

⁷ October 3, 2014 Office action, p. 11.

⁸ *Id.* at 8.

⁹ March 12, 2014 Office action at 34-35.

¹⁰ *Id.* at 37.

¹¹ *Id.* at 44.

9015 horse power gasoline ‘Kicker’ motor is better suited. Adding a ‘Kicker Motor’ is an additional cost....”¹²

A posting on the blog.boats.com website that includes the question, “I would like to mount a kicker...”¹³

The Examining Attorney has also submitted evidence regarding Applicant’s goods that underscores the purpose of Applicant’s mounting brackets is “for rigging an auxiliary outboard to a pontoon boat,”¹⁴ as set forth in the identification of goods.

Except for one reference in a blog, all of the uses of TOON that the Examining Attorney has made of record show that this element is part of various trademarks. The fact that a term may be used in a trademark does not prove that the term is merely descriptive. Although such use may show that a term has a significance within an industry, that significance may be a suggestive one. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d 1163, 1173 (TTAB 2011) (third-party registrations indicate term CLASSIC has suggestive meaning as applied to tobacco products). There is no dictionary evidence showing that “toon” is an abbreviation of “pontoon,” as might be expected if the term were recognized in the industry. Moreover, Applicant has submitted third-party registrations for marks that contain the word TOON that were registered without a disclaimer or pursuant to Section 2(f). *See, e.g.*, Registration No.

¹² *Id.* at 55.

¹³ October 3, 2014 Office action, p. 5.

¹⁴ Article entitled “New Toon Kicker: Auxiliary Outboard Mount for Pontoons” on boats.com blog, October 3, 2014 Office action, p. 2.

3183336 for POND TOON for “pontoon boat”; Registration No. 2152354 for TRI TOON for boats; and Registration No. 3403649 for V-TOON for pontoon boats.¹⁵ Certainly we cannot conclude only from the fact that the element TOON is contained in third-party trademarks that the term is merely descriptive. Clearly TOON is derived from “pontoon”, but these third parties might well have chosen to use TOON in their trademarks because it is *suggestive* of pontoon, not because it is the equivalent of pontoon. The only evidence we have of any non-trademark usage of “toon” is a single blogpost, but that is simply not sufficient for us to say that “toon” is an alternative term for “pontoon” or is an accepted abbreviation for that word. Given the amount of evidence that the Examining Attorney made of record (dictionary evidence, third-party registrations, Internet evidence consisting of companies selling boats and boating supplies, articles and blogs, and even images of pontoon boats), we must assume that she was unable to find any dictionary evidence or other usage of “toon” that would show it is regarded as a descriptive term. *Cf. In re The Monotype Corp. PLC*, 14 USPQ2d 1070, 1071 (TTAB 1989) (because the Examining Attorney made of record only two stories when the NEXIS search retrieved 48, and because the Examining Attorney is presumed to have made the best case possible, Board concluded that the 46 stories did not support the Office’s position).

¹⁵ The POND TOON registration was subsequently cancelled for failure to file a Section 8 affidavit. However, as discussed *supra*, one of the images retrieved by the google.com search made of record by the Examining Attorney shows the mark on a boat.

We acknowledge that no disclaimer would be required for the V-TOON registration even if the Examining Attorney considered TOON to be merely descriptive, since it is part of a hyphenated term. TMEP § 1213.05(a)(ii) (when a compound word is formed by hyphenating two words or terms, one of which would be unregistrable alone, no disclaimer is necessary).

Accordingly, we find that the Office has not met its burden to show that Applicant's mark TOON KICKER is merely descriptive. Moreover, although the evidence shows that KICKER *per se* has a recognized meaning as an auxiliary motor, that descriptive meaning is subsumed when used in the mark TOON KICKER. Because of the odd phraseology, a consumer seeing this mark for brackets designed to mount secondary outboard motors to pontoon boats would have a mental "hiccup" to understand the purpose of the goods. *See In re Southern Nat'l Bank of N.C.*, 219 USPQ 1231 (TTAB 1983) (MONEY 24 suggestive of automatic teller machine services because one must reverse the order of the elements of the mark and add words to transform the mark into a readily comprehensible expression). The mental steps a consumer would have to go through to transpose TOON KICKER brackets into "brackets for kickers used on pontoons" is enough to put TOON KICKER on the suggestive side of the "fine line" between descriptive and suggestive marks. *See In re Future Ads LLC*, 103 USPQ2d 1571, 1574 (TTAB 2012).

Decision: The refusal to register Applicant's mark TOON KICKER is reversed.