

**This Opinion is Not a
Precedent of the TTAB**

Hearing: August 18, 2020

Mailed: September 21, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Iguana Yachts
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Serial No. 87868306
—

Rebecca Gan of Wenderoth LLP,
for Iguana Yachts.

Amy Kergate, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.

—
Before Kuhlke, Greenbaum and Larkin,
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

Iguana Yachts (“Applicant”) seeks registration on the Principal Register of the
mark PRO IGUANA and Design (PRO disclaimed), displayed as



, for

Boats; amphibious vehicles; professional boats and
professional amphibious vehicles in the fields of security,

military, rescue and transport of goods and people, in International Class 12.¹

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 Applicant's



specimens of use are mere advertising that do not show use of in commerce for the identified goods. After the Examining Attorney made the refusal final, Applicant twice requested reconsideration, which the Examining Attorney denied. Applicant then appealed to this Board. The appeal is fully briefed, and an oral hearing was held on August 18, 2020. We affirm the refusal to register.

I. Background

Before we discuss the merits of the appeal, we review Applicant's three specimens.

¹ Application Serial No. 87868306 was filed on April 9, 2018 under Section 44(d) of the Trademark Act, 15 U.S.C. § 1126(d), claiming a priority filing date of March 23, 2018 based on French Application No. 184439909. In the August 4, 2018 Office Action, the Examining Attorney required, among other things, a copy of the French registration certificate (when available), and explained the options and requirements for amending the filing basis. In the January 31, 2019 Response to Office Action, Applicant retained the priority filing date, but amended the filing basis to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant's claim of first use anywhere and use in commerce since at least as early as April 9, 2018.

The application claims the colors black, blue, white and red as a feature of the proposed mark, and includes the following description thereof:

The mark consists of the stylized wording "PRO IGUANA" appearing in black with the word "PRO" enclosed within the black outline of a shield, two black dotted diagonal lines starting at the center left break in the shield and running through the top right side of the shield, and a blue rectangle, a white rectangle and a red rectangle, all with curved sides, appearing below the top border of the shield and above the word "PRO". The color white appearing behind the shield represents background only and is not part of the mark.

A. Banner/Sign

First, Applicant submitted with the January 31, 2019 Response to Office Action a photograph that Applicant identified as an “[i]mage from U.S. trade show” and a “trade show banner,” and the Examining Attorney refers to as the “sign specimen” and “a photograph of a sign appearing in an office”:

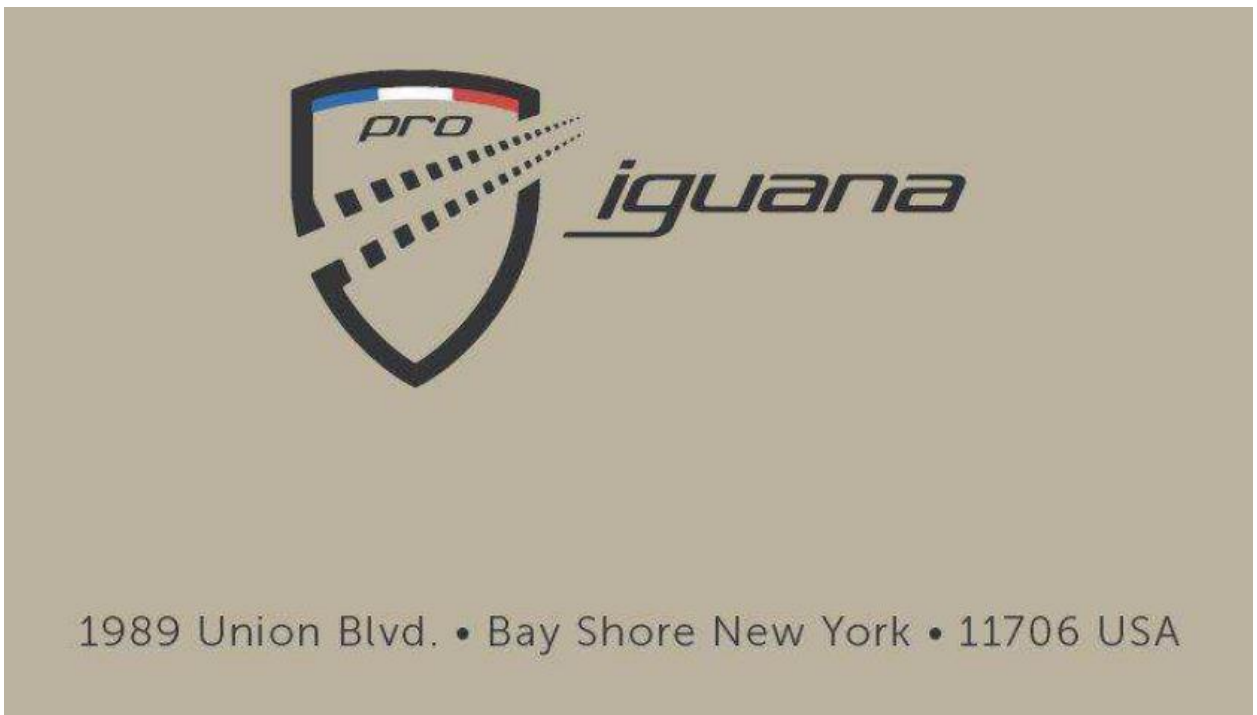


This specimen is a large sign or banner propped up on the floor, supported on the left and right lower front corners by the side arms of two red couches or chairs, in front of and below a large logo for “Impulse Technologies, Inc.” On the left side of the photograph, there is a portion of a doorway leading to an area with several items on top of and below a desk, and the corner of a file cabinet. On the right side of the

photograph, directly behind the arm of the red chair or sofa, there is a portion of what appears to be a magazine rack displaying some reading material.

B. Distributor Hand-Out/Business Card

Second, Applicant submitted with the January 31, 2019 Response to Office Action both sides of a business card for “Iguana Pro, USA Inc Mario R. Leone US Government Sales” that Applicant identified as a “distributor hand-out from trade show”:





C. Website Extract/Press Release – With “Custom Build Quote Form”

The third specimen, submitted with Applicant’s July 16, 2019 (second) Request for Reconsideration, is a screenshot of a “Bay Shore, NY, March 27, 2018” press release posted on Applicant’s website, with a “custom build quote form.” In the Request for Reconsideration, Applicant identifies this specimen as a “Website extract substantiating that Applicant participated in the April 9-11 ‘Sea-Air-Space’ trade show the largest maritime trade show held in the United States with a booth – photos of the booth have been previously provided (and improperly rejected by the Examiner)[.]”:



The latest developments and events at Iguana Pro

Bay Shore, NY, March 27, 2018

Iguana Pro, a French developer and manufacturer of high-speed amphibious boats designed for surveillance, interception and rescue missions, will be exhibiting at the upcoming Sea-Air-Space exposition to be held April 9 thru 11, 2018, at the Gaylord National Convention Center, National Harbor, MD., just south of Washington, D.C.

Produced by the Navy League of the U.S. since 1965, Sea-Air-Space is the largest maritime exposition held in the U.S. This year's event will feature over 275 exhibits showcasing the latest in maritime, defense and energy technologies, and includes professional development and expert speaker sessions.

Iguana Pro will be showcasing its IG Pro multi-purpose amphibious craft, including its IGPro 31 models which can be equipped with either shock mitigating seats or prepared flat for transport needs.

These boats have an operating range of 200 miles, achieve speeds on the water up to 57+ MPH, and come equipped with continuous tracks landing gear for onshore operators that can deploy in place in just 8 seconds.

Contact our US team to arrange an appointment or pop by Booth 1853 to visit us.

mleone@iguana-pro-usa.com

Office #: 1-631-968-4116
Cell. #: 1-631-355-4416

CUSTOM BUILD QUOTE FORM

First Name *

Last Name *

Email *

Mobile Phone

Your Message



IGUANA PRO - FRANCE
SAS IGUANA YACHTS
Le Mesnil, 50290 Bréhal, France
contact@iguana-pro.com

by



Iguana Pro USA
1969 Union Blvd
Bay Shore NY 11706

Email: mleone@iguana-pro-usa.com
Office 1-631-968-4416
Mobile 1-631-355-4116

This specimen displays Applicant's mark in the upper left corner, above an artistic rendition of the applied-for goods, and the text reads as follows:

The latest developments and events at Iguana Pro

Bay Shore, NY, March 27, 2018

Iguana Pro, a French developer and manufacturer of high-speed amphibious boats designed for surveillance, interception and rescue missions, will be exhibiting at the upcoming Sea-Air-Space exposition to be held April 9 thru 11, 2018 at the Gaylord National Convention Center, National Harbor, MD, just south of Washington, D.C.

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These boats have an operating range of 200 miles, achieve speeds on the water up to 57 + MPH, and come equipped with continuous tracks landing gear for onshore operations that can deploy in place in just 8 seconds.

Contact our US team to arrange an appointment or pop by Booth 1853 to visit us.

The lower portion of the specimen displays Mr. Leone's contact information and Applicant's addresses and phone numbers in France and the United States. The right side displays a "Custom Build Quote Form" with blocks that allow prospective purchasers to type their contact information and message.

II. Use in Commerce—Displays Associated With the Goods

Under Section 45 of the Trademark Act, 15 U.S.C. § 1127, a trademark is used in commerce when “it is placed in any manner on the goods or their containers or the displays associated therewith” *See also* Trademark Rule 2.56(b)(1), 37 C.F.R. § 2.56(b)(1). The issue on appeal, as argued by both Applicant and the Examining Attorney, is whether any of the specimens qualifies as a display associated with the goods, or whether they are mere advertising. *See In re Siny Corp.*, 920 F.3d 1331, 2019 USPQ2d 127099, *2-3 (Fed. Cir. 2019) (citing *Powermatics, Inc. v. Globe Roofing Prods. Co.*, 341 F.2d 127, 52 CCPA 950 (CCPA 1965) (“[I]t [is] well settled that mere advertising and documentary use of a notation apart from the goods do not constitute technical trademark use.”)).

The determination of whether any of the proffered specimens is merely advertising or serves the function of a display associated with the goods is a question of fact. *In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002, 2003 (TTAB 2014) (citing *In re Shipley Co.*, 230 USPQ 691, 694 (TTAB 1986)). “Factually, we need to ask whether the purported point-of-sale display provides the potential purchaser with the information normally associated with ordering products of that kind.” *In re Anpath Grp. Inc.*, 95 USPQ2d 1377, 1381 (TTAB 2010) (citing *In re Marriott*, 459 F.2d 525, 173 USPQ 799, 800 (CCPA 1972); *Lands’ End Inc. v. Manbeck*, 797 F. Supp. 511, 24 USPQ2d 1314, 1316 (E.D. Va. 1992); *Shipley*, 230 USPQ at 693-94).

Displays associated with the goods, including online displays, must be point-of-sale displays. *Lands’ End*, 24 USPQ2d at 1316 (“A crucial factor in the analysis is if

the use of an alleged mark is at a point of sale location. A point of sale location provides a customer with the opportunity to look to the displayed mark as a means of identifying and distinguishing the source of goods.”); *see also In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1122 (Fed. Cir. 2009) (quoting *In re Osterberg*, 83 USPQ2d 1220, 1222-23 (TTAB 2007) (“In [*Lands’ End*], the determinative factor was that the mark was used at the point of sale.”)). The Board has held:

[T]o be more than mere advertising, a point-of-sale display associated with the goods must do more than simply promote the goods and induce a person to buy them; that is the purpose of advertising in general. The specimen must be “calculated to **consummate a sale.**”

U.S. Tsubaki, 109 USPQ2d at 2009 (quoting *In re Bright of Am., Inc.*, 205 USPQ 63, 71 (TTAB 1979) (emphasis added)); *see also Avakoff v. S. Pac. Co.*, 764 F.2d 1097, 226 USPQ 435, 436 (Fed. Cir. 1985) (solicitation letters sent to retailers deemed mere advertisements in which use of the mark apart from the goods did not qualify as trademark use for the goods). To be calculated to consummate a sale, the specimen must contain sufficient practical information about the goods and a way to order to the goods, so as to put the prospective customer at the point of purchase. Examples include a catalog order form, a telephone number through which the consumer is invited to call in a purchase, *Lands’ End*, 24 USPQ2d at 1316, or in the case of webpage specimens, a way to “plac[e] orders for the goods via the Internet,” *Anpath Grp.*, 95 USPQ2d at 1381, such as selecting goods and adding them to a virtual shopping cart. Brochures and other advertising material may be acceptable specimens as print displays only if sufficient evidence, such as a photograph of a trade show booth, is provided showing how such specimens are used in an actual display

featuring the goods and print advertising material together. *See In re Ancha Elecs., Inc.*, 1 USPQ2d 1318, 1319-20 (TTAB 1986); TRADEMARK MANUAL OF EXAMINING PROCEDURE § 904.03(g) (2018) (“TMEP”).

On the other hand, a specimen fails to qualify as a point-of-sale display if it contains more limited information, and would require a prospective customer to “contact applicant to obtain preliminary information necessary to order the goods” before the prospective customer could actually place an order. *Anpath Grp.*, 95 USPQ2d at 1381; *see also U.S. Tsubaki*, 109 USPQ2d at 2005. In the context of affirming the Board’s decision to reject a webpage specimen because it was not a point-of-sale display, the U.S. Court of Appeals for the Federal Circuit, our primary reviewing court, held that substantial evidence supported the Board decision:

[The Board] noted the absence of information it considered essential to a purchasing decision, such as a price or range of prices for the goods, the minimum quantities one may order, accepted methods of payment, or how the goods would be shipped. J.A. 8. The Board also considered the “For sales information:” text and phone number contact. It assumed that the phone number would connect a prospective customer to sales personnel, but it found that “if virtually all important aspects of the transaction must be determined from information extraneous to the web page, then the web page is not a point of sale.” J.A. 9; *see* J.A. 6 (“A simple invitation to call applicant to get information—even to get quotes for placing orders—does not provide a means of ordering the product.” (quoting *In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002, 2005 (TTAB 2014))). The Board further noted the absence of any evidence (as opposed to attorney argument) of how sales are actually made—e.g., documentation or verified statements from knowledgeable personnel as to what happens and how. J.A. 9.

Siny, 2019 USPQ2d 127099, *3.

III. Analysis

Applicant's argument is best summarized in its own words:²

Applicant's 2018 Sea-Air-Space trade show booth is clearly a point-of-sale, and either Applicant's banner or business cards distributed at the trade show more than qualify as displays associated with [the identified goods.] *In re Ancha Electronics Inc.*, 1 USPQ2d 1318 (TTAB 1986) (informational flyers showing the mark which were distributed at trade shows exhibits considered displays associated with the goods). Similarly, Applicant's website extracts with integrated 'custom build quote form' for the same goods also qualifies as a display, because Applicant's website displays the mark in such a way that Applicant's customers of specialized amphibious boats, including the U.S. Government, would immediately associate Applicant's



Mark, , with Applicant's watercraft, and is calculated to consummate a sale since it provides a means of obtaining a custom build quote on such watercraft.

In other cases, the Board has found that the prominent display of the trademark on a trade show booth where product literature is distributed and orders for the goods are taken is a display associated with the goods, *ShIPLEY*, 230 USPQ at 693-94, and that informational fliers or leaflets clearly depicting the mark and presented on the goods at trade show exhibits are acceptable displays associated with the goods. *Ancha Elecs.*, 1 USPQ2d at 1320. In *ShIPLEY*, the Board found based on the applicant's declaration, "applicant's trade show booths are more than sites for the distribution of

² Applicant's Reply Brief, 8 TTABVUE 7. Applicant makes essentially the same arguments in its main Brief, although its first argument is worded differently: "Applicant's trade show display and business cards handed out at the trade show features Applicant's Mark in 'such a way that the customer can easily associate the mark with the goods' and are 'calculated to consummate a sale.'" (citations omitted). 5 TTABVUE 16.

advertising literature; these booths are also sales counters for applicant's products, including the chemicals for use in fabrication of printed circuit boards." 230 USPQ at 693. Accordingly, the Board held that "[a] purchaser, upon seeing such literature describing applicant's chemicals for use in the fabrication of printed circuit boards and being provided with the opportunity to buy these products at the trade show booths would, we think, associate the mark that is prominently displayed on that booth with such goods." 230 USPQ at 694. *See also Ancha Elecs.*, 1 USPQ2d at 1319 (applicant's declaration supported applicant's argument that specimens at trade show were point of sale materials).

Here, however, there is no evidence that Applicant attended the 2018 Air-Sea-Space trade show,³ that the photograph of the banner/sign depicted above is a photograph of Applicant's booth at that trade show (or any trade show), or that Mr. Leone's business cards were distributed at that trade show (or any trade show). We have only the unsupported arguments of Applicant's counsel, which are "no substitute for evidence." *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018 (quoting *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005))).

Moreover, the photograph does not show anything one would expect to see at a trade show (e.g., any booths or any people). The visual cues in the photograph, including the use of red couches or chairs to prop up the banner/sign, the portion of a

³ Applicant's March 27, 2018 press release is not even evidence that that there actually was a trade show on April 9-11, 2018.

doorway leading to another space with a desk and file cabinet, and the large logo of another company, Impulse Technology, Inc., above the banner/sign, suggest that the photograph was taken in the office of Impulse Technology, Inc., not at any trade show. Absent any corroborating evidence depicting or describing point-of-sale presentation, Applicant's banner/sign is merely advertising material that does not qualify as a display associated with the goods. *Cf. Ancha Elecs.*, 1 USPQ2d at 1319 (applicant's declaration supported applicant's argument that specimens at trade show were point of sale materials). This evidentiary infirmity applies equally to the business card specimen. As the Board stated in *Osterberg*, 83 USPQ2d at 1224, "applicant's mere statement that he distributed copies of the webpage at sales presentations is not sufficient to persuade us that the Intellx webpage is a display used in association with the goods."

As for the "Custom Build Quote Form" appearing on the right side of the webpage with Applicant's press release, this form simply seeks a prospective purchaser's contact information, and does not enable direct ordering of the goods. Nor is there evidence, such as documentation or verified statements from knowledgeable personnel (as opposed to unverified statements from Applicant's counsel), as to how sales actually are made. Consequently, the form does not demonstrate use of the proposed mark in commerce. *See Siny*, 2019 USPQ2d 127099, *3; *U.S. Tsubaki*, 109 USPQ2d at 2009.

Applicant cites *In re Valenite Inc.*, 84 USPQ2d 1346, 1349-50 (TTAB 2007) and TMEP § 904.03(i)(c)(2) as support for the proposition that its goods are specialized

and the “custom build quote form” provides a means for its customers, including the U.S. Government, to obtain a quote.⁴ In *Valenite*, however, appellant submitted the declaration of its director of marketing, who testified that appellant’s customers regularly order its products by contacting the customer service department by telephone. There is nothing similar in this record. In fact, in *U.S. Tsubaki*, the Board explained the need for the type of evidentiary support that is lacking here by citing, with approval, the evidence in the *Valenite* case:

If applicant wished to show that orders for its industrial chain cannot readily be ordered by reference to particular goods and pricing information, and are regularly ordered by telephone following customer review of technical information in its specimens and consultation with employees of applicant, so that applicant’s specimens are viewed as point of sale displays, applicant was obligated to introduce such evidence to rebut the prima facie case made by the Trademark Examining Attorney. In cases such as this, where it is asserted that the nature of the goods and the consumers therefor require more involved means for ordering products, it is critical that the examining attorney be provided with detailed information about the means for ordering goods, and that such information be corroborated by sufficient evidentiary support, for example, a declaration from the applicant about its process for taking and filling orders, as in the *Valenite* case. At best, applicant’s catalog pages provides applicant’s telephone number and domain name as information about applicant; the telephone number and domain name do not constitute a means to order applicant’s chains by telephone or the Internet.

U.S. Tsubaki, 109 USPQ2d at 2006-07.

⁴ Applicant’s Reply Brief, 8 TTABVUE 6-7.

Finally, the mere listing of telephone numbers and emails on the business card and “webpage extract” do not transform what are otherwise ordinary advertisements into a point-of-sale display or a “display used in association with the goods” and, thus, into valid specimens showing technical trademark use. *Cf. In re Genitope Corp.*, 78 USPQ2d 1819, 1822 (TTAB 2006) (“[T]he company name, address and phone number that appears at the end of the web page indicates only location information about applicant; it does not constitute a means to order goods through the mail or by telephone, in the way that a catalog sales form provides a means for one to fill out a sales form or call in a purchase by phone.”).

In short, there is no evidence that any of the specimens qualify as acceptable displays associated with the goods under Section 45 of the Trademark Act. On this record, we find instead that Applicant’s specimens are merely advertisements that do not show the proposed mark used in commerce as a trademark for the identified “boats; amphibious vehicles; professional boats and professional amphibious vehicles in the fields of security, military, rescue and transport of goods and people.”



Decision: The refusal to register Applicant’s proposed mark is affirmed.