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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	87868306
Applicant	Iguana Yachts
Applied for Mark	PRO IGUANA
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Application Serial No.:

87/868,306



Mark:

Applicant:

Filed:

Appealed:

Examining Attorney:

Law Office:

Iguana Yachts

April 9, 2018

October 2, 2019

Amy L. Kertgate

113

**APPLICANT'S EX PARTE APPEAL BRIEF**

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## **INTRODUCTION**

Applicant, Iguana Yachts, respectfully appeals the Examining Attorney's refusal to




register , in U.S. Trademark Application Serial No. 87/868,306 (hereinafter also referred to as the "Applicant's Mark") in connection with goods in International Class 12. The Examining Attorney's refusal to register Applicant's Mark in connection with these goods under Sections 1 and 45 of the Trademark Act of 1946, 15 U.S.C. §§1051, 1127, is inappropriate because Applicant's specimen of record clearly shows use of Applicant's Mark in U.S. commerce for goods in International Class 12.

## **PROSECUTION HISTORY**

Applicant filed an application seeking registration on the Principal Register for the



mark , for use in connection with (as currently amended): "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. The application was based on priority of a French application under Section 44(d), and was assigned U.S. Trademark Application Serial No. 87/868,306, with a filing date of April 9, 2018.

On August 4, 2018, the Examining Attorney issued a non-final Office Action refusing registration and requiring a disclaimer, amendment to the mark description, and submission of the corresponding French registration certificate.

Applicant responded to the Examining Attorney's non-final Office Action on January 31, 2019, in which Applicant entered a disclaimer, entered an amendment to the

mark description, and added the current use in commerce filing basis under Section 1(a) and stated that Applicant does not intend to rely on Section 44(e) as the basis for registration, but is only asserting a valid claim of priority.

On March 4, 2019, the Examining Attorney issued a second non-final Office Action in which the disclaimer was accepted, the requirement for a copy of the corresponding French registration certificate was withdrawn, the requirement for an acceptable mark description was maintained, and two new refusals were added: the specimens do not show the mark in the drawing in use in commerce in International Class 12; and the specimens in International Class 12 appear to be mere advertising material and thus the specimens fail to show Applicant's Mark in use in commerce, under Trademark Act Sections 1 and 45.

Applicant responded to the Examining Attorney's second non-final Office Action on April 18, 2019, in which Applicant amended the color claims and mark description, and stated that the application was in condition for publication.

The Examining Attorney issued a Final Office Action on May 16, 2019, in which the requirement for an acceptable mark description, and the two refusals under Trademark Act Sections 1 and 45 (the specimens do not show the mark in the drawing in use in commerce in International Class 12; and the specimens in International Class 12 appear to be mere advertising material and thus the specimens fail to show Applicant's Mark in use in commerce), were all maintained and made final.

Applicant responded to the Final Office Action on June 11, 2019, through a Request for Reconsideration, in which Applicant again amended the color claims and

mark description, and argued against the refusals under Trademark Act Sections 1 and 45.

The Examining Attorney denied the Request for Reconsideration on July 10, 2019, maintaining and continuing to be final the refusal to register under Trademark Act Sections 1 and 45, based on the specimens in International Class 12 appearing to be mere advertising material and thus the specimens fail to show Applicant's Mark in use in commerce. The Examining Attorney withdrew the refusal based on the specimens not showing the mark in the drawing in use in commerce in International Class 12, and withdrew the requirement for an acceptable description of the mark.

Applicant again responded to the Final Office Action on July 16, 2019, through a second Request for Reconsideration, in which Applicant again argued against the remaining refusal under Trademark Act Sections 1 and 45, and submitted additional specimens.

The Examining Attorney denied the second Request for Reconsideration on August 8, 2019, maintaining and continuing to be final the refusal to register under Trademark Act Sections 1 and 45, based on the specimens in International Class 12 appearing to be mere advertising material and thus the specimens fail to show Applicant's Mark in use in commerce.

On October 2, 2019, Applicant timely filed a Notice of Appeal with the Board. See 1 TTABVUE. The Board acknowledged, instituted, and suspended the appeal on the same day. See 2 TTABVUE. The Board subsequently issued an order resuming proceedings on October 17, 2019. See 4 TTABVUE.



## SUMMARY OF EVIDENCE

### Evidence of Record:

- A. 2018 Sea-Air-Space trade show banner and station for, *e.g.*, boats; amphibious vehicles; professional boats and professional amphibious vehicles in the fields of security, military, rescue and transport of goods and people;
- B. Business cards handed out at 2018 Sea-Air-Space trade show; and
- C. Website display with integrated “custom build quote form” for, *e.g.*, boats; amphibious vehicles; professional boats and professional amphibious vehicles in the fields of security, military, rescue and transport of goods and people.


## ARGUMENT

### I. SECTIONS 1 & 45 REFUSAL

Somehow, the Examining Attorney has refused registration under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051 and 1127, on the ground that Applicant failed to submit a specimen of use showing proper use of the mark in commerce.

Applicant’s specimen of record includes a trade show banner from the 2018 Sea-Air-Space trade show, the largest maritime exposition held in the United States, which



shows Applicant’s Mark, , pictures of Applicant’s “boats; amphibious vehicles; professional boats and professional amphibious vehicles in the fields of security, military, rescue and transport of goods and people,” the accompanying text “surveillance, black ops,<sup>1</sup> life-saving” and “extraordinary ground capabilities, gasoline engine, hydraulic

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<sup>1</sup> The Board may take judicial notice of dictionary definitions. “Black Ops” or “Black Operations” are defined as “secret military activities, especially illegal ones, that are ordered by a government or organization but that they will not admit to having ordered.” **Cambridge Advanced Learner’s Dictionary & Thesaurus © Cambridge University Press** <<https://dictionary.cambridge.org/us/dictionary/english/black-ops>> (last accessed December 16,

distribution, stainless sprocket wheel, fiber reinforced tracks, stainless tensioner.” Attendant to the trade show banner is a business card for Applicant’s U.S. sales office, which lists the contact information for Applicant’s “US Government Sales” point person, as well as a picture of Applicant’s “boats; amphibious vehicles; professional boats and professional amphibious vehicles in the fields of security, military, rescue and transport of goods and people.”



2019). *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013) (judicial notice taken of definition from Merriam-Webster Online Dictionary and Thesaurus); *In re Dietrich*, 91 USPQ2d 1622, 1631 n.15 (TTAB 2009) (judicial notice taken of definition from Merriam-Webster Online Dictionary from [www.merriam-webster.com](http://www.merriam-webster.com)); *In re Petroglyph Games Inc.*, 91 USPQ2d 1332, 1334 n.1 (TTAB 2009) (judicial notice taken of definition from Dictionary.com because taken from The Random House Unabridged Dictionary).



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## **Iguana Pro , USA Inc**

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Applicant further submitted a website screenshot of Applicant's "Custom Build Quote Form" and additional information regarding its participation in the Sea-Air-Space trade show.



## 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 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.

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### CUSTOM BUILD QUOTE FORM

First Name \*

Last Name \*

Email \*

Mobile Phone

Your Message

Submit



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The Trademark Act “provides for registration of a mark based on use of the mark in commerce.” *In re Siny Corp.*, 920 F.3d 1331, 2019 USPQ2d 11362, \*2 (Fed. Cir. 2019). The USPTO “requires an applicant to submit a specimen of use ‘showing the mark as used on or in connection with the goods.’” *Id.* (quoting *In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1120 (Fed. Cir. 2009)); see 37 C.F.R. § 2.56(a).

A mark is deemed in use in commerce on goods when, *inter alia*, “it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto.” *Siny*, 2019 USPQ2d 11362, \*2 (quoting 15 U.S.C. § 1127).

“Section 45 of the Trademark Act does not define the term ‘display associated therewith,’” *In re Kohr Bros., Inc.*, 121 USPQ2d 1793, 1794 (TTAB 2017) (quoting *In re Shipley Co.*, 230 USPQ 691, 692 (TTAB 1986)).

Nevertheless, the Board “must make a case-by-case determination of whether a particular use asserted to be a ‘display’ is adequate to demonstrate use in commerce,” *Kohr Bros.*, 121 USPQ2d at 1794 (quoting *Shipley Co.*, 230 USPQ at 692), and the Board’s primary reviewing court has “cautioned against bright-line rules in this context.” *Siny*, 2019 USPQ2d 11362, \*3.

“A display used in association with the goods is essentially a point-of-sale display designed to catch the attention of purchasers as an inducement to consummate a sale.” *Kohr Bros.*, 121 USPQ2d at 1795 n.5 (quoting *In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002, 2003 (TTAB 2014)). An important “factor in the analysis of whether a specimen is an acceptable display used in association with the goods is whether the mark is displayed in [ ] . . . such a way that the customer can easily associate the mark with the goods.” *Kohr*

*Bros.*, 121 USPQ2d at 1795 (quoting *In re Osterberg*, 83USPQ2d 1220, 1223 (TTAB 2007)). A display “must be designed to catch the attention of purchasers and prospective purchasers as an inducement to make a sale,” and “must prominently display the mark in question and associate it with, or relate it to, the goods.” *Kohr Bros.*, 121 USPQ2d at 1795 (quoting TMEP § 904.03(g)). *In re Duvernoy & Sons, Inc.*, 212 F.2d 202, 101 USPQ 288, 289 (CCPA 1954) (“[W]e think it is clear from the exhibits that Duvernoy & Sons, Inc., appellant’s trade name (generally shown in large, fanciful letters), is relied upon to denote origin and that ‘Consistently Superior’ is merely an adjunct thereto, operating in the shadow thereof, to indicate to purchasers that appellant’s goods are always superior in quality.”).

Applicant’s trade show booth is clearly a point of sale. *In re Ancha Electronics Inc.*, 1 USPQ2d 1318 (TTAB 1986) (informational flyers showing the mark which were distributed at trade shows exhibit considered displays associated with the goods); *In re Shipley Co. Inc.*, 230 USPQ 691 (TTAB 1986) (display of mark at trade show where consumers could order the goods held to be a point-of-sale display associated with the goods); *Siny*, 2019 USPQ2d 11362, \*3 (In determining whether a specimen qualifies as a display associated with the goods, one important consideration is whether the display is at a point-of-sale location (citing *Sones*, 93 USPQ2d at 2009)); *Lands’ End Inc. v. Manback*, 797 F. Supp. 511, 24 USPQ2d 1314, 1316 (E.D.Va. 1992) (“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.”); *In re ITT Rayonier Inc.*, 208 USPQ 86 (TTAB 1980), *In re Bright of America, Inc.*, 205 USPQ 63 (TTAB 1979); *In*

*re Griffin Pollution Control Corp.*, 517 F.2d 1356, 186 USPQ 166 (CCPA 1975) (use of the mark in descriptive materials distributed to the public in areas where gas-generating apparatus dispenses a mixture of gases is a display associated with the goods); *In re Marriott Corporation*, 459 F.2d 525, 173 USPQ 799 (CCPA 1972) (menu considered display directly associated with the goods); and TMEP § 808.05.

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." *U.S. Tsubaki*, 109 USPQ2d at 2009 (quoting *In re Bright of America, Inc.*, 205 USPQ 63, 71 (TTAB 1979)); see also TMEP § 904.03(g) ("These items must be designed to catch the attention of purchasers and prospective purchasers as an inducement to make a sale").

Similarly, Applicant's website with its integrated "Custom Build Quote Form" also 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, because it provides a means of obtaining a custom build quote on such watercraft.

## II. CONCLUSION

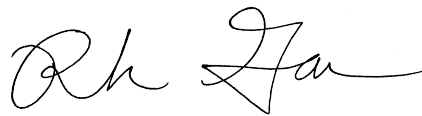
This Board's reviewing court has cautioned against the Office's application of "rigid, bright-line rule(s)" on specimen issues. See *In re Sones*, 590 F.3d 1282, 1288–89 (Fed. Cir. 2009) (holding that "a picture is not a mandatory requirement for a website-based specimen of use" and disapproving of the "rigid, bright-line rule" the PTO applied).

Indeed, the Lanham Act does not set forth specific requirements that a specimen of use must meet in order to demonstrate the source or origin of the goods. *Id.*; *see also In re Anpath Grp.*, 95 USPQ2d 1377, 1381 (TTAB 2010) (the crucial issue is “whether the purported point-of-sale display provides the potential purchaser with the information normally associated with ordering products of that kind”); *see also In re Marriott* at 526 (“The terms of the statute [15 USC §1127] are met if the mark is placed ‘in any manner’ on the ‘displays associated’ with the goods.”).

As such, Applicant respectfully submits that the Examining Attorney’s partial refusal should be REVERSED, and Applicant’s Mark should be advanced to publication for public opposition.

Dated this 16<sup>th</sup> day of December 2019.

Respectfully submitted,



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