

This Opinion is Not a
Precedent of the TTAB

Mailed: July 25, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re FMC Technologies, Inc.
—

Serial No. 88705569
—

Henry Query for FMC Technologies, Inc.

Jennifer O'Brien, Trademark Examining Attorney, Law Office 121,
Richard White, Managing Attorney.

—
Before Goodman, English and Thurmon, Administrative Trademark Judges.

Opinion by Thurmon, Administrative Trademark Judge.

FMC Technologies, Inc. ("Applicant") seeks registration on the Principal Register
of the mark SUBSEA 2.0, in standard characters, with SUBSEA disclaimed, for

Oil and gas drilling, production, processing and transportation system components of metal, namely, wellheads, tubing hangers, tree caps, manifolds, risers, running tools and landing strings; manually operated metal flow control valves and parts thereof; metal pipes, tubulars, flowlines and pipelines; flexible pipes comprising primarily [sic] metal parts, in International Class 6;

Parts of machines for oil and gas drilling, production, processing and transportation systems, namely, christmas [sic] trees, wellheads, tubing hangers, tree caps, manifolds and risers; riserless and riser-based well access systems comprised of risers, tension frames, slick joints, telescopic

joints, stress joints, tension joints, surface flow trees, circulation heads, lubricator valves, retainer valves, lubricators, upper lubricator packages, lower lubricator packages, lubricator tubulars, pressure control heads, well control packages, lower circulation modules, chemical injection units, subsea test trees, landing strings, landing string accumulator modules, running tools, emergency disconnect packages, workover control modules, hydraulic power units, hydraulic distribution units, control panels, umbilicals and umbilical reels, for oil and gas drilling, production, processing and transportation systems; landing strings being parts of machines; power operated tools for the installation, maintenance, workover and intervention of oil and gas wells and oil and gas drilling, production, processing and transportation system components; parts of machines for oil and gas drilling, production, processing and transportation systems, namely, flow control valves and chokes; power operated pneumatic, electric and hydraulic valve actuators; pumps being machines for oil and gas drilling, production, processing and transportation; couplings for machines, namely, power actuated connectors and couplings for oil and gas drilling, production, processing and transportation system components; electric, hydraulic and electro-hydraulic controls for operating oil and gas drilling, production, processing and transportation system components; umbilicals, namely, assemblies of electrical power cables, data transmission cables and flexible fluid conduits, in International Class 7; and,

Oil well Christmas trees in the nature of an assembly of valves, spools, and fittings that control the flow of oil or gas out of a well; control valves for regulating the flow of gases and liquids; electric controls for operating oil and gas drilling, production, processing and transportation system components; workover control systems comprised of control panels, control stations, control modules, umbilicals, umbilical reel systems, hydraulic power units, hydraulic distributions units and sensors, for use in controlling and operating oil and gas drilling, production and processing system components, in International Class 9.¹

¹ Application Serial No. 88705569 was filed on November 25, 2019 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

The Examining Attorney finally refused registration under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1127 on the ground that Applicant's specimen is mere advertising of the goods and not a use as a mark in commerce. Applicant appealed. This matter is fully briefed. We affirm the refusal.

I. Background

The application was filed under Section 1(a) and a specimen was submitted with the application.² The Examining Attorney found the original specimen "to be mere advertising" of the goods rather than a trademark use on or in connection with the goods.³ In response, Applicant amended its filing basis to Section 1(b), effectively withdrawing the original specimen.⁴ There were no other outstanding refusals, so the amendment placed the application in proper condition for publication, which occurred in January 2021.⁵

Citations in this opinion to the briefs refer to TTABVUE, the Board's online docketing system. See *New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Applicant's appeal brief appears at 4 TTABVUE and its reply brief appears at 7 TTABVUE. The Examining Attorney's brief appears at 6 TTABVUE.

Citations in this opinion to the application record are to pages in the Trademark Status & Document Retrieval ("TSDR") database of the United States Patent and Trademark Office ("USPTO").

² November 25, 2019 application with specimen.

³ Office Action dated March 16, 2020. Aaron Rosenthal of Law Office 120 handled the pre-publication examination of this application and issued this Office Action.

⁴ Response to Office Action dated September 15, 2020. Applicant also amended its identification of goods, resulting in goods in International Classes 6, 7 and 9. The original application placed all goods in Classes 6 and 7.

⁵ Notice of Publication dated December 23, 2020.

Following publication (without opposition) and issuance of a notice of allowance, Applicant filed a Statement of Use along with a new specimen, which is reproduced below:



Subsea 2.0™
Simpler, Leaner, Smarter



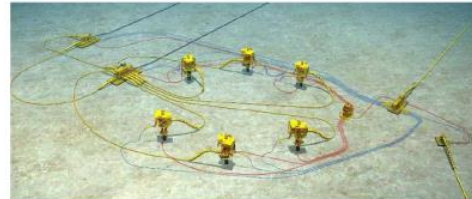
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Transforming subsea with iEPCI and Subsea 2.0

Combining Subsea 2.0™ and iEPCI™ maximizes the impact that simpler, leaner and smarter make – improving subsea economics and helping unlock first oil and gas faster, while maintaining the same or better functionality.



Subsea 2.0™ components compared to prior generation of equipment



Subsea 2.0™ configured and installed in the field





⁷ 7

⁶ Specimen dated September 3, 2021.

⁷ *Id.* at 2.

Compact tree summary

Key Differences	Subsea 1.0	Subsea 2.0™	Outcome
<ul style="list-style-type: none"> No change in functionality No change in tooling required Retrievable components (choke, meter, controls) 			<p>-50% weight</p> <p>-50% delivery time</p>



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Compact manifold summary

Key Differences	Subsea 1.0	Subsea 2.0™	Outcome
<ul style="list-style-type: none"> Compact block enables elimination of piping and welding Inline design for installation with flowline Available with robotic valve control, electric actuators or manual valves 			<p>-50% size & weight</p> <p>-40 to 70% part count</p> <p>-50% delivery time</p>



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⁸ *Id.* at 3.

⁹ *Id.* at 4.



Flexible jumpers summary

Key Differences	Subsea 1.0	Subsea 2.0™	Outcome
<ul style="list-style-type: none"> • 10,000 psi (690 bar) working pressure • New lower cost polymer pressure sheath • Standardized structure designs 			<ul style="list-style-type: none"> • Faster delivery and lower cost • Avoid jumper metrology for ease of installation • Enables longer offsets to optimize well placement and lower drilling costs • Multiple installation methods



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Distribution summary

Key Differences	Subsea 1.0	Subsea 2.0™	Outcome
<ul style="list-style-type: none"> • Design for inline / modular installation with umbilical • Flow rates: Low: < 3.2m3/hr Medium: < 15m3/hr High: < 30m3/hr Very high: < 60m3/hr • Inline structures designed to guarantee they can be transported in the vessel reel, and meets size criteria of API 17 TR-9 (unreleased) Category "A" 			<p>-40 to 60% weight of UTA</p>



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¹⁰ *Id.* at 5.

¹¹ *Id.* at 6.

Controls summary



Key Differences	Subsea 1.0	Subsea 2.0™	Outcome
<ul style="list-style-type: none"> • Power management capabilities • 100% uptime electronics system • Future proofing and field configurable • No leakage and contamination tolerant hydraulics • Weld and wire free integrated design • Modernized and industrial computer 			<p>-60% weight</p> <p>-80% delivery time</p> <p>-30% footprint</p>



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Horizontal connectors summary

Key Differences	Subsea 1.0	Subsea 2.0™	Outcome
<ul style="list-style-type: none"> • End fitting integrated into body of connector for optimized interface 			<p>-50% size and weight</p>



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¹² *Id.* at 7.

¹³ *Id.* at 8.



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The Statement of Use identifies the specimen as: “slides from a live sales presentation given to potential customers for purposes of soliciting orders for the equipment.”¹⁵ The Examining Attorney found two problems with this specimen. First, she found that it constituted mere advertising rather than trademark use.¹⁶ Second, she found the specimen failed to include “a description or indication of the specific goods being shown” and therefore it was “unclear that the applied-for goods [were] being offered.”¹⁷ Applicant responded, arguing the slide presentation was a proper specimen as “a display associated with the goods” and “show[ed] use of the mark directly associated with the goods in International Classes 6, 7, and 9.”¹⁸ In addition,

¹⁴ *Id.* at 9. The specimen covers 27 pages, but it appears to be three copies of the nine pages shown above. It is not helpful to the Office when parties submit duplicative materials.

¹⁵ Statement of Use dated September 3, 2021 at 2-3.

¹⁶ Office Action dated October 2, 2021.

¹⁷ *Id.*

¹⁸ Response to Office Action dated April 1, 2022.

Applicant submitted a declaration of Scott Pickett, its Senior Legal Counsel. In his declaration, Mr. Pickett makes the following statements concerning the slide presentation:

2. The attached document, entitled “Subsea 2.0™ Simpler, Leaner, Smarter”, is a set of select slides from a sales package Applicant’s sales personnel provided to Applicant’s prospective customers over a period of time beginning in early 2018. The slides were presented to Applicant’s prospective customers for the purpose of obtaining orders for the “Subsea 2.0” branded products illustrated therein.¹⁹
3. The third page of the attached select set of slides, which is page 25 of the complete set of slides, is labeled “Compact tree summary”. This slide contains a picture of Applicant’s Subsea 2.0 christmas [sic] tree directly below the mark “Subsea 2.0”.²⁰
4. The fourth page of the attached select set of slides, which is page 26 of the complete set of slides, is labeled “Compact manifold summary”. This slide contains a picture of Applicant’s Subsea 2.0 manifold directly below the mark “Subsea 2.0”.²¹
5. The fifth page of the attached select set of slides, which is page 27 of the complete set of slides, is labeled “Flexible jumpers summary”. This slide contains a picture of Applicant’s Subsea 2.0 flexible jumper directly below the mark “Subsea 2.0”.²²
6. The seventh page of the attached select set of slides, which is page 29 of the complete set of slides, is labeled “Controls summary”. This slide contains a picture of Applicant’s Subsea 2.0 control modules directly below the mark “Subsea 2.0”.²³

¹⁹ *Id.* at 8.

²⁰ *Id.*

²¹ *Id.*

²² *Id.* at 9.

²³ *Id.*

7. The products identified in paragraphs 3-6 hereof were available for sale at the time the sales package containing the attached select set of slides was provided to Applicant's prospective customers.²⁴

The Examining Attorney issued a final Office Action finding the slides were mere advertising and not a use of the mark on or in connection with the goods.²⁵ The Examining Attorney withdrew the refusal based on the specimen's "failure to show use in commerce with any of the specified goods for the goods not being shown."²⁶

II. Analysis

"To ensure that the applicant uses the mark in commerce ..., the PTO requires the applicant to submit a specimen of use 'showing the mark as used on or in connection with the goods.'" *In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1120 (Fed. Cir. 2009) (quoting 37 C.F.R. § 2.56(a) (2009)). A trademark is used in commerce when "it is placed in any manner on the goods or their containers or the displays associated therewith" 15 U.S.C. § 1127; *see also* Trademark Rule 2.56(b)(1), 37 C.F.R. § 2.56(b)(1). The specific question before us is whether the submitted specimen shown above, as explained by Mr. Pickett's testimony, constitutes a "display[] associated" with the goods or is mere advertising of the goods. *See In re Siny Corp.*, 920 F.3d 1331, 2019 USPQ2d 127099 at *2-3 (Fed. Cir. 2019) ("Mere advertising is not enough to qualify as such a display.").²⁷

²⁴ *Id.*

²⁵ Final Office Action dated May 12, 2022.

²⁶ *Id.*

²⁷ The determination of whether the proffered specimen is merely advertising or serves the function of a point-of-sale 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

To constitute such a display, the specimen must satisfy two requirements: (1) it must show use of the mark directly associated with the goods; and, (2) it must be a point-of-sale display or the equivalent of such a display. 37 C.F.R. § 2.56(b)(1). Applicant agrees that this is the question before the Board.²⁸ We examine only the second requirement below because we find that the slide presentation is not the equivalent of a point-of-sale display.

One way to distinguish advertising from point-of-sale materials is to ask how closely the materials are connected to purchases. Applicant argues that its slide presentation is similar to the trade show booth displaying the applicant's mark in *In re Shipley*, 230 USPQ 691. In *Shipley*, the goods were chemicals used in the fabrication of integrated circuit boards. *Id.* at 693-94. The evidence of record showed that the goods were ordered at the trade show booth, which associated the mark with the actual purchasing of the goods. *Id.* Applicant argues that it used the specimen here (the slide presentation) in a similar manner, that is, to present information about the goods to prospective customers in order to make a sale.²⁹ Indeed, Mr. Pickett declared that the slides were used by Applicant's sales force when meeting with prospective customers.³⁰

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).

²⁸ 4 TTABVUE 9.

²⁹ Response to Office Action dated April 1, 2022 at 8.

³⁰ *Id.* at 8.

There are similarities between the *Shipley* facts and those presented here. In both instances, displays (read broadly) were used to market the goods. But marketing alone isn't enough, because "to 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." *U.S. Tsubaki*, 109 USPQ2d at 2009.

We find Applicant's specimen shown above is not equivalent to a point-of-sale display like the trade show booth in *Shipley*. There are a few distinct reasons for this finding. First, the record here lacks the sort of detailed product information provided by the applicant in *Shipley*. The declaration in *Shipley* stated "Shipley sales personnel are at the booth at all times during the show promoting **and selling** Shipley's products." *Shipley*, 230 USPQ at 694 (emphasis added); *In re Hydron Techs., Inc.*, 51 USPQ2d 1531, 1533 (TTAB 1999) (observing that "[t]he crucial factor in [*Shipley*] was that the mark was being used at the point of sale, i.e. at the location where the goods could be ordered[.]"). There is no evidence in the record of selling the goods through use of the slide presentation, only that such slides were used "for the purpose of obtaining orders."³¹ When and how would such orders be made? Are they made immediately after the sales presentation, or is a quote submitted or discussed during the sales presentations? We don't know. Applicant's explanation and the specimen fail to show any direct connection between the slide presentation and a sale. See *In re Osterberg*, 83 USPQ2d 1220, 1224 (TTAB 2007) ("[T]he mere statement that

³¹ Response to Office Action dated April 1, 2022 at 8.

advertising and promotional materials are used in connection with sales presentations is not sufficient, in and of itself, to transform advertising and promotional materials into displays used in association with the goods.”). It is hardly surprising that the slide presentations, like any other marketing for goods of this nature, are done to “obtain orders.”

Where the applicant in *Shiplely* presented evidence that the goods were sold at the trade show booth, Applicant here provides no such evidence. The slides at issue here do not provide any information about purchasing the goods. There is no order form, no pricing information or information about how to obtain a quote, and no other information that would link the specimen to the purchasing of the goods. A point-of-sale display is directly connected to sales, that is, the goods are available for purchase at or using the point-of-sale display. *In re Hydron Techs., Inc.*, 51 USPQ2d 1531, 1533 (TTAB 1999) (observing that “[t]he crucial factor in [*Shiplely*] was that the mark was being used at the point of sale, i.e. at the location where the goods could be ordered[.]”). There is nothing in the record here that explains how or when sales are made, only that the goods “were available for sale at the time the sales package containing the attached select set of slides was provided to Applicant’s prospective customers.”³² That statement is too open-ended to make the slides equivalent to a point-of-sale display.

The record in *Shiplely* also contained product literature for the goods sold under the mark at issue. *Shiplely*, 230 USPQ at 694. This information allowed purchasers

³² *Id.* at 9.

to make informed purchasing decisions during the trade show. *Id.* at 693-94. The slides at issue here lack such detail. Most of the information either describes certain features of the goods or compares the Subsea 1.0 and Subsea 2.0 versions in terms of performance. This is general marketing information, not detailed product information that would enable one to make a purchase. *Anpath Grp.*, 95 USPQ2d at 1381 (“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.”).

For example, the third slide provided is titled “Compact tree summary,” and shows two pieces of equipment, one in the Subsea 1.0 column and another in the Subsea 2.0 column.³³ Under key differences, the slide provides the following information in bullet form:

- No change in functionality
- No change in tooling required
- Retrievable components (choke, meter, controls)³⁴

In the final column, on the right, the slide states: “-50% weight” and “-50% delivery time”.³⁵ There is no other information on the slide. Other slides are similar in this respect.

³³ Specimen dated September 3, 2021 at 3.

³⁴ *Id.*

³⁵ *Id.*

It is unlikely a customer would buy a compact tree from Applicant using only the information on this slide. What are the dimensions? We know the Subsea 2.0 version is half the weight of the Subsea 1.0 version, but that doesn't tell us the weight of Subsea 2.0. Does this item come in different sizes? Does it require outside power or control systems to operate? If so, what are the specifications for those connections? We surely are only scratching the surface concerning the type of technical information a purchaser would need to buy Applicant's goods. The slides are clearly not intended to provide that sort of detailed technical information. The Board explained in a case that also involved industrial goods:

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

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

Another reason we find the slide presentation is not a display associated with the goods is that these were confidential presentations. The final slide states, in small print "This document and all information herein are confidential, and may not be used, reproduced or distributed without prior authorization of TechnipFMC." Trademark use is, by definition, a public use, at least within the relevant market. *See, e.g., New England Duplicating Co. v. Mendes*, 190 F.2d 415, 90 USPQ 151, 153 (1st Cir. 1951) (to establish trademark rights requires "use in a way sufficiently public to identify or distinguish the marked goods in an appropriate segment of the public

mind as those of the adopter of the mark”); *Blue Bell, Inc. v. Farah Mfg. Co.*, 508 F.2d 1260, 185 USPQ 1, 4 (5th Cir. 1975) (“undisclosed internal shipments are generally inadequate to support the denomination ‘use.’”).

If the confidential notice on the slide presentation was meant only to protect certain confidential product information, and if the slides were widely-used within the relevant market, perhaps the confidential nature of the presentation would not be problematic. But we have no evidence to inform us on this point. We only know the presentation was confidential, and that fact cuts against Applicant’s arguments.

III. Conclusion

For the reasons given above, we find the specimen constitutes mere advertising rather than a display associated with the goods.

Decision: The refusal is affirmed.