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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78841309
Applicant	Brunswick Corporation
Applied for Mark	SMART TOW
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Submission	Appeal Brief
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Application of:	)	CERTIFICATION OF ELECTRONIC SUBMISSION
BRUNSWICK CORPORATION	)	
Serial No. 78/841,309	)	I hereby certify that this correspondence is being submitted electronically with the United States Patent and Trademark Office's electronic filing system (EFS Web) on this 20th day of July, 2007.
Filed: March 20, 2006	)	
Examining Attorney: John M. Gartner	)	
Law Office: 102	)	Jo Ann Kuczynski 7-20-07 Jo Ann Kuczynski Date
Mark: SMART TOW	)	

APPLICANT'S BRIEF ON APPEAL

MAIL STOP: TTAB
NO FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Sir:

Applicant appeals from the Examining Attorney's January 31, 2007 final refusal to register the above-identified pending application. Attached hereto is the Applicant's Brief on Appeal.

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1 USPQ2d 1233, 1235-1236 (TTAB 1986) 18

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Application of:	)
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BRUNSWICK CORPORATION	)
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Serial No. 78/841,309	)
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Filed: March 20, 2006	)
	)
Examining Attorney: John M. Gartner	)
	)
Law Office: 102	)
	)
Mark: SMART TOW	)

APPLICANT'S BRIEF ON APPEAL

MAIL STOP: TTAB
NO FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Sir:

Applicant appeals from the Examining Attorney's January 31, 2007 final refusal to register the above-identified pending application.

I. THE RECORD

Applicant filed the present application on March 20, 2006.

The Examining Attorney refused registration in a final Office Action dated January 31, 2007. Registration was finally refused under Trademark Act §2(e)(1) because the mark for which registration is sought is deemed to merely describe the goods.

The record consists of the following communications between Applicant and the Examining Attorney:

A. Application filed March 20, 2006;

B. First Office Action dated August 22, 2006;

C. Applicant's Response dated September 25, 2006;

D. Second Office Action finally refusing registration dated November 28, 2006;

E. Applicant's Response dated December 13, 2006;

F. Refusal of Request for Reconsideration of January 31, 2006; and

F. Applicant's Notice of Appeal dated May 23, 2007.

II. SUMMARY OF THE APPLICATION

The Applicant has applied for registration of the mark SMART TOW for watercraft speed control systems, namely computer controllers having operating software for the launch and cruise of a watercraft. The application was filed based upon Applicant's intent to use the mark in commerce. Applicant has subsequently begun using the mark on the listed goods in United States interstate commerce.

The mark is for use on Applicant's new and inventive computer controllers for controlling acceleration of a watercraft. The controllers operate software that is designed to control the instantaneous velocity of the watercraft over a designated period of time, which changes as the watercraft accelerates from its standstill condition to a desired speed. The controllers establish an rpm-based set-point and allow the watercraft driver to choose a launch pattern of the watercraft. The end result is the rider receives a consistent out-of-the-hole launch and a desired rpm set point. The goods are touted as being useful for towing a water-skier behind the watercraft. However, the controller and software in fact only control watercraft acceleration and are not directly concerned with whether or not the watercraft is used to tow a water-skier or any other object.

III. SUMMARY OF THE EXAMINING ATTORNEY'S POSITION

The Examining Attorney has refused registration on the Principal Register because the proposed mark is deemed to merely describe the nature of Applicant's goods according to Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); TMEP §§1209 *et seq.*

The Examining Attorney relies upon selected dictionary definitions of the terms "smart" and "tow" and states that "combined as the term SMART TOW the mark immediately describes the fact that the goods allow for the towing of watercraft using

controllers equipped with microprocessors." See first Office Action dated August 22, 2006.

The Examining Attorney states that a term need not describe all of the purposes, functions, characteristics or features of the goods to be merely descriptive. For the purpose of a Section 2(e)(1) analysis, it is sufficient that the term describe only one attribute of the goods to be found merely descriptive. The Examining Attorney reasons that

> "in this case, the fact that the goods can be, and in fact are meant to be, used while towing is enough for a finding of descriptiveness. It is clear from Applicant's own description of the goods that they are primarily marketed as goods intended to assist watercraft drivers in smoothly accelerating when towing someone in connection with water sports. Again, the goods provide a 'smart tow' in that they provide a microprocessor-controlled tow for tow-based water sports."

The Examining Attorney cites third party publications and comments made by a representative of the Applicant in support of his conclusion. See second, final Office Action dated November 28, 2006 and Refusal of Request for Reconsideration dated January 31, 2007.

IV. SUMMARY OF THE APPLICANT'S POSITION

Applicant seeks reversal of the refusal to register its mark.

The mark SMART TOW is suggestive and is not merely descriptive of the goods. The mark SMART TOW suggests that the representative goods involve some kind of intelligent or electronic act or way of towing. However it requires imagination, thought, perception and mental gymnastics to reach a conclusion about the nature of Applicant's goods. The association created between the mark and the goods is also subtle enough so that the mark would not be needed by competitive sellers to fairly describe their goods. Applicant therefore believes that the mark is registrable.

V. ARGUMENTS

QUESTION PRESENTED

The question presented is whether the mark SMART TOW is merely descriptive or is suggestive of watercraft speed control systems, namely computer controllers having operating software for the launch and cruise of a watercraft. Applicant strongly asserts that SMART TOW is suggestive, and is not merely descriptive of the goods.

THE DESCRIPTIVENESS / SUGGESTIVENESS DISTINCTION

A mark is merely descriptive under Section 2(e)(1) of the Trademark Act where, as applied to the goods in question, the mark immediately describes an ingredient, quality, characteristic, function, feature, composition, purpose, attribute, use, etc., of such goods. The question of whether a particular term is merely descriptive must not be determined in the abstract, but in relation to the goods for which registration is sought, the context in which the mark is used, and the significance that the mark is likely to have to the average purchaser as he or she encounters the goods or services bearing the mark in the marketplace. *In re Quick-Print Copy Shop Inc.*, 203 USPQ 624 (TTAB 1979).

Suggestive terms also shed light upon the characteristics of the goods or services, but as applied they involve some element of incongruity, and, in order to be understood as descriptive, they must be taken in a suggestive or figurative sense through an effort of imagination on the part of the observer. *General Shoe Corp. v. Rosen*, 45 USPQ 196 (4th Cir. 1940). It is not prohibited that a mark has the capacity to draw attention to the nature of the product or service or to its characteristics. *See e.g., The Nautilus Group, Inc. v. Icon Health and Fitness, Inc.*, 372 F.3d 1330 (Fed. Cir. 2004) (BOWFLEX suggestive and not descriptive of exercise equipment containing flexible bows).

In contrast to merely descriptive terms, suggestive marks are distinctive and are good, registrable trademarks. As the Fourth Circuit explained:

> ...if the words are merely suggestive of the character of the goods or the properties which users of the mark wish the public to attribute to them and not merely descriptive, the mark will be good.

W.G. Reardon Laboratories v. B&B Exterminators, Inc., 71 F.2d 515, 517(4th Cir. 1934). Indeed, the Court of Customs and Patent Appeals, which is the predecessor of the Court of Appeals for the Federal Circuit, commented that in its opinion the best marks are often highly suggestive. *Van Camp Sea Food Co. v. The Alexander B. Stewart Organization*, 50 F.2d 976, 979 (CCPA 1931).

There are several tests for determining the difference between a suggestive mark and a descriptive mark. Two commonly-used tests are discussed in the following section and applied to the mark SMART TOW.

SMART TOW IS SUGGESTIVE AND NOT MERELY DESCRIPTIVE

The Degree of Imagination Test

The primary test for determining the difference between descriptive marks and suggestive marks is the "Degree of Imagination Test". According to this test, a descriptive term directly and immediately conveys information about the ingredients, qualities or characteristics of the product or services. *Continental Grain Co. v. Central Soya Co., Inc.*, 1995 U.S. App. Lexis 31379 (Fed. Cir. 1995). A suggestive mark also

provides information about the product or service, but a suggestive mark only suggests these things. Under the Degree of Imagination Test, the question is: *How immediate and direct is the thought process from the mark to the particular characteristic of the product?* If the mental leap between the word and the product attributes is not almost instantaneous, this strongly indicates suggestiveness, not descriptiveness. *Id. at *10.* The U.S. Trademark Office Trademark Trial and Appeals Board (TTAB) applied the "Degree of Imagination Test" in *Airco, Inc. v. Air Products & Chemicals, Inc.*, 196 USPQ 832 (TTAB 1977), to distinguish between descriptive and suggestive marks.

> The mark AIR-CARE is, moreover, not merely descriptive as applied to Applicant's services. The literal meaning of the mark, namely, "care of the air", may, through an exercise of mental gymnastics and extrapolation, suggest or hint at the nature of Applicant's services, but it does not, in any clear or precise way, serve merely to describe Applicant's preventative maintenance services directed to a scheduled maintenance program for hospital and medical anesthesia and inhalation therapy equipment.

In the present application, the mark SMART TOW may through an exercise of mental gymnastics and extrapolation, suggest or hint at the nature of Applicant's goods, but it does not serve to merely describe the Applicant's goods. More specifically:

- A first cognitive step is necessary to recognize that the mark SMART TOW denotes a system for controlling watercraft speed.
- A second cognitive step is necessary to recognize that SMART TOW denotes computer controllers.
- An even further cognitive step is necessary to recognize that SMART TOW relates to software for controlling launch and cruise of a watercraft.

Whereas, the designations "computer controllers" or "software for controlling a watercraft" are descriptive of the Applicant's goods, the mark SMART TOW simply suggests that the representative goods involve some kind of intelligent or electronic act or way of towing. It requires imagination, thought, perception and mental gymnastics to reach a conclusion about the nature of Applicant's watercraft speed control systems. Therefore according to the standard set forth by the TTAB, the mark SMART TOW cannot be descriptive.

The Competitors' Needs Test

Another test for determining the difference between descriptive marks and suggestive marks is the "Competitors' Needs Test". This test asks: *Is the suggestion made by the mark subtle enough so that it is not likely to be needed by competitive sellers*

to describe their goods? If yes, then the mark is suggestive and not merely descriptive. If however the message conveyed by the mark about the goods is so direct and clear that competitors would be likely to require the term when describing their goods, the mark is descriptive. *Rodeo Collection, Ltd., West Seventh*, 2 U.S.P.Q.2d 1204, 1206 (9th Cir. 1987). The Competitor's Needs Test is directly related to the Degree of Imagination Test because the more imagination required and the less immediate and direct the thought process is from the mark to the particular characteristic of the goods, the less likely the mark is to be required by a competitor.

To Applicant's knowledge, there are no competitive sellers currently using the mark SMART TOW to describe watercraft speed control systems, namely computer controllers having operating software for the launch and cruise of a watercraft. Rather, competitive sellers are describing their watercraft speed control systems with completely different words, such as for example the PerfectPass® "Speed Control System". Therefore, according to the Competitors' Needs Test, the mark SMART TOW is not descriptive.

REBUTTAL OF THE EXAMINING ATTORNEY'S POSITION

In the present application, the Examining Attorney relies upon both dictionary definitions and trade publications to argue that the term SMART TOW is merely

descriptive. Dictionary definitions can help to determine whether a term has a descriptive meaning. Articles from trade publications evidencing use by others of the mark in a descriptive manner are also useful to prove descriptiveness. *In re Omaha Nat'l Corp.*, 2 U.S.P.Q.2d 1859 (Fed. Cir. 1987).

In the first Office Action, the Examining Attorney refers to the dictionary definitions of the terms "smart" and "tow" to arrive at the conclusion that the mark is merely descriptive. That is, the term "smart" can be defined as "electronic: fitted with a built-in microprocessor" and the term "tow" can be defined as "to pull something such as a barge or a broken-down car along by a rope or chain attached to it". The Examining Attorney concludes that the mark is descriptive because it "immediately describes the fact that the goods allow for the towing of watercraft using controllers equipped with microprocessors". See Office Action dated August 22, 2006.

In the second Office Action, the Examining Attorney references use of the mark in printed advertising to supplement the analysis set forth in the first Office Action. The Examining Attorney also asserts that the term "smart" has been held merely descriptive of automated devices, citing *In re Cryomedical Sciences Inc.*, 32 USPQ2d 1377, 1378 (TTAB 1994) and *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002). Specifically, the Examining Attorney states that:

> "the fact that the goods can be, and in fact are meant to be, used while towing is enough for a finding of descriptiveness. It is clear from

> Applicant's own description of the goods that they are primarily marketed as goods intended to assist watercraft drivers in smoothly accelerating when towing someone in connection with water sports. Again, the goods provide a "smart tow" in that they provide a microprocessor-controlled tow for tow-based water sports. In fact, one online source has described the Applicant's goods as an "electronic tow system."

See Office Action dated November 8, 2006.

In the Refusal of Request for Reconsideration, the Examining Attorney cites additional print media wherein a representative of the Applicant states that the goods "allow someone with little experience to tow like an expert." See Refusal of Request for Reconsideration dated January 31, 2007.

The Examining Attorney's analysis is flawed for several reasons. Firstly, Applicant agrees that the literal meaning of the mark SMART TOW can be understood as "an electronic or intelligent act or instance of towing." In spite of this however, per the Degree of Imagination Test, it is only through an exercise of mental gymnastics and extrapolation that this definition suggests or hints at the nature of Applicant's goods. The Examining Attorney's dictionary definitions do not, in any clear or precise way, serve to

merely describe computer controllers having operating software for the launch and cruise of a watercraft.

The validity of the analysis above is evidenced by the fact that the Examining Attorney, even with the benefit of the cited advertisements and the description of goods in the present application, incorrectly characterized the goods in the first Office Action. The initial mental impression of the Examining Attorney himself, **incorrectly** characterizing the goods, strongly evidences the lack of descriptiveness of the mark. In the first Office Action, the Examining Attorney states that "...the mark immediately describes the fact that the goods allow for the towing of watercraft using controllers equipped with microprocessors". However, as stated above, the Applicant's watercraft speed control systems can be used to tow a water-skier, but they are not for towing watercraft. It was not until the Applicant provided further explanation of the nature of the goods (see Applicant's Response dated September 25, 2006) that the Examining Attorney fully understood the goods represented by the mark.

Secondly, the Examining Attorney cites case law regarding composite marks having the word "smart" combined with a second, highly descriptive word (e.g., SMART*PROBE* for surgical *probes*; SMART*TOWER* for cooling *towers*) (emphasis added). However the present application is clearly distinguishable from the cited cases because in the present application the word "smart" is combined with the suggestive word "tow". The word "tow" is at most suggestive of the goods because it only suggests

to prospective consumers that the goods are in some way related to the pulling of an object. The actual goods could be a hitch for attachment to a trailer, or a cable system for use on a tow truck, or a system that controls operation of a transmission of a towing vehicle to avoid damage to the vehicle when it is towing another vehicle, or any one of a multitude of alternative items. Clearly the word "tow" does not immediately or merely describe computer controllers having operating software for the launch and cruise of a watercraft.

As stated above, the Examining Attorney also refers to discussion of the Applicant's products in printed advertising media as evidence of the descriptiveness of the mark. Initially, Applicant notes that contrary to the advertisements cited by the Examining Attorney, the goods designated by the mark are in fact primarily related to speed control and acceleration control for watercraft rather than a "tow system". More specifically, the goods control the instantaneous velocity over a designated period of time, which changes as the boat accelerates from its standstill condition to a desired speed. The goods establish an rpm-based set-point control and allows the boat driver to choose a launch pattern of the watercraft. The end result is the rider receives a consistent out-of-the-hole launch and a desired rpm set point. The goods are touted as being useful for towing a water-skier behind the watercraft. However, the controller and software in fact only control watercraft acceleration and are not directly concerned with whether or not the watercraft is used for towing.

Thirdly, the Examining Attorney correctly states that for a mark to be descriptive, it must "immediately" describe a feature or characteristic of the goods. On this basis, the Examining Attorney reasons that the mark SMART TOW is descriptive because it "immediately describes the fact that the goods allow for the towing of watercraft using controllers equipped with microprocessors". See the first Office Action, dated August 22, 2006. However if, as the Examining Attorney states, the composite mark SMART TOW conveys one possible end result from the use of the Applicant's goods, *i.e.* that an object will be intelligently or electronically towed, case law clearly states that the mark is suggestive and not descriptive. For example, in *In re Nalco Chemical Co.*, the Trademark Trial and Appeal Board concluded that the term "VERI-CLEAN," as applied to Applicant's chemical anti-fouling additives for use in refineries, is suggestive of the desired end result of the use of the Applicant's additives, but does not serve to describe the goods themselves. 228 U.S.P.Q. 972, 973 (T.T.A.B. 1986). Many other cases have historically applied this same line of reasoning while performing a "descriptiveness" analysis. *See e.g., In re C.J. Webb, Inc.*, 182 U.S.P.Q. 63 (TTAB 1974) ("BRAKLEEN" suggestive of a desired result of a brake cleaner and therefore not descriptive); *In re Universal Water Systems, Inc.*, 209 U.S.P.Q. 165 (TTAB 1980) ("PURITY" applied to water filtering units, water filter cartridges, and water softening units, merely suggestive of the end result); *In re Recovery, Inc.*, 196 U.S.P.Q. 830 (T.T.A.B. 1977) ("RECOVERY" merely suggestive of the result of services of, inter alia, providing group

therapy in the form of self-help aftercare to follow psychiatric or other professional counseling and/or treatment); *In re Frank J. Curran Co.*, 189 U.S.P.Q. 560 (T.T.B.B. 1975) ("CLOTHES FRESH", as used in connection with a clothes and shoe spray deodorant, are "merely suggestive of a possible desirable end result, but do not in any accepted concept of descriptiveness serve to describe the Applicant's goods").

SMART TOW IS NOT MERELY DESCRIPTIVE

Even if the mark SMART TOW could somehow be considered descriptive of Applicant's goods, it is not *merely* descriptive because it projects multiple meanings, i.e., "tow" may pertain to multiple types of goods such as, for example, automobiles such as tow trucks, airborne gliders, etc. It is settled that where a mark as applied to its goods or services has two or more meanings, one of which is descriptive, the mark is not merely descriptive as applied to those goods or services. *C. Henry Siegel Company v. M&R Mfg. Company*, 4 USPQ 2d 1154, 1159 (TTAB 1987); *In re Colonial Stores, Inc.*, 157 USPQ 382, 385 (CCPA 1968); *In re National Tea Company*, 144 USPQ 286, 287 (TTAB 1965). Here, Applicant has shown that the mark SMART TOW may suggest the towing of trucks. Second, the mark SMART TOW may suggest the towing of aircraft. Third, the mark may suggest towing of watercraft. As such, the mark SMART TOW is not merely descriptive of Applicant's watercraft speed control systems.

THE COMPOSITE MARK IS NOT DESCRIPTIVE

The unique combination of the terms "smart" and "tow" provides a unique overall impression which, when viewed as a whole, is distinctive. To support this assertion, Applicant refers the Board to some of the numerous existing U.S. Trademark Registrations in International Class 9 that consist of a combination of the word "smart" and a merely descriptive term. As discussed above, the word "tow" is not merely descriptive of the Applicant's goods. Certainly if the following marks are registrable on the Principle Register, the present application is also registrable on the Principle Register.

Registration No.	Mark	Goods/Services
2,982,894	SMARTSWIPE	Prepaid telecommunications calling cards, magnetically encoded
2,962,337	SMART AC	AC/DC inverters
3,045,848	SMARTFEED	Electrical controller for use in water treatment systems to regulate addition of chemicals to cooling systems
3,051,515	SMART TAPE	Measuring tape

Registration No.	Mark	Goods/Services
3,070,711	SMARTWHEEL	Force measurement device for analyzing manual wheelchair propulsion, which collects data to calculate the forces and kinetics of manual wheelchair propulsion and is comprised of an instrumented wheel with a three-beam strain gage system mounted to the handrim, and includes mechanical components, electrical components and user interface software, and which may be used in medical rehabilitation research, and in rehabilitation and wheelchair clinics.
3,097,496	SMART CLIPS	Terminator for insulated electrical wire used for medical devices
3,103,199	SMART CABLES	Universal electrical conductor cables

ANY DOUBT SHOULD BE RESOLVED BY PUBLISHING THE MARK

Applicant further notes that if there is any doubt as to the character of the Applicant's mark SMART TOW, that doubt must be resolved in favor of the Applicant. *See In re Bel Paese Sales Co.*, 1 USPQ2d 1233, 1235-1236 (TTAB 1986). Doubt is properly resolved by publishing the mark and allowing any person that believes he or she would be damaged by the registration of the mark to file an opposition.

VI. CONCLUSION

As discussed above, the Applicant's mark is suggestive and not merely descriptive. The mark is therefore allowable on the Principal Register and such action is earnestly solicited.

Respectfully submitted,

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