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SERIAL NO: 78/841309

MARK: SMART TOW



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EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

Applicant is appealing the examining attorney's refusal to register the standard character mark SMART TOW for goods identified as "watercraft speed control systems, namely, computer controllers with operating software for the launch and cruise of a watercraft," in International Class 9. Pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), the applicant's mark, when used on or in connection with the identified goods, merely describes those goods.

STATEMENT OF FACTS

On March 20, 2006, applicant filed U.S. Application Serial No. 78841309 to register the standard character mark SMART TOW on the Principal Register for goods identified as

“watercraft speed control systems, namely, computer controllers with operating software for the launch and cruise of a watercraft,” in International Class 9.

In an Office action dated August 22, 2006, the examining attorney refused registration of the mark under Section 2(e)(1) of the Trademark Act on the grounds that applicant’s mark, when used in connection with the identified goods, merely describes those goods.

In a response filed September 26, 2006, applicant set forth reasons as to why the Section 2(e)(1) refusal should be withdrawn.

In an Office action dated November 27, 2006, the examining attorney made final the refusal to register the mark.

On December 15, 2006, applicant filed a request for reconsideration, which the examining attorney denied on January 31, 2007.

On May 23, 2007, applicant filed a notice of appeal and on June 20, 2007, applicant filed its appeal brief. On July 25, 2007, the Trademark Trial and Appeal Board forwarded the application file to the examining attorney for his brief.

ARGUMENT

A mark is merely descriptive under Section 2(e)(1) if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP §1209.01(b).

In this case, applicant has applied to register the mark SMART TOW for goods identified as “watercraft speed control systems, namely, computer controllers with operating software for the launch and cruise of a watercraft.” The definition of SMART is: “Fitted with a built-in microprocessor smart traffic signals.” The definition of TOW: is: “To pull something such as a barge or a broken-down car along by a rope or chain attached to it.” Please see dictionary definitions attached to the examining attorney’s August 22, 2006 Office action. Combined as the term SMART TOW the mark immediately describes the fact that the goods allow for towing using controllers equipped with microprocessors.

Applicant itself acknowledges that the mark is immediately descriptive of the goods when applicant writes: “Applicant agrees that the literal meaning of the mark SMART TOW can be understood as ‘an electronic or intelligent act or instance of towing’” (applicant’s appeal brief, p. 12). Because the goods do, in fact, provide microprocessor-

controlled towing functions, the mark is immediately descriptive of the function and purpose of the goods, even under the meaning given to the mark by applicant.

Despite this acknowledgement by applicant as to the meaning of SMART TOW, applicant argues that the mark is nevertheless suggestive. In making this argument, however, applicant makes two fundamental errors regarding the standards used to determine descriptiveness under Trademark Act Section 2(e)(1).

Applicant argues that the mark is suggestive because too many mental steps are required to connect the mark with the goods:

- 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.
- A third 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.

(Applicant’s appeal brief, p. 9 [emphasis in the original]).

In presenting this argument, applicant makes two fundamental errors regarding the standards used to determine descriptiveness. First, applicant’s argument suggests that in

order for a mark to be descriptive, one must be able to “guess” what the goods and services are simply by viewing the mark in a vacuum. That, however, is not the proper test for descriptiveness. The determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978); *see, e.g., In re Polo Int’l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (DOC in DOC-CONTROL would be understood to refer to the “documents” managed by applicant’s software, not “doctor” as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (CONCURRENT PC-DOS found merely descriptive of “computer programs recorded on disk” where relevant trade uses the denomination “concurrent” as a descriptor of this particular type of operating system). “Whether consumers could guess what the product is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985); *see* TMEP §1209.01(b).

In this case, the question would not be whether users can deduce from the words SMART TOW that the goods comprise “watercraft speed control systems, namely, computer controllers with operating software for the launch and cruise of a watercraft.” Rather, the question is whether users, already knowing that the goods comprise such computer controllers, would view SMART TOW as immediately descriptive of such computer controllers. In fact SMART TOW, used in connection with “watercraft speed control systems, namely, computer controllers with operating software for the launch and cruise of a watercraft” does immediately describe the function of the computer controllers because it immediately describes the fact that the controllers allow the identified

watercraft to provide a “smart” or microprocessor-assisted tow. Using this test, no amount of imagination, thought or perception is required to determine the purpose of the goods. For this reason, applicant’s related argument that the goods could be understood to be “a hitch for attachment to a trailer, or a cable system for use on a tow truck” carries little weight, as the goods are understood to be used with watercraft and not with tow trucks or trailers (see applicant’s appeal brief, pp. 14 and 16).

The second error applicant makes regarding the standards used to determine descriptiveness is in stating that “the designations ‘computer controllers’ or ‘software for controlling a watercraft’ are descriptive of the applicant’s goods,” with the implication that only marks that describe the physical nature or generic name of the goods are descriptive of those goods. Applicant makes a similar argument later in its appeal brief, writing “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” (applicant’s appeal brief, p. 14). However, to be descriptive it is not necessary for a mark to only describe the physical nature of the goods. A mark that describes the purpose or function of the goods is considered descriptive as well. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP §1209.01(b).

In this case, the mark SMART TOW immediately describes a function of the goods, that is, that they provide a “smart” or microprocessor-assisted tow. The record is very clear

on this point. A press release made of record by applicant in its September 26, 2006 response reads, in part: “Good tow-sports drivers just got a lot easier to come by. Mercury Marine introduces SmartTow, a precise and easy-to-use control system boat drivers can program to achieve smooth and consistent launch and cruise control for water sports activities.” A screen capture from the website www.fishingandboats.com made of record by the examining attorney in his November 27, 2006 Office action announces the arrival of the SmartTow system under the headline “Mercury Launch a New electronic tow system.” A screen capture from the website www.ibinews.com made of record by the examining attorney in his January 31, 2007 Office action quotes Ben Duke, SmartTow product manager, as saying: “It emulates a driver with 20 year’s towing experience with the push of a button. It allows someone with little experience to tow like an expert.” Applicant, in its appeal brief, states that “the goods are touted as being useful for towing a water-skier behind a watercraft” (applicant’s appeal brief, pp. 3, 14). Applicant clearly wishes for its consumers to understand that SMART TOW is meant to provide microprocessor-controlled towing for watercraft.

Applicant argues that “the unique combination of the terms ‘smart’ and ‘tow’ provides a unique overall impression, which, when viewed as a whole, is distinctive” (applicant’s appeal brief, at p. 17).

A mark that combines descriptive terms is generally not registrable unless the composite creates a unitary mark with a unique, non-descriptive meaning or commercial impression. *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) (SMARTTOWER merely

descriptive of “commercial and industrial cooling towers and accessories therefor, sold as a unit”); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS held merely descriptive of “computer software for use in the development and deployment of application programs on a global computer network”); *In re Shiva Corp.*, 48 USPQ2d 1957 (TTAB 1998) (TARIFF MANAGEMENT held merely descriptive for “computer hardware and computer programs to control, reduce and render more efficient wide area network (WAN) usage and printed user manuals sold therewith”); *In re Putnam Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE merely descriptive of “a news and information service updated daily for the food processing industry, contained in a database”); *In re Copytele, Inc.*, 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of “facsimile terminals employing electrophoretic displays”); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (CONCURRENT DOS and CONCURRENT PC-DOS held merely descriptive of “computer programs recorded on disk”).

In this case, the examining attorney has shown that SMART is immediately descriptive of applicant’s goods because they are microprocessor-controlled and that TOW is immediately descriptive of applicant’s goods because they are used for pulling. Combining the two terms into SMART TOW does nothing to change the immediately descriptive meaning of these words. The combination does not, for instance, create a double entendre, or an incongruity, or a slogan, or any other unitary, non-descriptive meaning. Rather, the combination of the two terms creates a mark that simply refers to microprocessor-assisted towing, which is an immediately descriptive term when used in

connection with “watercraft speed control systems, namely, computer controllers with operating software for the launch and cruise of a watercraft.”

Applicant argues that, “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.”

The fact that an applicant may be the first and sole user of a merely descriptive or generic designation does not justify registration where the evidence shows that the term is merely descriptive of the identified goods and/or services. *In re Acuson*, 225 USPQ 790 (TTAB 1985) (COMPUTED SONOGRAPHY descriptive of ultrasonic imaging instruments); *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983) (SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE held apt descriptive name for conducting and arranging trade shows in the hunting, shooting and outdoor sports products field); TMEP §1209.03(c).

Finally, applicant argues that there are other marks that use SMART plus a descriptive term on the register.

Third-party registrations are not conclusive on the question of descriptiveness. Each case must be considered on its own merits. A proposed mark that is merely descriptive does

not become registrable simply because other similar marks appear on the register. *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977); TMEP §1209.03(a).

Regardless of what marks may be on the register, the term “smart” has been held merely descriptive of automated devices. *See In re Cryomedical Sciences Inc.*, 32 USPQ2d 1377, 1378 (TTAB 1994) (SMARTPROBE merely descriptive of disposable cryosurgical probes); *See also In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) (SMARTTOWER merely descriptive of “commercial and industrial cooling towers and accessories therefor, sold as a unit”). The record shows that applicant’s goods are “smart” goods as that term is understood in the cases cited above.

CONCLUSION

When used in applicant’s mark in connection with applicant’s goods, SMART immediately describes the fact that the goods are microprocessor-controlled and TOW immediately describes the fact that the purpose of the goods is to assist in pulling things. The combination of these two descriptive terms does not create a unitary mark with a separate, non-descriptive meaning; rather, the terms, when combined, retain their descriptive meanings. Based on the foregoing, the refusal to register SMART TOW under Section 2(e)(1) of the Trademark Act for the goods identified herein is proper and should be affirmed.

Respectfully submitted,

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