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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
Correspondence Address	Peter T. Holsen Andrus, Sceales, Starke & Sawall LLP Suite 1100100 East Wisconsin Avenue Milwaukee, WI 53202 UNITED STATES peterh@andruslaw.com
Submission	Reply Brief
Attachments	2007_09_17_MT5343_3798-00054_Applicant's_Reply_Brief_on_Appeal.pdf (12 pages)(109651 bytes)
Filer's Name	Peter T. Holsen
Filer's e-mail	peterh@andruslaw.com, aleshiap@andruslaw.com
Signature	/peter t holsen/
Date	09/17/2007

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
Filed: March 20, 2006)	being deposited with the Commissioner for
Examining Attorney: John M. Gartner)	Trademarks on this 17th day of September
)	2007 via the Electronic System for
Law Office: 102)	Trademark Trials and Appeals.
)	
Mark: SMART TOW)	
)	
)	<i>Aleshia Prange</i> 09/17/07
)	Aleshia Prange Date

APPLICANT'S REPLY BRIEF ON APPEAL

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

Sir:

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

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Commissioner for Trademarks
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Sir:

I. SUMMARY OF ARGUMENT

The Examining Attorney has failed to meet his burden of showing that the mark SMART TOW is merely descriptive rather than suggestive.

The Examining Attorney has drastically changed his position as to what he contends is merely descriptive. Initially, the Examining Attorney concluded that "... the mark immediately describes the fact that the goods allow for the towing of watercraft ..." (First Office Action, p. 2, L10-11). His conclusion that the mark immediately described the "towing of watercraft" was based on the Examining Attorney's review of applicant's description of goods set forth in the application and dictionary definitions based on internet research. When applicant pointed out that none of the evidence cited by the Examining Attorney showed that the goods are for "towing of watercraft," the Examining

Attorney changed his position and alleged that applicant's mark merely described a feature or characteristic of the goods (*see*, Final Office Action, p. 2, L24-25). In its Brief on Appeal, applicant refuted the Examining Attorney's contention that the mark merely described a feature or characteristic of the goods themselves. Thereafter, the Examining Attorney again changed his position in the Examining Attorney's Appeal Brief¹ to now contend that applicant's mark is merely descriptive of a function of applicant's goods (*see*, Examining Attorney's Appeal Brief, p. 5, L7 and p. 6, L5). The Examining Attorney's latest newly submitted contention is also without merit, as will be more fully set forth herein. In any event, the Examining Attorney's repeated changes in position as to what applicant's mark merely describes constitutes strong evidence that applicant's mark is suggestive, not merely descriptive.

The Examining Attorney has failed to refute that applicant's mark only suggests a "desired result" obtained by the usage of applicant's goods, and does not merely describe a function of the goods, as erroneously contended by the Examining Attorney. Further, applicant's mark results in ambiguities such that no single meaning of applicant's mark is immediately apparent (e.g., different meaning to applicant's customers, the Examining Attorney's multiple changes of position, etc.). The lack of third party usage of applicant's mark raises strong doubts as to whether SMART TOW is merely descriptive as applied to applicant's watercraft speed control systems.

Applicant has set forth four separate independent grounds, each of which leads to the conclusion that applicant's mark, SMART TOW, is suggestive and not merely descriptive. When considered together, all four grounds make such conclusion inescapable.

¹ Hereafter, applicant will use the term "E. A. Brief" to refer to Examining Attorney's Appeal Brief.

In this case, there are no doubts. In any event, doubt must be resolved in the favor of applicant.²

II. SMART TOW IS SUGGESTIVE OF A DESIRED RESULT

Contrary to the Examining Attorney's assertions, SMART TOW is not merely descriptive of the function of applicant's goods within the meaning of § 2(e)(1) of the Trademark Act. Rather, SMART TOW only suggests a "desired result" obtained by the use of the applicant's goods. The goods are watercraft speed control systems, namely computer controllers having operating software for controlling the launch and cruise of a watercraft. In use, the "function" of the controllers is 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 "function" occurs regardless of whether the boat is in the process of towing. While the Examining Attorney continually changes his conclusion as to what applicant's mark merely describes; his most recent allegation is that SMART TOW "immediately describes "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" (E. A. Brief, p.3, L3-4) (emphasis added). What the controllers do and do not "allow" the watercraft to do are the results obtained by use of the goods -- not the function of the goods. Here, one "desired result" of the use of the goods is that someone with little expertise is able to tow like an expert.³ The fact that SMART TOW suggests a

² In re Atavio, 25 USPQ2d 1361 (TTAB 1992), the Board held that the mark ATAVIO was suggestive and not merely descriptive and stated:

Any doubt that we may have in reaching this conclusion, and we frankly admit that doubt exists, is resolved in favor of the applicant, that is to say, in favor of publication for opposition. *See, also*, In re The Rank Organisation Limited, 222 USPQ 324 (TTAB 1984).

³ The very advertising cited by the Examiner describes the goods as allowing "someone with little expertise to tow like an expert." (Examiner's Denial of Request for Reconsideration, January 31, 2004). This is a desired result, not a function.

"desired result" does not render it merely descriptive. In re Universal Water Systems, Inc., 209 USPQ 165 (TTAB 1980) held that the mark PURITY was suggestive and not merely descriptive of water filtering units, water filter cartridges and water softening units. The applicant argued that PURITY, at most, was merely suggestive of the "desired result" obtained by the use of applicant's water filters. The Board agreed, stating:

It is a rather abstract concept which in our opinion does not immediately convey or describe any aspect of the applicant's goods or the purpose for which they are used. Rather, as applicant has contended, it is suggestive of the desired result of the use of those goods, and as such is not merely descriptive of them within the meaning of Section 2(e)(1) of the Statute. (emphasis added).

In a similar manner, SMART TOW is merely suggestive of the desired result of the use of those goods, and as such is not merely descriptive of the them within the meaning of Section 2(e)(1) of the Statute. Id., *see, also*; In re Nalco Chemical Co., 228 USPQ 972, 973 (TTAB 1986) ("VERI-CLEAN," as applied to chemical anti-fouling additives for use in refineries, defined the desired end result of the use of the additives and, therefore, was suggestive, not merely descriptive); In re C.J. Webb, Inc., 182 USPQ 63 (TTAB 1974) ("BRAKLEEN" suggestive of a desired result of a brake cleaner and therefore not descriptive); In re Universal Water Systems, Inc., Id.; In re Recovery, Inc., 196 USPQ 830 (TTAB 1977) ("RECOVERY" suggestive of the end 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 and, therefore, not merely descriptive); In re Frank J. Curran Co., 189 USPQ 560 (TTAB 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"); In re Penwalt Corporation, 173 USPQ (BNA) 317 (TTAB 1972) ("DRI-FOOT" suggestive and not merely descriptive of an anti-perspirant deodorant for feet).

III. THE EXAMINING ATTORNEY'S CONTINUAL CHANGES OF WHAT THE MARK MERELY DESCRIBES IS EVIDENCE OF SUGGESTIVENESS

As stated at pp. 1-2, the Examining Attorney has repeatedly changed his opinion as to what applicant's mark merely describes.

Initially, the Examining Attorney opined that applicant's mark merely described the "towing of watercraft."⁴ Subsequently, the Examining Attorney changed his position and opined that applicant's mark merely described a feature or characteristic of the goods themselves. Thereafter, the Examining Attorney again changed his position and opined that applicant's mark is merely descriptive of a function of applicant's goods.

The mental gymnastics of the Examining Attorney in continually changing positions as to what applicant's mark merely describes reflects the mental processing that is required of actual and prospective customers of applicant's goods to readily perceive the alleged merely descriptive significance of the mark as it pertains to marketing of the goods in the boating community, including individual boating enthusiasts. Such continued changes in positions constitutes strong evidence that applicant's mark is suggestive, not merely descriptive.

IV. SMART TOW IS SUGGESTIVE BECAUSE OF AMBIGUITIES

Considering the mark as a whole, the combination of the words in the mark SMART TOW results in ambiguities, such that no single meaning for the phrase is immediately apparent. Simply stated, the mark SMART TOW is suggestive and not merely descriptive.

The Examining Attorney fails to acknowledge that the terms "SMART" and "TOW" each have multiple definitions within dictionaries. For example, the Examining

⁴ Such mischaracterization of the functioning of applicant's goods is a result of the Examining Attorney's erroneous definition of the term "tow" taken from dictionaries which specifies pulling a barge or a broken down car. This is the antithesis to a speed control system using computer controllers with operating software for the launch and cruise of a watercraft, such as in waterskiing where the watercraft is launched at zero or very low speed and accelerated to a cruising speed.

Attorney fails to acknowledge that the dictionary definition of "SMART" is not limited to "Fitted with a built-in microprocessor smart traffic signals" (Examining Attorney's Brief, p. 3, L3-4), but also is defined as "lively: vigorous and brisk," as well as numerous other definitions (*see*, list of MSN dictionary definitions submitted by Examining Attorney).⁵

On the other hand, the Examining Attorney claims that the definition of "TOW" is limited "To pull something such as a barge or a broken-down car along by a rope or chain attached to it" (E.A. Brief, p. 3, L4-5). However, the extract of MSN dictionary definitions submitted by the Examining Attorney also defines "TOW" as meaning "act of pulling something along: the act of pulling something along by a rope or chain attached to it."

The Examining Attorney overlooks the fact that actual or prospective customers would be required to use imagination, thought or perception, or a multi-stage reasoning process as to which definition should be applied.⁶

⁵ The case of In re Cryomedical Services, Inc., 32 USPQ2d 1377 (TTAB 1994), which is cited by the Examining Attorney, is clearly distinguishable from the present case because the Board in Cryomedical was determining whether or not the mark merely described an important characteristic of the goods. The Cryomedical case did not involve the issues of whether the mark only suggested a "desired result" obtained by the use of applicant's goods, whether the mark resulted in ambiguities such that no single meaning of the phrase is immediately apparent, whether the lack of third party usage indicated that the mark was not merely descriptive, nor involved an Examining Attorney's repeated changes of position as to what applicant's mark described.

The case of In re Tower Tech, Inc., 64 USPQ2d 1314 (TTAB 2002), which is cited by the Examining Attorney, is clearly distinguishable from the present case because the Board in Tower Tech was determining whether or not the mark merely described or suggested a characteristic of the goods themselves. The Tower Tech case did not involve the issues of whether the mark only suggested a "desired result" obtained by the use of applicant's goods, whether the lack of third party usage indicated the mark was not merely descriptive, nor involved an Examining Attorney's repeated changes of position as to what applicant's mark described.

⁶ Applicant's products marketed under the mark SMART TOW are marketed to actual and potential customers in the boating community, including individual boating enthusiasts. The Examining Attorney has failed to show that such individuals are well versed in the computer electronics industry and would immediately understand the term "SMART" to mean "equipped with a microprocessor."

Here, the actual or prospective customer, when viewing the mark SMART TOW in association with the applicant's watercraft speed control systems, could just as likely believe the end results "provided by the goods are a vigorous and brisk pull" (i.e., a "smart tow"), rather than to "allow for towing using controllers equipped with microprocessors." That is, the combination of words in the mark SMART TOW cannot be merely descriptive because they result in ambiguities such that no single meaning for the phrase is immediately apparent.⁷

In In re Recovery, Inc., 196 USPQ 830 (TTAB 1997), the Board reversed refusal to register RECOVERY for group therapy and self-help aftercare services because the

⁷ In In re Atavio, 25 USPQ2d 1361 (TTAB 1992), the mark ATAVIO (a Spanish word meaning the dress and ornament of a person, that is, the accoutrement, finery, gear) was held suggestive and not merely descriptive for fashion jewelry. The Board stated:

Thus, it appears to be an inclusive term for the overall attire of an individual rather than a reference to a particular item of attire. We do not think that it is accurate to conclude, solely on the basis of these definitions, which we find ambiguous, that ATAVIO is the precise equivalent of "ornament" and/or "adornment" and that ATAVIO is, therefore, merely descriptive of fashion jewelry (assuming, arguendo, that the English words "ornament" and "adornment" are merely descriptive of applicant's goods).

In In re TMS Corporation of the Americas, 200 USPQ 57 (TTAB 1978) (the mark THE MONEY SERVICE was held suggestive and not merely descriptive for services wherein funds are transferred to and from a savings account from locations remote from the associated financial institution. The Board rejected the contention that the mark was merely descriptive because the purpose of the service was to arrange for the transfer of funds (or money) to and from savings accounts from remote locations. The Board stated:

... it is our opinion that because the mark "THE MONEY SERVICE" is composed of commonly used words of the English language, it suggests a number of things, but yet falls short of describing applicant's services in any one degree of particularity. To effect a readily understood connection between applicant's mark and its services requires the actual or prospective customer to use thought, imagination and perhaps an exercise in extrapolation. In short, what we are saying is that the applicant's mark "THE MONEY SERVICE" does not directly or indirectly convey any vital purposes, characteristics or qualities of applicant's services. Thus, the mark is suggestive and not a merely descriptive designation
....

term "appears, at first blush, to possess a descriptive significance," but requires mental processing to obtain significance.

Considering the mark SMART TOW as a whole, the Examining Attorney has failed to meet his burden to show that such combination of words will not result in certain ambiguities, and that only a single meaning for the phrase is immediately apparent.

V. NO THIRD PARTY USAGE IS INDICATIVE OF LACK OF DESCRIPTIVENESS

The Examining Attorney incorrectly disregards the fact that the record is completely devoid of evidence that neither the applicant, nor anyone else, have previously used the words "smart" and "tow," either alone or together, to describe watercraft speed control systems. This fact raises strong doubts as to whether SMART TOW is descriptive as applied to applicant's watercraft speed control systems, The Firestone Tire & Rubber Co. v. The Goodyear Tire & Rubber Co., 186 USPQ 557 (TTAB 1975), *aff'd.*, 189 USPQ 348 (CCPA 1976) ("[T]he record is devoid of evidence that appellant or anyone else has used the words 'bias' and 'steel' together to describe tires. In the past, we have viewed such a lack of evidence to be at least some indication that the proposed trademark is not merely descriptive.").

The incongruous nature of the mark, and the fact that the message conveyed by the mark is neither direct, nor clear, is evidenced by the fact that the mark is not used by any of applicant's competitors to describe similar products. That is, the suggestion made by the mark is subtle enough so that it is not likely to be needed by competitive sellers to describe their goods. In re The Stroh Brewery Company, 34 USPQ2d (BNA) 1796 (TTAB 1994) held the design mark ST BART'S THE VIRGIN BREW suggestive and not merely descriptive of non-alcoholic malt beverages. The issue was whether the term "virgin" was descriptive of non-alcoholic malt beverages. The Court stated:

If the term "virgin" was descriptive of non-alcoholic malt beverages, it would have been used in relationship to such beverages at least occasionally. The fact that it has not raises strong doubts in our minds as to whether a term is descriptive as applied to the goods or

services for which registration is sought, and it is the practice of this Board to resolve doubts in favor of the applicant and pass the mark to publication with the knowledge that a competitor of applicant can come forth and initiate an opposition proceeding in which a more complete record can be established.

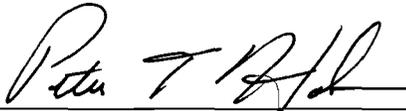
VI. CONCLUSION

While a thin line of demarcation generally exists between a suggestive mark and a merely descriptive one,⁸ the overwhelming evidence in this case clearly shows that applicant's mark is suggestive, not merely descriptive.

Applicant requests that the refusal of registration be reversed.

Respectfully submitted,

ANDRUS, SCEALES, STARKE & SAWALL, LLP

By 

Peter T. Holsen
Reg. No. 54,180

Andrus, Sceales, Starke & Sawall, LLP
100 East Wisconsin Avenue, Suite 1100
Milwaukee, WI 53202
Phone: 414-271-7590
Facsimile: 414-271-5770
Attorney Docket No. 3798-00054

⁸ There is generally a thin line of demarcation between a suggestive term and a merely descriptive term and it is often quite difficult to make a determination between the permissible scope of suggestiveness and the impermissible descriptive connotation of a term. In re The Rank Organisation Limited, 222 USPQ 324 (TTAB 1984); In re TMS Corporation of America, 200 USPQ 57 (TTAB 1978); In re Recovery, Inc., 196 USPQ 830 (TTAB 1977).