

From: Tierney, Margery

Sent: 2/4/2014 2:05:13 PM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 85560074 - SMTS - N/A - EXAMINER BRIEF

Attachment Information:

Count: 1

Files: 85560074.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85560074

MARK: SMTS



CORRESPONDENT ADDRESS:

ANDREW C AITKEN

IP LAW LEADERS PLLC

1701 PENNSYLVANIA AVE NW STE 300

WASHINGTON, DC 20006

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Savi Technology, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

aaiken@ipllfirm.com

EXAMINING ATTORNEY'S APPEAL BRIEF

1. PROSECUTION HISTORY

On March 5, 2012, applicant applied to register SMTS for:

“computer hardware and computer software for use in tracking, monitoring, and managing the condition, status, location, security and integrity of tangible assets, equipment, vehicles and cargo; computer hardware and computer software for use with GPS, GPRS, RFID, and satellite communication technologies for monitoring and managing tangible assets, equipment, vehicles and cargo; computer hardware and computer software for use in collecting, analyzing, and displaying data on the identity, location, and status of tangible assets, equipment, vehicles, and cargo; computer hardware and computer software for use in analyzing and displaying mapped routes to monitor the identity, location, and status of tangible assets, equipment, vehicles, and cargo; computer hardware and computer software to detect, alert, and respond to tampering and unauthorized access to tangible assets, equipment, vehicles, and cargo; computer hardware and computer software for use in providing real-time alerts and updates on the location of tangible assets, equipment, vehicles and cargo to improve transit times, identify diversion of tangible assets from established routes and locations, identify theft, and recover stolen tangible assets; computer hardware and computer software for real-time identification and tracking of the location, movement and condition of high-value tangible assets; computer hardware and computer software for use by large organizations, manufacturers, heavy industry and governments to manage tangible assets in distributed supply chains and complex logistics. (emphasis supplied.)

On June 15, 2013, the Examining Attorney refused the mark because it is merely descriptive of the function of the goods. In the first office action evidence was included that SMTS is a well-known abbreviation for “software management tracking system” or “software maintenance management system.” The application was abandoned and later revived on March 18, 2013. A final office action was issued on April 11, 2013. On October 11, 2013, applicant filed an Appeal and a Request for Reconsideration. On October 30, 2013, the Request for Reconsideration was denied. This appeal followed.

2. SMTS DESCRIBES A FEATURE OF APPLICANT’S SOFTWARE

Registration was refused under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), because the subject matter for which registration is sought is merely descriptive of the goods. SMTS is an abbreviation for “software management tracking system” or “software maintenance management system.” Applicant’s goods include a management and tracking function.

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the products and services it identifies. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the goods and services for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the question is not whether someone presented only with the mark could guess what the products and services are. Rather, the question is whether someone who knows the products and services will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

“On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive.” *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978). *See also*, *In re Shutts*, 217 USPQ 363, 364-365 (TTAB 1983); *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980).

As stated above, SMTS is an abbreviation for “software management tracking system” or “software maintenance tracking system.” An abbreviation, initialism, or acronym is merely descriptive

when it is generally understood as “substantially synonymous” with the descriptive words it represents. See *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1715 (TTAB 2011) (citing *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504, 506, 110 USPQ 293, 295 (C.C.P.A. 1956)) (holding NKJV substantially synonymous with merely descriptive term “New King James Version” and thus merely descriptive of bibles); *In re BetaBatt Inc.*, 89 USPQ2d 1152, 1155 (TTAB 2008) (holding DEC substantially synonymous with merely descriptive term “direct energy conversion” and thus merely descriptive of a type of batteries and battery related services); TMEP §1209.03(h).

A mark consisting of an abbreviation, initialism, or acronym will be considered substantially synonymous with descriptive wording if:

(1) the applied-for mark is an abbreviation, initialism, or acronym for specific wording;

(2) the specific wording is merely descriptive of applicant’s goods and/or services; and

(3) a relevant consumer viewing the abbreviation, initialism, or acronym in connection with applicant’s goods and/or services will recognize it as the equivalent of the merely descriptive wording it represents.

See *In re Thomas Nelson, Inc.*, 97 USPQ2d at 1715-16 (citing *In re Harco Corp.*, 220 USPQ 1075, 1076 (TTAB 1984)).

The following evidence demonstrates that SMTS is known to mean “software management tracking system” or “software maintenance tracking system.”

- The Acronym Finder website at www.acronymfinder.com shows that SMTS means “software management tracking system” or “software maintenance tracking system.” (Office action dated June 15, 2012)
- Definitions from the Dictionary.com website at www.dictionary.com defining software, track, system, maintenance and management. (Office action dated June 15, 2012)
- Article from Slide World at www.slideworld.com showing that SMTS means “software maintenance tracking system. (Office action dated June 15, 2012)
- Excerpt from the New Orleans Job website at <http://jobneworleans.com> posting an employment position for a System Administrator and stating that one qualification is knowledge of software management tracking system (SMTS). (Office action dated June 15, 2012)
- The ZDNet summary page lists articles about asset software management tracking. The articles show that software management tracking, specifically of assets such as applicant has in its description of goods, is a well-known field of software in the computer industry. (Office action dated June 15, 2012)
- The Indeed website at www.indeed.com advertises for a SMTS Software Development Engineer. This shows that this is a recognized kind of software. (Office action dated June 15, 2012)

Average **SMTS** Software Development Engineer salaries for job postings in Sunnyvale, CA are 26% higher than average **SMTS** Software Development Engineer Salaries for job postings nationwide.

- The Mai Shareef website at <http://maishareef.com> contains a resume from which indicates that this individual has experience as a programmer on a SMTS (software maintenance tracking system). (Office action dated June 15, 2012)

Working as a programmer in the information system department of the following projects: Time-Attendance system, CARE (Hospital Information) system, **SMTS (Software Maintenance Tracking System)**.

- The Acronym Geek website at www.acronymgeek.com states that SMTS means Software Maintenance Tracking System. (Office action dated June 15, 2012)

- The Acronym Attic website at <http://www.acronymattic.com/SMTS.html> states that SMTS means “Software Maintenance Tracking System.” (Office action dated April 11, 2013)

- The Brice Place website at <http://www.briceplace.com/Flash/Remedy28.swf> indicates that SMTS means “Software Maintenance Tracking System.” (Office action dated April 11, 2013)

- The Force R Supply Viking website at www.force-rsupplyviking.com/documents/SAA4.4.ppt indicates that SMTS means SOFTWARE MAINTENANCE TRACKING SYSTEM). (Office action dated April 11, 2013)

- The Free Dictionary website at www.freedictionary.com states that SMTS means Software Management Tracking System. (Office action dated April 11, 2013)

- The Global Security website at <http://www.globalsecurity.org/intell/library/reports/2001/compendium/compendium.pdf> indicates that SMTS means Software Maintenance Tracking System. (Office action dated April 11, 2013)

Problems with the ATLASS II+ software are identified by the Fleet and are submitted via the **Software Maintenance Tracking System (SMTS)** to the developer at SPAWAR, Chesapeake for review.

- The Media Careers website at www.media-careers.net/job/33168/system-administrator-at/ states that SMTS refers to a Software Maintenance Tracking System.

SYSTEM ADMINISTRATOR

Provides adequate controls to ensure system security and access granted to users are consistent with their duties

Identify user problems and submit NALCOMIS Trouble Report (TR)/Change Proposal (CP) via **Software Maintenance Tracking System (SMTS)**

- The Resume My Career website at www.resumemycareer.com identifies an employment experience which includes using a Software Maintenance Tracking System (SMTS).

Enhance R-ADM application using the **Software Maintenance Tracking System (SMTS)**; Review, analyze and prioritize change proposals submitted by Fleet users recommending changes to functions within the Application.

- The Serco website at www.serco-na.com/docs/materials/03333.012.0023.pdf states that providing a Software Management Tracking System (SMTS) is a contract provision.

3.4 Provide **Software Management Tracking Systems (SMTS)** supply input. This includes monitoring and correction of Trouble Reports (TR's) and Change Proposals (CP), coordination of the Fleet TR/CP prioritization for logistics and supply chain AIS an application software releases, bi-monthly extraction of SMTS trouble reports to facilitate NAVSUP prioritization action, identification and resolution of TR's/CP, clarification of SMTS input, and TR/CP rand analysis.

- The USA Jobs website at <https://applicationmanager.gov> advertises for a Logistics Management Specialist. One of the requirements is familiarity with a the Software Maintenance Tracking System (SMTS):

Lead the Fleet Design Team to provide guidance for all submitted Trouble Reports (TRs) within the **Software Maintenance Tracking System (SMTS)**.

In the office action dated June 15, 2012, Applicant was required to provide information about its goods.

In its response dated October 11, 2013, applicant's information states that it is a "mobile tracking system." Applicant's materials state that one of its key features is "journey management." Applicant's supporting data further states that its software functions include managing your account and maintaining inquiries. The following is an excerpt from applicant's information.

Savi Professional Services

Savi offers world class professional services to support the Savi Mobile Tracking System. Whether your business needs are standard or customized, we offer services for your implementation, training and deployment. You can also trust Savi to help **manage** your account, once deployed, to handle any customer support **or maintain** inquiries."

An excerpt from applicant's website included in the final office action dated April 11, 2013 indicates that applicant's computer software has a management function. Note the following:

SAVI DRAMATICALLY IMPROVES INSIGHT INTO CARGO SHIPMENTS AND LOGISTICS

Improved Journey Management, Tag And Alert Support, Expanded Search Capabilities And Usability Improvements In SMTS 2.2

Savi Mobile Tracking System is an integrated platform that includes specialized software and hardware devices designed specifically for securing and monitoring a wide range of cargo types – ISO containers on road and rail, closed rail wagons and tanker railcars, wet cargo (fuel trucks) and in-vehicle units for vehicle tracking. The system supports a wide range of “tag” technologies including GPS, GPRS, RFID, and satellite communications that provide in-transit visibility and **real-time asset management** for greater accuracy in location and movement tracking.

The applicant’s website also states that it offers journey management and vehicle & driver management software. The following excerpt was attached to the final office action dated April 11, 2013:

Journey Management

Journey Management provides users with a single dashboard to view multiple assets, their condition or status, route deviations or progress and related alerts. As a user, you can view status on individual tags or shipments, locate a shipment on a real-time mapping feature, and refresh status of shipments remotely.

Vehicle & Driver Management System

Savi Mobile Tracking System also monitors critical information about the vehicle and driver that can help operators identify a problem and prevent it from causing greater loss. The system can read and report vehicle speeding events, which can alert users to a potentially unsafe driver. The system also detects towing and idling and can help reduce fuel costs when using journey data to choose the most efficient routes.

Based on applicant's supporting materials, information and its website, it is clear that its software offers a management and maintenance function.

3. APPLICANT'S ARGUMENTS DO NOT OVERCOME THE REFUSAL TO REGISTER

Applicant asserts that the refusal to register is unfounded because it is based on evidence from Acronym Finder (www.acronymfinder.com) which is not reliable. The Trademark Trial and Appeal Board has regularly accepted evidence from Acronym Finder and its online version as probative in determining descriptiveness. See *Baroness Small Estates Inc. v. American Wine Trade Inc.*, 104 USPQ2d 1224 (TTAB 2012); *In re BetaBatt Inc.*, 89 USPQ2d 1152 (TTAB 2008); *In re IP Carrier Consulting Group*, 84 USPQ2d 1028 (TTAB 2007); *In re Microsoft Corp.*, 68 USPQ2d 1195 (TTAB 2003); *In re Zanova Inc.*, 59 USPQ2d 1300 (TTAB 2001); *In re Styleclick.com Inc.*, 57 USPQ2d 1445 (TTAB 2000); *Department of Justice, Federal Bureau of Investigation v. Calspan Corporation*, 196 USPQ 326 (TTAB 1977).

Applicant also argues that its software manages and tracks "tangible assets" not computer software thus rendering its mark suggestive. What is important is that applicant's software manages

and tracks or maintains and tracks not what it manages and tracks or what it maintains or tracks. The mark SMTS (the abbreviation for *software management tracking system* or *software maintenance tracking system*) describes the function of its software. Either meaning of the mark describes a feature and function of applicant's computer software. "A mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods." *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if a mark describes only one significant function, attribute, or property. *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); Finally, the fact that SMTS has other meanings is irrelevant. Descriptiveness is considered in relation to the relevant goods. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). "That a term may have other meanings in different contexts is not controlling." *In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)); TMEP §1209.03(e).

Applicant further contends that consumers for the goods would not recognize that the abbreviation SMTS describes the goods. Evidence discussed above shows that consumers in the software field are familiar with the abbreviation SMTS and will know that the mark conveys information about applicant's goods.

4. CONCLUSION

Accordingly, applicant's mark SMTS describes a feature of its software. For the foregoing reasons, the Examining Attorney requests that the Trademark Trial and Appeal Board affirm the refusal to

register the proposed mark under Section 2(e)(1) of the Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1),

Respectfully submitted,

/Margery A. Tierney/

Trademark Examining Attorney

Law Office 111

571-272-9234

margery.tierney@uspto.gov

Robert L. Lorenzo

Managing Attorney

Law Office 111