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Subject: U.S. TRADEMARK APPLICATION NO. 85760873 - SMART BROWSER - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85760873

MARK: SMART BROWSER



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GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: Internet Promise Group LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

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EXAMINING ATTORNEY'S APPEAL BRIEF

The Applicant has appealed the trademark Examining Attorney's final refusal to register the mark SMART BROWSER for "computer software application for use in computing and communication devices that reformats a received web page content in the device to remove and/or reposition advertising content and reformats the webpage content for viewing on limited

size screens,” in International Class 9. Registration was refused on the Principal Register because the asserted mark, when used in connection with the goods at issue, primarily merely describes a significant function, feature, purpose or use of the specified goods. For the reasons and authorities cited below, it is requested that the refusal to register be affirmed.

FACTS AND PROCEEDINGS

On October 23, 2012, Applicant Internet Promise Group LLC filed an Intent to Use-based application seeking registration on the Principal Register for the mark SMART BROWSER in typed form for use in connection with “a browser application for wireless mobile devices reformats received web page content to remove or reposition unnecessary advertising content and formats the webpage into display content customized to the limited screen size and customer preferences,” in International Class 9.

On December 7, 2012, the Examining Attorney issued an Office action refusing registration on the Principal Register of the Applicant’s mark, pursuant to Section 2(e)(1) of the Trademark Act, requiring an amendment to the identification of goods.

On May 31, 2013, the Applicant filed a Response to Office action amending the identification of goods to, “computer software, namely, a browser application for use on wireless mobile devices; computer software, namely, for use in reformatting received web page content to remove or reposition unnecessary advertising content, for use in custom user formatting of a webpage displays for viewing limited screen sizes,” in International Class 9, and presenting arguments in favor of registration on the Principal Register.

On June 29, 2013, the Examining Attorney issued an Office action, noting the Office's acceptance of the proposed amendment to the identification of goods and making Final the refusal to register the asserted mark on the Principal Register for being primarily merely descriptive, pursuant to Section 2(e)(1) of the Trademark Act.

On December 26, 2013, the Applicant filed a Notice of Appeal in conjunction with a Request for Reconsideration which addressed the 2(e)(1), primarily merely descriptive refusal. In addition, the Applicant proposed a voluntary amendment to narrow the identification of goods, requesting that the identification read, "computer software application for use in computing and communication devices that reformats a received web page content into the device to remove and/or reposition advertising content and reformats the webpage content for viewing on limited size screens."

On January 27, 2014, the Examining Attorney denied the Request for Reconsideration, simultaneously accepting the proposed amendment to narrow the identification. The file was remanded to the TTAB for a continuation of the appeal proceedings.

ISSUE ON APPEAL

Whether the asserted mark "SMART BROWSER," defined as a "web browser that assists a user in obtaining the desired website content," primarily merely describes features and functions as well as the use and purpose of the Applicant's software for use in reformatting a received web page's content for viewing on limited size screens, within the meaning of Section 2(e)(1) of the Trademark Act.

ARGUMENT

The Plain Meaning Of The Term “SMART BROWSER” Describes The Features, Functions, Use And Purpose Of The Web Page Size Reformatting Software For Which Protection Is Sought.

The Applicant seeks registration of the mark SMART BROWSER for “computer software application for use in computing and communication devices that reformats a received web page content in the device to remove and/or reposition advertising content and reformats the webpage content for viewing on limited size screens,” in International Class 9. The examining attorney contends that the asserted mark “SMART BROWSER” immediately conveys the purpose of the web page size reformatting software for which protection is sought in that “smart browsers” are used in “smart browsing,” which is defined as a feature of a web browser to assist users in obtaining desired website content. In other words, the asserted mark primarily merely describes a significant characteristic and feature, as well as the function and purpose of the relevant goods, and the asserted mark, therefore, is not registrable on the Principal Register pursuant to Section 2(e)(1) of the Trademark Act.

Section 2(e)(1) of the Trademark Act provides:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on account of its nature unless it-

(e) Consists of a mark which, (1) when applied to the goods of the applicant is merely descriptive or deceptively misdescriptive of them.

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an Applicant's goods. TMEP §1209.01(b); *see, e.g., DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, ___ F.3d ___, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)).

The determination of whether a mark is merely descriptive is made in relation to an Applicant's goods, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, ___ F.3d ___, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *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); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the "documents" managed by applicant's software rather than the term "doctor" shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of "computer programs recorded on disk" where the relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system).

The Court's decision in *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 216 (CCPA 1978), in affirming the board's finding that the mark was merely descriptive, the Court quoted the following language from the board's opinion:

Whether or not a term is merely descriptive in a trademark sense must necessarily be considered in relation to the specific goods for

which registration is sought, the context of which is used on labels, packages, or advertising materials directed to these goods, *the possible significance of the term in relation to the goods, and the likely reaction thereto of the average purchaser as he encounters the goods in the marketplace.* (emphasis added).

In other words, “[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). Furthermore, the fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness. *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979); TMEP §1209.03(e).

“A mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.” *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); see *In re Oppedahl & Larson LLP*, 373 F.3d at 1173, 71 USPQ2d at 1371.

The two major reasons for not protecting descriptive marks are (1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to avoid the possibility of costly infringement suits brought by the trademark or service mark owner. *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978); TMEP §1209. Businesses and competitors should be free to use descriptive language when describing their own

goods to the public in advertising and marketing materials. *See In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001).

In consideration thereof, the Examining Attorney made of record the following definitions of terms relevant to the prosecution of the trademark application:

Definition No. 1: Smart – The terms "smart" or "intelligent" may be used to refer to any computer-controlled device. The "smartphone" is the most obvious.

(<http://encyclopedia2.thefreedictionary.com/smart>, last visited May 9, 2014; *see* Offc. Act'n. 12/7/2012)

Definition No. 2: Browser – A program that accesses and displays files and other data available on the Internet and other networks.

(<https://education.yahoo.com/reference/dictionary/entry/browser>, last visited May 9, 2014; *see* Offc. Act'n. 12/7/2012)

Definition No. 3: Smart Browser – A Web browser that implements smart browsing features. See smart browsing.

(<http://encyclopedia2.thefreedictionary.com/smart+browser>, last visited May 9, 2014; *see* Req. Recon. Denied 1/27/2014)

Definition No. 4: Smart Browsing – Features in a Web browser that assist the user in obtaining the desired Web site or content. Basic features include automatic entering of the http:// prefix or .com suffix for the URL as well as using previous lookups to complete the URL after the first several characters have been typed in (see auto complete). Other features include analyzing what is typed in and determining whether the browser should go to a site with that name or to a search site to search for content.

(<http://encyclopedia2.thefreedictionary.com/smart+browsing>, last visited May 9, 2014; *see* Req. Recon. Denied 1/27/2014)

Definition No. 5: Smart Browsing – Web browser enhancements that help the user obtain the desired results. Starting around the turn of the century, the browser automatically added the http:// prefix and the .com domain name to the URL. Other features include automatic completion of the URL based on site visit history (see auto complete). A major improvement added later was the use of a single search box for both the Web site URL and search engine query.

http://lookup.computerlanguage.com/host_app/search?cid=C999999&term=smart+browsing, last visited May 9, 2014; *see* Req. Recon. Denied 1/27/2014)

The Trademark Trial and Appeal Board has held that printouts obtained through global computerized networks are admissible under Rule 2.122(e). *Raccioppi v. Apogee, Inc.*, 47 USPQ2d 1368 (TTAB 1998).

In addition, the Examining Attorney made of record in the 12/7/2012 Office Action, examples of third party registrations wherein the word “SMART” was disclaimed, registered under Trademark Act Section 2(f) based on acquired distinctiveness, or registered on the Supplemental Register in relation to the same or similar computer software. *See, e.g.*, “SMART CONTROL,” Reg. No. 3537758, Principal Reg., for various types of “computer software” and “computer hardware,” where “SMART” is disclaimed with respect to “to BIOS (basic input output system) computer programs; cd drives for computers; computer buffers; computer cables; computer cameras; computer disc drives; computer hardware and computer software programs for the integration of text, audio, graphics, still image and moving pictures into an interactive delivery for multimedia applications; computer hardware for telecommunications; computer mouse; computer software for computer system and application development, deployment and management”; “SMART SOFTWARE,” Reg. No. 4092725, Principal Reg., for computer application software for mobile phones for improvement of image quality, where “SMART

SOFTWARE” is disclaimed; and, “SMART HUB,” Reg. No. 4169403, Supplemental Reg., for “computer hardware and software for medical data collection, storage and display; asset management software, namely, computer software for use in healthcare facilities to collect, monitor, transmit and display information related to medical equipment and medical facility resource allocation, utilization and status” where “SMART” is disclaimed for being generic

Third-party registrations featuring goods the same as or similar to Applicant’s goods are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on acquired distinctiveness, or registered on the Supplemental Register. *See Inst. Nat’l des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 1581-82, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006).

In light of the plain meanings of the words comprising the asserted mark “SMART BROWSER,” and the definition of the terms “smart browser” and “smart browsing” as a whole, and in consideration of the evidence establishing the descriptive nature of the word “smart” in the context of computer related goods, the Examining Attorney refused registration of the asserted mark for being primarily merely descriptive, arguing that the Applicant sought protection of the mark “SMART BROWSER” for computer controlled browser software” (See Initial Office action.) After Applicant amended the identification, the Examining Attorney made Final the refusal to register the asserted mark for being primarily merely descriptive, continuing the assertion that the Applicant sought protection of the mark “‘SMART BROWSER’ for

computer controlled browser software, noting that the refusal applied even to the amended identification of record, which read as follows:

Computer software, namely, a browser application for use on wireless mobile devices; computer software, namely, software for use in reformatting received web page content to remove or reposition unnecessary advertising content, and for use in custom user formatting of webpage displays for viewing limited screen sizes, in International Class 9.

In response to the refusals, Applicant argued that:

The word “smart” by itself does not characterize the applicant’s goods as the word “smart” customary usage is generally applicable to humans and not to software applications.

The Applicant continued the argument, contending that:

The word “browser” by itself also does not characterize the applicant’s goods as the word browser by itself is generic and does not imply a “browser application of a mobile device”.

In its Request for Reconsideration and in light of the Examining Attorney’s repeated statements of record making clear that an Applicant may amend an identification of goods only to clarify or limit the goods and may not add to or broaden the scope of the goods, the Applicant submitted a voluntary amendment narrowing the scope of the identification of goods so that it currently reads, “computer software application for use in computing and communication devices that reformats a received web page content into the device to remove and/or reposition advertising content and reformats the webpage content for viewing on limited size screens.” *See*, 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07 *et seq.*

The Request for Reconsideration also included a response to the 2(e)(1) issue in the Final Refusal which simply stated that:

With due respect, with the amended identification of the goods, the mark cannot be construed as “merely descriptive as the mark does not convey an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant’s goods and/or services and therefore is not merely descriptive.

The Applicant is not clear as to why the Office should not consider the term “smart” descriptive of the computer controlled devices on which the goods are to be used or of the computer-controlled nature of the software, or why the Office should not consider the term “browser” descriptive of its previously described, “browser application” or the narrower identified, reformatting software, when “smart browsing” software is defined as software for use in assisting the user in obtaining the desired Web site or content, such as by reformatting web page content to the size of the device using the software, ostensibly so that the content is viewable by the user.

The Examining Attorney contends that the Applicant’s various arguments ignore the Applicant’s own use of the term “browser” when it first amended its identification, the established definitions of the term “smart browsing” as it applies to its own software, and the fact that an identification amended from an already accepted identification of goods necessarily is not broader than the original goods or otherwise outside of the scope of the goods contemplated prior to the amendment. That is, as amended in the Request for Reconsideration, the identification continues to refer to a function of the “web browser application” for which the applicant

originally sought protection. As “smart browser” is descriptive of the features of a “web browsing application,” and the current identification refers primarily to a reformatting function that is reasonably considered a feature of “web browsing applications,” then the term “smart browser” and thereby the asserted mark “SMART BROWSER,” continue to be descriptive in relation to the web page reformatting software at issue herein.

At each stage of the application’s prosecution, the Applicant has failed to submit evidence or case law references to support its contention that the words comprising the mark are not descriptive in the context of the goods for which it seeks protection. Further, the Applicant has failed to challenge the validity of the definitions made of record or present a reasonable explanation for why such definitions do not establish that the asserted mark is primarily merely descriptive.

The Examining Attorney does note that on Appeal the Applicant presents a new argument in support of registration, contending that “SMART BROWSER” comprises “incongruous” wording and therefore cannot be held primarily merely descriptive. The Applicant states that:

The mark “SMART BROWSER” are word combinations whose import cannot be grasped without some measure of imagination and mental pause. Each of the words in the mark SMART and “BROWSE” and its noun version BROWSER individually are common English language words and thus an incongruent combination of them cannot be merely descriptive.

The combination of the words is incongruent because SMART is a quality of a human being and not that of an object or a machine and BROWSER in the mark does not refer to any aspect of the identified goods, as in the identification of goods, the goods refers to something entirely different than a browse function or a search function or as a browser used in the Internet Industry; and thus a combination of these words SMART and BROWSER is incongruent.

(App. Br. at pgs. 17-18)

The Board had made clear that a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, non-descriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (SUGAR & SPICE held not merely descriptive of bakery products); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool); TMEP Section 1209.03(d). However, the Board also has held that when there is evidence that the composite mark itself has been used together to form a phrase that is descriptive of the goods or services, it is unnecessary to engage in an analysis of each individual component. *In re Shiva Corp.*, 48 USPQ2d 1957, 1958 (TTAB 1998) (TARIFF MANAGEMENT merely descriptive of computer hardware and computer programs to control, reduce, and render more efficient wide area network usage).

Here, the record reflects that the composite mark is in common use, forming a unitary term that describes software similar to that sought for protection by the Applicant. More importantly, the Applicant has not made clear how the components are incongruous as applied to the goods. Despite the evidence of record establishing that the terms, both individually and as a

single phrase, have specific definitions that are descriptive in the context of the goods, the Applicant argues that:

An objective person being exposed to the mark “SMART BROWSER” alone cannot come up with any sensible identification of the goods, as the goods have nothing to do with a browser or a browse function as used in the Internet industry for web searches; and vice versa, an objective person reading the identification of the goods alone cannot come up with the mark ... With due respect, this definition of smart browser and smart browsing as cited by the Examiner ... has no relationship to the description of the goods.

(App. Br. at pgs. 16, 17)

Finally, it is of note that the Applicant presented the following interpretation of the Examining Attorney’s analysis:

The definitions as has been cited by the examiner have everything to do with computer applications generally caller Internet Browser, as these definitions are directed to the act of browsing or searching, whereas in contrast, the description of goods has nothing to do with either searching or browsing the Internet of Web but to reformat and present data on a received web page on a limited size screens of devices that includes remove or reposition the advertising content on the webpage. The mark therefore is suggestive and not merely descriptive.

(App. Br. at pg. 16)

It seems that the Applicant’s premise is that it no longer wishes to seek protection for software that was originally described as being a “browser application” and then continued to be referred to as a “browser application” in the Applicant’s first amendment to the identification of goods. Instead, Applicant now seeks protection for a “computer software application” that

“reformats a received web page content,” as well as removes and/or repositions “advertising content and reformats the webpage content for viewing on limited size screens.” And because its third iteration of the function of the software no longer refers to “a browser application” or even uses the word “browser within the identification, the Applicant seems to argue that the asserted mark “SMART BROWSER” can no longer describe either the type of goods being sought for protection or their intended use.

If this is an accurate assessment of the Applicant’s position, then the problems with the Applicant’s argument on Appeal are twofold: first, the definitions of “smart browser” and “smart browsing” that have been made of record contemplate the “reformatting” feature as being a general feature of “smart browsing” type software, and so the mark remains primarily merely descriptive of a function or feature of the goods for which protection is sought even if the word “browser” is not actually used therein; and second, because there is verifiable and relevant evidence establishing the primarily merely descriptive nature of the mark components as well as the mark as a whole in the context of computer software, claiming that the SMART BROWSER “has no relationship to the description of the goods” effectively makes the mark primarily merely deceptively misdescriptive, and the mark would therefore be unregistrable. *See* TMEP §1203.02(b) *et seq.* However, the record makes clear that the asserted mark “SMART BROWSER” does indeed have a relationship to the goods for which protection is sought, and the “deceptively misdescriptive” issue is not being raised herein.

The plain meanings of the individual words comprising the asserted mark, the plain meaning of the asserted mark as a whole, the Applicant’s submitted amendment to the

identification of goods referring to “a browser application,” and even parts of the Applicant’s anecdotal explanations of the generic meaning of the word “browser,” make clear that in the context of the computer software goods for which protection is sought, software that was twice referred to as having a “browser” function, the asserted trademark is primarily merely descriptive of a significant characteristic and feature, as well as the function and purpose, of the goods for which protection is sought, namely, that the Applicant’s reformatting software will be used to assist users in obtaining desired website content.

In light of the definitions made of record, as well as the probative, third-party evidence on the issue of descriptiveness, the Examining Attorney contends that the average purchaser of Applicant’s computer software will understand the plain meaning, descriptive significance of the asserted mark “SMART BROWSER” in relation to the software at issue. Further, the descriptive significance of each word comprising the asserted mark “SMART BROWSER” will be retained even if the Applicant seeks protection of software focusing on only a single feature of what is considered “smart browsing” software. Allowing the Applicant to register the asserted mark would prevent others from entering into and already within the computer software industry from seeking protection for “smart browsing software” or concisely describing their goods as actually being “smart browser” software.

For the reasons and authorities cited above, it is requested that the refusal to register pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), be affirmed.

CONCLUSION

For the foregoing reasons and authorities, the Examining Attorney submits that the refusal to register applicant's mark on the basis that the mark is merely descriptive of the recited goods should be affirmed.

Respectfully submitted,

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