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Subject: U.S. TRADEMARK APPLICATION NO. 85760873 - SMART BROWSER - N/A - Request for  
Reconsideration Denied - Return to TTAB - Message 1 of 2

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Attachment Information:

Count: 3

Files: smrtbrws-1.jpg, smrtbrws-2.jpg, 85760873.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO.** 85760873

**MARK:** SMART BROWSER



**CORRESPONDENT ADDRESS:**

INTERNET PROMISE GROUP LLC

2390 CRENSHAW BLVD STE 239

TORRANCE, CA 90501-3300

**GENERAL TRADEMARK INFORMATION:**

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

**APPLICANT:** Internet Promise Group LLC

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

chand@InternetPromise.com

**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:** 1/27/2014

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The refusal made final in the Office action dated 6/29/2013 is maintained and continue to be final. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues.

The applicant should note the following:

Registration is refused because the applied-for mark merely describes the purpose and function of applicant's goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); see TMEP §§1209.01(b), 1209.03 *et seq.*

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).

“Whether 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).

“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.

Descriptiveness is considered in relation to the relevant goods. **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).

The applicant applied to register the mark SMART BROWSER for 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.

In determining the descriptiveness of a term or mark comprising more than one element, it is permissible to consider the significance of each element separately in the course of evaluating the term or mark as a whole. See *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1174-75, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004) (holding PATENTS.COM merely descriptive of computer software for managing and tracking the status of database records when noting that “the PTO may [separately] consider the meaning of ‘patents’ and the meaning of ‘.com’ with respect to the goods identified in the application.”); *In re Save Venice N.Y., Inc.*, 259 F.3d 1346, 1352, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001) (holding a mark primarily geographically deceptively misdescriptive for a variety of goods when noting that “[i]t is not erroneous, however, for the examiner to consider the significance of each element within the composite mark in the course of evaluating the mark as a whole.”); *In re Med. Plastics, Inc.*, 192 USPQ 239, 240 (TTAB 1976) (holding a mark generic when noting that “[t]he Examiner did discuss each word in the mark separately in order to show that the term in its entirety was the apt name of the applicant’s goods. This is not the same thing as dissecting a mark.”).

The applicant has argued that the word “smart” is “generally applicable to humans and not to software applications” and that the word “browser” is “generic and does not imply a ‘browser application of a mobile wireless device.’” The examining attorney has already found this argument unpersuasive and provided evidence and arguments in support of this position. Further, in the response to the final Office action, the applicant states for the record that the mark cannot be merely descriptive, “because it 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 Request for Reconsideration also includes amendments to the identification: the applicant has voluntarily amended its identification of goods. This amendment is permissible. However, neither applicant’s amendment of the identification, nor the Applicant’s response to the final Office action raise new issues: the applicant’s interpretation of the meaning or lack of meaning to be attributed to the asserted mark ignores its own use of the terms to describe its own goods, as well as the dictionary and Internet evidence made of record in support of the refusal.

The applicant should note the attached information establishing that “smart browser” is a recognized term within the computing industry, and refers to browsers having the same functionality as the applicant’s software:

The examining attorney refers to the definitions of the term “smart browser,” resulting from the examining attorney’s search in a global computer network dictionary. See attached.

Definition No. 1: SMART BROWSER – A Web browser that implements smart browsing features. See smart browsing.

Definition No. 2: 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

See attached from:

<http://encyclopedia2.thefreedictionary.com/smart+browser>

<http://encyclopedia2.thefreedictionary.com/smart+browsing>

[http://lookup.computerlanguage.com/host\\_app/search?cid=C999999&term=smart+browsing](http://lookup.computerlanguage.com/host_app/search?cid=C999999&term=smart+browsing)

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).

Moreover, the applicant has failed to submit evidence or case law to support its contention that the words are not descriptive in the context of the goods for which it seeks protection.

Accordingly, the request is denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

/Ronald E. Aikens/

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A Web browser that implements smart browsing features. See [smart browsing](#).

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*BlackBerry eyes more sales by Khaleej Times (Dubai, United Arab Emirates)*

Both the Karbonn Smart Tablets come preloaded with Karbonn **Smart Browser** and Karbonn Smart games apps.

*Karbonn Unveils A11, A7+ and A1+ Android Smartphones and Smart Tabs by International Business Times - US ed.*

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