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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85760873
Applicant	Internet Promise Group LLC
Applied for Mark	SMART BROWSER
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re: INTERNET PROMISE GROUP®, LLC
Applicant

Mark: SMART BROWSER
Application Ser. No.: 85/760,873
Filed: 10/23/2012

APPEAL BRIEF

Honorable Commissioner of Trademarks
P O Box 1451
Alexandria, VA 22313-1451.

After the Final Rejection by the Examining Attorney of the applicant's mark, Applicant files the attached Appeal Brief. The Appeal Brief is timely filed within 60 days of the Notice of Final Rejection dated 01/29/2014 that is on or before 3/29/2014.

Respectfully submitted,

Date: March 22, 2014

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APPEAL BRIEF

INTRODUCTION

The mark is SMART BROWSER and the identification of the goods/services is:

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.

The issue is whether this mark is “Merely Descriptive” under Section 2(e) (1) as the Examiner states in the Final Rejection.

TMEP Section 1209 Refusal on Basis of Descriptiveness based on cited case law, the descriptiveness of the marks are defined on a continuum starting from (i)

arbitrary, (ii) fanciful, (iii) suggestive, (iv) incongruent (v) merely descriptive, and (iv) generic, where arbitrary and generic are on the two ends of the spectrum. Each of these identifications on the continuum has been defined with the help of case law.

Further, **TMEP** based on case law states that the degree of distinctiveness on this continuum can be determined only by considering the mark in relation to the specific goods or services. Applicant submits this determination would be judged on an objective standard and not a subjective standard.

TMEP also states that first four on this continuum (i) arbitrary, (ii) fanciful, (iii) suggestive, and (iv) incongruent may be registered while generic marks are banned from registration. The marks that are merely descriptive may be registered if they have acquired distinctiveness.

Applicant submits that the mark SMART BROWSER based on the identification of the good/services fits in the continuum in “suggestive” identification and not “merely descriptive”.

Applicant in addition and or in the alternative submits that the mark SMART BROWSER based on the identification of the good/services fits in the continuum in “incongruent” identification and not “merely descriptive”.

ARGUMENTS:

Applicant submits that the mark SMART BROWSER based on the identification of the good/services fits in the continuum in “suggestive” identification and not “merely descriptive”.

Applicant provides the following arguments in support of that submission. Relevant pages of TMEP Section 1209 are first reproduced herein followed by arguments.

1209 Refusal on Basis of Descriptiveness

15 U.S.C. §1052 (Extract)

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it (e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them....

Matter that “merely describes” the goods or services on or in connection with which it is used is not registrable on the Principal Register. As noted in *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978):

The major reasons for not protecting such marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.

1209.01 Distinctiveness/Descriptiveness Continuum

With regard to trademark significance, matter may be categorized along a continuum, ranging from marks that are highly distinctive to matter that is a generic name for the goods or services. The degree of distinctiveness – or, on the other hand, descriptiveness – of a designation can be determined only by considering it in relation to the specific goods or services. *Remington Products, Inc. v. N. Am. Philips Corp.*, 892 F.2d 1576, 1580, 13 USPQ2d 1444, 1448 (Fed. Cir. 1990) (the mark must be considered in context, i.e., in connection with the goods).

At one extreme are marks that, when used in relation to the goods or services, are completely arbitrary or fanciful. Next on the continuum are suggestive marks, followed by merely descriptive matter. Finally, generic terms for the goods or services are at the opposite end of the continuum from arbitrary or fanciful marks. As stated in *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986), quoting *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 847, 129 USPQ 411, 413 (C.C.P.A. 1961), “[t]he name of a thing is in fact the ultimate in descriptiveness.”

Fanciful, arbitrary, and suggestive marks, often referred to as “inherently distinctive” marks, are registrable on the Principal Register without proof of acquired distinctiveness. See [TMEP §1209.01\(a\)](#).

Marks that are merely descriptive of the goods or services may not be registered on the Principal Register absent a showing of acquired distinctiveness under 15 U.S.C. §1052(f). See [TMEP §1209.01\(b\)](#) regarding merely descriptive marks, and [TMEP §§1212–1212.10](#) regarding acquired distinctiveness. Merely descriptive marks may be registrable on the Supplemental Register in applications under §1 or §44 of the Trademark Act. 15 U.S.C. §1091.

Matter that is generic for the goods or services is not registrable on either the Principal or the Supplemental Register under any circumstances. *See* [TMEP §§1209.01\(c\)–\(c\)\(iii\)](#).

1209.01(a) Fanciful, Arbitrary, and Suggestive Marks

Fanciful marks comprise terms that have been invented for the sole purpose of functioning as a trademark or service mark. Such marks comprise words that are either unknown in the language (e.g., PEPSI, KODAK, and EXXON) or are completely out of common usage (e.g., FLIVVER).

Arbitrary marks comprise words that are in common linguistic use but, when used to identify particular goods or services, do not suggest or describe a significant ingredient, quality, or characteristic of the goods or services (e.g., APPLE for computers; OLD CROW for whiskey). *See, e.g., Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (VEUVE – meaning WIDOW in English – held to be “an arbitrary term as applied to champagne and sparkling wine, and thus conceptually strong as a trademark”); *Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1340, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004) (defining an arbitrary mark as “a known word used in an unexpected or uncommon way”).

Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services. *See In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) (SPEEDI BAKE for frozen dough found to fall within the category of suggestive marks because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread); *In re The Noble Co.*, 225 USPQ 749 (TTAB 1985) (NOBURST for liquid antifreeze and rust inhibitor for hot-water-heating systems found to suggest a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute); *In re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972) (DRI-FOOT held suggestive of anti-perspirant deodorant for feet in part because, in the singular, it is not the usual or normal manner in which the purpose of an anti-perspirant and deodorant for the feet would be described).

Incongruity is a strong indication that a mark is suggestive rather than merely descriptive. *In re Tennis in the Round Inc.*, 199 USPQ 496, 498 (TTAB 1978) (TENNIS IN THE ROUND held not merely descriptive for providing tennis facilities, the Board finding that the association of applicant's marks with the phrase “theater-in-the-round” created an incongruity because applicant's tennis

facilities are not at all analogous to those used in a “theater-in-the-round”). The Board has described incongruity in a mark as “one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark,” and has noted that the concept of mere descriptiveness “should not penalize coinage of hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and ‘mental pause.’” *In re Shutts*, 217 USPQ 363, 364–5 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow-removal hand tool); *see also In re Vienna Sausage Mfg. Co.*, 156 USPQ 155, 156 (TTAB 1967) (FRANKWURST held not merely descriptive for wieners, the Board finding that although “frank” may be synonymous with “wiener,” and “wurst” is synonymous with “sausage,” the combination of the terms is incongruous and results in a mark that is no more than suggestive of the nature of the goods); *In re John H. Breck, Inc.*, 150 USPQ 397, 398 (TTAB 1966) (TINT TONE held suggestive for hair coloring, the Board finding that the words overlap in significance and their combination is somewhat incongruous or redundant and does not immediately convey the nature of the product); *cf. In re Getz Found.*, 227 USPQ 571, 572 (TTAB 1985) (MOUSE HOUSE held fanciful for museum services featuring mice figurines made up to appear as human beings, the Board finding that the only

conceivable meaning of “mouse house,” i.e., a building at a zoo in which live and/or stuffed mice are displayed, is incongruous).

Suggestive marks, like fanciful and arbitrary marks, are registrable on the Principal Register without proof of secondary meaning. *See Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1340, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004). Therefore, a designation does not have to be devoid of all meaning in relation to the goods/services to be registrable. If, after conducting independent research, it is unclear to the examining attorney whether a term in a mark has meaning in the relevant industry, the examining attorney must make an inquiry of the applicant, pursuant to 37 C.F.R. §2.61(b). If the examining attorney determines that the term is arbitrary or fanciful, the examining attorney may enter a Note to the File in the record indicating that research was conducted regarding the meaning of the term in the relevant industry, without stating any legal opinions or conclusions.

1209.01(b) Merely Descriptive Marks

To be refused registration on the Principal Register under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), a mark must be merely descriptive or deceptively misdescriptive of the goods or services to which it relates. A mark is considered merely descriptive if it describes an ingredient, quality, characteristic,

function, feature, purpose, or use of the specified goods or services. *See In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE PIE held merely descriptive of potpourri); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY held merely descriptive of lodging reservations services); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984) (MALE-P.A.P. TEST held merely descriptive of clinical pathological immunoassay testing services for detecting and monitoring prostatic cancer); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979) (COASTER-CARDS held merely descriptive of a coaster suitable for direct mailing). Similarly, a mark is considered merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of an applicant's goods or services. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007).

The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. *In re Chamber of Commerce*, 675 F.3d at 1300, 102 USPQ2d at 1219; *In re Bayer*, 488 F.3d at 964, 82 USPQ2d at 1831. This requires consideration of the context in which the mark is used or intended to be used in connection with those goods/services, and the possible significance that the mark would have to the

average purchaser of the goods or services in the marketplace. *See In re Chamber of Commerce*, 675 F.3d at 1300, 102 USPQ2d at 1219; *In re Bayer*, 488 F.3d at 964, 82 USPQ2d at 1831; *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); *In re Venture Lending Assocs.*, 226 USPQ 285 (TTAB 1985).

The mark need not describe all the goods and services identified, as long as it merely describes one of them. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 1041, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005) (“[T]he Trademark Office may require a disclaimer as a condition of registration if the mark is merely descriptive for at least one of the products or services involved.”)

It is not necessary that a term describe all of the purposes, functions, characteristics, or features of a product to be considered merely descriptive; it is enough if the term describes one significant function, attribute, or property. *In re Chamber of Commerce*, 675 F.3d at 1300, 102 USPQ2d at 1219; *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (“A mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services,” citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); *Gyulay*, 820 F.2d at 1218, 3 USPQ2d at 1010; *In re Positec Group Ltd.*, 108 USPQ2d 1161, 1171 (TTAB 2013) (“[I]f the mark is descriptive of some identified

items – or even just one – the whole class of goods still may be refused by the examiner.”); *In re Cox Enters. Inc.*, 82 USPQ2d 1040 (TTAB 2007) *see also In re Omaha Nat’l Corp.*, 819 F.2d 1117, 1119, 2 USPQ2d 1859, 1861 (Fed. Cir. 1987) (rejecting argument that descriptiveness should be limited to a quality or characteristic of the service itself and holding that it includes a designation descriptive of the service provider).

A term also may be considered merely descriptive if the identified services fall within a subset of services indicated by the term. *See In re Amer. Soc’y of Clinical Pathologists, Inc.*, 442 F.2d 1404, 1406-07, 169 USPQ 800, 801 (C.C.P.A. 1971) (holding that REGISTRY OF MEDICAL PATHOLOGISTS was descriptive of certain claimed services that were implicitly subsumed within service of providing a registry of medical pathologists and of additional claimed services that were “supporting, ancillary or auxiliary to the primary function” of applicant’s registry services). *See also In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1301-02, 102 USPQ2d 1217, 1220 (Fed. Cir. 2012) (NATIONAL CHAMBER held descriptive because “substantial evidence supports the TTAB's determination that the designated business and regulatory data analysis services are within the scope of traditional chambers of commerce activities” of “promoting the interests of businessmen and businesswomen”).

The great variation in facts from case to case prevents the formulation of specific rules for specific fact situations. Each case must be decided on its own merits. *See In re Ampco Foods, Inc.*, 227 USPQ 331 (TTAB 1985); *In re Venturi, Inc.*, 197 USPQ 714 (TTAB 1977).

See [TMEP §§1209.03–1209.03\(u\)](#) regarding factors that often arise in determining whether a mark is merely descriptive or generic.

See also [TMEP §§1213–1213.11](#) concerning disclaimer of merely descriptive matter within a mark.

Arguments:

Based on a fair and equitable reading of the TMEP Section 1209 and it many cites, the mark is not “merely descriptive” because:

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. Thus the mark cannot be “merely descriptive” and

the mark is suggestive because: suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or

perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services. *See In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985); the mark SMART BROWSER requires imagination, thought or perception to reach a conclusion as to the nature of the goods or services.

With this mark an objective person requires imagination, thought or perception as to the nature of the goods, which are a specific kind of computer application for a specific application, which is not a “browser” that is used for web searches and is identified as: *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.*

Examiner cites two different definitions as follows:

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 website or content. Basic features include automatic entering of the http:// prefix or .com suffix as well as using previous lookups to complete the URL after the first several characters have been typed in. Other

features include analyzing what is typed in and determining whether the browser should go to a site with that name or to search site to search for content.

With due respect, this definition of smart browser and smart browsing as cited by the Examiner and reproduced above has no relationship to the description of the goods. The description of the goods is reproduced here below:

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.

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 or 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.

Further, based on a fair and equitable reading of the TMEP Section 1209 and it many cites therein, the mark is not “merely descriptive” because:

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. Thus the mark cannot be “merely descriptive” and

the mark is incongruent because: the Board has described incongruity in a mark as “one of the accepted guideposts in the evolved set of legal principals for discriminating the suggestive from the descriptive mark.”

And has noted that the concept mere descriptiveness “should not penalize coinage of hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and “mental pause”.

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 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.

Applicant respectfully submits that the mark is not merely descriptive but suggestive for the following reasons. First, the words SMART and BROWSER are incongruous terms as these two terms are not commonly used in combination. Second the mark does not convey an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods and/or services.

Based on the applicable law and regulations above, Applicant argues the applicant's mark for the identified good/services is suggestive and the mark is also incongruent and thus also suggestive.

The identification of goods defines the goods in question as: *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.

Therefore, with due respect, with this 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.

Therefore Applicant respectfully submits that based on the foregoing analysis, the mark is not “merely descriptive” as the mark does not satisfy the legal standard of “merely descriptive”.

Signed/Date: 03/22/2014

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