

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: April 2, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Dish Network, LLC*  
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Serial No. 85851513  
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Ian L. Saffer of Kilpatrick Townsend & Stockton LP for Dish Network, LLC.

Andrea P. Butler, Trademark Examining Attorney, Law Office 102,  
Mitchell Front, Managing Attorney.

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Before Richey, Deputy Chief Administrative Trademark Judge, and Kuhlke and  
Wolfson, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Dish Network, LLC (Applicant), seeks registration on the Principal Register of the standard character mark SMARTBOX for “set-top boxes,” in International Class 9.<sup>1</sup>

The Trademark Examining Attorney has refused registration of Applicant’s mark on the ground that SMARTBOX is merely descriptive of Applicant’s goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

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<sup>1</sup> The original Applicant, Enseo, Inc., filed Application Serial No. 85851513 on February 15, 2013, based upon Applicant’s allegation of first use and first use in commerce on October 1, 2012 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

When the refusal was made final, Applicant appealed and filed a request for reconsideration.<sup>2</sup> On July 10, 2014, the Examining Attorney denied the request and the appeal was resumed. The Examining Attorney and Applicant filed briefs. We affirm the refusal to register.

### **Mere Descriptiveness**

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). *See also In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (*quoting, Estate of P.D. Beckwith, Inc. v. Commissioner*, 252 U.S. 538, 543 (1920) (“A mark is merely descriptive if it ‘consist[s] merely of words descriptive of the qualities, ingredients or characteristics of’ the goods or services related to the mark.”)) The determination of

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<sup>2</sup> In the first Office action, the Examining Attorney also refused registration because the specimen of use did not show the applied-for mark in use in commerce as a trademark. June 5, 2013 Office Action, TSDR (Trademark Status & Document Retrieval the USPTO online database) p. 1. On December 2, 2013, Dish Network, LLC submitted a substitute specimen of use, displaying SMARTBOX in close proximity to DISH on the set-top box, verifying the substitute specimen was in use as of the filing date of the application, February 15, 2013. We note the assignment from Enseio, Inc. to Dish Network, LLC was signed on July 1, 2013 and July 15, 2013, and filed with the Assignment Branch on July 23, 2013. *See* Reel/Frame 005076/0226. The assignment indicates it is “effective” as of June 24, 2013, approximately four months after the February 15, 2013 application filing date. We further note that, pictures of the same product in Dish Network, LLC’s advertising do not include SMARTBOX on the set-top box itself. Compare specimen of use filed December 4, 2013 (TSDR p. 66) with the product information sheets submitted on June 19, 2014 (TSDR p. 11) and on December 23, 2013 (TSDR pp. 44, 46). It does appear on the set-top box on the web page downloaded on July 9, 2014 (July 10, 2014 Denial of Request for Reconsideration, TSDR pp. 2-3). In any event, the Examining Attorney accepted the substitute specimen and withdrew that refusal.

whether a mark is merely descriptive must be made “in relation to the goods [or services] for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use.” *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant ingredient, quality, characteristic, function, feature, purpose or use of the goods or services. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987).

Where a mark consists of multiple words, the mere combination of descriptive words does not necessarily create a nondescriptive word or phrase. *In re Phoseon Tech., Inc.*, 103 UPQ2d 1822, 1823 (TTAB 2012); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988); *cf. In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987) (SCREENWIPE held generic). If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. *Oppedahl & Larson LLP*, 71 USPQ2d at 1371. However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods or services. *See*

*generally In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968). *See also In re Shutts*, 217 USPQ 363, 364-65 (TTAB 1983).

### **Evidence and Argument**

The Examining Attorney asserts that “[t]he term SMARTBOX immediately conveys information about a feature of the applicant’s goods. Specifically, the goods are a set-top box with ‘smart’ capabilities.” Ex. Att. Br. p. 3.

In support of her position, the Examining Attorney submitted definitions for the terms “SMART” “BOX” and “SET TOP BOXES”:

Smart ... “Of, relating to, or being a highly automated device, especially one that imitates human intelligence (yahoo.com/reference/dictionary, June 5, 2013 Office action, TSDR p. 3), “smart machines, especially weapons, use computer technology to make them effective” (www.macmillandictionary.com, June 5, 2013 Office action, TSDR p. 20), “In computer technology, a relative term, indicating how sophisticated a program or machine is and how many capabilities it has. A ‘smart missile’ is one that is guided electronically, as opposed to a non-hi-tech missile; “smart modems” have more capabilities and can be programed to make more decisions than earlier modems” (www.computeruser.com, July 10, 2014 Denial of Request for Reconsideration, TSDR p. 4), and “operating by automation” (www.merriam-webster.com, July 10, 2014 Denial of Request for Reconsideration, TSDR p. 44);

Box ... “a self-contained piece of electronic equipment” (www.merriam-webster.com, June 5, 2013 Office Action, TSDR p. 11);

Set-Top Box ... “A set-top box is a device that enables a television set to become a user interface to the Internet and also enables a television set to receive and decode digital television (DTV) broadcasts. ... In the DTV realm, a typical digital set-top box contains one or more microprocessors for running the operating system, possibly Linux or Windows CE, and for parsing the MPEG

transport stream. A set-top box also includes RAM, an MPEG decoder chip, and more chips for audio decoding and processing. The contents of a set-top box depend on the DTB standard used. European DVB-compliant set-top boxes contain parts to decode COFDM transmissions while ATSC-compliant set-top boxes contain a hard drive for storing recorded television broadcasts, for downloaded software, and for other applications provided by your DTV service provider.” (www.searchnetworking.techtarget.com, June 5, 2013 Office Action, TSDR pp. 7-8), and “[Set top boxes are] designed to sit atop a television and serve as a link to interactive communications systems” (**RANDOM HOUSE UNABRIDGED DICTIONARY** (1997) from <http://dictionary.infoplease.com>, December 23, 2013 Office action, p. 37).

The Examining Attorney also submitted an excerpt from Wikipedia for the term “Smart device” describing it as “an electronic device, generally connected to other devices or networks via different protocols such as Bluetooth, NFC, WIFI, 3G, etc., that can operate to some extent interactively and autonomously.”<sup>3</sup>

In addition, she submitted “internet evidence relating to the ‘smart’ attributes of set-top boxes”:

A set-top box is a device that enables a television set to become a user interface to the Internet and also enables a television to receive and decode digital television (DTV) broadcasts ... In the Internet realm, a set-top box is really a specialized computer that can ‘talk to’ the Internet ... In the DTV realm, a typical digital set-top box contains one or more microprocessors for running the operating system, possibly Linux or Windows CE, and for parsing the MPEG transport stream. A set-top box also includes RAM, and MPEG decoder chip, and more chips for audio decoding and processing;<sup>4</sup>

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<sup>3</sup> www.wikipedia.org, July 10, 2014 Denial of Request for Reconsideration, TSDR p. 51.

<sup>4</sup> www.searchnetworking.com, June 5, 2013 Office action, TSDR pp. 7-8.

Cavium family of Celestial Set Top Box processors offer industry leading integration ... Benefits [include] ... Secure Microprocessor and OTP ... and Smart Card;<sup>5</sup>

Its high processing capabilities enable fast transcoding for true multiscreen experiences on PCs, televisions, tablets and mobile devices throughout the home. ...We are very proud to introduce our new generation of set-top boxes offering smart features for IPTV services and high performance for seamless end-user experiences...;<sup>6</sup> and

By acting as an interface between the operator's delivery network and the television – smart or otherwise – the set-top box ensures content is delivered with quality and a consistent user experience. ... Set-top boxes are also getting 'smarter' themselves. Powerful processors with advanced chipsets are helping to deliver an increasingly sophisticated product with advanced functionality, including 3D viewing, games and apps.<sup>7</sup>

She also submitted evidence showing that Applicant's set-top boxes contain the same type of "smart" features:

All set-top boxes include an imbedded platform for better performance and speed, are capable of Pro:Idiom and Verimatrix decryption, and have integrated control display for more than 400 commercial and hospitality display ... Enseio [Applicant's predecessor-in-interest] set-top boxes in guest rooms can be updated for firmware and configuration (cloned) from the head-end, without a costly room visit or disruption to the guest;<sup>8</sup>

SMARTbox is an enterprise-grade solution that boasts a number of features designed to support hotel use. As hotels face increasing costs to transition to HD, SMARTbox will deliver digital HD capabilities and analog SD from a single unit, ...Other benefits offered by

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<sup>5</sup> www.cavium.com, June 5, 2013 Office action, TSDR pp. 5-6.

<sup>6</sup> www.st.com, December 23, 2013 Office action, TSDR pp. 13-15.

<sup>7</sup> www.theguardian.com (U.S. Edition), December 23, 2013 Office action, TSDR p. 18.

<sup>8</sup> www.enseio.com, June 5, 2013 Office action, TSDR p. 18.

SMARTbox include: remote monitoring and management capabilities;<sup>9</sup>

Smartbox adapts to current configurations and is always prepared for the next upgrade as technology advances ... delivers more features, capabilities and quality picture than traditional solutions ... simple, user-friendly onscreen guide;<sup>10</sup>

The technology packed inside smartbox is why it's revolutionary. What used to need an entire room is now housed within a box slightly bigger than a microwave and it's smaller than any other product of its kind, ... The first consolidated video platform that has the ability to service any property configuration or infrastructure. ... Offers integrated wireless modem that connects to the private and secure DISH network. The network is continually monitored for real-time updates on the status of each smartbox;<sup>11</sup>

Monitoring power, system health and configuration are implemented with the integrated wireless modem. Remote management is also fulfilled with the same integrated wireless modem."<sup>12</sup>

She concludes that the "evidence shows that the applicant's set-top boxes are 'smart' because they have the capability to receive, process, control and transmit data. Thus, the term SMARTBOX clearly describes a key feature of the goods." Ex. Att. Br. p. 6.

In support of its position that its proposed mark SMARTBOX is not merely descriptive of its goods, Applicant submitted:

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<sup>9</sup> <http://satellite.tmcnet.com>, December 23, 2013 Office action, TSDR p. 43.

<sup>10</sup> <http://commercial.dish.com>, July 10, 2014 Denial of Request for Reconsideration, TSDR p. 3.

<sup>11</sup> [www.don-lors.com/DISH](http://www.don-lors.com/DISH), July 10, 2014 Denial of Request for Reconsideration, TSDR p. 55-56.

<sup>12</sup> <http://commercial.dish.com>, December 23, 2013 Office action, TSDR p. 44.

A search result from the online dictionaries showing no result for “SMARTBOX”;<sup>13</sup>

An entry from Wikipedia for “Set-top box” describing it as “an information appliance device that generally contains a TV-tuner input and displays output connects to a television set and an external source of signal, turning the source signal into content in a form that can then be displayed on the television screen or other display device. They are used in cable television, satellite television, and over-the-air- television systems, as well as other uses. ... Satellite and microwave-based services also require specific external receiver hardware, so the use of set-top boxes of various formats has never completely disappeared. ... ”;<sup>14</sup>

Advertising for its SMARTBOX product describing one of its features as an “integrated wireless modem” used to monitor power, system health and configuration, and remote management;<sup>15</sup> and

Excerpts from third-party websites using the term “Smartbox” as a trademark for (1) gift packages “which entitles you to a leisure activity (ex: Ferrari car driving, pampering in a spa institute, luxurious escapes)” (2) portable storage services for home staging or moving (3) a pesticide application system (4) an automated euthanasia for animals (5) a vending machine and (6) plaster dispenser for a dental laboratory.<sup>16</sup>

Applicant argues that its proposed mark SMARTBOX is unitary with “no space, hyphen, or other punctuation between the ‘SMART and ‘BOX’ components” and the Examining Attorney erred in her analysis by “breaking Applicant’s mark into two

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<sup>13</sup> www.merriam-webster.com, www.dictionary.reference.com, December 4, 2013 App. Response, TSDR pp. 3, 4.

<sup>14</sup> www.wikipedia.com, June 19, 2014 Request for Reconsideration, TSDR p. 3.

<sup>15</sup> *Id.*, TSDR pp. 9-12.

<sup>16</sup> *Id.*, TSDR pp. 14-22. The evidence attached to the brief has not been considered as it is untimely and the Examining Attorney’s objection is sustained. Trademark Rule 2.142(d). To the extent it comprises material already submitted that material is of record and has been considered.

parts, ‘SMART’ and ‘BOX,’ and then attempting to separately define each part.” App. Br. p. 4. We see no error in the Examining Attorney’s analysis. To understand the meaning of the mark it is appropriate to look at its separate components, but the final analysis must be as to the mark in its entirety. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219 (affirming Board’s determination of mere descriptiveness based on dictionary definitions of individual terms). After showing the meaning of the separate parts the Examining Attorney correctly analyzed the mark in its entirety concluding that “[t]he evidence shows that this combination of descriptive terms retains its descriptive meaning and thus, the composite term SMARTBOX does not create a unique, incongruous or otherwise nondescriptive meaning in relation to the applicant’s goods.” Ex. Att. Br. p. 8.

Applicant argues that the evidence supports a finding that potential consumers would “understand the words ‘smart’ and ‘box’ to refer to something other than Applicant’s goods.” App. Br. p. 4. In support of this argument Applicant asserts that it “is a coined word with no dictionary definition ... [a]s such, Applicant’s mark cannot be said to immediately and directly convey information about the goods that would be readily understood by the consuming public.” *Id.* p. 5. However, the fact that the term SMARTBOX is not found in the dictionary is not controlling on the question of registrability. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987). In addition, the fact that Applicant may be the first and only user of the term for such goods does not obviate a mere descriptiveness refusal. *In re Nat’l Shooting Sports Found., Inc.*, 219 USPQ 1018, 1020 (TTAB 1983).

Applicant's arguments regarding the other meanings of the word SMART do not take into account the perception of the consumer as to meaning in the context of Applicant's goods, *i.e.*, what meaning is relevant to "set-top boxes." The meanings "person who is bright," "energetic," "shrewd" or "fashionable" have no relevance to Applicant's goods. Applicant's argument that "[a] consumer encountering the term 'SMARTBOX' would have no way to conclude that term refers to a set-top box versus a multitude of other types of boxes without either mature reasoning or additional information about the goods" is misplaced. App. Br. p. 5. Applicant misunderstands the premise of the analysis which is to analyze consumer perception when confronted with the mark on the goods. The fact that SMART may have a different merely descriptive meaning in another context, is not controlling on the question of descriptiveness. *In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012); *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984).

Applicant argues that "[t]wo recent [non precedential] TTAB decisions compel reversal of the descriptiveness refusal." App Br. p. 7. The first decision Applicant relies on is *In re WGI Innovations, Ltd.*, Serial No. 85245646 (TTAB 2013) wherein the Board held the mark LIVEVIEW for use in connection with "game scouting cameras," was not merely descriptive based on findings that the record showed the term "live view" referred to functions not present in the applied-for goods and therefore resolved doubt in favor of Applicant. The Board did not make its decision, as applicant suggests, because the mark "should not have been dissected." App. Br. p. 7. In *In re Barteca Restaurants, LLC*, Serial Nos. 85202482 and 85202583 (TTAB

2013), the Board held the mark BARTACO was not merely descriptive of “restaurant and bar services” because it was not clear from the record if prospective consumers would perceive the separate elements BAR and TACO in the unitary mark BARTACO due to the “unnatural order of the words” and the need for some mental reasoning to determine the nature of the services. *Id.* pp. 6, 8. The Board highlighted that “the mere telescoping of the term BARTACO is [not] sufficient to overcome a refusal to register based upon mere descriptiveness.” *Id.* at 6. In the case before us, the wording in the telescoped term is not in an “unnatural order” and Applicant’s advertising, which touts smart capabilities such as “imbedded platforms,” “decryption,” “integrated control display,” “remote monitoring,” and an “integrated wireless modem,” shows how consumers will be presented with the term SMARTBOX in connection with an integrated, or smart, set-top box.

Applicant also relies on prior Board non-precedential decisions with “SMART”-formative marks” where the Board reversed descriptiveness refusals. We first note that prior decisions concerning other marks and other goods are not binding on the Board and each case must be decided on its own merits. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). With regard to *In re PointCast Inc.*, Serial No. 75022018 (SMARTSCREEN for “computer software, and manuals sold as a unit, for dynamically composing a script-based animation in which news headlines, stock information, and other content are combined with graphics and advertisements to form a presentation of useful information”),<sup>17</sup> we observe that the

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<sup>17</sup> December 4, 2013 App. Response, TSDR pp. 26-36.

Board cited to the precedential decision *In re Cryomedical Sciences Inc.*, 32 USPQ2d 1377, 1379 (TTAB 1994) (SMARTPROBE for “one time use, disposable cryosurgical probes”) and distinguished the case before it because in *Cryomedical* the term SMART preceded and modified the generic name of the goods PROBE. This case is more akin to the facts in the precedential *Cryomedical* decision as SMART modifies BOX which comprises part of the generic term for set-top box. As the Board noted in *Cryomedical* in 1994, “[i]t is undeniable that computers have become pervasive in American daily life [and] [t]he ‘computer’ meaning of the term ‘smart,’ as is the case with many ‘computer’ words, is making its way into the general language.” *Cryomedical*, 32 USPQ2d at 1378. Nothing has changed in that regard since 1994, other than the fact that it is a pervasive practice, as shown by this record, to incorporate the term SMART to designate computational abilities in a product. See *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002) (SMARTTOWER merely descriptive of commercial and industrial cooling towers and accessories therefor sold as a unit). *In re DLI Engineering Corporation*, Serial No. 75725582 (TTAB 2001) presented the question whether the term SMARTMACHINE TECHNOLOGIES was merely descriptive of “computer software and hardware for predicting and communicating maintenance needs for industrial machinery.”<sup>18</sup> This case undermines Applicant’s argument because the applicant in that case disclaimed SMART MACHINE and the Board stated “there is no doubt that SMARTMACHINE is a descriptive term as applied to applicant’s goods.” *Id.* at 5. In

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<sup>18</sup> December 4, 2013 App. Response, TSDR pp. 38-53.

*In re Smart Belt Corp. of America*, Serial No. 75763106 (TTAB 2002) the Board found SMART BELT was not merely descriptive of “packaging machines for use in the food packaging industry” inasmuch as the USPTO did not establish “a prima facie showing that the mark SMART BELT is merely descriptive of applicant’s identified goods.”<sup>19</sup> *Id.* at 5. Noting that it may be merely descriptive of an automated conveyor belt, the Board stated that there was no evidence that conveyer belts were a “significant feature of [the applied-for goods] packaging machines.” *Id.* at 6. Again, this case tends to support the Examining Attorney’s position in that a “box” is a significant feature of a set-top box.

Applicant argues that “there is no evidence in the record that any other party in Applicant’s industry uses the term ‘SMARTBOX’ descriptively with respect to their goods and services.” App. Br. p. 10. The presence of third-party use could be probative on the question of competitive need but the absence thereof is not dispositive. As noted above, although Applicant may be the first and only user of the term for such goods, this fact, does not obviate a mere descriptiveness refusal. *Nat’l Shooting Sports Found., Inc.*, 219 USPQ at 1020.

Both the Examining Attorney and Applicant submitted third-party registrations in support of their respective positions. The Examining Attorney submitted third-party registrations for marks that incorporate the term SMART registered on the Supplemental Register indicating the term is merely descriptive of those goods. *See, e.g.*, Reg. No. 1488905 for the mark SMART GATE for “electronic musical

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<sup>19</sup> December 4, 2013 App. Response, TSDR pp. 55-61.

instrument products, namely power attenuators, signal processors and parts therefor”; Reg. No. 3443105 for the mark SMARTPOWER for “an automatic power-off mechanism sold as an integral component of a radar/laser detector”; Reg. No. 4434038 for the mark SMARTVALVE for “electronically controllable valves specifically for use in reclamation of refrigerant during appliance recycling or maintenance”; Reg. No. 4255603 for the mark SMARTSPEAKER for “audio speakers, audio amplifiers, and audio receivers for use with telephones, mobile phones, cellular phones, MP3 players, portable and handheld digital electronic devices, and computers”; and Reg. No. 4545326 for the mark SMARTVP for “electronic video equipment connected to a television and the internet to enable IP-based video and phone conversations, with and without audio.”<sup>20</sup>

Applicant submitted various third-party registrations for the mark SMARTBOX registered on the Principal register without a showing of acquired distinctiveness under Section 2(f) of the Trademark Act or a disclaimer under Section 6 of the Trademark Act. *See, e.g.*, Reg. No. 3821950 for, *inter alia*, magnetically encoded credit cards, issue of gift vouchers for commercial or advertising purposes; Reg. No. 2664032 for microprocessors used with soft tissue enhancement devices for collecting data from said devices, for transmitting data to and from said devices, and for controlling said devices from a remote location; Reg. No. 3125397 for non-metallic pesticide container with a metering device for dispensing material from the

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<sup>20</sup> July 10, 2014 Denial of Request for Reconsideration, TSDR pp. 19, 20-21, 24-25, 34-36, 39-40.

container, for use in agriculture sold empty for the mark;<sup>21</sup> and Reg. No. 3350117 for “tamper and pilfer resistant lock on closed, portable electronic safes that provide a continuous chain of custody and are opened with unique access codes issued against strong authentication requirements.”<sup>22</sup>

We do not find the third-party registrations particularly probative on this issue. The most that can be said is sometimes examining attorneys consider terms that incorporate the word SMART to be merely descriptive and sometimes they do not, depending on the circumstances of each case. As is well established, we must make our decision in each case on its own merits “[e]ven if some prior registrations had some characteristics similar to” the current application, “the PTO’s allowance of such prior registrations does not bind the Board ... .” *In re Nett Designs Inc.*, 57 USPQ2d at 1566; *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006) (SMARTSFP merely descriptive of optical transceivers).

### **Analysis**

The term “BOX” is, at a minimum, merely descriptive of Applicant’s “set-top boxes” and Applicant does not dispute this. The term “SMART” also describes a feature of Applicant’s set-top boxes, namely, that they have the capability to receive, process, control and transmit data. As shown by the record, set-top boxes contain microprocessors, as observed by Applicant. App. Br. p. 6. Further, the combination SMARTBOX does not present a unique or incongruous term such that the combination removes the merely descriptive significance from the terms.

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<sup>21</sup> December 4, 2013, TSDR pp. 63-65.

<sup>22</sup> June 16, 2014 Denial of Request for Reconsideration, TSDR p. 24.

Applicant's argument is largely dependent on ignoring the context in which Applicant uses its proposed mark. However, as noted above, we must consider "the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the *manner of its use* or intended use." *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219 (emphasis added). Applicant's broad identification encompasses set-top boxes with smart capabilities and Applicant's website makes clear that significant features of its goods include an "imbedded platform," "integrated wireless modem" and "remote monitoring." *See Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219. *See also In re Bayer Aktiengesellschaft*, 82 USPQ2d at 1832 (Internet evidence may be considered for purposes of evaluating a trademark). *Cf. In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007) (appropriate to review applicant's website for context to inform the understanding of a term in order to define the genus).

Where the combination of descriptive terms creates a unitary mark with a unique incongruous or otherwise non descriptive meaning in relation to the goods, the mark is registrable. *Colonial Stores, Inc.*, 157 USPQ at 384. Applicant's use of the term SMARTBOX does not evoke other meanings such that "the merely descriptive significance of the term[s] is lost in the mark as a whole." *RiseSmart Inc.*, 104 USPQ2d at 1934 (*quoting In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983)). *See also In re Tower Tech, Inc.*, 64 USPQ2d at 1317-18 and *In re Cryomedical Sciences Inc.*, 32 USPQ2d at 1379. In the context of the goods, set-top

boxes, the meaning of SMARTBOX is clear; there is no incongruity or double entendre.

We find that SMARTBOX immediately describes a significant feature of the goods, namely that they have smart, or automated, capabilities.

***Decision:*** The refusal to register Applicant's mark SMARTBOX as merely descriptive under Section 2(e)(1) is affirmed.