

This Opinion is not a
Precedent of the TTAB

Mailed: September 3, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

In re LumaSense Technologies Holdings, Inc.
—

Serial No. 86004595
—

John W. Montgomery of Osha Liang LLP,
for LumaSense Technologies Holdings Inc.

Jennifer D. Richardson, Trademark Examining Attorney, Law Office 113,
Odette Bonnet, Managing Attorney.

—
Before Bucher, Shaw, and Hightower,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

LumaSense Technologies Holdings, Inc. (“Applicant”) seeks registration on the
Principal Register of the mark shown at right for:

The logo for SmartDGA is displayed in a yellow, rounded rectangular shape. The text "SmartDGA" is written in a bold, black, sans-serif font.

Early fall detector for electrical power distribution transformers; Dissolved gas conditions monitor for electrical power transformers; On load tap changer condition monitor for electrical transformers; Computer program for analyzing dissolved gas conditions data; Computer program for comparing monitor instrument data to laboratory data, in International Class 9.¹

¹ Application Serial No. 86004595 was filed on July 8, 2013, based on Applicant’s claim of first use anywhere and use in commerce since at least as early as March 30, 2012.

The designation “SmartDGA”² is disclaimed apart from the mark as shown. The colors gold and black are claimed as a feature of the mark, which includes the following description: “The mark consists of a polygon shaded in gold containing the wording ‘SMARTDGA’ in stylized black font.”

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

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.


It has long been held that the disclaimer of a term constitutes an admission of the merely descriptive nature of that term, as applied to the goods or services with which it is used, at the time the disclaimer was made. *See Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972); *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1442 (TTAB 2005). In this instance, SmartDGA, the only wording in the composite, has been disclaimed and therefore is descriptive in its entirety.³

An applicant may register a display of descriptive matter on the Principal Register if the stylization of the words or the accompanying design features of the asserted mark create an impression on purchasers separate and apart from the

² DGA is an initialism for “Dissolved Gas Analysis.” *See* October 25, 2013 Office action at 11-17.

³ Applicant’s Registration No. 4416158 for the same wording in standard characters and near-identical goods is on the Supplemental Register. *Id.* at 2-4.

impression made by the descriptive wording. See *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961, 964 (Fed. Cir. 1985); *In re American Academy of Facial Plastic and Reconstructive Surgery*, 64 USPQ2d 1748, 1753 (TTAB 2002). If the background or other design elements are inherently distinctive, the mark may be registered without evidence that it is recognized as a trademark; if they are not inherently distinctive, then proof of acquired distinctiveness as provided under Section 2(f) of the Trademark Act is required. *In re E. J. Brach & Sons*, 256 F.2d 325, 118 USPQ 308, 310 (CCPA 1958).

Applicant seeks to register  without proof of acquired distinctiveness. Therefore, we must determine whether the design components claimed by Applicant – the colors gold and black, the polygon shape, and the stylized font – create a commercial impression apart from the significance of the disclaimed and descriptive wording SmartDGA. Our decision is “a necessarily subjective one,” *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224, 1227 (TTAB 1987), which “must be determined based on a viewer’s first impression.” *In re Grande Cheese Co.*, 2 USPQ2d 1447, 1449 (TTAB 1986).

We find that the design components of the mark do not create a commercial impression separate and apart from the verbal components of the composite, for the following reasons. First, the typeface in which the lettering appears is a simple sans-serif font; the capitalization and slight bolding of the initialism “DGA” do not contribute to the design’s commercial impression.

Second, the shape of the carrier in which the wording is presented is a uniform polygon. Applicant emphasizes that the shape is an elongated, rather than an

equilateral, hexagon.⁴ Although Applicant's elongated hexagon may not be as common a shape as, e.g., a rectangle, it remains a nondistinctive geometric figure used as a background for the display of the term SmartDGA. We do not find that consumers would regard this shape as a trademark for Applicant's goods absent evidence of distinctiveness of the background design. *See In re Anton/Bauer Inc.*, 7 USPQ2d 1380, 1381 (TTAB 1988).

Finally, the fact that Applicant's design is shaded in gold "does not change the standard by which these types of marks are judged." *In re Benetton Group S.p.A.*, 48 USPQ2d 1214, 1216 (TTAB 1998). Color, moreover, can never be inherently distinctive. *See Wal-Mart Stores Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1164 (1995).

Distinctiveness means that the primary significance of the non-literal components of the applied-for mark is as a designation of source rather than as a mere background to the presentation of the term SmartDGA. *See Roselux Chem. Co. v. Parsons Ammonia Co.*, 229 F.2d 855, 132 USPQ 627 (CCPA 1962). Considering all design elements of Applicant's composite together in their entirety, we conclude that these non-literal aspects do not create a separate commercial impression. Thus, we find that Applicant's mark as a whole is merely descriptive.

Decision: The refusal to register is affirmed.⁵

⁴ Appeal Brief at 7, 7 TTABVUE 9.

⁵ Because we affirm the refusal of registration, the request in Applicant's reply brief to amend its identification of goods is denied as moot.