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Subject: U.S. TRADEMARK APPLICATION NO. 86004595 - SMARTDGA - 17677027001 - EXAMINER BRIEF

Attachment Information:

Count: 7

Files: 74557953P001OF002.JPG, 74557953P002OF002.JPG, 85389635P001OF003.JPG,
85389635P002OF003.JPG, 85389635P003OF003.JPG, images attachment #2.jpg, 86004595.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86004595

MARK: SMARTDGA



CORRESPONDENT ADDRESS:

JOHN W MONTGOMERY

OSHA LIANG LLP

909 FANNIN ST STE 3500

HOUSTON, TX 77010-1034

GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: LumaSense Technologies Holdings, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

17677027001

CORRESPONDENT E-MAIL ADDRESS:

docketing@oshaliang.com

EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

Applicant has appealed the examining attorney's final refusal to register the mark "SMARTDGA" plus design for "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." Registration was refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that the applied-for mark is merely descriptive of the identified goods.

STATEMENT OF THE FACTS

Applicant filed an application on July 8, 2013 seeking registration of the mark "SMARTDGA" plus design for "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 an Office action dated October 25, 2013, registration was refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1) on the ground that the applied-for mark is merely descriptive of the identified goods. Applicant was also required to claim ownership of a relevant prior registration and amend the mark description and color claim.

On April 25, 2014, applicant submitted a response to the Office action where it argued against the Section 2(e)(1) refusal, submitted a claim of ownership of the relevant prior registration and amended the mark description and color claim.

On May 16, 2014, the Section 2(e)(1) refusal was made final. Applicant was advised that the requirements to claim ownership of a relevant prior registration and amend the mark description and color claim had been satisfied.

On November 14, 2014, applicant simultaneously filed a Notice of Appeal and Request for Reconsideration.

On December 5, 2014, applicant's Request for Reconsideration was denied and applicant was advised that the Section 2(e)(1) refusal was continued and maintained.

On February 12, 2015, applicant filed its appeal brief, which was forwarded to the examining attorney on March 3, 2015, for statement.

ISSUE ON APPEAL

The sole issue on appeal is whether the applied-for mark, "SMARTDGA" plus design, when used in connection with "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" is merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act.

ARGUMENT

THE WORDING IN THE APPLIED-FOR MARK, "SMARTDGA," DESCRIBES A FEATURE AND THE FUNCTION OF APPLICANT'S GOODS AND THE STYLIZATION AND DESIGN IN APPLICANT'S MARK ARE NOT SUFFICIENT TO CREATE AN IMPRESSION SEPARATE AND APART FROM THE IMPRESSION MADE BY THE WORDING ITSELF SUCH THAT THE MARK IS MERELY DESCRIPTIVE WITHIN THE MEANING OF SECTION 2(e)(1) OF THE TRADEMARK ACT.

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.*, 695 F.3d 1247, 1251, 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)).

Applicant seeks to register the mark "SMARTDGA" plus design for use in connection with "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."

As applied to electronic goods and computer software, such as applicant's, the word "smart" describes a feature of goods which "operat[e] as if by human intelligence by using automatic computer control."¹ The term "smart" has been held merely descriptive of automated devices. *See In re Cryomedical Scis. Inc.*, 32 USPQ2d 1377, 1378 (TTAB 1994) (holding SMARTPROBE merely descriptive of disposable cryosurgical probes); *see also In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002) (holding SMARTTOWER merely descriptive of commercial and industrial cooling towers and accessories therefor, sold as a unit).

The wording "DGA" is substantially synonymous with the wording "dissolved gas analysis," which refers to the study of dissolved gases in transformer oil used to identify the gases being generated by a particular unit for preventative maintenance reasons and to detect faults.²

¹ *See, non-final Office action dated October 25, 2013 at pg. 6*

² *See, non-final Office action dated October 25, 2013 at pgs. 11-17*

Therefore, in connection with applicant's goods, the wording "SMARTDGA" merely describes a feature and the function of the goods, namely, that applicant's electronic goods and computer software are "smart" and thus operate as if by human intelligence by using automatic computer control and function to perform a "dissolved gas analysis" by studying dissolved gases in transformer oil to supply information about the gases being generated in a particular unit for use in performing preventative maintenance and detecting faults.

Generally, if the individual components of a mark retain their descriptive meaning in relation to the goods, the combination results in a composite mark that is itself descriptive and not registrable. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012); TMEP §1209.03(d); *see, e.g., In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows where the evidence showed that the term "BREATHABLE" retained its ordinary dictionary meaning when combined with the term "MATTRESS" and the resulting combination was used in the relevant industry in a descriptive sense); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services, because such wording "is nothing more than a combination of the two common descriptive terms most applicable to applicant's services which in combination achieve no different status but remain a common descriptive compound expression").

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods is the combined mark registrable. *See In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013).

In this case, both the individual components and the composite result are descriptive of applicant's goods and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods.

Specifically, “SMARTDGA” immediately conveys that a feature of the goods is that they operate as if by human intelligence using automatic computer control and study gases generated being generated by a transformer.

In the present case, applicant does not dispute that the wording “SMARTDGA” is descriptive. Applicant has disclaimed the wording “SMARTDGA,” which is in line with Registration No. 4416158, owned by applicant, for the mark “SMARTDGA” in standard character format for the same goods at issue herein on the Supplemental Register.³

Based upon applicant’s admission that the wording “SMARTDGA” in the mark is merely descriptive, the crux of this case is whether the stylized font in which the wording in the mark is written and design element in the mark are sufficient to create an impression separate and apart from the impression made by the wording itself.

The stylization must be sufficiently distinctive so as to “create an impression on purchasers separate and apart from the impression made by words themselves.” *See In re Am. Academy of Facial Plastic & Reconstructive Surgery*, 64 USPQ2d 1748, 1753 (TTAB 2002); *see also In re Sadoru Group, Ltd.*, 105 USPQ2d 1484, 1485 (TTAB 2012); *In re Guilford Mills Inc.*, 33 USPQ2d 1042, 1044 (TTAB 1994).

The determination regarding whether stylization is sufficiently distinctive in character to “rescue” the designation as a whole is “a necessarily subjective one,” *In re Bonni Keller Collections Ltd.*, 6 USPQ2d, 1224, 1227 (TTAB 1987), and “must be determined based on a viewer’s first impression.” *In re Grande Cheese Co.*, 2 USPQ2d 1447, 1449 (TTAB 1986).

Here, the stylized font used by applicant in the mark consists of an extremely basic sans-serif font. There is a very minor difference in thickness between the “SMART” portion of the wording and the

³ *See, non-final Office action dated October 25, 2013 at pgs. 2-4*

“DGA” portion of the wording. Further, the wording “SMART” appears with the letter “S” in upper case and the remainder of the wording in lower case, while the wording “DGA” appears in all upper case. The degree of stylization in this case is not sufficiently striking, unique or distinctive so as to create a commercial impression separate and apart from the unregistrable components of the mark. *See In re Sambado & Son Inc.*, 45 USPQ2d 1312 (TTAB 1997); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224 (TTAB 1987).

Specifically, the font is nothing other than ordinary in nature and the difference in thickness between the wording “SMART” and “DGA,” as well as the variance in the use of upper case and lower case letters, do not add a striking, unique or distinctive element to the wording in the mark. *See, e.g., In re Hookah Portable Enterprises, Inc.*, Serial No. 85829768, 2015 TTAB LEXIS ____ (March 27, 2015)⁴ (the stylization of “Hookah Portable”⁵ found insufficient to create an inherently distinctive impression apart from the term itself; *In re Cordua Rests. LP*, 110 USPQ2d 1227 (TTAB 2014) (the stylization of “Churrascos”⁶ found insufficient to create an inherently distinctive impression apart from the term itself); *In re Sadoru Group*, 105 USPQ2d 1484 (TTAB 2012) (the stylization of “Sadoru”⁷ found insufficient to create an inherently distinctive impression apart from the term itself). In fact, the use of all upper case letters for the “DGA” portion of the mark, which is an acronym as discussed above, is not striking, unique, or distinctive at all because acronyms are commonly presented in all upper case letters as demonstrated by the evidence showing the meaning of the acronym “DGA” discussed above.

The design element in the applied-for mark consists of a gold hexagon. Common geometric shapes, such as circles, ovals, triangles, diamonds, or stars, when used as a background for word or letter marks

⁴ To independently view and print this decision, visit <http://ttabvue.uspto.gov/ttabvue/> and insert the opposition number specified. Find the final decision in the prosecution history and left click on it to view it as a .pdf document.

⁵ Due to technological limitations, images cannot be included in the body of the brief. Therefore, the relevant image is attached hereto.

⁶ *Id.*

⁷ *Id.*

are not considered inherently distinctive. *See In re Benetton Group S.p.A.*, 48 USPQ2d 1214, 1216 (TTAB 1998). As the Board explained,

The rationale . . . is that designs of this character have been so commonly employed as background devices for word marks that composite marks of this type create but a single commercial impression with the result that purchasers would normally utilize the word portions of the marks to identify and distinguish the goods sold thereunder

Bd. of Trs. v. Pitts, Jr., 107 USPQ2d 2001, 2014 (TTAB 2013) (citing *Permatex Co. v. Cal. Tube Prods., Inc.*, 175 USPQ 764, 766 (TTAB 1972)).

Hexagons, and more specifically, gold hexagons, are common background shapes for trademarks. Specifically, the screenshot of the Hampton Inn website shows a hexagon shape used as a background shape for words.⁸ Additionally, the screenshot of the Honey Maid website shows a gold hexagon used as a background shape for words and a design.⁹ Finally, the screenshot of the Rowse Honey website shows a gold hexagon used as background shape for words and a design.¹⁰ Therefore, the evidence demonstrates that hexagons, and more specifically, gold hexagons, serve as common backgrounds for words and/or designs in marks such that consumers will need to utilize the word portions of the marks to identify and distinguish the source of the goods sold in connection with the marks.

For the foregoing reasons, the stylized font and design element in the applied-for mark do not create a separate and inherently distinctive commercial impression apart from the wording “SMARTDGA.”

⁸ *See, final Office action dated May 16, 2014 at pg. 4*

⁹ *See, final Office action dated May 16, 2014 at pg. 2*

¹⁰ *See, final Office action dated May 16, 2014 at pg. 3*

Applicant argues that the stylization and design element in the applied-for mark create an impression on relevant consumers that is separate and apart from the impression made by the words.¹¹ With respect to the stylization, applicant argues that the wording “SMARTDGA” is in a “particularly stylized font”.¹² Contrary to applicant’s assertion, the font used for the wording “SMARTDGA” is a rather ordinary font. The stylization in the applied-for mark is in no way comparable to the mark discussed in the Clutter Control, Inc. case. In that case, the applied-for mark contained a tube-like rendition of the letter “C” in the word “construct” and “closet” which made a commercial impression separate and apart from the word portion of the mark. *In re Clutter Control Inc.*, 231 USPQ 588, 589 (TTAB 1986). In the present case, applicant’s mark does not contain a degree of stylization which is anywhere near the level of stylization found in the Clutter Control, Inc. case. As noted above, the wording in the mark appears in a very basic sans-serif font and none of the letters contain any particular element of stylization. Specifically, the wording “SMARTDGA” in applicant’s mark appears very similar to, if not identical to, Arial font, and demonstrates that the font used by applicant is a commonly used font which is not striking, unique or distinctive in any way.¹³

The stylization in applicant’s mark is also not comparable to the mark discussed in the Kar Auction Services, Inc. case. In that case, the applied-for mark contained differences as to font size and spacing which the Board held create a logo/design feel. *In re Kar Auction Services, Inc.*, Serial No. 77852072 2011 TTAB LEXIS 389 (December 1, 2011)¹⁴. Here, the wording in the applied-for mark appears all in one size and there is no variance as to spacing which creates a degree of stylization in the mark comparable to the Kar Auction Services, Inc. case.

¹¹ See, applicant’s Appeal Brief at pg. 7

¹² See, applicant’s Appeal Brief at pg. 8

¹³ Footnote 5, *supra*.

¹⁴ To independently view and print this decision, visit <http://ttabvue.uspto.gov/ttabvue/> and insert the opposition number specified. Find the final decision in the prosecution history and left click on it to view it as a .pdf document.

With respect to the design element, applicant argues that the hexagon in the applied-for mark is “uniquely elongated,” and contains “unique shading” which “gives the impression that the shape is three-dimensional and gives the commercial impression of three-dimensional depth to the polygon.”¹⁵ The shape, color and shading of the design element in applicant’s mark do not obviate the refusal. As noted above, the design element in the mark is a common geometric shape. Regarding the color and shading in the mark, the addition of a color to a background design “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), citing, *In re E.J. Brach & Sons*, 256 F.2d 325, 118 USPQ 308, 310 (CCPA 1958). Here, the use of color and shading does nothing to transform the simple geometric background design into a design that is inherently distinctive. Further, applicant’s mark cannot be compared in any way to the marks in Registration Nos. 1914973 (“RUBBERMAID” plus polygon design) and 4236137 (“NETFLIX” plus red rectangle design)¹⁶ because in these registrations, the wording in the mark is not descriptive, thus rendering any determination as to whether or not the background designs in the marks are inherently distinctive unnecessary, and therefore these cases have no relevance as to the question at issue in this appeal.

Applicant additionally argues, essentially, that the examining attorney has improperly dissected the mark and that “[i]t is not proper to separate parts and disregard a distinctive design feature uniquely combined with a stylized word portion.”¹⁷ This argument is misplaced. The entire question in this case is whether the stylization and design element in the applied-for mark create a separate and inherently distinctive commercial impression apart from the wording “SMARTDGA” or whether the mark creates a single commercial impression which would render the mark descriptive under Section 2(e)(1) of the Trademark Act. Therefore, it is necessary to examine the stylization and design element in the mark

¹⁵ See, *applicant’s Appeal Brief at pg. 9*

¹⁶ *Copies of the registrations referenced by applicant, but not previously made of record, are attached hereto for the Board’s convenience.*

¹⁷ See, *applicant’s Appeal Brief at pg. 7*

separate and apart from the wording in the mark in order to determine if the stylization and design element create a commercial impression separate and apart from the word portion of the mark.

For the foregoing reasons, applicant's arguments are not persuasive.

CONCLUSION

In conclusion, applicant's mark as a whole is merely descriptive, and the stylization and design element do not create a separate and inherently distinctive commercial impression apart from the wording "SMARTDGA" such that the mark is registrable with a disclaimer of all of the wording in the mark. Accordingly, the refusal to register the applied-for mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that the applied-for mark is merely descriptive of the identified goods should be affirmed.

Respectfully submitted,

/Jennifer D. Richardson/

Trademark Examining Attorney

Law Office 113

(571) 272-6153

jennifer.richardson@uspto.gov

Odette Bonnet

Managing Attorney

Law Office 113

IMAGES

Footnote #5

Hookah
PORTABLE

Footnote #6

Churrascos

Footnote #7

SADORU

Footnote #13

SmartDGA

SmartDGA

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