

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

In re Brio AB

Serial No. 90091387

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for Brio AB.

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Before Taylor, Lykos and Adlin, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Brio AB seeks a Principal Register registration for the proposed mark SMART TECH (with “TECH” disclaimed¹), in standard characters, for “downloadable software for controlling RFID-enabled electronic toy and model trains, toy and model train sets, and components therefor,” in International Class 9; and “RFID-enabled

¹ Applicant voluntarily disclaimed the term “TECH” in its January 26, 2022 Request for Reconsideration, but the disclaimer was never entered. Nonetheless, in her March 8, 2022 Denial of the Request for Reconsideration, as well as her Appeal Brief, the Examining Attorney treated the application as including the disclaimer, and therefore we do the same in this decision.

toy and model electronic trains and train sets, and accessories and components therefor, namely, train tracks, buildings, figures, signs, vehicles and trees,” in International Class 28.²

The Examining Attorney refused registration in both classes on the ground that the proposed mark is merely descriptive of the identified goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). After the refusal became final, Applicant appealed, and filed a request for reconsideration that was denied. Applicant and the Examining Attorney filed briefs.

II. Evidence and Arguments

The Examining Attorney relies on the following dictionary definitions of the proposed mark’s constituent terms, as well as a term used multiple times in Applicant’s identification of goods:

SMART—“capable of making adjustments that resemble those resulting from human decisions, chiefly by means of electronic sensors and computer technology: smart missiles; smart machines.”³

TECH—“informal” for “technology”⁴

TECHNOLOGY—“the application of science, especially to industrial or commercial objectives” and “electronic or

² Application Serial No. 90091387, filed August 4, 2020 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on first use dates anywhere and in commerce of July 16, 2020 for the Class 9 goods and March 2018 for the Class 28 goods.

³ <https://www.ahdictionary.com/word/search.html?q=smart>.

⁴ <https://www.ahdictionary.com/word/search.html?q=tech>.

digital products and systems considered as a group: a store specializing in office technology”⁵

RFID—(abbreviation) “radio frequency identification, denoting technologies that use radio waves to identify people or objects carrying encoded microchips”⁶

December 5, 2020 Office Action TSDR 9, 11, 13;⁷ July 27, 2021 Office Action TSDR 52.

The Examining Attorney also introduced printouts from Applicant’s website showing how Applicant uses the term “smart tech.” For example:

A page from Applicant’s website featuring a “Brio World” video depicting a toy or model train states that “**Smart Tech technology is adding extra layers of functionality** and play value to BRIO Toys.”

A product listing for Applicant’s “Smart Engine Set with Action Tunnels,” also referred to as Applicant’s “Smart Tech Engine Set with Action Tunnels,” states that the engine “can communicate with its surroundings, automatically responding with various train actions like lights, sounds and motion ... you control the interactive play.” By way of example, “[w]hen approaching the **Smart Tech Bridge, the engine will automatically detect whether the stop signal is set to red or green.**”

Applicant’s description of the “Smart Washing Station” accessory for its toy or model trains states: “The rollers roll and the Smart Tech Engine moves by itself as the sound of water and bubbles is playing ... **Based on smart interactive technology with action chips. BRIO Smart toys are preferably used with BRIO Smart Tech Engine to make sounds and actions possible.**”

⁵ <https://www.ahdictionary.com/word/search.html?q=technology>.

⁶ <https://www.lexico.com/en/definition/RFID>.

⁷ Citations to the application file are to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) online database, by page number, in the downloadable .pdf format.

The “Smart Tech” page on Applicant’s website states
**“Smart Tech is our way of adding extra layers of
functionality and play value to BRIO Toys. Integrated
technology and ingenious design opens up a new kind of
interaction between child and toy. Sound, light and
action are combined to create cause-and-effect chain
reactions, telling little stories in the process. A
passing train makes the farm animals come to life
....”**

July 27, 2021 Office Action TSDR 40, 44, 48 (emphasis added); March 8, 2022 Denial
of Request for Reconsideration TSDR 24 (emphasis added).

Finally, the Examining Attorney relies on a number of third-party registrations
for marks including “SMART TECH” or close variations thereof in which the marks
are registered on the Supplemental Register or on the Principal Register under
Section 2(f) of the Act, or in which the terms “SMART,” “TECH” or “SMART TECH”
are disclaimed. July 27, 2021 Office Action TSDR 5-39. In fact, many of the Principal
Register registrations include disclaimers of the phrase “SMART TECH,” or close
variations thereof such as “SMART TECHNOLOGY.” *Id.* at 10, 19, 23, 25, 29, 31, 37.

Based on this evidence, the Examining Attorney argues that the proposed mark
combines the descriptive terms “SMART” and “TECH,” and “creates no commercial
impression separate and apart from [the] component descriptive terms.” 10
TTABVUE 4.⁸ In fact, “Applicant’s webpages explicitly state, and clearly
demonstrate, that the applicant’s goods contain automated, or ‘smart’, technology.”

⁸ Citations to the appeal record are to TTABVUE, the Board’s online docketing system. The
number preceding TTABVUE corresponds to the docket entry number, and any numbers
following TTABVUE refer to the page(s) of the docket entry where the cited materials appear.

Id. The Examining Attorney also points out that Applicant’s website describes its identified goods as “RFID enabled,” which “implies a ‘smart’ technology.” *Id.* at 5. Finally, the Examining Attorney contends that the third-party registrations of record show that the proposed mark is descriptive. *Id.* at 6.

For its part, Applicant relies on evidence “that play time is critical to child development” and that “[w]hether a toy is educational – or will help make a child ‘smarter’ by encouraging the development of certain skills – is a critical factor parents consider when shopping for toys.” It also introduced evidence that “SMART is widely used in connection with children’s toys,” and, according to Applicant, “most often does not indicate the toys are enabled with any kind of technology.” Applicant also relies on evidence that train sets “are recognized by experts as a top educational toy because playing with them develops fine motor skills, promotes problem-solving skills, and encourages creativity.” January 26, 2022 Request for Reconsideration TSDR 9-10, 15-24, 30-31, 33-38, 40-43. Finally, Applicant relies on its own descriptions of third-party registrations which it failed to properly make of record. June 4, 2021 Office Action response TSDR 8-9.⁹

⁹ Rather than introducing “copies of the registrations,” as required by *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012), Applicant merely characterized some of them in a chart, claiming that its search of USPTO records revealed that “‘SMART TECH’ (or close variations thereof) is no more than suggestive of similar goods that very likely include sensors or other types of ‘smart’ technology.” June 4, 2021 Office Action response TSDR 8-9. In the following Office Action, the Examining Attorney did not object to Applicant’s reliance on the third-party registrations it cited but did not properly introduce, instead arguing that “the registrations provided by the applicant” do not establish that the USPTO has treated the term “SMART TECH” as suggestive. July 27, 2021 Office Action TSDR 3. We address below Applicant’s reliance on the cited but not of record third-party registrations.

Applicant argues that the proposed mark is suggestive rather than merely descriptive because it “has several different suggestive connotations rather than a single descriptive meaning.” 8 TTABVUE 10. Furthermore, the proposed mark “is undoubtedly vague with respect to what qualities, features, or characteristics might appear in Applicant’s trains or software,” as evidenced by the third-party uses of “SMART” for toys that are not “enabled” by technology. *Id.* at 11-12. Moreover, Applicant argues that even if consumers perceived SMART TECH as a reference to RFID technology, “nothing about RFID technology immediately brings to mind toys or toy train sets.” *Id.* at 12.

III. Decision

The record leaves no doubt that SMART TECH is merely descriptive because it “immediately conveys knowledge of a quality, feature, function, or characteristic” of Applicant’s “RFID-enabled” toy trains and toy train software. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer AG*, 82 USPQ2d at 1831); *In re Abcor Dev.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). Specifically, the mark immediately conveys that Applicant’s software directs Applicant’s “RFID-enabled” toy trains, and that Applicant’s “RFID-enabled” toy trains take action through computer and sensor technology.

Applicant’s identification of goods and website make this clear. According to Applicant’s identification of goods, its toy trains are “RFID-enabled,” and its toy train software controls Applicant’s toy trains through RFID technology. Through this “tech” (RFID and associated software), Applicant’s “RFID-enabled” toy trains become

“smart,” and thus, as explained on Applicant’s website, the toy trains gain “extra layers of functionality,” and communicate with their surroundings, “automatically responding with various train actions like lights, sounds and motion.” July 27, 2021 Office Action TSDR 40, 44, 48; March 8, 2022 Denial of Request for Reconsideration TSDR 24.

While Applicant provided information about third-party registrations, June 4, 2021 Office Action response TSDR 8-9, even if we considered Applicant’s representations about those registrations despite their not being properly introduced into the record, they would not support a finding that the proposed mark is inherently distinctive. Applicant’s description of the results of a TESS search it conducted is meaningless because Applicant did not provide key details, such as the goods or services for which the marks are registered, whether the marks were registered under Section 2(f) of the Act or whether the terms “SMART” or “TECH” or the phrase “SMART TECH,” or variations thereof, was disclaimed. *See In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1405 n.17 (TTAB 2018) (“[T]he list does not include enough information to be probative. The list includes only the serial number, registration number, mark, and status (live or dead) of the applications or registrations. Because the goods are not listed, we do not know whether the listed [applications or] registrations are relevant.”); *see also Edom Labs. Inc. v. Licher*, 102 USPQ2d 1546, 1550 (TTAB 2012). Furthermore, even if we considered the six registrations about which Applicant did provide some pertinent details, the Examining Attorney has introduced twice as many third-party registrations for

related goods in which “SMART TECH” or close variations thereof was treated as merely descriptive. July 27, 2021 Office Action TSDR 5-39. We hasten to add that neither the existence of the third-party registrations Applicant cites nor any of the evidence in their prosecution records (even if it were of record here) compels a specific result in later, allegedly analogous cases. *See, e.g., Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1377 (Fed. Cir. 2018) (“these prior registrations do not compel registration of [Applicant’s] proposed mar[k]”) (citing *In re Cordua Rests., Inc.*, 823 F.3d 594, 600 (Fed. Cir. 2016)); *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009). As we recently stated in an analogous situation, to the extent that our decision here is inconsistent with the third-party registrations, “it is the decision required under the statute on the record before us.” *In re Ala. Tourism Dept.*, 2020 USPQ2d 10485, at *11 (TTAB 2020).

We are unpersuaded by Applicant’s arguments that the proposed mark is not merely descriptive because it: (1) “has several different suggestive connotations;” (2) is too “vague with respect to what qualities, features or characteristics might appear in Applicant’s” goods; and (3) does not immediately bring to mind toy trains. 8 TTABVUE 10-11. These arguments all suffer the same flaw, which is that Applicant misapprehends the applicable standard. “The question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them.” *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012)

(quoting *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)). In other words, whether a mark is merely descriptive is determined not in the abstract, but in relation to the goods for which registration is sought, the context in which it is being used on or in connection with the goods, and the possible significance that the proposed mark would have to the average purchaser of the goods because of the manner of its use. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

Here, consumers who know that Applicant offers “RFID-enabled” toy trains and software to control the trains will immediately understand SMART TECH to convey information about both the toy trains and the software. Specifically, they will understand that the trains will be “smart” in that they will take action (such as moving, making sounds or turning on lights) when commanded to do so through Applicant’s RFID-enabled “tech.”

Our finding here should not be surprising. Applicant voluntarily disclaimed “TECH,” which is an effective admission that the term is merely descriptive here. *In re Carlson*, 91 USPQ2d 1198, 1200 (TTAB 2009); *Bass Pro Trademarks LLC v. Sportsman’s Warehouse, Inc.*, 89 USPQ2d 1844, 1851 (TTAB 2008). *See also Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1762 (TTAB 2013), *aff’d mem.*, 565 Fed. Appx. 900 (Fed. Cir. 2014). Furthermore, we have found the term “SMART” to be descriptive in closely analogous circumstances. *See e.g. In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006) (“While it may be true that the term ‘smart’ may be used on an array of goods, e.g., telephones, missiles, copiers, its use in these various contexts has a consistent specific meaning; it tells the consumer that

the product is highly automated and capable of computing information.”); *In re Tower Tech*, 64 USPQ2d at 1318 (SMARTTOWER “merely describes cooling towers that are highly automated”); *In re Cryomedical Sciences Inc.*, 32 USPQ2d 1377, 1379 (TTAB 1994) (“Consumers will immediately perceive SMARTPROBE, when applied to such probes, as describing an important characteristic of those probes, namely that they are equipped with electronic control devices or microprocessors.”).

While Applicant is correct that the proposed mark could have other meanings in different contexts, or for different goods or services, that is beside the point. *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984) (“It is well settled that so long as any one of the meanings of a term is descriptive, the term may be considered to be merely descriptive.”). *See also*, *In re IP Carrier Consulting Grp.*, 84 USPQ2d 1028, 1034 (TTAB 2007); *In re Bright-Crest*, 204 USPQ at 593. As the Examining Attorney points out, in the proposed mark, the term “smart” modifies the term “tech,” so it is the “tech” that is “smart,” rather than the children who may derive educational benefit from Applicant’s toy trains. This is clear from how Applicant uses the proposed mark on its website.

Relatedly, it does not matter that the proposed mark is “vague” or broad in the abstract. What matters is how it will be perceived by consumers who know that Applicant offers RFID-enabled toy trains and software to control them. *In re Patent & Trademark Svcs., Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998) (“Here, PATENT & TRADEMARK SERVICES, INC. describes significant aspects of applicant’s services, and the fact that the phrase does not specify exactly which patent and trademark

services applicant offers does not mean that applicant is entitled to exclusively appropriate the phrase.”); *In re Entenmann’s Inc.*, 15 USPQ2d 1750, 1751 (TTAB 1990), *aff’d unpub’d*, 928 F.2d 411 (Fed. Cir. 1991) (“While it is true that in order to be held merely descriptive, a term must describe with some particularity a quality or ingredient of the product in question, it need not describe it exactly.”). In fact, we have previously rejected an almost identical argument that “SMART” is “too broad” to be found descriptive. *In re Finisar*, 78 USPQ2d at 1623 (TTAB 2006) (“the term SMART is not broad and general as used in connection with applicant’s goods but rather, in a concise manner, informs the consumer that applicant’s product has automated capabilities”).

As the Examining Attorney points out, Applicant’s combination of the descriptive terms “SMART” and “TECH” does not make the composite term “SMART TECH” registrable. Not only is each term merely descriptive of Applicant’s goods, but when combined, the resulting phrase SMART TECH does not evoke a new nondescriptive commercial impression. To the contrary, in Applicant’s proposed mark, each component retains its merely descriptive significance in relation to the goods, as confirmed by how Applicant uses the proposed mark on its website. The composite term SMART TECH is therefore merely descriptive. *See, e.g., In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004) (PATENTS.COM merely descriptive of computer software for managing a database of records that could include patents, and for tracking the status of the records by means of the Internet); *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332 (TTAB 2009) (BATTLECAM

merely descriptive for computer game software); *In re Carlson*, 91 USPQ2d 1198 (TTAB 2009) (URBANHOUSING merely descriptive of real estate brokerage, real estate consultation and real estate listing services); *In re Tower Tech Inc.*, 64 USPQ2d 1314 (TTAB 2002) (SMARTTOWER merely descriptive of commercial and industrial cooling towers); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer programs for use in developing and deploying application programs).

The third-party registrations that include disclaimers of the phrase “SMART TECH,” or close variations of that phrase such as “SMART TECHNOLOGY,” also support a finding that the phrase is descriptive. July 27, 2021 Office Action TSDR 10, 19, 23, 25, 29, 31, 37. So does Applicant’s own uses of the phrase on its website, in which the term “SMART” modifies the term “TECH.” Thus, “SMART would not be regarded by consumer[s] to suggest smart or smarter kids, as applicant suggests, because the mark is not SMART KIDS, for example, but SMART TECH.” March 8, 2022 Denial of Request for Reconsideration TSDR 2.

IV. Conclusion

The record leaves no doubt that SMART TECH is merely descriptive of Applicant’s “RFID-enabled” toy trains and the software used to control them. Applicant’s competitors in the toy and software industries should remain free to use SMART TECH and variations thereof for their own “smart” toys and related software. *See In re Abcor Dev.*, 200 USPQ at 217 (“The major reasons for not protecting [merely descriptive] marks are ... to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the

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registrant against others who use the mark when advertising or describing their own products.”).

Decision: The refusal to register Applicant’s proposed mark on the Principal Register in either class because it is merely descriptive under Section 2(e)(1) of the Trademark Act is affirmed.