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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re RiseSmart, Inc.

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Serial No. 86533730

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Dyan M. House of Carter Scholer Arnett Hamada & Mockler PLLC,
    for RiseSmart, Inc.

Kim T. Moninghoff, Trademark Examining Attorney, Law Office 113,
    Odette Bonnet, Managing Attorney.

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Before Bergsman, Adlin and Lynch,
        Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

RiseSmart, Inc. ("Applicant") seeks registration on the Principal Register of the

proposed mark SMARTMATCH in standard characters for "Software as a service

(SAAS) services, namely, software for conducting a job search" in International Class 42.[1]

The Trademark Examining Attorney refused registration of Applicant's proposed mark under Section 2(e)(1), 15 U.S.C. § 1052(e)(1), as merely descriptive of the identified services. After the Trademark Examining Attorney made the refusal final, Applicant requested reconsideration and appealed to this Board. The Examining Attorney denied the request for reconsideration. The appeal resumed and is fully briefed. We affirm the refusal to register.

Section 2(e)(1) of the Trademark Act precludes registration of "a mark which, (1) when used on or in connection with the goods [or services] of the applicant is merely descriptive . . . of them." 15 U.S.C. § 1052(e)(1). A term is merely descriptive within the meaning of Section 2(e)(1) "if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used." *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); *see also In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015).

We consider whether someone familiar with the identified services will understand the mark to convey information about them, rather than whether someone presented only with the mark could guess the products or activities listed in the description of goods or services. *DuoProSS Meditech Corp. v. Inviro Med.*

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[1] Application Serial No. 86533730 was filed on February 12, 2015, based on Applicant's intent to use the proposed mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Devices Ltd., 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). Descriptiveness must be assessed "in relation to the [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 [services] because of the manner of its use or intended use." *Bayer Aktiengesellschaft*, 82 USPQ2d at 1831 (citing *Abcor Dev.*, 200 USPQ at 218).

Applicant has identified its services as "software as a service for conducting a job search." The Examining Attorney's evidence establishes that "smart" means "operating by automation,"[2] and "match" means, *inter alia,* "to provide something that is suitable for a particular situation, person, or purpose."[3] Additional evidence shows that in the context of job search assistance, those in the industry use "match" to refer to a job suitable for a candidate or a candidate suitable for a job. They also use "smart" to refer to automation and technology in conducting searches. Examples of such usage include the following:

- An online press release from StaffDNA announces the release of its *SmartMatch* Job Board software that "*matches* candidates to jobs that best fit their skill set," allowing candidates to "view the best available job *matches*;"[4]

- An article on the Recruiter website reports that "Beyond has announced the launch of a new technology designed to *match* job seekers to available positions using an algorithm that learns from user habits. Called *SmartMatch*….;"[5]

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[2] May 21, 2015 Office Action at 24 (merriam-webster.com).

[3] *Id.* at 25-26 (macmillandictionary.com).

[4] *Id.* at 29 (prnewswire.com) (emphasis added).

[5] *Id.* at 33 (recruiter.com) (emphasis added).

- An online press release from Advanced Personnel Systems, Inc. announces "the addition of a new '*SmartMatch*' function for users of its SmartSearch solution," later identified as recruiting software, whereby users can "*match* selected candidates to the job;"[6]

- An article on HR.com touts the availability of a webinar demonstration of Pointwing *Smart Match*, a "resume search engine" that helps recruiters "easily find candidates that *match* the requested career and experience profile;"[7]

- An article on VB News reports on a startup company's "*smart* algorithm" that "*matches* grads with dream jobs;"[8]

- The website for Gild promotes its "*smart* candidate search technology" to create and publish job requirements, allowing users to "*match* prospects to [their] requirements;"[9]

- The website for WCC Smart Search & Match states: "*Matching* jobs with people and people with jobs in a *smarter* way then [sic] employment professionals thought possible. That is what WCC's ELISE Software Platform does....;"[10] and

- An article in Wired.com entitled "AI Software that Could Score You the Perfect Job" reports on software "that uses natural language processing and machine learning to *match* you with a suitable job."[11]

This evidence convincingly refutes Applicant's argument that consumers encountering the terms "smart" and "match" in the context of Applicant's services must use a "multi-stage reasoning process" to determine the attributes of the services. Rather than requiring consumer imagination, the evidence shows that

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[6] *Id.* at 34 (aps2k.com) (emphasis added).

[7] *Id.* at 35 (hr.com) (emphasis added).

[8] *Id.* at 36-37 (venturebeat.com) (emphasis added).

[9] *Id.* at 38-39 (gild.com) (emphasis added).

[10] *Id.* at 30 (wcc-group.com) (emphasis added).

[11] *Id.* at 31-32 (wired.com) (emphasis added).

consumers would tend to come across "smart" and "match" as common terms to describe these types of job search software services. The record even reflects numerous third-party uses of "smart match" or the telescoped term "smartmatch" in connection with the relevant services.

Applicant's own website further supports the refusal, as it describes the software as "bringing only the most relevant matches to our job seekers."[12] According to Applicant, its "technology parses all that data semantically, and maps the results to determine the relevance and quality of each match," and Applicant offers additional support to rank "all job matches for relevancy and accuracy."[13] Thus, Applicant's description of its services on the website repeatedly uses "match" to describe what the software does – matching candidates with jobs – as well as what it provides to users – resulting job matches. Applicant's website further reflects that the software services operate by automation to achieve tailored results for the user – *i.e.* in a "smart" manner.[14]

Applicant criticizes the descriptiveness refusal as an improper dissection of its mark. However, if the individual components of a mark retain their descriptive meaning in relation to the goods and/or services, the combination results in a composite mark that is itself descriptive and not registrable. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1516 (TTAB 2016); *In re Cannon Safe, Inc.*, 116 USPQ2d 1348, 1351 (TTAB 2015) (holding SMART SERIES merely descriptive of

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[12] *Id.* at 27 (risesmart.com).

[13] *Id.* at 28 (risesmart.com).

[14] *Id.* at 27-28 (risesmart.com).

metal gun safes, because "each component term retains its merely descriptive significance in relation to the goods, resulting in a mark that is also merely descriptive"); *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002) (holding SMARTTOWER merely descriptive of highly automated "commercial and industrial cooling towers and accessories therefor, sold as a unit"). Applicant makes no argument that the combination of SMART and MATCH changes the meanings of the terms, and we find no altered significance from joining the words in the mark. To the contrary, StaffDNA, Recruiter, Advanced Personnel Systems and Pointwing all use the term for the services identified in the involved application.

Applicant further asserts that because SMART has other relevant meanings than the definition relied on by the Examining Attorney ("operating by automation"), it cannot be considered descriptive. According to Applicant, other definitions apply to its software services, such as "quick in movement," "considerable," "intelligent," and "sophisticated," and these meanings render SMART suggestive rather than descriptive.[15] The Board rejected the same type of argument in *Tower Tech,* 64 USPQ2d at 1316, where the applicant for the mark SMARTTOWER countered a descriptiveness refusal by "arguing that the word 'smart' has many different meanings." Given the automated nature of the cooling towers at issue, the Board in *Tower Tech* held that "Applicant's argument that the relevant purchasers would think of other possible meanings (e.g., 'clever or intelligent,' 'fashionable or elegant,' 'saucy or pert') would require considering the

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[15] 8 TTABVUE 9 (Applicant's Brief) (citing definitions attached to November 20, 2015 Response to Office Action at 13-20).

applied-for mark in a vacuum." We consider descriptiveness in relation to the relevant services. *DuoProSS Meditech* 103 USPQ2d at 1757. In this case, the third-party evidence discussed above demonstrates that "smart" has a well-recognized meaning in the relevant industry, and Applicant points to no evidence indicating otherwise. Applicant's website promotes its "technology" that "parses all that data semantically and maps the results," clearly emphasizing the automation aspect. We find Applicant's contentions regarding a suggestive connotation of SMART unavailing. *See In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1087 (TTAB 2012) ("That a term may have other meanings in different contexts is not controlling").

Consumers would immediately understand SMARTMATCH, when used in connection with Applicant's identified services, to describe key features of the software services – that it is "smart" in using automation to conduct job searching, and that the software will "match" jobs to candidates, and provide those "matches" to the user.

Decision: The refusal to register Applicant's mark SMARTMATCH as merely descriptive is affirmed.