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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Nartron Corporation

Serial No. 75/486,276

Robert C. J. Tuttle of Brooks & Kushman P.C. for Nartron Corporation.

Brandon Boss, Trademark Examining Attorney, Law Office 114 (Mary Frances Bruce, Managing Attorney).

Before Cissel, Hanak and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On May 15, 1998, Nartron Corporation filed an application, based on Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), (applicant claimed a date of first use of July 1996), to register the mark SMART VOV on the Principal Register for "refrigerant metering valves for use in motor vehicles."

The Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e),

on the basis that, when used on or in connection with applicant's goods, the term SMART VOV is merely descriptive of them.[1]

When the refusal was made final, applicant appealed to this Board. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The Examining Attorney contends that applicant's identification of goods is broad enough to encompass a variable orifice valve, commonly known as a "VOV"; that the term "smart" informs consumers that the valves have a computational ability; and that because consumers will immediately perceive "smart" as describing an important characteristic of the involved valves (i.e., refrigerant metering valves having a computational ability), the mark describes a significant aspect of the goods.

The evidence submitted by the Examining Attorney in support of the refusal consists of dictionary definitions of the word "smart"; an excerpt from a patent referring to a "Variable Orifice Valve (VOV)"; excerpts from three other patents showing that valves with variable orifices may be controlled by microprocessors; and several third-party

[1] The Examining Attorney initially refused registration on the grounds of genericness and mere descriptiveness, or alternatively, on deceptive misdescriptiveness. The Examining Attorney's brief on appeal is clear that the only issue before the Board is that of mere descriptiveness. (Brief, p. 1)

registrations wherein the term “smart” was disclaimed when included as part of marks on the Principal Register.

Applicant, on the other hand, argues that a microprocessor is but one type of a logic device (e.g., programmable, hard-wired), and thus the idea that the term “SMART” has an immediate connotation of a “microprocessor” is not consistent with historical or current electrical engineering or computer science; and that in further support of applicant’s position that the word “SMART” should not be equated with a microprocessor, applicant submitted photocopies of its two registrations on the Principal Register which include the word “SMART”[2] for goods arguably related to those involved in its current application. In its brief on appeal, applicant, citing the case of In re Hutchinson Technology, Inc., 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988), contends that the Examining Attorney made two errors: (i) that the Examining Attorney did not consider the mark in its entirety, but rather dissected the mark analyzing the word elements separately; and (ii) that a word element of a mark which may be broadly

[2] Applicant submitted photocopies of applicant’s Reg. No. 1,190,527, issued February 23, 1982, for the mark SMART-POWER for “electrical power circuits in combination with electrical logic circuits and parts thereof,” Section 8 accepted, Section 15 acknowledged; and Reg. No. 1,681,891, issued April 7, 1992, for the mark SMART TOUCH for “electronic proximity sensors and switching devices,” Section 8 accepted, Section 15 acknowledged.

descriptive of the goods, is not fatal to the registrability of the entire mark (i.e., the word "SMART" is so broad in meaning that when the mark is viewed as a whole it is not merely descriptive). From this, applicant concludes that "the per se rule of the Board," set forth in the case of In re Cryomedical Sciences, Inc., 32 USPQ2d 1377 (TTAB 1994), regarding the registrability of marks which include the word SMART where the goods contain electronic devices or microprocessors is incorrect[3]; that the mark SMART VOV, considered in its entirety, does not convey an immediate idea of the qualities of applicant's goods; and that the present refusal is improper in view of the Patent and Trademark Office's (PTO) allowance of another mark on the Principal Register which includes the term SMART[4].

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[3] In the Cryomedical case, supra, the Board did not hold that marks which include the word SMART are per se unregistrable. Rather, the Board held SMARTPROBE merely descriptive of disposable cryosurgical probes because the term SMART preceded and thus modified, in the adjectival sense, the generic name for the involved goods. "The factual situations in which mere descriptiveness must be resolved are too varied to lend themselves to resolution under any rigid formula." In re Omaha National Corporation, 819 F.2d 1117, 2 USPQ2d 1859, at 1861 (Fed. Cir. 1987).

[4] Applicant attached to its brief a photocopy of one third-party registration (Registration No. 2,048,808, issued April 1, 1997, for the mark SMARTPOWER for internal combustion engines). This evidence was submitted untimely pursuant to Trademark Rule 2.142(d). However, inasmuch as the Examining Attorney did not object thereto and, in fact, treated the third-party registration as if it were properly of record, the Board has considered it for whatever probative value, if any, it may have.

The test for determining whether a mark is merely descriptive under Section 2(e)(1) of the Trademark Act is whether the term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used. See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978); In re Venture Associates, 226 USPQ 285 (TTAB 1985); and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). A mark does not have to describe every quality, feature, function, etc. of the goods or services in order to be found merely descriptive; it is sufficient for the purpose if the mark describes a single significant quality, feature, function, etc. thereof.

Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995); and In re Pennzoil Products Co., 20

USPQ2d 1753 (TTAB 1991). The question is not whether someone presented with only the mark could guess what the goods are. Rather, the question is whether someone who knows what the goods are will understand the mark to convey information about them. See In re Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990); and In re American Greetings Corp., 226 USPQ 365 (TTAB 1985).

In this case, we agree with the Examining Attorney that SMART VOV is merely descriptive of the involved goods. One of the patent excerpts put into the record by the Examining Attorney reads, in relevant part, as follows:

> Variable Orifice Valve (VOV)
> A variable orifice valve VOV includes an axially shiftable valve element 57 (Fig. 7) surrounded by an annular groove 58 which receives pressure fluid from conduit 43....

Further, we note that in applicant's March 12, 1999 response to the first Office action, applicant, in explaining why its response focused on the word "SMART," stated as follows: "The 'VOV' element of the mark will be assumed, *arguendo*, to be an abbreviation for 'variable valve orifice' [sic] (not that this point is conceded for purposes of determining the registerability [sic] of the mark)." While applicant may not have conceded that VOV means "variable orifice valve," applicant did not contest

this meaning of the letters VOV, or offer any evidence to the contrary. Therefore, on this record and in the context of applicant's goods, we accept VOV as meaning "variable orifice valve."

Through the other patent excepts submitted by the Examining Attorney, it has been shown that a variable orifice valve may have a microprocessor. Applicant did not state for the record whether or not its goods include a microprocessor (or any other type of logic device)[5]; however, applicant's identification of goods, "refrigerant metering valves for use in motor vehicles," is clearly broad enough to encompass all possible types of refrigerant metering valves, including variable orifice valves (VOVs). We note that applicant's identification of goods does not exclude valves with any type of logic device.

The Examining Attorney submitted the following dictionary definitions of "smart":

> (1) "Having some computational ability of its own. Smart devices usually contain their own microprocessors." Webster's New World Dictionary of Computer Terms (1992)[6]; and

[5] The specimens of record are labels which include only the following wording: the mark, applicant's name and address, the words "Pats. Pend.," and either "Part No. 1502002" or "Part No. 1502004."

[6] The Examining Attorney's request that we take judicial notice of this definition submitted with his brief on appeal is granted. See TBMP §712.01.

> (2) "5a. Of, relating to, or being a highly automated device, especially one that imitates human intelligence: *smart missiles*. b. *Computer science*. Having the capacity to perform operations independently of the computer. Used of a computer terminal." The American Heritage Dictionary (1992) (emphasis in original)

In the case of In re Cryomedical Sciences Inc., 32 USPQ2d 1377, 1379 (TTAB 1994), the Board stated "we find that consumers for applicant's probes would readily understand that SMART, as would be used in SMARTPROBE, refers to an electronic or microprocessor component of the probes." It is our view that in today's world with computers involved in virtually all facets of commercial as well as everyday life, when the term SMART VOV is used in connection with "refrigerant metering valves for use in motor vehicles," it immediately describes, without conjecture or speculation, a significant characteristic or feature of those goods, namely, that the variable orifice valve has some type of computational or logic ability used in operating or controlling the valve. That is, applicant's use of the mark SMART VOV would be perceived by consumers as relating to the logic capability of the valves.

Applicant's arguments regarding its two registrations and one third-party registration all for marks including the word SMART, are not persuasive. The existence of a few third-party registrations certainly does not establish an inconsistent PTO policy regarding registrability of any particular term. Even if applicant had established an inconsistency in PTO policy on this specific issue involving the term SMART, while the PTO strives for consistency, each case must be decided on its own facts and record. Of course, we do not have before us any information from applicant's registration files or from the one third-party registration file.

Moreover, as stated earlier, the Board has not established a "per se rule" that the term SMART is not registrable. Rather, registrability of a mark must be determined on a case-by-case basis and in relation to the involved goods or services. That is, each case must be decided on its own facts. See In re Dos Padres, Inc., 49 USPQ2d 1860 (TTAB 1998).

The Hutchinson case, supra, cited by applicant, does not require a different result herein. In that case the Court majority's discussion of the term "technology" was within the context of whether the mark HUTCHINSON TECHNOLOGY was primarily merely a surname, and, in fact,

the Court remanded the case for a disclaimer of the term "technology." In the case now before the Board the refusal to register is based on mere descriptiveness, not surname significance.

Decision: The refusal to register the mark as merely descriptive under Section 2(e)(1) of the Trademark Act is affirmed.

R. F. Cissel

E. W. Hanak

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board