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Paper No. 17
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re GAI-Tronics Corporation

Serial Nos. 75/257,552 and 75.257,553

Laura Genovese Miller and Bonnie G. Klein of Woodcock,
Washburn, Kurtz, Mackiewicz & Norris for applicant.

Lisa W. Rosaya, Trademark Examining Attorney, Law Office 112
(Janice O'Lear, Managing Attorney).

Before Hohein, Walters and Bottorff, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

GAI-Tronics Corporation has filed two trademark applications to register SMARTSERIES and the mark shown below, both for "micro-processor-based communications system, communications management system, and emergency notification system, for use in industrial environments and featuring a control panel; telephone handsets; telephone receivers; telephone interfaces; radio interfaces; supervised input/output devices; software; amplifiers;

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alarms; microphones; loudspeakers; receivers; strobe lights;
and printers.”¹



In application Serial No. 75/257,522, for the design mark, the Trademark Examining Attorney has issued a final refusal requiring a disclaimer of SMARTSERIES, under Section 6 of the Trademark Act, 15 U.S.C. 1056, on the ground that applicant's mark is merely descriptive of its goods, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1). In application Serial No. 75/257,553, for the word mark, the Examining Attorney has issued a final refusal of registration, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its goods.

¹ Serial Nos. 75/257,553 and 75/257,552, respectively. Both applications are in International Class 9, were filed March 14, 1997, and are based on use of the marks in commerce, alleging first use and use in commerce of both marks as of January 13, 1997. Application Serial No. 75/257,552, for the design mark, includes a statement that "the drawing consists of stylized, back-to-back letter 'S's' and the word SMARTSERIES within a rectangular shape."

Applicant has appealed the refusal in each application. Applicant and the Examining Attorney have filed briefs in both cases, but oral hearings were not requested.²

Because the word mark SMARTSERIES and the term SMARTSERIES in the design mark are identical and the facts and legal issues are essentially the same in both cases, we consider these two cases together and issue a single opinion.

The question in both cases is whether SMARTSERIES is merely descriptive in connection with the identified goods. The additional question with respect to the design mark is, if we find SMARTSERIES to be merely descriptive, is the mark unitary so that a disclaimer is not appropriate.

The Examining Attorney contends that "the two terms which make up the applicant's mark - SMART and SERIES - are not distinct in that they merely describe a characteristic or feature of the applicant's goods, namely, that applicant's communications products contain microprocessors which process information - or 'smart' technology - and these products are part of a larger group or line (or series) of similar products." She argues that the term SMARTSERIES consists of two words that, considered both individually and together, are merely descriptive of

² Applicant submitted evidence with its reply brief. Such evidence is untimely and has not been considered. Trademark Rule 2.142(d).

features of the goods; and that, as applied to the goods, the combined term does not evoke a unique commercial impression or provide an incongruous meaning.

Additionally, with respect to the design mark, the Examining Attorney contends that the mark is not unitary because the term SMARTSERIES is separate from the "SS" design, and the black rectangle is merely a background carrier and does not serve to unify the mark. Thus, she argues, a disclaimer of SMARTSERIES is appropriate.

Applicant contends that, while the Examining Attorney relied on evidence of "the use of the term 'smart' in the computer industry to refer to items containing a microprocessor ... applicant supplies communications products, not computer products"; and that, "although 'smart' and 'series' are arguably 'common words,'" its mark consists of "the novel combination of words 'smart' and 'series,' two words whose joint impact is incongruous as to the goods associated with this mark."

Applicant and the Examining Attorney submitted dictionary definitions. Of these entries, we note that "smart" is defined as "synonym for *intelligent*; in relation to software or hardware, capable of processing information, typically beyond what is currently expected,"³ and as "*computer science* - having the capacity to perform

³ *Microsoft Press Computer Dictionary* (2nd ed. 1994).

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operations independently of the computer."⁴ "Series" is defined as "a number of objects or events arranged or coming one after the other in succession."⁵

We take judicial notice of the following additional definitions and synonyms:

Series: "A group of objects related by ... configurational characteristics." *Webster's II New College Dictionary* (1995).

Series: "Set 74.11" "74. Assemblage." "74.11 set, suit, suite, series, ..." *Roget's International Thesaurus* (3rd ed. 1962).

Smart: "Having some computational ability of its own[;] smart devices usually contain their own microprocessor. *Computer Dictionary* (3rd ed. 1992).

Microprocessor: "Also called a *CPU* (*Central Processing Unit*) - the device within a computer (or switch or other machine that performs complex tasks) that controls the transfer of the individual instructions from one device connected to its bus ... to another ... Some communications equipment manufacturers actually call a certain card or portion of the system the *CPU*." *Illustrated Telecom Dictionary* (1998).

Applicant submitted, *inter alia*, copies of its specifications sheets and booklets for its products, one of which is entitled "SmartSeries™ Intelligent Intra-Plant Communication and Emergency Notification System." One specification sheet states that "[t]he SmartSeries™ Handset Amplifier is a microprocessor controlled field station that

⁴ *The American Heritage Dictionary of the English Language* (3rd ed. 1992).

⁵ *Id.*

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provides added features over standard industrial communications equipment."

The Examining Attorney submitted excerpts of articles from the LEXIS/NEXIS database that use the word "smart" in connection with various products containing microprocessors.

Following are several examples:

Like smart cards, iKey includes a microprocessor and local memory to store digital certificates and other information. [*InternetWeek*, March 22, 1999.]

The chargers possess a smart/fast feature that uses microprocessor technology to charge each battery assembly within one hour and to detect when charging is complete. [*Battery & EV Technology*, March, 1999.]

The shift to digital-TV technology is driving broadcasters to build networks of equipment that include embedded microprocessor-based encoders, video servers and smart multiplexers with embedded microprocessor intelligence. [*Electronic Engineering Times*, March 1, 1999.]

The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a

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single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). 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 mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

It is clear that the word "smart" is used to describe various products that contain microprocessors. Applicant's identified products contain microprocessors and, as identified, its systems are "microprocessor-controlled." Thus, it is reasonable to conclude that applicant's products are "smart," and that this word merely describes a significant feature of applicant's products. See *In re Cryomedical Sciences Inc.*, 32 USPQ2d 1377 (TTAB 1994) [SMARTPROBE held merely descriptive for cryosurgical probes having electronic or microprocessor components due to meaning of "smart" as a computer term].

Regarding the term "series," applicant refers to it as a "common term." We agree and, from the definitions and synonyms of which we have taken notice, we conclude that "a series" refers to a line of products. In this case, applicant's brochure and specifications sheet establish that

its products are a series of products for use in the systems identified in the application. Because applicant's products are microprocessor-based and, thus, are "smart," it follows that applicant's products comprise a "smart series." There is nothing about the combination of these two words, as SMARTSERIES, that is incongruous or creates a meaning different from the individual meanings of these "common words."

We are not persuaded otherwise by applicant's arguments. The mere fact that the individual words are subject to a variety of different meanings does not render the mark ambiguous because we must consider the meaning in connection with the identified goods. Nor is the fact that the dictionary has no entry for the term SMARTSERIES dispositive. Finally, the LEXIS/NEXIS excerpts submitted by applicant to show use of the combined term as a trademark or to show the two words in the same excerpt, but in an entirely different context, are inapposite.

In the present case, it is our view that, when applied to applicant's goods, the term SMARTSERIES immediately describes, without conjecture or speculation, a significant feature or function of applicant's goods, as discussed herein. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective

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customers for applicant's services to readily perceive the merely descriptive significance of the term SMARTSERIES as it pertains to applicant's goods.

Finally, we conclude that the design mark in application Serial No. 75/257,552 is not unitary and, therefore, disclaimer of the term SMARTSERIES is appropriate. As the Examining Attorney argued, the term SMARTSERIES is quite separate from the "SS" design and the black rectangle serves merely as a background design and border.

Decision: The refusal in application Serial No. 75/257,553 under Section 2(e)(1) of the Act is affirmed. The refusal in application Serial No. 75/257,552 based on the requirement for a disclaimer under Section 6 of the Act is affirmed.

However, with respect to application Serial No. 75/257,552 for the design mark, this decision will be set aside, and applicant's mark will be published for opposition if applicant submits an appropriate disclaimer of SMARTSERIES within thirty days from the mailing date of this decision. See Trademark Rule 2.142(g).