

THIS DISPOSITION IS NOT CITABLE AS
PRECEDENT OF THE TTAB

JUNE 18, 1997

Paper No. 13
PTH

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Gast Manufacturing Coporation**

Serial No. 74/**541,668**

Gerard T. Gallagher of **Barnes & Thornburg** for **Gast Manufacturing Corporation**.

Won T. Oh, Trademark Examining Attorney, Law Office 104
(**Sidney Moskowitz**, Managing Attorney).

Before **Hohein**, **Hairston** and **Walters**, Administrative
Trademark Judges.

Opinion by **Hairston**, Administrative Trademark Judge:

An application has been filed by Gast Manufacturing Corporation to register the mark SMART AIR (the word "AIR" is disclaimed) for "air compressors and vacuum pumps."¹

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, when used on applicant's goods, the mark is merely descriptive of them.

¹Application Serial No. 74/541,668, filed June 21, 1994, which alleges a bona fide intention to use the mark in commerce.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We reverse the refusal to register.

The Examining Attorney maintains that when the words "smart" and "air" are combined, the resulting term SMART AIR conveys information regarding the nature of the identified goods, namely, that the air compressors and vacuum pumps utilize air and contain a microprocessor. The Examining Attorney has submitted dictionary definitions of the term "smart." The Computer Dictionary (3d ed. 1992) defines "smart" as:

Having some computational ability of its own.
Smart devices usually contain their own
microprocessor. A synonym for intelligent.

Further, the Examining Attorney submitted excerpts of articles/patents from the NEXIS data base showing descriptive uses of "smart" in connection with various products having microprocessors. The following are representative examples:

Now comes something that millions of Americans have long desired: smart elevators. Microprocessors and artificial intelligence software are adding zip to lifts new and old, with the goal of trimming those annoying waits in the lobby.

"The Washington Post," July 8, 1994.

...Energizer Power Systems division of Eveready Battery Co. recently announced a relationship with National Semiconductor Corp. to develop smart battery packs with built-in microprocessors.

"Info World," June 6, 1994.

The smart card is equipped with an integrated microprocessor; it can perform many functions, including high security "handshakes" with the transactions terminal or computer.
"Voice Technology News," June 14, 1994.

This invention relates to a microprocessor controlled or 'smart' AC outlet and encoded plug which can be read by the microprocessor. Common wall mounted AC outlets have different current ratings which should not be exceeded.
Patent No. 4,915,639 for "Smart" AC receptacle and complementary plug.

...only illustrates the method of operation of the custom integrated circuit version disclosed as the preferred embodiment herein but also may be used by the skilled worker as a flowchart for programming a microprocessor chip to accomplish smart pressure switch functions. The method embodiment disclosed begins with turning on power at step 701.
Patent No. 4,621,503 for Pressure sensing devices and methods.

Applicant, on the other hand, maintains that the Examining Attorney has improperly dissected applicant's mark, and that SMART AIR is only suggestive of air compressors and vacuum pumps. Applicant also argues that the present refusal is improper in view of the Office's allowance of other marks which consist of the word SMART. In this connection, applicant has submitted copies of five third-party registrations of marks consisting of the word SMART.

A term is merely descriptive, and therefore, unregistrable pursuant to Section 2(e)(1), if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods with which it is used. On the

other hand, a term which is suggestive is registrable. A suggestive term is one which suggests, rather than describes, such that imagination, thought or perception is required to reach a conclusion on the nature of the goods. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

As evidenced by the disclaimer of record, there is no dispute that the word "air" is descriptive of a characteristic of applicant's air compressors and vacuum pumps. Furthermore, it is clear from this record that the word "smart" is used to describe various products which employ microprocessors. Although this is an intent-to-use application, the identification of goods, as listed in the application, is broad enough to include all types of air compressors and vacuum pumps, including those containing microprocessors. Thus, we must presume that applicant's air compressors and vacuum pumps will include microprocessors and thus are "smart."

However, it does not automatically follow that because the words "smart" and "air" are descriptive, that the mark SMART AIR in its entirety is descriptive of air compressors and vacuum pumps. The question of mere descriptiveness is not resolved by analyzing the words "smart" and "air" separately; rather the composite mark SMART AIR must be considered in its entirety to determine whether it is merely descriptive of the identified goods. See *The Firestone Tire & Rubber Company v. The Goodyear Tire & Rubber Company*, 186

Ser No. 74/541,668

USPQ 557 (TTAB 1975) and In re J. P. Stevens & Co., Inc.,
160 USPQ 692 (TTAB 1969).

Applying these principles here, we conclude that SMART AIR has not been proven to be merely descriptive of air compressors and vacuum pumps. While the individual elements SMART and AIR each have a descriptive significance in connection with the goods, when the words are combined the significance of the phrase SMART AIR is only suggestive. As used in the mark, SMART is an adjective modifying AIR. SMART AIR has an incongruous meaning because the air in applicant's air compressors and vacuum pumps is not "smart," i.e., equipped with microprocessors. It requires some imagination and mental steps to conclude from SMART AIR that the identified goods contain microprocessors and use air.

This case is readily distinguishable from In re Cryomedical Sciences, Inc., 32 USPQ2d 1377 (TTAB 1994), relied on by the Examining Attorney, wherein SMARTPROBE was held merely descriptive of cryosurgical probes. In that case, SMART preceded the generic name of the goods, with no resulting incongruity.

On the record before us, we find that SMART AIR is not merely descriptive of air compressors and vacuum pumps.

Decision: The refusal to register under Section 2(e)(1) of the Trademark Act is reversed.

Ser No. 74/541,668

G. D. Hohein

P. T. Hairston

C. E. Walters
Administrative Trademark
Judges, Trademark Trial and
Appeal Board

Ser No. 74/541,668