

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

AUG 6, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re K-2 Corporation

Serial No. 74/508,154

James R. Uhlir and Faye L. Mattson of Christensen, O'Connor,
Johnson, & Kindness for applicant.

Cheryl A. Butler, Trademark Examining Attorney, Law Office
107 (Thomas Lamone, Managing Attorney).

Before Hanak, Quinn and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

K-2 Corporation has filed a trademark application to register the mark SMART SKI for "sporting goods, namely, snow skis and ski poles."¹ The application includes a disclaimer of SKI apart from the mark as a whole.

The Trademark Examining Attorney has finally refused registration under Section 2(e)(1) of the Trademark Act, 15

¹ Serial No. 74/508,154, in International Class 28, filed March 30, 1994, based on an allegation of a bona fide intention to use the mark in commerce. On February 23, 1996, applicant filed its statement of use, alleging first use and first use in commerce as of December 1, 1995, and specimens of use.

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U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its goods.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

We address, first, applicant's contention that the refusal to register is improper because it was made for the first time in response to applicant's statement of use and accompanying specimens; that at this stage of examination, in the absence of a clear error, the Examining Attorney should not issue a refusal concerning matters which could or should have been raised during examination prior to issuance of the notice of allowance; and that "in this case, the Office has not met its burden of showing clear error."

The Trademark Manual of Examining Procedure (TMEP), Section 1105.05(f)(ii), states that for the purpose of the examination of the statement of use, the Examining Attorney may issue a refusal under Section 2(e)(1) of the Act only "if the refusal is dictated by changed circumstances from the time of initial examination or the failure to issue such a refusal would constitute clear error." The Examining Attorney's position is that this case involves changed circumstances. She contends that at the time of the initial examination of the application, in 1994, there was no

indication that smart materials and technology were used in consumer goods.

In the recent case of *In re Sambado & Son Inc.*, 45 USPQ2d 1312 (TTAB 1998) [*expressly overruling In re Parfums Schiaparelli, Inc.*, 37 USPQ2d 1864 (TTAB 1995)], the application had been refused registration on the ground of mere descriptiveness during examination of the statement of use. In response, applicant amended its application to the Supplemental Register. A final refusal was ultimately issued on the ground that the subject matter sought to be registered is generic. Applicant in that case sought the Board's determination both of the substantive issue concerning whether the applied-for mark is capable of identifying and distinguishing applicant's goods, and of the procedural question of whether the failure to issue the mere descriptiveness refusal during initial examination of applicant's application constitutes clear error. Regarding the latter issue, the Board concluded the following.

The Examination Organization makes the determination of 'clear error,' which determination ultimately is properly reviewable on petition to the Commissioner. (*footnote omitted*) The Board's determination on appeal is to be limited to the correctness of the underlying substantive refusal to register. The Board will not second guess the Examining Organization's procedural determination, that is, the latter's application of the 'clear error' standard. As noted, the application of the 'clear error' standard is, in this context, a procedural question (one that answers the question, 'Should a new refusal be made and defended by the Examining Attorney?').

In this case, the Examining Attorney contends that the new refusal under Section 2(e)(1) was properly made during the examination of the statement of use in view of changed circumstances, as provided in *TMEP* Section 1105.05(f)(ii), rather than due to the presence of clear error. However, this is a procedural determination by the Examining Organization that is completely analogous to the situation in *In re Samboda & Son Inc., supra*. As such, it is properly reviewable on petition to the Commissioner rather than in this appeal to the Board of the substantive refusal to register. Thus, we have not considered this issue further herein.

Turning to the issue properly before us of mere descriptiveness, the Examining Attorney contends that applicant's "goods were developed using smart structures technology, a specific field of study"; that "the piezoelectric materials used in the skis are known as smart materials"; and that "SMART is a term of art in regard to such materials." The Examining Attorney states that applicant's specimens "clearly indicate that the skis use new technologies based on smart structures technologies, including a built-in electric circuit, to convert unwanted vibrations into useful electrical energy" and, thus, she concludes that SMART SKIS describes skis produced using smart materials and technology. In support of her argument,

the Examining Attorney has submitted numerous excerpts, several of which are noted below, of articles retrieved from the LEXIS/NEXIS information database.

. . . international scientists representing 21 countries, on various aspects of ferroelectrics and their applications, covering major advances in the areas of: piezoelectrics; dielectrics; thin film ferroelectrics; actuators; smart materials; . . . [*Innovator's Digest*, April 16, 1996]

. . . a radical ski that it claims performs well in all conditions - because it has a "brain." It uses piezoelectric "smart materials," which can detect vibration and convert it directly into an electrical energy which, in turn smoothes out the vibrations . . . [*The Vancouver Sun*, April 6, 1996, writing about applicant's product]

It is basically the rotor mast and blades made of smart materials, Barrett said March 28. Smart materials, known as piezoelectric materials, are composites that expand or contract when voltage is applied to their surface. [*Defense News*, April 7, 1996]

In Mothra the stabilators still pivot, but all that machinery has been replaced by a rear spar made of a smart material: a piezoelectric ceramic that expands or contracts when zapped with an electric current. [*The San Diego Union-Tribune*, September 6, 1995]

Douglas has done preliminary studies on all three materials for the U.S. Army, and will choose two for the smart rotor. "We'll use either piezoelectric or magnetostrictive actuators on one set of flaps, and shape-memory alloy on the other," says King. [*Machine Design*, August 8, 1994]

The Examining Attorney has also submitted a copy of an advertisement for applicant's goods from the December 1995 issue of *Ski* magazine wherein applicant touts its goods as incorporating smart technologies and materials.

Applicant concedes that "the terms 'smart technologies' or 'smart materials' . . . are used to denote piezoelectric materials," but contends that "the word 'smart' by itself is not a term of art for piezoelectric materials, nor is it commonly used as an equivalent for the term 'smart technologies' or the term 'smart materials'"; and that when "the mark is considered in its entirety the result . . . , SMART SKI, is an incongruous term because a ski cannot think and be smart." Applicant included with its brief a complete print-out of an article, an excerpt of which was previously submitted by the Examining Attorney. It appears, in pertinent part, as follows.

HEADLINE: SMART SENSORS

BODY:

This report (from the INSPEC Database) concerns the design, development, evaluation, and applications of smart sensors. It includes, for example: the development of silicon, piezoelectric, intelligent, and solid-state sensors; applications in factory automation, aerospace flight control, optical communication, automotive electronics, biomedical measurement, and vibration detection and control in general; composite materials with inherent sensing properties; and more.

The test for determining whether a mark is merely descriptive is whether the involved 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, or intended to be used. *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re*

Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods, only that it describe a 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).

There is no question in this case that applicant's goods are produced using "smart" technology and materials. We note that, in addition to text on the specimens indicating that smart technology is used in producing applicant's skis, applicant's specimens prominently display the applied-for mark, SMART SKI, directly above the word TECHNOLOGY and in the same style and size font. Contrary to applicant's contentions otherwise, it is equally evident that, considered in connection with the identified goods, the single word SMART modifies the word SKI (*i.e.* SMART SKI), to directly convey to prospective purchasers that the goods identified by the mark consist of smart materials. There is support for this conclusion in the LEXIS/NEXIS

excerpts of record wherein the word "smart" is used without the words "technology" or "materials" to indicate that the identified product utilizes smart materials or technology [e.g., "smart rotor," "smart sensor," "smart systems," and "smart structures"].

In conclusion, it is our view that, when applied to applicant's goods, the term SMART SKI immediately describes, without conjecture or speculation, a significant feature or function of applicant's goods, namely, that applicant's goods are produced using smart technology and/or materials. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's goods to readily perceive the merely descriptive significance of the term SMART SKI as it pertains to applicant's identified goods.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed.

E. W. Hanak

T. J. Quinn

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