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SEPT 9, 98

Paper No. 12
RFC

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Matsushita Electric Corporation of America**

Serial No. 74/**672,187**

Morton Amster of Amster, Rothstein & Ebenstein for
Matsushita Electric Corporation of America.

Margaret Le, Trademark Examining Attorney, Law Office **104**
(Sidney Moscovitz, Managing Attorney).

Before Cissel, **Hanak** and Hohein, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On May 10, 1995, applicant filed the above-referenced
application to register the mark "SMART CART" on the
Principal Register for a "multi-cassette library," in Class
9. The basis for the application was applicant's assertion
that it possessed a bona fide intention to use the mark on
these goods in commerce.

The Examining Attorney required applicant to disclaim the term "CART" apart from the mark as shown on the ground that the word is merely descriptive of the goods because it identifies a feature of them, and also required applicant to amend the identification-of-goods clause to make it more definite.

Applicant responded by disclaiming the word "CART" and amending the application to specify the goods with which it intends to use the mark as "robotic multiple cartridge retrieval system for storage and access to audio, video and data information."

The Examining Attorney considered the proposed mark in conjunction with the amended version of the goods, which makes it clear that these devices are electronic cartridge storage and retrieval machines, and on that basis, she concluded that the word "SMART" would be considered to be merely descriptive of the goods, just as "CART" is. In fact, she found the combination of the two descriptive words, "SMART CART," to be merely descriptive of the goods specified in the application. Accordingly, she withdrew the disclaimer requirement and refused registration under Section 2(e)(1) of the Act on the ground that "SMART CART" is merely descriptive of a robotic multiple cartridge

Ser. No. 74/672,187

retrieval system for storage and access to audio, video and data information.

Attached to the Office Action were copies of excerpts retrieved from the Nexis® database of published articles.

In pertinent part, they state as follows:

"BTS and Panasonic also have many other DVC PRO packages slated for later introduction, including a miniature field editing system, a four-times playback fast transfer player, a smart cart machine, and a host of other ancillary products."

"...Panasonic will demonstrate the Tektronix Profile™ disk-based audio and video server working with their own M.A.R.C. Systems (100 to 1000 cassette capacity) and a new, smaller Smart-Cart System (50 to 70 cassettes)."

"...enough spots can be stored to cover a six to 12-hour broadcast period, which should provide enough of a buffer to cover any required loading or maintenance of the M.A.R.C. or Smart Cart system and robotics."

"Matsushita also plans to market...a smart-cart automation system starting in 1996."

[Panasonic Broadcast & Television Systems equipment] "will be on display at the show, including...[t]he Smart-Cart automated record/playback system, a mini-cassette library for small to medium-size facilities."

"The system will be a hybrid of Tektronix's Profile disk-based AV storage system and Panasonic's ARC and Smart-Cart systems."

Applicant responded to the refusal to register by changing the description of goods again. This time the application was amended to read as follows: "robotic

multiple cartridge retrieval system comprising record/play transports for either audio/video or data for storage and access to audio, video and data information." Applicant argued that its mark is not merely descriptive of these goods, but rather is at most suggestive of them. Applicant contended that the articles made of record by the Examining Attorney use "Smart Cart" to refer to applicant's product, rather than in a merely descriptive sense, and that generic wording such as "system," "machine," or "automated record/playback system" is used after the trademark in these story excerpts.

Included with the response were copies from promotional brochures for applicant's product. "Smart-Cart" is pictured displayed in a trademark fashion on the front of applicant's machine, and the text of the brochure uses it as a trademark would be used, e.g., "The new Panasonic Smart-Cart mini cassette library shares the same advanced technology and sophisticated control system of the acclaimed M.A.R.C. system."

The Examining Attorney was not persuaded by applicant's argument and evidence, and she made the refusal to register under Section 2(e)(1) final in her third Office Action on January 8, 1997.

Additional excerpts from published articles were also submitted at that time. Some show that the word "cart" is used to refer to an audio or video tape cassette or cartridge. Others show the use of "cart machine" and "cart system," which is defined as "the traditional videotape robotics carousel...which manages a library of cartridges and is programmed to play back commercials, promotional spots and other short-form pre-produced programming."

The Examining Attorney argued that the term "CART" is recognized as referring to an audio or video cartridge, and that "SMART" is used to describe a product which is "electronic and automated." These facts lead her to the conclusion that the combination of the two words, "SMART CART," is merely descriptive of applicant's electronic system which automates the cartridge playing and switching functions.

Applicant timely filed a notice of appeal, and both applicant and the Examining Attorney filed briefs. Applicant filed a reply brief. In its main brief, applicant makes the arguments it had made to the Examining Attorney, but also lists eight trademarks incorporating the

term "SMART" with other matter.¹ Applicant alleges that these marks have been registered by the U.S. Patent and Trademark Office in only the last two years, and applicant contends that these registrations demonstrate that the fact that a mark contains the word "smart" does not bar its registration.

Applicant did not request an oral hearing before the Board. Accordingly, we have resolved this appeal based on the written record and arguments of the applicant and the Examining Attorney.

Careful consideration of the record in this appeal, the written arguments of the applicant and the Examining Attorney, and the relevant legal principles leads us to conclude that the refusal to register is not justified in this case.

Neither applicant nor the Examining Attorney disputes the basic legal principles upon which we must base our determination of whether a term is merely descriptive of the goods with which it is used. A term is merely descriptive, and hence unregistrable in the absence of a showing of distinctiveness under Section 2(f) of the Act,

¹ Ordinarily, this evidence would not be considered because it was untimely submitted after the record had closed, but the Examining Attorney treated it as if it were of record and argued its significance, so we have considered it as if it had been

if it immediately and forthwith conveys information concerning a significant ingredient, quality, feature or characteristic of the goods with which it is used. If, however, imagination, thought or perception is required to reach a conclusion as to the nature of the product, the term is suggestive, and therefore registrable without establishing that it has acquired secondary meaning through use and promotion as a trademark. In re Gyulay, 820 F.2d 1216, 3 USPQ 1009 (Fed. Cir. 1987).

In the instant case, we find that the word "SMART" is merely descriptive of the goods identified in the application. In the parlance of today's computer-literate business world, "smart" is used to convey the fact that a particular device has a microprocessor or has some other means of computational ability. The Examining Attorney made of record a dictionary definition of the word as "equipped with, using, or containing electronic control devices." This word simply tells us that the machine has at least some artificial intelligence or that it is electronically controlled by a digital device. In this case, the promotional brochure makes it clear that the features of applicant's robotic cartridge retrieval systems

timely introduced during the prosecution of the application prior to appeal.

include a "central sequence controller [which] commands the VTRs, robotics, audio/visual routing switcher and also interfaces with the console PC." This certainly appears to be the work of at least one microprocessor or other electronic control device. The word "SMART" is clearly descriptive of this characteristic of these goods.

"CART" is also merely descriptive of the goods specified in the application. This record shows that the word is a recognized synonym for "cartridge." Cartridges are the cassettes that applicant's robotic retrieval system stores and retrieves. Carts are therefore the things which applicant's devices manipulate. Under these circumstances, the term identifies a characteristic or feature of the product. That makes "CART" merely descriptive of the goods within the meaning of Section 2(e)(1) of the Act, which is the reason why the Examining Attorney required it to be disclaimed, and, presumably, why applicant disclaimed it.

It does not necessarily follow that the combination of these two descriptive terms, "SMART" and "CART," is itself merely descriptive of applicant's product, however. The question of mere descriptiveness is not to be resolved by separate analysis of each component of the mark. The whole mark, "SMART CART," must be considered in its entirety to determine whether registration is proper. See: The

Ser. No. 74/672,187

Firestone Tire & Rubber Company v. The Goodyear Tire & Rubber Company, 186 USPQ 557 (TTAB 1975); and In re J. P. Stevens & Co., Inc., 160 USPQ 692 (TTAB 1969).

When the mark sought to be registered in the case at hand is evaluated in light of these principles, we find that "SMART CART" has not been proven to be merely descriptive of a robotic multiple cartridge retrieval system comprising record/play transports for either audio/video or data for storage and access to audio, video and data information. Whereas the individual words in the mark, "SMART" and "CART," each have descriptive significance in connection with these products, when the words are combined, the significance of the term "SMART CART" is only suggestive. This is because, as used in the mark, "SMART" is an adjective modifying the noun "CART." "SMART CART" is somewhat incongruous, in that the carts which applicant's device store and retrieve are not themselves "smart," i.e., equipped with electronic control devices. Applicant's product may be "smart" in the technical sense of the word, but the carts it handles are not. It requires some thought process, imagination, reasoning or perception in order to conclude from consideration of "SMART CART" in connection with these

goods that the goods utilize electronic control devices and that they store and retrieve carts.

The Examining Attorney argues that our decision in *In re Cryomedical Sciences, Inc.*, 32 USPQ2d 1377 (TTAB 1994), mandates affirmance of the refusal under Section 2(e)(1), but that case is readily distinguished from this one. There we held "SMART PROBE" to be merely descriptive of surgical probes. "SMART" preceded, and thus modified, in the adjectival sense, the generic name for the goods. Here, the goods are not carts, but rather the cart storage and retrieval systems set forth in the application.

Each of the excerpts made of record with the second Office Action does show "Smart-Cart" or a variation thereof used in reference to applicant's product, just as applicant argued. That the journalist(s) who wrote these articles did not make it clear that "SMART CART" is applicant's trademark, however, and even used the component words in what could be considered to be a descriptive context, does not outweigh the fact that, as the rest of the record shows, the combination of "SMART" and "CART" does not immediately and forthwith convey information about applicant's goods. The misuse of the mark in an arguably descriptive sense that the excerpted articles show does not

Ser. No. 74/672,187

persuade us that the significance of the term to a person in the market for these devices is descriptive.

Because the term sought to be registered is not merely descriptive of the goods, the refusal to register under Section 2(e)(1) of the Act is reversed.

R. F. Cissel

E. W. Hanak

G. D. Hohein
Administrative Trademark Judges
Trademark Trial & Appeal Board

Ser. No. 74/672,187