Paper No. 44/46
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re C & D Technologies, Inc.

Serial Nos. 74/196,304 and 74/802,601

Charles N. Quinn of Dann, Dorfman, Herrell & Skillman for applicant.

Chad T. O'Hara, Trademark Examining Attorney, Law Office 113 (Meryl Hershkowitz, Managing Attorney).

Before Simms, Walters and Wendel, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

This case concerns two applications on the Principal Register for the mark SMART BATTERY. One application is for "lead-acid batteries for motive power applications,"[1] and the other application is for "lead-acid batteries for

[1] Serial No. 74/196,304, in International Class 9, filed August 19, 1991, based on an allegation of a bona fide intention to use the mark in commerce. The owner of record of this application is C & D Technologies, Inc.

electrically driven industrial material handling vehicles."[2] Each application includes a disclaimer of BATTERY apart from the mark as a whole.

These two applications are the result of a division of a single application for SMART BATTERY into two applications for SMART BATTERY for different goods. During the prosecution of the original application, applicant requested that the goods identified as "lead-acid batteries for electrically driven industrial material handling vehicles" be divided out of the original application and proceed as a separate application. The Examining Attorney had refused registration in the original application on the basis of mere descriptiveness in relation to all of the recited goods and the Examining Attorney maintained this refusal in each of the two separate applications. In application Serial No. 74/196,304, pertaining to "lead-acid batteries for motive power applications," applicant has submitted an amendment seeking registration on the Supplemental Register.

There have been a number of procedural missteps, such as the submission of unsigned declarations, papers crossing

[2] Serial No. 74/802,601, in International Class 9, filed August 19, 1991, based on an allegation of a bona fide intention to use the mark in commerce. The owner of record of this application is C & D Technologies, Inc.

in the mail, and numerous extensions of time, that have complicated this case but do not bear repeating. What is pertinent to the issues before us on appeal is the fact that, in each application, applicant has submitted an amendment to allege use accompanied by specimens consisting of an advertising brochure.

In each application, the Examining Attorney has issued a final requirement for the submission of substitute specimens showing use of the mark in connection with the goods identified in the application. The Examining Attorney contends that the specimens of record show use of the mark in connection with a module that is attached to batteries, but that these goods are different from, and not encompassed by, the batteries identified in each application. Applicant contends, essentially, that the specimens are acceptable as displays associated with the goods and that, in fact, the mark is used on the batteries identified in each application.

Additionally, in each application, the Examining Attorney has finally refused 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. In application Serial No. 74/196,304, which contains applicant’s amendment to the Supplemental

Register, this refusal is in the alternative. In other words, if we find the specimens to be unacceptable, the amendment to allege use is incomplete. In this case, applicant's amendment to the Supplemental Register would be unacceptable because the application would remain an intent-to-use application, which is not eligible for the Supplemental Register. Thus, the refusal on the ground of mere descriptiveness, which would have been overcome by the amendment to the Supplemental Register, would be applicable to this application.

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

Specimens

The brochure submitted as specimens in these two applications pictures the mark, SMART BATTERY, on a small device attached to the top of a battery, rather than on the battery itself. The brochure describes the goods as follows:

> **C&D SmartBattery is like a thinking cap for batteries.** SmartBattery is a battery management tool. The low-profile, fully encapsulated module mounts flush onto the battery top.
>
> **Four good reasons to buy SmartBattery**
> - **Battery fleet management yields longer batter life**, and that saves you money

- **Lower operating costs by getting longer life out of your batteries**. … Based on information provided by SmartBattery, you can take action, eliminating situations where harmful over-discharging or under-discharging are occurring.
- **You have the information needed to obtain the optimum number of batteries in your fleet**. … SmartBattery gives you a better handle on your usage needs.
- **Avoid premature replacements and "surprise" failures** because you will know the status of your batteries and can plan when to replace them.

  SmartBattery can be retrofit to your existing battery and new batteries can be ordered with the SmartBattery already installed.

Applicant's amendment to allege use in each application also contains the following statement: "The mark is used on point of sale materials displayed in close adjacent proximity to the lead-acid batteries [for the application identified in the respective application] at trade shows where orders for the lead-acid batteries [for the application identified in the respective application] are solicited and accepted."

Sections 1(a)(1)(C) and 1(d)(1) of the Trademark Act, 15 U.S.C. 1051(a)(1)(C) and (d)(1), require the submission in an application of specimens of the mark "as used." Trademark Rule 2.56, 37 CFR 2.56, requires the submission of "specimens of the trademark as used on or in connection with the goods in commerce."

The court, in *In re Bose Corp*., 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976), stated that "[b]efore there can be registration, there must be a trademark, and unless words have been so used they cannot qualify." (*citation omitted.*) Noting that "the classic function of a trademark is to point out distinctively the origin of the goods to which it is attached," the court stated further (*citations and footnote omitted*):

> An important function of specimens in a trademark application is, manifestly, to enable the PTO to verify the statements made in the application regarding trademark use. In this regard, the manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the asserted mark has been used *as a trademark* with respect to the goods named in the application.

Id. at 215-216.

Advertising material is generally not considered an acceptable specimen evidencing trademark use on goods, unless the advertising material features a picture of the goods with the mark thereon. As the Board stated in *In re Mediashare Corp*., 43 USPQ2d 1304, 1307 (1997):

> Such material, generally speaking, is not acceptable as specimens for goods. This is because any material whose function is simply to tell a prospective purchaser about the goods or to promote the sale of the goods is unacceptable to support trademark use.

In certain circumstances advertising material may function, also, as a display associated with the goods, in which case the material is, essentially, point-of-sale material designed to catch the attention of prospective purchasers and serve as an inducement to consummate a sale. *In re Bright of America, Inc.*, 205 USPQ 63 (TTAB 1979).

We agree with the Examining Attorney that the brochure submitted as a specimen in each of the applications in this case does not evidence use of the mark *on the goods identified in the application* and, therefore, is an unacceptable specimen of use. Both the picture and text of the brochure pertain to the mark SMART BATTERY as used in connection with a device that attaches to and monitors batteries. Even assuming this brochure is used as a point of purchase display, it is clearly a display in connection with the device advertised therein, not in connection with batteries. Applicant’s statement in the amendment to allege use does not contradict this conclusion. In view of the nature of this device, it is reasonable that, as stated in the amendment to allege use, it is displayed in close proximity to the described batteries at trade shows where such batteries are sold or offered for sale. We find applicant’s contrary arguments in this regard to be unpersuasive.

Because we have found the specimens to be unacceptable evidence of use of the mark in connection with the goods identified in each of the applications herein, the amendment to allege use in each application is incomplete and, thus, unacceptable. In view thereof, applicant's request to amend application Serial No. 74/196,304 to the Supplemental Register is, likewise, unacceptable. *See*, Section 23 of the Trademark Act, 15 U.S.C. 1091, and Trademark Rule 2.75, 37 CFR 2.75.

Mere Descriptiveness

We consider, next, the question of whether the mark, SMART BATTERY, is merely descriptive in connection with the goods identified in each of the applications herein. 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).

We must consider the issue of descriptiveness before us in relation to the goods identified in these applications, i.e., the specified batteries, regardless of the actual goods on which applicant may now use the asserted mark. However, in so doing we also consider the evidence in the record regarding the nature of the goods. In particular, we have applicant's express statement that the goods contain a microprocessor. The Examining Attorney has submitted evidence that the term SMART is defined as "having some computational ability of its own … [s]mart devices usually contain their own microprocessors or microcomputers."[3] Additionally, the Examining Attorney has submitted excerpts of articles from the LEXIS/NEXIS database demonstrating use of the term SMART to refer to batteries with microprocessors in various applications.

[3] *Webster's New World Dictionary of Computer Terms* (3rd ed.).

Clearly, the term BATTERY is the generic name of the identified goods. Based on the evidence of record, it is equally clear that the term SMART, as an adjective for BATTERY, merely describes the nature of the goods, namely that the battery contains a microprocessor that allows monitoring of various aspects of the operation of the battery. We find this to be the case notwithstanding applicant's arguments to the contrary. Further, we find the mark to be equally descriptive of the batteries identified in each application before us.

Thus, in the present case, it is our view that, when applied to applicant's goods in each application, the term immediately describes, without conjecture or speculation, a significant feature or function of applicant's goods, namely, that the goods are batteries containing, or having affixed thereto, microprocessors for monitoring the features and functions of the batteries. 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 BATTERY as it pertains to the goods in each application.

Decision: The refusal is affirmed in application Serial No. 74/196,304 and application Serial No. 74/802,601, on the ground that the Examining Attorney properly required substitute specimens because the specimens of record do not show use of the mark in connection with the identified goods. Additionally, the refusal under Section 2(e)(1) of the Act is affirmed in each application.

R. L. Simms

C. E. Walters

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board