

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JAN. 11, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Animatics Corporation

Serial No. 74/529,244

Amy L. Gilson and Joseph D. Hernandez of Wise & Shepard LLP
for Applicant.

Richard A. Straser, Trademark Examining Attorney, Law
Office 104 (Sidney Moskowitz, Managing Attorney).

Before Seeherman, Chapman and Bucher, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Animatics Corporation has filed an application to
register the mark "SMARTMOTOR" for an "apparatus for

controlling robotic machines, namely, electric motors with built-in controls."¹

The Trademark Examining Attorney issued a final refusal to register based upon 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 the goods.

Applicant has appealed the final refusal to register. Briefs have been filed, but applicant did not request an oral hearing. We affirm the refusal to register.

The sole question to be determined herein is whether "SMARTMOTOR" is descriptive of a characteristic, intended purpose, function, or use of applicant's goods as contended by the Trademark Examining Attorney²; or whether, as urged by appellant, the mark "should be considered suggestive" of the goods.

We must consider the question of descriptiveness under Section 2(e)(1) with respect to the goods as stated in the application, i.e., apparatus for controlling robotic

¹ Serial No. 75/529,244, in International Class 7, filed May 25, 1994, based upon an allegation of a *bona fide* intention to use the mark in commerce; amendment to allege use filed on April 5, 1995, claimed dates of first use of December 7, 1994.

² The standard for refusal under Section 2(e)(1) is mere descriptiveness. At various points, applicant cites to cases and principles dealing with the capability of alleged generic matter. The Examining Attorney does not have the same burden herein as would be the case if the issue were genericness under Section 23 of the Lanham Act. Cf. *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987).

machines, namely, electric motors with built-in controls. It is clear from the application and information placed in the file during examination that the goods in question are "electric motors," usually designated simply as "motors," in the field of robotics.

The Trademark Examining Attorney contends that "SMARTMOTOR" is merely descriptive of electric motors with built-in controls because it immediately and directly conveys the information that the motors are controlled by a microprocessor. In support of his position, the Trademark Examining Attorney has made of record more than a hundred NEXIS excerpts of news stories and patent documents showing a variety of uses of the combination of the word "smart" immediately before the word "motor". A representative sample is shown below:

". . . Baldor Electric Co., Ft. Smith, Ark., hopes to prove the doubters wrong when it begins producing a family of 'smart motors' with integrated control electronics. . ." (*Machine Design*, July 13, 1995).³

"The sensor configuration chosen depends ultimately upon the intended application... [T]here appear to be five categories of applications: low-cost motors for basically constant speed operation; traditional BLDC motors with

³ Applicant pointed out that it has objected to Baldor Electric, a competitor, using the designation "Smart Motor."

resolver or encoder feedback;
integrated sensor motors; high
performance integrated sensor motors;
and smart motors." (*"Appliance,"* April
1995).

"...However, we did incorporate smart
motor controls (SMC's) for all the
drives. This allows us to ramp up and
ramp down the conveyor speeds when we
start and stop..." (*"Beverage World,"*
August 1994).

"...To reduce the need for repairs, the
plant also purchased updated variable
frequency drive technology and smart
motor controllers to maximize the
blower's efficiency." (*"American City
& County,"* May 1994).

"...But the need for integrated MCAD/EDA
[mechanical computer-aided
engineering/electronic design
automation] goes far beyond the
obvious. Take Allan-Bradley,
Milwaukee, WI, a leading maker of
industrial motor controls. "Up until a
few years ago, we were known for
mechanical motor controls," says Barry
Umbs ... Now the company offers smart
motor controls, programmable logic
controllers, ... (*"Computer Aided
Engineering,"* April 1994).

"The 1560 Medium Voltage smart motor
controller combines an intelligent
microcomputer with state-of-the-art
power technology to stop or start 100-
to 6000-hp AC motors..." (*"Packaging,"*
January 1994).

"General Electric Company says its ECM™
programmable motor represents a first
in consumer units -- the combination of
ultra-high efficiency with a

programmable control capability that delivers to the user a smart motor with efficiencies and benefits 'never before attained' with traditional induction motor technology..." ("Appliance," April 1993).

The Trademark Examining Attorney argues that if applicant's robotic motor comes integrated in some way with a control system having a microprocessor, this entire system would readily be recognized as a "smart motor." That is, this combination of words succinctly informs potential buyers, using the requisite degree of particularity, of a function of applicant's products. Contrary to applicant's contention, the Examining Attorney has never taken the position that the goods are "merely motors." Rather, the Examining Attorney argues that the entire matter is "merely descriptive" precisely because the goods include more than motors.

The Trademark Examining Attorney's position is consistent with earlier treatment of the term "Smart" by the Board. See *In re Cryomedical Sciences Inc.*, 32 USPQ2d 1377 (TTAB 1994) ["SMARTPROBE" held merely descriptive for disposable cryosurgical probes having microprocessors].

Based on the evidence of record, we find that consumers of applicant's controls would readily understand that SMART, as it is being used in SMARTMOTOR, refers to the electronic or microprocessor component of the control

system, and therefore, that SMARTMOTOR would immediately be perceived as describing electric motors with such built-in controls. All of applicant's competitors should be equally free to use the designation "smart motor" to describe this system.

Applicant contends that there are other marks on the register that include the word "SMART." As stated by a panel of this Board several years ago:

"...[A]pplicant has submitted four third-party registrations of marks, which include, in part, SMART for goods, which, according to applicant, may include a microprocessor... These registrations offer little help in making a determination of the merits of this appeal. While uniform treatment under the Act is a goal, our task in this appeal is to determine, based on the record before us, whether applicant's mark is merely descriptive. As often noted by the Board, each case must be determined on its own set of facts. We are not privy to the records in the files of the cited registrations and, moreover, the determination of registrability of particular marks by the Trademark Examining Groups cannot control the result in another case involving a different mark for different goods."

"Having said the above, we recognize that an argument can be made that the Office has taken in the past a different position with respect to marks of the nature of applicant's. We again would point to the recent proliferation of computers in every

facet of daily life. Not so long ago the "computer" meaning of "smart" may have been known by only those in the computer field, whereas now that meaning of "smart" is likely to be commonly recognized and understood by others as reflected by the dictionary and NEXIS evidence."

In re Cryomedical Sciences Inc., *supra* at 1379 (TTAB 1994).

Substantially all of the registrations listed by applicant -- especially where the matter in the mark modified by the word SMART is even arguably analogous to applicant's "MOTOR" -- preceded the issuance of this 1994 decision.

Decision: The refusal of registration is affirmed inasmuch as the term "SMARTMOTOR" is held to be merely descriptive of the identified goods under Section 2(e)(1) of the Trademark Act.

E. J. Seeherman

B. A. Chapman

D. E. Bucher

Administrative Trademark
Judges, Trademark Trial and
Appeal Board