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Hearing:
March 14, 2001

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 17
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sharp Kabushiki Kaisha, ata Sharp Corporation

Serial No. 75/501,156

Robert W. Adams of Nixon & Vanderhye P.C. for Sharp Kabushiki Kaisha, ata Sharp Corporation.

LaVerne T. Thompson, Trademark Examining Attorney, Law Office 113 (Meryl Hershkowitz, Managing Attorney).

Before Seeherman, Walters and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On June 12, 1998, Sharp Kabushiki Kaisha, ata Sharp Corporation filed an application to register the mark SMART PACKAGE on the Principal Register for goods identified, as amended, as "integrated circuits for use in liquid crystal display apparatus" in International Class 9.¹

The Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e),

¹ Application Serial No. 75/501,156, filed June 12, 1998, based on applicant's assertion of a bona fide intention to use the mark in commerce.

on the basis that, when used on or in connection with applicant's goods, the term SMART PACKAGE is merely descriptive of them.

When the refusal was made final, applicant appealed to this Board. Both applicant and the Examining Attorney have filed briefs. An oral hearing was held on March 14, 2001.

The Examining Attorney contends that the mark is comprised of two descriptive terms, the combination of which does not change the overall descriptiveness of the mark. The Examining Attorney specifically contends that applicant's goods, "integrated circuits," are essentially computer chips²; that the word "smart" is a synonym for intelligent, and in relation to computer hardware and software, a capability of processing information; and that the word "package" is descriptive of integrated circuits because it refers to a type of PCB (printed circuit board) component which contains a chip and the package serves as the electrical connection between the chip and the printed board. Based thereon, the Examining Attorney concludes

² In order to more fully understand the identified goods, we take judicial notice of the following Random House Dictionary (2d ed. 1987) definition of "integrated circuit":

Electronics. a circuit of transistors, resistors, and capacitors constructed on a single semiconductor wafer or chip, in which the components are interconnected to perform a given function. Abbr.: IC Also called microcircuit.

that applicant's mark is merely descriptive whether it is seen as describing either "a smart circuit contained in a package" or "a smart integrated circuit package, a pre-assembled unit." (Brief, p. 12.)

The evidence relied on by the Examining Attorney in support of the refusal consists of dictionary definitions of the words "smart," "package," and "integrated circuit"³; several excerpted stories from the Nexis database showing that the terms "smart" and "package" are commonly used in relation to integrated circuits and liquid crystal displays; several third-party registrations wherein the term "smart" was disclaimed, or the marks were registered under Section 2(f) or on the Supplemental Register; and the material submitted by applicant in response to the Examining Attorney's requirement for advertisements or promotional materials for the same types of goods as those which applicant intends to sell under this mark.

Applicant, on the other hand, argues that the mark SMART PACKAGE "is a completely arbitrary term that has no meaning, let alone a generic or merely descriptive meaning,

³ The Examining Attorney's request that we take judicial notice of the on-line dictionary definition of the term "package," as well as "any other dictionary definitions" included with her brief, is granted. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). See also, TBMP §712.01.

with respect to integrated circuits used in LCDs" (brief, p. 4); that the Examining Attorney has not met her burden of proving "that the combination word mark has any merely descriptive or generic meaning" (Id.)⁴; that the mark does not immediately and only tell potential purchasers what applicant's goods are, or their function; that there are several third-party registrations in which the term "smart" was not disclaimed; and that the mark is arbitrary or at least suggestive because it requires imagination, thought and perception to determine the nature of the goods. Applicant also specifically contends that the present refusal is improper in view of the United States Patent and Trademark Office's (USPTO) allowance of the two registrations originally cited, but later withdrawn as a basis for refusal, by the Examining Attorney.⁵

The test for determining whether a mark is merely descriptive under Section 2(e)(1) of the Trademark Act is whether the term immediately conveys information concerning

⁴ There is no refusal to register on the basis of genericness.

⁵ The first Examining Attorney had refused registration under Section 2(d), citing Registration Nos. 1,964,130 issued January 2, 1996 for the mark SMART PAC and design for "products for access control, namely an electronic circuitry for powering an electronic strike over a range of voltages with minimum electric power demand," and No. 1,989,083, issued July 23, 1996 for the mark SMARTPAK for "removable computer data storage modules and base units." The refusal to register under Section 2(d) was withdrawn as to both registrations.

a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Associates*, 226 USPQ 285 (TTAB 1985); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). A mark does not have to describe every quality, feature, function, etc. of the goods or services in order to be found merely descriptive; it is sufficient for the purpose if the mark describes a single significant quality, feature, function, etc. thereof.

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 term or phrase is being used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991). The question is not whether someone presented with only the mark could guess what the goods are. Rather, the question is whether someone who

knows what the goods are will understand the mark to convey information about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985). In this case, we agree with the Examining Attorney that SMART PACKAGE is merely descriptive of the involved goods.

The Examining Attorney submitted the following dictionary definition of "smart" from the Microsoft Press Computer Dictionary (2d ed.):

"A synonym for *intelligent*; in relation to software or hardware, capable of processing information, typically beyond what is currently expected. *Smartness* does not imply rationality."
(Italics in original.)

In addition, we take judicial notice of the following Random House Dictionary (2d ed. 1987) definitions of

"smart":

"17. *Informal*. equipped with, using, or containing electronic control devices, as computer systems, microprocessors, or missiles: *a smart phone; a smart copier*. 18. *Computers*. intelligent."
(Italics in original.)

Applicant is correct that the Examining Attorney did not submit any Nexis articles showing use of the term "SMART PACKAGE"; however, there are numerous excerpted Nexis articles showing use of "smart" or "smart circuit" or

"LCD," or "integrated circuit package," examples of which are shown below (emphasis added):

Headline: Doing the Local Motion [--]
Long-Distance Firms, Start-ups [and]
Cable All Want Piece of for Whom Bell
Tolls
Graphic: ...Joe Lacher, Southern Bell's
Florida president displays "**smart**"
circuit pack. "Sun-Sentinel (Fort
Lauderdale)," March 28, 1994;

Headline: Digital dampers; K2 Smart
Shock damping shock
In the variable damping suspension, a
sensor in the shock reads the piston's
speed and position, then sends the data
back to a **smart circuit** that transmits
the signal to a piezoelectric actuator
in the valve, flexing it in
milliseconds. "Mechanical Engineering-
CIME," March 1988;

Headline: 3M's Big Bets
Microflex circuits--Description: Used in
inkjet printers, hearing aids and
integrated circuit packages...
"Star Tribune (Minneapolis, MN),"
September 13, 1999;

Headline: Digital Imaging for Circuit
Boards
...The difficulty with this checking
system is it does not identify specific
internal problems with **integrated**
circuit packages on the board.
Specific areas of difficulty had to be
located through a time-consuming and
costly manual process." "NDT Update,"
September 1999;

Headline: Cadence releases IC Packaging
Tool; SPECTRAQuest from Cadence Design
Systems...
Cadence Design Systems Inc., San Jose,
today is announcing a tool for silicon

and package optimization of **integrated-circuit (IC) packaging**. SPECTRAQuest interconnect designer for **IC packaging**, part of the Cadence Advanced packaging ensemble expert system, merges electrical and physical design into an environment that provides a complete solution for optimizing **IC package performance**." "Electronic News," August 23, 1999;

Headline: Super Lynx to get new cockpit display

At the heart of the new cockpit will be active matrix liquid crystal technology using **"smart" integrated display units** capable of displaying self-generated symbology and video. "Aerospace Daily," June 23, 1999;

Headline; Controller Delivers On-Screen Animation

...access to VRAM, allowing the new IC to virtually eliminate display screen distortion. The on-chip I/O register control logic for the display enhances flexibility in designing the microcontroller interface, increases CPU speed, and reduces the number of I/O pins necessary for the **LCD controller package**. "Display Development News," August 1998; and

Headline: Mitsubishi Forklift Trucks Introduces New Models

...The **LCD smart display** monitors the truck's performance levels and operational indicators, such as battery charge indicator, travel speed, truck hours, drive motor hours and clock. "Southwest Contractor," April 1999;

Applicant submitted four pages (consisting of the front cover, the content page, page 5 showing "TFT LCD

Drivers," and the back page) from its 1999/2000 Integrated Circuits catalog.⁶ The "CONTENTS" page lists several categories of goods, such as "LCD DRIVERS," "IC PACKAGES," "SPECIAL-FUNCTION ICs," "ASICs," and "MICROCOMPUTERS." Thus, applicant's own catalog treats integrated circuit packages as a category.

In this case, "smart" means "intelligent," and "capable of processing information beyond what is typically expected"; and the record clearly shows that "package" is used to refer to integrated circuits. Thus, the two words separately have an easily understood meaning in the integrated circuit industry, and when combined and used on or in connection with applicant's goods ("integrated circuits for use in liquid crystal display apparatus"), there is no unique or incongruous meaning created. When the combined words are used in connection with integrated circuits, they immediately and directly convey that the goods are smart integrated circuit packages.

The fact that applicant's goods are integrated circuits specifically used in liquid crystal displays does

⁶ This was submitted on March 23, 2000 in response to the Examining Attorney's request for advertising or promotional materials for the same types of goods. Applicant stated that "Such material showing use of the mark of the present application are not available. However, enclosed are materials for the same type of goods that applicant intends to sell under the subject mark." March 23, 2000 Request for Reconsideration, p. 7.

not negate the descriptiveness of the mark SMART PACKAGE. The common meanings of the words and what purchasers will make of them in the context of the goods are pivotal. See *Remington Products Inc. v. North American Philips Corp.*, 892 F.2d 1576, 13 USPQ2d 1444 (Fed. Cir. 1990), and the discussion therein of *DeWalt, Inc. v. Magna Power Tool Corporation*, 289 F.2d 656, 129 USPQ 275 (CCPA 1961). To the extent that the term SMART PACKAGE is used in connection with "integrated circuits for use in liquid crystal display apparatus," it immediately describes, without conjecture or speculation, a significant characteristic or feature of those goods, namely, that the integrated circuit has some type of computational or logic ability used for operating or controlling either the integrated circuit itself or the product in which the integrated circuit is installed. That is, applicant's use of the mark SMART PACKAGE would be perceived by consumers as relating to the logic capability of the integrated circuits.

In the record now before us, the Examining Attorney has established a prima facie showing that this mark is merely descriptive of the identified goods. See *In re Cryomedical Sciences Inc.*, 32 USPQ2d 1377 (TTAB 1994) (*SMARTPROBE* held merely descriptive of disposable

cryosurgical probes, that is involving the term "smart" with the generic term for the goods).

Applicant has submitted several third-party registrations, all for marks which include either the word SMART or PACKAGE. These registrations offer little help in making a determination of the merits of this appeal. While uniform treatment under the Trademark Act is certainly a goal of the USPTO, the Board's 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 referenced third-party registrations. See *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Certainly, the Board has not established a "per se rule" that the term SMART is not registrable. Rather, registrability of a mark must be determined on a case-by-case basis and in relation to the involved goods or services. See *In re Dos Padres, Inc.*, 49 USPQ2d 1860 (TTAB 1998).

Applicant's argument that the record contains no evidence of third-party use of "SMART PACKAGE" is unavailing. Even if applicant is the first (and/or only) entity to use the term SMART PACKAGE in relation to

integrated circuits for use in liquid crystal display apparatus, such is not dispositive where, as here, the term unquestionably projects a merely descriptive connotation, and should remain available so that others engaged in the relevant industry remain free to use the term. See *In re Tekdyne Inc.*, 33 USPQ2d 1949, 1953 (TTAB 1994), and cases cited therein.

In this case, it is our view that, if applied to applicant's identified goods, the term SMART PACKAGE immediately describes, without conjecture or speculation, a significant feature or characteristic of applicant's goods, as discussed herein. 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 PACKAGE as it pertains to applicant's goods.

Decision: The refusal to register the mark as merely descriptive under Section 2(e)(1) of the Trademark Act is affirmed.