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Hearing:
Sept. 18, 2002

Paper No. 17
Bottorff

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Johnson & Johnson

Serial No. 75/799,927

Norm D. St.Landau and Adam Barea of Drinker, Biddle & Reath
LLP for Johnson & Johnson.

David E. Yontef, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Cissel, Quinn and Bottorff, Administrative Trademark
Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark SMARTVAC, in typed form, for goods identified
in the application as "surgical device, namely, a vacuum

used in breast biopsies.”¹ Registration has been finally refused on the ground that the mark is merely descriptive of the goods. See Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). Applicant has appealed the final refusal to register. The appeal has been fully briefed, and an oral hearing was held at which the Trademark Examining Attorney and counsel for applicant each presented arguments.

After careful consideration of the evidence of record and the arguments of counsel, we find that the mark is merely descriptive, and we accordingly affirm the refusal to register. That is, we find that SMART is merely descriptive of a key feature or characteristic of applicant’s goods, that VAC likewise is merely descriptive of the goods, and that applicant’s combining of these merely descriptive terms does not result in an inherently distinctive composite mark.

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re*

¹ Serial No. 75/799,927, filed September 15, 1999. The application is based on applicant’s asserted intention to use the mark in commerce. Trademark Act Section 1(b).

Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use; that a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Finally, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re American Greetings Corporation*, 226 USPQ 365, 366 (TTAB 1985).

Applicant's mark consists of the components SMART and VAC. The evidence of record establishes, and applicant

does not dispute, that VAC is short for VACUUM, and that it is merely descriptive as applied to applicant's vacuum device. Rather, the disputed issue in this appeal is whether SMART is merely descriptive of applicant's goods.

The Trademark Examining Attorney has presented dictionary evidence establishing that SMART is defined, in pertinent part, as "equipped with, using, or containing electronic control devices."² The Trademark Examining Attorney also has made of record several excerpts from articles obtained from the NEXIS database which show the term "smart" used descriptively in this manner in connection with computer-controlled medical devices or devices employing computer microchip technologies. For example: "Scientists at a government laboratory in New Mexico unveiled a 'smart scalpel' in which a tiny vacuum sucks cells through microchip-connected sensors for analysis during surgery..." (Medical Industry Today, March 27, 2000); "RTI, with NASA, will hold a briefing Nov. 7 to discuss development of a multi-modality smart surgical probe for biopsies. This new medical device will incorporate sensors to make sure the biopsy sample is taken from the lesion and that the reading is more accurate"

² Random House Unabridged Dictionary (1993) at 1803.

(Triangle Business Journal-Raleigh NC (October 31, 1997)); "...to develop and sell a version of Linux that runs on the tiny computers found in automobiles, medical devices and other small, smart machines" (The News and Observer (Raleigh, NC), April 6, 2000); "...trying to etch the blades with computer circuitry for sensors that could detect diseased tissue and relay the findings to the surgeon. Lal figures his smart scalpels someday could find a use in telemedicine and remote surgery" (H&HN ["Copyright 1999 American Hospital Publishing Inc."], July 1, 1999); and "...`smart` medical devices run by a silicon chip are being designed to help patients whose problems range from heart ailments to diabetes" (The Washington Post, August 19, 1984).

It is undisputed that applicant's goods employ or consist of a vacuum system which is "computer-controlled." See applicant's Web page, attached to applicant's response to the first Office action. Based on the evidence discussed above, we find that the term SMART merely describes this feature or characteristic of applicant's goods.

This case is highly analogous to *In re Cryomedical Sciences Inc.*, 32 USPQ2d 1377 (TTAB 1994), where the Board found that SMARTPROBE is merely descriptive of goods

identified as "one time use, disposable cryosurgical probes." The Board noted that the applicant's goods were probes which were or could be equipped with electronic control devices or microprocessors, and found, based on essentially the same type of evidence as that presented by the Trademark Examining Attorney in the present case, that SMART is merely descriptive of that feature of the devices. Applicant's attempts to distinguish the present case are unpersuasive.

Likewise, applicant's efforts to analogize the present case to *In re Intelligent Medical Systems Inc.*, 5 USPQ2d 1674 (TTAB 1987), are unavailing. In that case, the Board reversed a mere descriptiveness refusal to register INTELLIGENT MEDICAL SYSTEMS for "electronic thermometers for measuring human body temperature" because the record in that case showed "that the word 'intelligent' has no special significance or meaning in the medical products field." *Id.* at 1675. In the present case, by contrast, the record establishes that "smart" is often used as a descriptive term in connection with devices, including medical devices, which are equipped with or utilize computer-controlled systems. We find that the SMARTPROBE case, *In re Cryomedical Sciences Inc.*, *supra*, is more on

point in this case than is *In re Intelligent Medical Systems Inc.*, *supra*.

Applicant's primary argument in opposition to the mere descriptiveness refusal is that SMART is not merely descriptive of applicant's goods because it does not convey to purchasers anything that they do not already know about the goods. That is, applicant contends that all surgical vacuum devices of the type identified in the application are "smart," i.e., are equipped with microprocessors and are computer-controlled, that purchasers of these goods are already well aware of that fact, and that such purchasers therefore will assume that SMART, as it is used in applicant's mark, must mean something other than, or in addition to, the fact that the goods are computer-controlled. Because that other or additional meaning is not immediately apparent, applicant argues, the term is not merely descriptive.

The apparent novelty of this argument is matched only by its utter lack of persuasiveness. Under applicant's theory, SWEET is not merely descriptive of candy, nor is SALTY merely descriptive of pretzels, because purchasers already know that candy is sweet and that pretzels are salty, and they therefore would assume that if SWEET appears in a trademark for candy it must refer to something

besides the candy's sweetness, and that if SALTY appears in a trademark for pretzels it must refer to something besides the pretzels' saltiness.

Regardless of the significance applicant might subjectively intend the term SMART to have in connection with its goods (i.e., that its goods feature an improved design, or that they are the intelligent choice), the fact remains that SMART is and would be directly perceived by purchasers as an indication that applicant's goods are computer-controlled. No more is required in order to establish mere descriptiveness.³

In short, we find that SMART is merely descriptive of a key feature or characteristic of applicant's goods, i.e., that they are computer-controlled. VAC also is merely descriptive of applicant's surgical vacuum devices. Combining the two terms into SMART VAC or its legal equivalent SMARTVAC does not negate the mere descriptiveness of these terms; the composite is as merely descriptive of the goods as the two terms are when considered separately. Applicant is not entitled to

³ Applicant has not expressly argued that the term SMART, as used in connection with applicant's goods, creates a double entendre of some sort which negates the mere descriptiveness of the term. Indeed, the apparent elusiveness (according to applicant) of the other or additional meaning of the term precludes any finding that the mark would be perceived as a clever or incongruous double entendre.

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appropriate to itself (via federal registration) the exclusive right to use the term SMARTVAC in connection with computer-controlled, i.e., smart, surgical vacuum devices.

Decision: The refusal to register is affirmed.