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TTAB

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AD

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Brunswick Corporation

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Serial No. 78841309

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Peter T. Holsen of Andrus, Scales, Starke & Sawall, LLP  
for Brunswick Corporation.

John M. Gartner, Trademark Examining Attorney, Law Office  
102 (Karen M. Strzyz, Managing Attorney).

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Before Hohein, Drost, and Cataldo, Administrative Trademark  
Judges.

Opinion by Drost, Administrative Trademark Judge:

On March 20, 2006, Brunswick Corporation (applicant)  
applied to register the mark SMART TOW in standard  
character form on the Principal Register for goods  
identified as "Watercraft speed control systems, namely,  
computer controllers with operating software for the launch  
and cruise of a watercraft" in Class 9. The application

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(Serial No. 78841309) is based on applicant's allegation of a bona fide intention to use the mark in commerce.

The examining attorney refused registration on the ground that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), because the mark SMART TOW "immediately describes the fact that the goods allow for towing using controllers equipped with microprocessors." Brief at unnumbered p. 3.

Applicant argues that the mark "only suggests a 'desired result' obtained by the use of the applicant's goods."

Brief at 3.

After the examining attorney made the refusal final, applicant appealed.<sup>1</sup>

For a mark to be merely descriptive, it must immediately convey knowledge of the ingredients, qualities, or characteristics of the goods or services. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004). *See also In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). To be merely descriptive, a term need only describe a single significant quality or property of the goods. *Meehanite Metal Corp. v. International Nickel Co.*, 262 F.2d 806, 120 USPQ 293, 294

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<sup>1</sup> On November 6, 2007, applicant withdrew its request for an oral hearing.

(CCPA 1959). See also *In re Litehouse Inc.*, 82 USPQ2d 1471, 1472 (TTAB 2007) ("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"). Mere descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or services for which registration is sought. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

In this case, the examining attorney relies on, inter alia, relevant dictionary definitions of the terms Smart ("fitted with a built-in microprocessor") and Tow ("pull something"). Office Action dated August 22, 2006 attachments. Other evidence of record includes applicant's press release (also dated August 22, 2006) that describes the goods as follows:

[A] precise and easy-to-use control system boat drivers can program to achieve smooth and consistent launch and cruise control for water sport activities... The Launch Control System consists of five pre-set launch profiles designed to meet different water sports needs, from tubing to wakeboarding to slalom skiing. Drivers simply select a launch profile for out-of-the-hole intensity, enter an rpm set point based on the rider's desired pull speed and move the throttle to wide-open. SmartTow does the rest.

See also [www.fishingandboats.com](http://www.fishingandboats.com) ("Mercury launches a New electronic tow system").

In another article, applicant's spokesman says its product "simulates a driver with 20 years towing experience with the push of a button. It allows someone with little experience to tow like an expert." [www.ibinews.com](http://www.ibinews.com).

Applicant points to several "Smart" registrations that issued on the Principal Register to support its argument that its mark "is also registrable on the Principal Register." Brief at 17. See also Response dated December 15, 2007 at 6-7 (SMARTSWIPE for calling cards, SMART AC for AC/DC inverters, SMARTFEED for electrical controller for use in water treatment systems, SMART TAPE for measuring tapes, SMARTWHEEL for force measurement device for analyzing manual wheelchair propulsion, SMART CLIPS for terminator for insulated electrical wire, and SMART CABLES for cables).<sup>2</sup>

In order to determine whether applicant's mark is merely descriptive, we must, of course, view the mark in relation to the goods on which applicant intends to use the mark. In this case, the goods are "watercraft speed

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<sup>2</sup> We will consider the information that applicant has made of record inasmuch as the examining attorney has not objected to this evidence and discussed the registrations in his brief. TBMP § 1207.03 (2d ed. rev. 2004); *Litehouse*, 82 USPQ2d at 1475 n.2.

control systems, namely, computer controllers with operating software for the launch and cruise of a watercraft." Inasmuch as applicant's goods feature a "computer controller," the term "Smart," which can mean "fitted with a microprocessor" certainly has some descriptive significance for these goods. See, e.g., *In re Finisar Corp.*, 78 USPQ2d 1618, 1623 (TTAB 2006) (SMARTSFP merely descriptive of optical transceivers that contain automated capabilities and are small form-factor pluggable); *In re Cryomedical Sciences Inc.*, 32 USPQ2d 1377, 1378 (TTAB 1994) ("It is undeniable that computers have become pervasive in American daily life. The 'computer' meaning of the term 'smart,' as is the case with many 'computer' words, is making its way into the general language"). Furthermore, the evidence of record indicates that applicant's goods are used with a watercraft that "tows" an individual in various water sports. Therefore, the individual terms have some descriptive significance.

However, whether terms are individually descriptive does not mean that the combined term is merely descriptive. *In re Marriott Corp.*, 517 F.2d 1364, 186 USPQ 218, 222 (CCPA 1975) ("Nor do we view the slogan WE SMILE MORE as descriptive of hotel, restaurant, or convention services. That the individual words are common and ordinary is

undeniable. That each is descriptive of something is clear. But marks must be considered in their entireties"). See also *In re Automatic Radio Mfg. Co., Inc.*, 404 F.2d 1391, 160 USPQ 233, 235 (CCPA 1969) ("We quite agree that 'automatic volume control' is wholly descriptive of that feature of a radio receiver, but that does not make AUTOMATIC merely descriptive of the radio receiver. Nor does it make 'AUTOMATIC RADIO' the name of the receiver").

Here, applicant argues that "SMART TOW is merely suggestive of the desired result of the use of the goods." Brief at 4. Our case law recognizes that if a term is suggestive of the result of using the product, it is not merely descriptive of the product. See *In re Nalco Chemical Co.*, 228 USPQ 972, 973 (TTAB 1986) (The "term 'VERI-CLEAN,' as applied to applicant's chemical anti-fouling additives for use in refineries, is suggestive of the desired end result of the use of applicant's additives, but does not serve to describe the goods themselves"); *In re The Noble Co.*, 225 USPQ 749, 750 (TTAB 1985) (The "board is of the opinion that the mark {NOBURST for antifreeze} suggests a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function or attribute thereof"); *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166

(TTAB 1980) (PURITY for water filtering units "is suggestive of the desired result of the use of those goods, and as such is not merely descriptive of them"); and *In re C. J. Webb, Inc.*, 182 USPQ 63, 64 (TTAB 1974) ("'[B]rake clean' is suggestive of a desired result of a brake cleaner and therefore the asserted phonetic equivalent 'Br'akleen' must be considered to be suggestive rather than merely descriptive when applied to applicant's goods").

In this case, when we look at the combined term SMART TOW in relation to applicant's watercraft speed control systems, we are not persuaded that the limited evidence in this case demonstrates that the combined term is merely descriptive. The ultimate question here is whether the term SMART TOW will immediately inform prospective purchasers of a feature, characteristic, or quality of the goods, which in this case are watercraft speed control systems. While the examining attorney argues that the mark "immediately describes a function of the goods, that is that they provide a 'smart' or microprocessor-assisted tow" (Brief at 6), it is not clear to us that prospective purchasers will immediately understand that applicant's SMART TOW describes a quality, function or feature of applicant's watercraft speed controllers. *In re The Rank Organization Limited*, 222 USPQ 324, 326 (TTAB 1984) (The

"fact that the term 'LASER' is capable of being analyzed does not render the term merely descriptive"). Applicant's goods are not toys fitted with a microprocessor. While customers are likely eventually to understand the relationship of the mark to applicant's goods, we find that the mark falls on the highly suggestive side of the suggestive/descriptive line. Rather than immediately understanding the assertedly descriptive meaning or significance of the term, prospective purchasers are likely to study the product more closely to understand what the relationship of the mark to the product is. A "mark is suggestive if imagination, thought, or perception is required to reach a conclusion on the nature of the goods or services." *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). Here, the term is likely to be viewed as suggesting that as a result of using the product the purchaser will receive the benefits of a computer to achieve a more professional towing experience.

Obviously, we base our decision on the record we have before us in this case.<sup>3</sup> In mere descriptiveness cases, we

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<sup>3</sup> While applicant, as noted previously, has submitted evidence of certain third-party registrations for marks that contain the term "smart," we do not find this evidence very persuasive. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (Even "if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court").

are required to resolve any doubts in favor of the applicant for registration. *In re Morton-Norwich Products, Inc.*, 209 USPQ 791, 791 (TTAB 1981) (The Board's practice is "to resolve doubts in applicant's favor and publish the mark for opposition"). *See also In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002) ("While our determination is not free from doubt, we resolve that doubt in favor of applicant and reverse the refusal to register"). Here, we do have doubts about whether prospective purchasers will view the term SMART TOW for watercraft speed controllers as merely descriptive and, therefore, we resolve them in applicant's favor. *Remacle*, 66 USPQ2d at 1223 n.1 ((BIO-CD is not merely descriptive in connection with, inter alia, "modified compact discs on which biological molecules such as nucleic acids, antigens, antibodies and biological receptors are fixed").

Decision: The refusal to register applicant's mark SMART TOW under Section 2(e)(1) of the Trademark Act is reversed.