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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re PointCast Incorporated

Serial No. 75/022,018

Andrew P. Bridges of Wilson Sonsini Goodrich & Rosati for PointCast Incorporated

Kathleen M. Vanston, Trademark Examining Attorney, Law Office 103 (Michael A. Szoke, Managing Attorney)

Before Simms, Hairston and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

PointCast Incorporated has filed an application to register the mark SMARTSCREEN for "computer software, and manuals sold as a unit, for dynamically composing a script-based animation in which news headlines, stock information, and other content are combined with graphics and

advertisements to form a presentation of useful information".[1]

The Examining Attorney has finally refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e), on the grounds that applicant's mark is merely descriptive of applicant's goods, or alternatively, that the mark is deceptively misdescriptive of applicant's goods.

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

The Examining Attorney essentially contends that "'smart screen' describes a computer screen which would be able to process information or respond appropriately to changing stimuli" (brief, p.4); and that "unlike ordinary screen saver programs which display dumb (or noninteractive) screens," applicant's computer software screen saver program "creates smart screens which can respond to user requests for further information" (brief, p. 6), and therefore the mark describes a significant aspect of the goods. Alternatively, the Examining Attorney

[1] Application Serial No. 75/022,018, filed November 20, 1995. The application is based on applicant's bona fide intent to use the mark in commerce.

argues that, because applicant contends its goods are not "smart" in the sense generally ascribed to computer goods, and because consumers would have a reasonable expectation that that applicant's goods would possess the generally understood "smart" characteristics, the mark is deceptively misdescriptive.

The evidence submitted by the Examining Attorney in support of her refusals consists of five computer dictionary definitions, and seven stories obtained from the Nexis database (one story reprinted in full[2] and six excerpted stories[3]).

Applicant, on the other hand, maintains that the mark SMARTSCREEN is suggestive, not descriptive or misdescriptive of applicant's goods; that the term SMART is

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[2] This story is identified as from "PR Newswire," and labeled "Distribution: To Business and Technology Editors." It is unclear if this story is from a wire service or if this story was available in a printed publication. Wire service articles are of limited probative value in assessing the reaction of the public to the term applicant seeks to register because evidence from a proprietary news service is not presumed to have circulated among the general public. Even if this item actually appeared in a printed publication in general circulation, our decision would remain the same.

[3] Two of the six excerpted stories were from foreign publications, and therefore are of little probative value because it cannot be assumed that foreign uses had any material impact on the perceptions of the public in the United States. See In re Manco Inc., 24 USPQ2d 1938 (TTAB 1992).

Another of the Nexis excerpts was a headline only with no textual story at all. ("Headline: Smart Screens Help Out Dumb Users," Computer Technology Review, July 1992.) Obviously, with no textual article it is impossible to draw any conclusions from this submission.

subject to numerous interpretations as evidenced by Webster's Ninth New Collegiate Dictionary (1988) with meanings as varied as "mentally alert, knowledgeable, spirited, witty, stylish, saucy, sophisticated, operating by automation, or having part of the processing done by a microcomputer"; that within the computer field, the term has come to have a more narrow meaning most like the last meaning involving processing done by microcomputer; that applicant's goods are not screens for computer or video monitors, and the term "screen" in applicant's mark is a suffix merely suggesting a feature of applicant's "updatable 'screensaver' software"; that the mark SMARTSCREEN, considered in its entirety, does not convey an immediate idea of the qualities of applicant's goods[4]; and that the present refusal is improper in view of the Patent and Trademark Office's allowance of other marks which include the term SMART[5].

[4] Applicant's application is based on intent to use, but the record is clear that applicant has commenced use of the mark. In fact, applicant submitted about 100 excerpted Nexis stories to show that the public views SMARTCREEN as applicant's trademark, not as a descriptive term. Even without considering the stories from newswires, foreign press and repeated stories, there are a significant number of such stories. Based on these Nexis stories, applicant offered an alternative amendment to seek registration under Section 2(f). The Examining Attorney stated this was "not appropriate" in an application filed under Section 1(b), and applicant did not pursue the issue. See TMEP §1212.09.

[5] Applicant submitted a Trademarkscan database search report assertedly showing 119 "marks for software registered on the

Applicant further contends that the mark does not misdescribe the goods in view of the numerous meanings of the term SMART, and its suggestion of utility in connection with the involved goods; that the term SMARTSCREEN is certainly not understood by today's consumers as being equipped with a microprocessor because applicant's goods are software, not hardware, products; that the Examining Attorney did not meet the burden necessary to demonstrate that applicant's mark is unregisterable under Section 2(e)(1); and that doubt must be resolved in applicant's favor.

A term is considered merely descriptive, and therefore unregisterable pursuant to Section 2(e)(1), if it immediately conveys knowledge or information about the qualities, characteristics, or feature of the goods on which it is used or intended to be used. On the other hand a term which is suggestive is registerable. A suggestive term is one which suggests, rather than describes, such

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Principal Register that contain and do not disclaim the word 'smart.'" Generally, mere listings of third-party registrations are insufficient to make them of record. See In re Consolidated Cigar Corp., 35 USPQ2d 1290 (TTAB 1995); and In re Duofold, 184 USPQ 638 (TTAB 1974). However, the Examining Attorney has not objected to the evidence and thus, it will be treated as of record for whatever probative value it may have. We note that the listing includes no information as to matters such as the registration dates, registrants, or the current status of the registrations.

that imagination, thought or perception is required to reach a conclusion on the nature of the goods. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). The test for determining whether a term is deceptively misdescriptive as applied to the goods involves a two-part determination of (1) whether the matter sought to be registered misdescribes the goods, and (2) whether anyone is likely to believe the misrepresentation. See In re Quady Winery, Inc., 221 USPQ 1213 (TTAB 1984).

The initial computer dictionary definition of "smart" submitted by the Examining Attorney in this case refers to an independent computational ability and usually including its own microprocessor. In the case of In re Cryomedical Sciences Inc., 32 USPQ2d 1377, 1379 (TTAB 1994), the Board stated "we find that consumers for applicant's probes would readily understand that SMART, as would be used in SMARTPROBE, refers to an electronic or microprocessor component of the probes." Moreover, the second computer dictionary definition of "smart," referring to "intelligent" leads to the computer dictionary definition of "intelligence." This definition is considered not only with regard to that portion of the definition relating to "reasoning and logic" which was utilized by the Examining Attorney (stimulating human thought and responding to

changing stimuli), but it is also considered with regard to the portion relating to computer software. "Intelligence" as defined "in relation to software" is "the ability of a program to monitor its environment and initiate appropriate actions to achieve a desired state. For example, a program waiting for data to be read from disk might do another task in the meantime to achieve high performance." Thus, the record before us shows many definitions of "smart," virtually all of which are commonly understood by the purchasing public.

The Examining Attorney's sparse excerpted evidence from Nexis follows:

> (1) "...The Application Server provides the business rules and logic to the Web application. The HTML Generator provides "smart" screen presentations that dynamically change based on the value of the data provided by the application server. For further development productivity, MagicWeb comes with templates that help in controlling page content and structure. An Auditor features logs documents and browser...," M2 Communications, December 11, 1996;
>
> (2) "Headline: Christopher Hassett, PointCast" "...What other changes have been made? In version 1.1 you'll see a variety of new content. You'll see a new look and feel to all of the smart screens. Moving through the summer, you'll see the MacIntosh opened up. In September, we'll have yet another release, coincident with the Iserver

product that's going out....," Upside, September 1996; and

(3) "...inclusive. C++ will often be the language in which components are written, a common macro language will be the glue at the solutions level, and the middle level will (or should) include tools as diverse as neural nets, database agents, genetic algorithm libraries, and smart screen painters....," AI Expert, May 1993.

The full article submitted by the Examining Attorney is dated February 13, 1996, and carries the headline "CMP Becomes First Technology Information Provider On Pointcast." The portion relied upon by the Examining Attorney is reproduced below:

> "After the software has been initially downloaded, PCN will offer a level of interactivity unsurpassed in Internet technology. When a user's computer is not in use, PCN Smart Screens (TM) will automatically appear, displaying headlines indicating the latest news items on a variety of channels, including a rolling stock ticker. For technology news, the PCN Smart Screen will display CMP's Technology Channel, where users can get an abstract on a news story. Full text of the articles will be available on CMP's TechWeb."

Applicant points out that the full story article refers to applicant's product and uses a "TM" within the story; that one of the excerpted stories is also about applicant and its product, through an interview of the chairman of the company, Christopher Hassett; and that the other excerpted stories appear to discuss a feature of

software development tools, none of them involving or discussing a product like applicant's screen saver program.

The Examining Attorney's argument that the term describes computer screens is inapposite. Applicant's goods are not computer screens. Rather, applicant's goods are computer software programs which are screen saver programs. In the Cryomedical case, supra, the Board held SMARTPROBE merely descriptive of disposable cryosurgical probes, but the term SMART preceded and thus modified, in the adjectival sense, the generic name for the goods. In the case now before us, applicant did not apply for the mark SMARTSCREENSAVER for its goods or for the mark SMARTSCREEN for screens for computer video monitors. Thus, there is a different situation.

The goods in this case, being computer software (essentially a screen saver program), do not contain a microprocessor. There is not sufficient evidence of record to establish a prima facie case that purchasers of computer software would expect (erroneously) that software could or would contain a microprocessor. See U.S. West Inc. v. BellSouth Corp., 18 USPQ2d 1307 (TTAB 1990). See also, 2 McCarthy, McCarthy on Trademarks and Unfair Competition, §§11:19 and 11:58 (4th ed. 1999).

The burden of proving that applicant's mark is merely descriptive or alternatively that it is deceptively misdescriptive rests with the Examining Attorney. The dictionary definitions of the terms "screen," "screen saver," "smart" and "intelligence" do not show that the term SMARTSCREEN has a readily recognized meaning with regard to the involved goods. We find that it is simply unclear whether the term SMARTSCREEN is merely descriptive of applicant's computer software.

When doubt exists as to whether a term is merely descriptive or deceptively misdescriptive, it is the practice of this Board to resolve doubts in favor of the applicant and pass the application to publication. See In re Gourmet Bakers Inc., 173 USPQ 565 (TTAB 1972). In this way, anyone who believes that the term is, in fact, descriptive or misdescriptive, may oppose and present evidence on this issue to the Board.

Decision: The refusals to register the mark as merely

descriptive or alternatively, as deceptively misdescriptive, both under Section 2(e)(1) of the Trademark Act, are reversed.

R. L. Simms

P. T. Hairston

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal