

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK:	SMART WOOD (Word Mark)(the "Mark")
SERIAL NO.:	88332457
CLASS(ES):	028
GOODS:	Toys made of wood
APPLICANT:	S.I.P. SA

On May 23, 2019, an Office Action was issued refusing registration for Applicant, S.I.P. SA's ("Applicant") application to register, SMART WOOD (Word Mark)(U.S. Trademark Ser. No. 88332457) for "Toys made of wood " in International Class 028 (hereinafter, the "Applicant's Goods").

Registration for the Mark was rejected on the grounds that the Mark is "merely descriptive" under Section 2(e)(1) of the Lanham Act. The Examiner has also required an amendment to the Applicant's Goods. Since both inquiries are interconnected, Applicant addresses them both jointly hereinbelow.

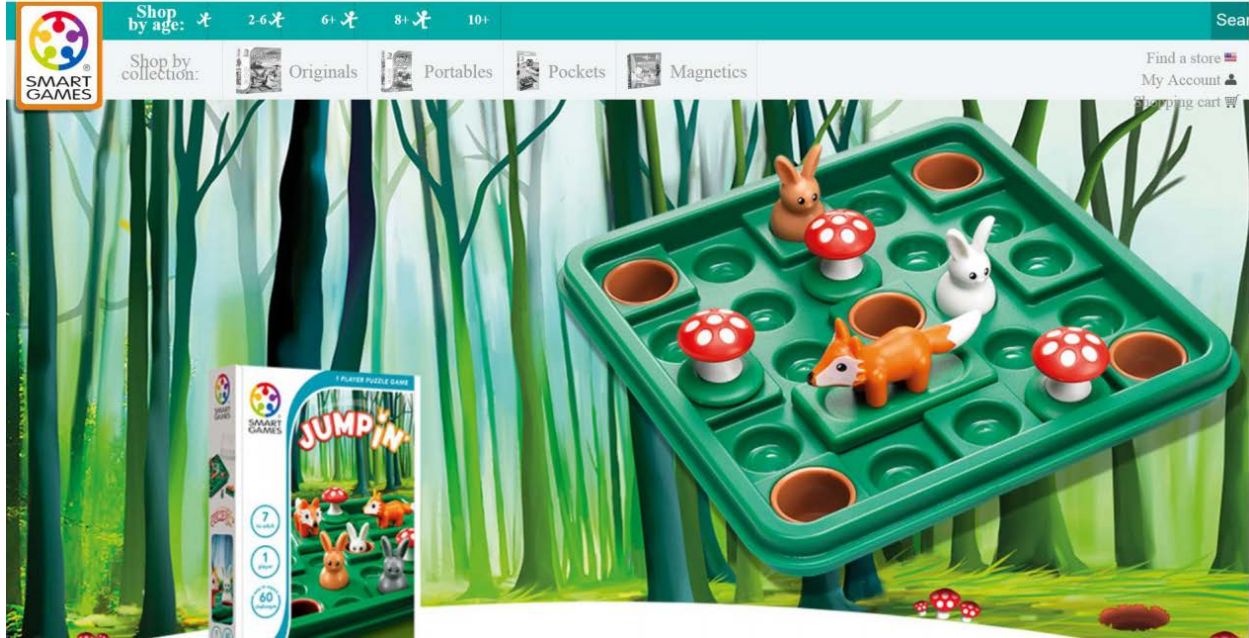
I. The Section 2(e)(1) Refusal

The Examiner has posited that the Mark is descriptive because of a supposed connection with "smart toys." In that regard, the argument is as follows: smart toys are "toys that listen and speak to your children, reading stories, asking them questions, and searching for information on the Internet. Some toys come equipped with cameras, microphones, and speakers so that the toys **can interact with the child.**" The Wikipedia article highlighted by the Examiner points out the difference between a "smart" toy (e.g., one containing electronic technology) and an educational toy that helps a child become "smart" or "creative":

"Smart toys are frequently confused with toys for which it is claimed that children who play with them become smarter. Examples are educational toys that may or may not provide on-board intelligence features."

This is precisely the type of toy that Applicant intends to use in U.S. commerce under the Mark. There are no electronic parts having a "smart" function.

The Examiner also cites Applicant's website where it is stated that "[Applicant] is the worldwide leader in multi-level logic games." The website does not state that Applicant is a leader in electronic games. Toward that end, the snapshot provided by the Examiner actually features a non-electronic logic game:



The word “Smart” in the English language is versatile as seen by the below dictionary definition for the word:

- 1) Making one smart: causing a sharp stinging;
- 2) Marked by often sharp, forceful activity or vigorous strength;
- 3) Brisk, spirited;
- 4)
 - (a) Mentally alert; bright;
 - (b) Knowledgeable;
 - (c) Shrewd;
- 5)
 - (a) Witty, clever;
 - (b) Rude or impolite in a bold and disrespectful way: pert;
- 6)
 - (a) Neat; trim;
 - (b) Stylish or elegant in dress or appearance;
 - (c)
 - (1) Appealing to sophisticated tastes;
 - (2) Characteristic of or patronized by fashionable society;
- 7)
 - (a) Being a guided missile;
 - (b) **Operating by automation**; and
 - (c) Using a built-in microprocessor for automatic operation, for processing of data, or for achieving greater versatility.

See <https://www.merriam-webster.com/dictionary/smart> (visited Nov. 23, 2019)(annexed hereto as Exhibit “A”). The Examiner argues that the 7th acceptable definition of the term is the operative term. Applicant, knowing its goods, counters that part of the 4th and 5th definitions for the term is the suggestion to the consumer: use these wooden toys and learn by your interaction with them.

Here, “the question of whether or not a particular designation is merely descriptive must be determined not in the abstract, but in relation to the goods and/or services for which registration is sought, the context in which the designation is being used on or in connection with said goods or services, and the possible significance that it would have, because of such manner of use, to the average purchaser of the goods or services.” See *In re Bright-Crest, Ltd.*, 204 U.S.P.Q. 591 (T.T.A.B. 1979). In that regard, “[w]hether consumers could guess what the product is from consideration of the mark alone is not the test.” *In re Amer. Greetings Corp.*, 226 U.S.P.Q. 365 (T.T.A.B. 1985). According to an article annexed to this response by Applicant, “[w]ooden toys are great for sparking a child’s creativity and imagination. Toys made of wood have been around since ancient times and continue to fascinate us today with their simplicity and elegance.” See Exhibit “B” (annexing article). Wooden toys—e.g., Applicant’s Goods herein—are not of the sort that the average purchaser would associate with electronics or automation. To prove that point, “**[i]nstead of the dictated play with plastic toys which make sounds and run on batteries, wooden toys are simple and help develop problem solving and fine motor skills [...] [i]nstead of thinking for the child and stifling the creativity and imagination with plastic toys.**” *Id.*

In determining the descriptiveness of a given term, Applicant contends that the holding in *In re Nett Designs, Inc.*, 236 F.3d 1339, 1341 (Fed. Cir. 2001) ought be applied to the instant analysis:

“In the complex world of etymology, connotation, syntax, and meaning, a term may possess elements of suggestiveness and descriptiveness at the same time. No clean boundaries separate these legal categories. Rather, a term may slide along the continuum between suggestiveness and descriptiveness depending on usage, context, and other factors that affect the relevant public’s perception of the term.”

Id. “These categories, like the tones in a spectrum, tends to blur at the edges and merge together. The labels are more advisory than definitional, more like guidelines than pigeonholes.” *Id.* (quoting *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786 (5th Cir. 1983)).

For these reasons, the edit to the identification proposed by the Examiner, “electronic learning toys made of wood” is not appropriate. It is not accurate and it “pigeonholes” the term SMART. As noted above, Applicant’s Goods lack any electronic or automated component. The average consumer would understand the connotation of the use of the term SMART in the Mark is suggestive: the user will find the wooden toy to be clever and intuitive. With that in mind, Applicant is prepared to narrow Applicant’s Goods as follows—should it be acceptable to the Examiner: “Toys made of wood, excluding those having electronic components.”

With the above-noted arguments being now considered, Applicant respectfully contends that allowance is in order.

II. Other Issues

The Examiner has also requested that a copy of the Section 44 basis, e.g., the Benelux registration for SMART WOOD be furnished – together with a translation of the same. The undersigned is informed that the Mark has registered in the Benelux Trademark Office. Applicant will provide a copy and translation of the same at the earliest possible juncture.