

RESPONSE TO OFFICE ACTION

The Office has issued an Office Action related to U.S. Application Ser. No. 97/178152 for the mark SMARTFLOW for “medical devices, namely, sequential compression and therapeutic systems consisting of controller, liners and tubing for the prevention of deep vein thrombosis” (“Applicant’s Mark”). The Office has refused registration of Applicant’s Mark on the ground that the mark is merely descriptive of Applicant’s goods. Applicant respectfully disagrees and urges the Office to reconsider its position in view of the following.

It is well settled that the Office bears the burden of showing that a mark is merely descriptive of the relevant goods or services. *See In re Remacle*, 66 U.S.P.Q.2d 1222, 1224 (TTAB 2002); *see also In re Crocker*, 223 U.S.P.Q. 152, 154 (TTAB 1984). The Board has also made it clear that in order for a mark to be considered merely descriptive, the term must describe goods or services *with particularity*. *See In re TMS Corp. of the Americas*, 200 U.S.P.Q. 57, 59 (TTAB 1978) (THE MONEY STORE held registrable; “falls short of describing [a]pplicant’s services in any one degree of particularity”); *Holiday Inns, Inc. v. Monolith Enterprises*, 213 U.S.P.Q. 949, 952 (TTAB 1981) (THE AMERICAN CAFE held registrable; “American” fails to “immediately tell a diner what to expect his or her dinner to be”). The primary test for determining whether a mark is merely descriptive is whether it *immediately* conveys to consumers a feature, characteristic or the nature of the applicant’s goods or services or whether consumers must use “imagination, thought or perception” to draw that conclusion. *J.S. Paluch Co. v. Irwin*, 215 U.S.P.Q. 533, 536 (TTAB 1982). Moreover, “if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive.” *In re Tennis in the Round Inc.*, 199 U.S.P.Q. 496, 498 (TTAB 1978).

A. The Nature of Applicant's Goods Is Not Immediately Apparent

The mark SMARTFLOW is not descriptive of Applicant's goods because it does not immediately convey to consumers meaningful information about the goods, specifically, "medical devices, namely, sequential compression and therapeutic systems consisting of controller, liners and tubing for the prevention of deep vein thrombosis." Applicant's Mark does not indicate to a potential customer the exact nature of the goods associated with the mark SMARTFLOW.

The Office cites a dictionary definition of the term "SMART-" as meaning "operating by automation" and notes that compression devices deal with flow of blood. However, the term "SMART" has several other meanings, including, for example, "using a built-in microprocessor," "marked by . . . vigorous strength," and "brisk." See <https://www.merriam-webster.com/dictionary/smart> (Exhibit A). When a word has multiple meanings, it does not "immediately convey" to a consumer a feature, characteristic or the nature of the applicant's goods in the descriptiveness analysis. See *In re Hutchinson Technology Incorporated*, 852 F.2d 552 (Fed. Cir. 1988) ("TECHNOLOGY," which is used to describe different types of goods, is not merely descriptive of "etched metal electronic components; flexible circuits; actuator bands for disk drives; print bands; increment discs; [and] flexible assemblies for disk drives."). With multiple possible definitions of SMART in the medical device space, the unique, coined term SMARTFLOW does not immediately convey a feature, characteristic, or the nature of the applicant's products here.

B. Applicant's Mark is in Fact Suggestive

Applicant urges that its mark is a classically suggestive mark. A term is suggestive if it "requires imagination, thought and perception to reach a conclusion as to the nature of goods."

Stix Products, Inc. v. United Merchants & Manufacturers, Inc., 160 U.S.P.Q. 777, 785 (S.D.N.Y. 1968); *In re Quick-Print v. the Copy Shop, Inc.*, 203 U.S.P.Q. 624 (T.T.A.B. 1979) (recognizing that if a mark “requires imagination, thought, perception, or mental gymnastics to arrive at a conclusion as to the nature of the goods or services asserted to be described by the mark, [then] the term is a suggestive one”). Similarly, imagination and thought are a prerequisite to making any connection between the mark SMARTFLOW and “medical devices, namely, sequential compression and therapeutic systems consisting of controller, liners and tubing for the prevention of deep vein thrombosis.”

The terms “SMART” and “FLOW” are common words with meanings that do not immediately relate to medical products for the prevention of deep vein thrombosis, such as those covered by Applicant’s Mark, and certainly do not combine to create a mark that would immediately bring to mind such products. Further, it is highly doubtful that consumers encountering Applicant’s Mark would immediately and without further thought conjure any type of medical device. If, as in the present case, some imagination, thought or perception is required on the part of the consumer to determine the nature of the goods or services offered in connection with the mark, such mark is suggestive and registrable. *See In re Box Solutions Corp.* 79 U.S.P.Q.2d 1953, 1954-55 (T.T.A.B. 2006).

C. The Office Routinely Approves Similar Marks for Publication on the Principal Register Without Issues Regarding Descriptiveness

Applicant also notes that the Office regularly approves marks containing SMART and FLOW in the medical device space without descriptiveness objections. In particular, the following marks cleared the examination process without objections based on descriptiveness or requiring any kind of disclaimer:

- AQUADEX SMARTFLOW (U.S. Reg. No. 6267810) for “medical devices for extracorporeal blood treatment, namely, filtration and ultra-filtration; blood filters used for extracorporeal blood treatment, disposable blood circuits used for extracorporeal blood treatment, blood pumps and blood pump controllers used for extracorporeal blood treatment,” owned by Nuwellis, Inc.;
- FLOWSMART (U.S. Reg. No. 5129401) for “a feature of subcutaneous infusion sets for use by diabetes patients in connection with insulin pumps” owned by Embecta Corp.
- SMART FLO (U.S. Reg. No. 5601778) for “dental instruments, namely, dispensing tips with brush heads used to apply dental materials and ampoule tips with brush heads used to apply dental material,” owned by Young Microbrush LLC;
- SMART PEAK FLOW (U.S. Reg. No. 5521741) for, inter alia, “software, namely, software for use in medical devices for monitoring respiratory diseases; computer software, namely, software for use in medical devices for monitoring respiratory diseases” owned by Smart Respiratory Products Limited;
- BD FLOWSMART (U.S. Reg. No. 5129400) for, “a feature of subcutaneous infusion sets for use by diabetes patients in connection with insulin pumps” owned by Becton, Dickinson and Company.

Copies of the registration certificates for these marks are attached as Exhibit B. Applicant’s Mark should be similarly treated, and the descriptiveness objection should be removed.

D. All Doubt Should be Resolved in Favor of Applicant

Finally, it is a well-established principle of U.S. trademark law that where the question of whether a mark is merely descriptive is a close one, the USPTO should resolve such doubt in the

applicant's favor and publish the mark for opposition. *See, e.g., In re Aid Labs., Inc.*, 221 U.S.P.Q. 1215, 1216 (T.T.A.B. 1983); *In re The Gracious Lady Service, Inc.*, 175 U.S.P.Q. 380, 382 (T.T.A.B. 1972); *In re Intelligent Medical Systems Inc.*, 5 U.S.P.Q.2d at 1676 ("It is the Board's practice to resolve the doubt in applicant's favor..."). Thus, to the extent that there are doubts as to the alleged descriptive nature of Applicant's Mark, such doubts should be resolved in Applicant's favor.

E. Conclusion

In view of the foregoing, Applicant respectfully requests that the Office withdraw its 2(e)(1) refusal.