

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

SambaNova Systems, Inc.,
Applicant.

Serial No.: 88/293,967
Filed: February 8, 2019
Mark: YOUR AI

RESPONSE TO OFFICE ACTION

Applicant SambaNova Systems, Inc. (“Applicant”) respectfully submits this response to the Office Action issued on July 6, 2019 for the mark YOUR AI, Serial No. 88/293,967, filed on February 8, 2019 (“Applicant’s Mark”). For the reasons stated below, Applicant requests that the refusal be withdrawn.

Applicant’s Mark Is Not Merely Descriptive

Applicant respectfully asks the examining attorney to reconsider and withdraw the descriptiveness refusal because Applicant’s Mark is not descriptive, but instead is suggestive of Applicant’s services.

It is acceptable for a mark to have *some* meaning that relates to the services, as long as the mark does not merely describe them. Such a mark is properly classified as suggestive and is registrable:

Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought or perception to reach a conclusion as to the nature of the goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services. ... Suggestive marks, like fanciful and arbitrary marks, are registrable on the Principal Register without proof of secondary meaning. ***Therefore, a designation does not have to be devoid of all meaning in relation to the goods/services to be registrable.***

TMEP § 1209.01(a) (emphasis added, internal citations omitted). Here, one would need to apply imagination to connect Applicant’s Mark and relevant services. A consumer would need to somehow deduce that the phrase “YOUR AI” refers to the development of computer software and hardware. Although the services to be offered by Applicant under Applicant’s Mark relate to artificial intelligence (as well as general computing), Applicant’s Mark does not describe the actual services offered, namely, “Computer software and hardware development in the field of artificial intelligence and general computing,” as listed in the Application.

For Applicant's Mark to be descriptive, the words "YOUR AI" would have to describe the services, but they do not do that. Instead, Applicant's Mark is suggestive of the listed services, requiring an imaginative leap to conclude that Applicant's Mark refers to the development of software and hardware. The services are not "artificial intelligence" but instead are the development of computer software and hardware. This distinction requires a consumer to make a leap from artificial intelligence to computer development. It is this required leap that makes Applicant's Mark suggestive and registrable on the Principal Register.

Indeed, the mere use of the word "AI" in a mark does not make a mark descriptive because the word "AI" by itself can relate to any other number of goods and services. For example, the mark AIWORLD, Reg. No. 5155884, was registered in the Principal Register under class 41 for educational services relating to AI. Thus, the fact that Applicant's Mark contains the word "AI" does not mean that the mark is descriptive of computer software and hardware development. Applicant's Mark could as easily refer to educational services, business services, t-shirts, or any number of other goods and services. Thus, the use of the word "AI" for Applicant's services is not descriptive, but is instead suggestive.

For these reasons, Applicant respectfully requests that the descriptiveness refusal be withdrawn and that the mark be approved for publication.