

Applicant's Response to Office Action

US 88482584 for Applicant VOLTU MOTOR INC.

SUMMARY OF ISSUES:

The Office Action of September 20, 2019 raises the following issues, which will be addressed herein:

- **Prior-Pending Advisory**
- **Section 2(e)(1) Refusal**

PRIOR-PENDING APPLICATION ADVISORY

In the Office Action of September 20, 2019, the Examiner issues a preliminary rejection based on US TM Application Serial Number 86,751,745 (the '745 application). However, according to USPTO records (exhibit 1), the '745 application went abandoned on October 28, 2019 for failure to submit a Statement of Use or request an Extension of time. As the '745 application has been abandoned, Applicant respectfully submits that this preliminary rejection is rendered moot and should not block the Applicant's registration of this mark. Therefore, withdrawal of this preliminary rejection is respectfully requested.

SECTION 2(E)(1) REFUSAL

I. INTRODUCTION

In the September 20, 2019 Office Action, the Examining Attorney refused registration of Applicant's mark, BLOCK ("Applicant's Mark"), under 15 U.S.C. § 1052(e)(1) on the grounds that the mark merely describes Applicant's goods. For the following reasons, Applicant respectfully submits that Applicant's Mark is not merely descriptive, and requests that the refusal be withdrawn.

II. ARGUMENTS - DESCRIPTIVENESS

A. Applicant's Mark is Merely Suggestive of Applicant's Goods

The Examining Attorney stated in the September 20 Office Action that Applicant's Mark is merely descriptive of Applicant's goods. Applicant respectfully disagrees with this finding because the word "BLOCK" does not describe Applicant's products ("electrical converters; electrical inverters; electrical transformers; electric capacitors; electric batteries for vehicles; electrical accumulators for vehicles; electric batteries for energy storage; electrical accumulators for energy storage; battery chargers"). Consumers do not use the word "BLOCK" to describe products, nor does the word "products" have any meaning or significance in the industry of electrical converters, electrical inverters, electrical transformers, electric capacitors, electric batteries for vehicles, electrical accumulators for vehicles, electric batteries for energy storage, electrical accumulators for energy storage, battery chargers.

Moreover, the word "BLOCK" is not required by competitors to describe or identify products or any features or characteristics related to the products of the Applicant ("electrical converters, electrical inverters, electrical transformers, electric capacitors, electric batteries for

vehicles, electrical accumulators for vehicles, electric batteries for energy storage, electrical accumulators for energy storage, battery chargers”).

Applicant notes that the Examiner asserts that the word “BLOCK” refers to “engine blocks” and thus asserts that Applicant’s use describes a characteristic of the products (e.g., that they are intended to be used with the engine block of a car. For the reasons, discussed below, Applicant respectfully submits that this argument mischaracterizes the required standards for demonstrating descriptiveness of an applied for mark.

Indeed, Applicant respectfully submits that the cases cited by the Examining Attorney does not support a finding of descriptiveness in this case. In *In re Polo Int’l Inc.*, the term “DOC” in “DOC-CONTROL” was found to be descriptive of Documents managed by the Applicant’s software. In that case, such a finding was appropriate because the term “DOC” was widely associated with software products with limited meaning apart from the identified goods and plainly reflected a significant feature of the mark. Similarly, in *In re Digital Research Inc.* the TTAB found that the terms “CONCURRENT PC-DOS” and “CONCURRENT DOS” were merely descriptive of “computer programs recorded on disk”. Again, such a finding was appropriate because the terms “CONCURRENT PC-DOS” and “CONCURRENT DOS” are widely associated with software products with limited meaning apart from the identified goods and plainly reflected significant features of the mark. In other words, the allegedly descriptive terms had little meaning apart from the goods and thus are primarily descriptive of features of the identified goods.

Conversely, the allegedly descriptive term of the present registration (e.g., “BLOCK”) have significant meaning outside of Applicant’s products and thus are not immediately associated with features of the identified goods. Applicant respectfully submits that as there could be multiple different meanings for the term, the term itself does not immediately describe features of the identified goods. For example, the term “BLOCK” does not immediately describe electrical converters, electrical inverters, electrical transformers, electric capacitors, electric batteries for vehicles, electrical accumulators for vehicles, electric batteries for energy storage, electrical accumulators for energy storage, battery chargers, because BLOCK can indicate construction components, or other building materials, possibly interlocking components that build a product or component (e.g., building blocks). BLOCK can also indicate something the protects or impairs access (e.g., a blocking component).

Instead, Applicant respectfully submits that its mark is, at most, suggestive. A mark is suggestive if, when the goods or services are encountered in connection with the mark, a multi-stage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See, e.g., *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1349 (TTAB 1984).

Applicant's Mark is at most merely suggestive because it involves the required level of imagination to determine the nature of the goods. Consumers first must identify the mark ("BLOCK"), then the goods ("electrical converters, electrical inverters, electrical transformers, electric capacitors, electric batteries for vehicles, electrical accumulators for vehicles, electric batteries for energy storage, electrical accumulators for energy storage, battery chargers"), and then try to imagine a connection between the two. Here, consumers could imagine multiple different connections because the word “BLOCK” has multiple possible meanings as discussed

above. "BLOCK" could suggest interlocking or building aspects of a product. "BLOCK" could also suggest shielding or blocking aspects of a product. Even as the Examiner's suggests, consumers may imagine an engine block. In any case, the consumer would then have to make additional imaginative or mental leaps to get to the Applicant's product.

However, because this thought process requires "imagination, thought and perception to reach a conclusion as to the nature of the [goods]," *Stix Prod. Inc.*, 295 F. Supp. at 488, and "the mental leap between the word and the [good] attributes is not almost instantaneous," *In re Tennis in the Round*, 199 USPQ at 498, the mark is at most suggestive, not descriptive. Indeed, the analysis the Examiner provides ("BLOCK" suggesting an Engine block and the Applicants products may be used with an Engine block), clearly demonstrates multiple mental leaps to get from the applied for mark to the Applicant's products, thereby showing the mark to be at most suggested and not descriptive.

Moreover, a designation does not need to be devoid of all meaning in relation to the goods or services to be registerable. T.M.E.P. Section 1209.01(a). In this case, the use of a term "BLOCK" simply serves as inspiration for a branding strategy.

As already noted above, the word "BLOCK" does not describe anything about the products themselves or their features, other than merely to suggest a connection to aspects the products may have in general. Thus, for all of the reasons discussed above, Applicant respectfully submits that the mark is not descriptive of the identified goods, but is instead suggestive.

CONCLUSION

Applicant respectfully requests that the Examining Attorney withdraw the refusal to register. The Examining Attorney is invited to contact the undersigned at (650) 645-9012 if further discussion is warranted.

Respectfully submitted,

/Michael C. Jones/

California bar member

Attorney of Record