

## ARGUMENT

Applicant has amended the identification of goods to now read: "Computing systems used in cooling immersion environments for high speed computing comprised of data centers with modular servers and enclosures for same." The Examiner initially refused registration contending that the mark HYDROBLADE (the "Mark") was merely descriptive of the goods identified in Applicant's response to the first office action, which were "Immersion cooling system and parts for immersion cooling of computer components." Applicant requests that the Examiner reconsider his decision to issue a Section 2(e) refusal and approve the application for registration.

It is settled that "[w]hether a given mark is suggestive or merely descriptive depends on whether the mark '*immediately conveys . . . knowledge of the ingredients, qualities, or characteristics of the goods . . . with which it is used*', or whether '*imagination, thought, or perception is required to reach a conclusion on the nature of the goods.*'" *In re Gyulay*, 820 F.2d 1216, 1217 (Fed. Cir. 1987); *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 525, 205 U.S.P.Q. (BNA) 505, 507 (C.C.P.A. 1980). The commercial impression cannot be a time consuming, tenuous, or pensive connection -- it must be immediate.

The PTO has made it clear that the concept of mere descriptiveness "should not penalize coinage of hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and 'mental pause.'" T.M.E.P. § 1209.01(a). If imagination, thought or perception is required to reach a conclusion on the nature of the goods or services, the mark is suggestive and registrable.

*See In re Nett Designs*, 236 F.3d 1339, 57 U.S.P.Q.2d 1564 (Fed. Cir. 2001); *In re Gyulay*, *supra*; *In re Tennis in the Round, Inc.* , 199 USPQ 496, 498 (TTAB 1978)( “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 Shutts* , 217 USPQ 363, 364-365 (TTAB 1983) (SNO-RAKE not merely descriptive for snow removal hand tool); *In re Universal Water Systems, Inc.* , 209 USPQ 165, 166 (TTAB 1980). Further, “a designation does not have to be devoid of all meaning in relation to the goods and services to be registrable.” T.M.E.P. § 1209.01(a).

Applicant believes that the Mark is suggestive and can be registered because it does not *immediately* convey knowledge of the qualities or characteristics of Applicant’s goods. The Examiner engaged in a multi-step reasoning process in order to find descriptiveness, reading the words “hydro” and “blade” too broadly to make a tenuous connection between one possible characteristic of applicant’s goods and obscure definitions of the words “hydro” and “blade.” The terms “hydro” and “blade” each have multiple meanings. The Examiner found that the term “hydro” could mean “containing hydrogen,” but that is based on an obscure definition and is not the commonly understood meaning of “hydro.”

Adopting the Examiner’s formulation would lead to an absurd result since hydrogen, being the most common element in the universe, is a part of almost everything. Under that reasoning, the PTO would never register a mark that contained the word “hydro” under Section 2(e). Since virtually all goods contain hydrogen, “hydro” would

always be descriptive. Of course, such a reading is impractical and not legally pertinent since there are over 4000 applications and registrations for marks that contain “hydro.”

It is more likely that, based on more commonly understood meanings, HYDROBLADE would be perceived to refer to a water ski, ice skates, windshield wipers, or shaving razors. In fact, there are many possible interpretations of the term HYDROBLADE, and it is clear from the Examiner’s own reasoning that the term does *not* have a *primary* significance that is descriptive in relation to its goods, and, therefore, the term is not merely descriptive.

The Court of Appeals for the Federal Circuit has observed:

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.

*In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Where the border between finding a mark merely descriptive or suggestive is ambiguous, the doubt should be resolved in the Applicant’s favor. After all, “any person who believes that he would be damaged by the registration will have an opportunity . . . to oppose the registration of the mark and to present evidence. . . .” *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565, 565 (T.T.A.B.1972). *See also In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1571 (Fed. Cir. 1987) (the Board should “balance the evidence of public understanding of the mark against the degree of descriptiveness encumbering the mark, and to resolve reasonable doubt in favor of the applicant, in accordance with

practice and precedent.”); *In re Application of Aid Labs, Inc.*, 221 U.S.P.Q. 1215, 1216 (T.T.A.B. 1983) (“Where there is doubt on the matter, the doubt should be resolved in applicant’s behalf and the mark should be published . . . for purposes of opposition.”); *In re Entenmann’s Inc.*, 15 U.S.P.Q.2d 1750, 1751 n.2 (T.T.A.B. 1990) (affirming decision under Section 2(e)(1) but recognizing “that in ex parte cases involving a refusal to register on the basis of mere descriptiveness, it is the practice of this Board to resolve doubts in the favor of the applicant and pass the mark to publication”).

The mark at issue is suggestive without being specific or immediately telling consumers anything with a degree of particularity. The information, if any, given by the mark is indirect and vague. The thought process beginning with the mark HYDROBLADE and leading to a characteristic or feature of Applicant’s goods is neither immediate nor direct. The degree of descriptiveness encumbering Applicant’s mark is slight when compared to its function as a unique source identifier. Ultimately, any ambiguity should be resolved in Applicant’s favor.

#### CONCLUSION

For the reasons set forth above, Applicant respectfully requests that the Examiner’s refusal to register based upon Section 2(e) of the Trademark Act be reversed.