

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Trademark Application of:  Applicant: Ventiva, Inc. Serial No. 88770123 Filed: January 22, 2020 Mark: ICE Docket No. VT-08	Trademark Law Office No.: 123 Examining Attorney: Sarah Hopkins
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Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

**RESPONSE**

Dear Examiner:

In the Office Action dated April 16, 2020, the Trademark Examining Attorney (“Examiner”) issued a refusal for the following reasons:

- Amendment of the Identification of Goods Required
- Section 2(d) Refusal – Likelihood of Confusion
- Specimen Refusal
- Clarification of the Number of Classes for Which Registration is Sought

Applicant respectfully requests reconsideration of the Examiner’s objection in view of the following remarks and submissions.

**REMARKS**

**1. AMENDMENTS OF THE IDENTIFICATION OF GOODS REQUIRED (AND CLARIFICATION OF NUMBER OF CLASSES)**

Applicant filed this Application under International Class 9. The Examiner suggested that goods could be related to both Class 9 and Class 11. Applicant is restricting the goods only to those in Class 9. In particular the Examiner suggested the following:

solid-state electronic components, *namely, {indicate the specific type, e.g., drives}*;

solid-state electronic components for cooling systems, *namely, {indicate the specific type e.g., drives}*;

electro-hydrodynamic cooling systems *being cooling pads for { indicate goods, e.g. computers, notebooks}*;

electro-hydrodynamic cooling systems using a forced convective gaseous flow *being cooling pads for {indicate goods, e.g. computers, notebooks}*;

ionic cooling systems, *namely, cooling pads for {indicate goods, e.g. computers, notebooks}*;

ionic cooling systems using a forced convective gaseous flow, *namely, cooling pads for {indicate goods, e.g. computers, notebooks}*;

electronic components in the nature of cooling systems, *namely cooling pads for {indicate goods, e.g. computers, notebooks}*;

electronic components in the nature of cooling systems *being cooling pads for {indicate goods, e.g. computers, notebooks}*

Applicant has adopted most of the suggested goods and presents the amended goods as follows with respect to the original list of goods:

~~solid state electronic components;~~

~~solid state~~ electronic components for solid state cooling systems, namely, cooling for

wireless charging pads, laptops, tablets, televisions, smart phones, VR headsets, and other small consumer electronic devices;

electro-hydrodynamic cooling systems;

electro-hydrodynamic cooling systems using a forced convective gaseous flow being solid state cooling fans for wireless charging pads, laptops, tablets, televisions, smart phones, VR headsets, and other small consumer electronic devices;

~~ionic cooling systems;~~

ionic cooling systems using a forced convective gaseous flow, namely, solid state cooling fans for wireless charging pads, laptops, tablets, televisions, smart phones, VR headsets, and other small consumer electronic devices;

electronic components in the nature of cooling systems being solid state cooling fans for wireless charging pads, laptops, tablets, televisions, smart phones, VR headsets, and other small consumer electronic devices

All goods have been narrowed and not expanded.

## **2. LIKELIHOOD OF CONFUSION**

The Examiner has refused registration of the mark under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because Applicant's mark, when used on or in connection with the identified goods and services, so resembles the mark in U.S. Registration Nos. 3123077 (ICE) and 4569686 (GT ICE JUST COOLER) as to be likely to cause confusion.

The Examiner cites *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) for the proposition that the Examining Attorney must compare the marks for

similarities in sound, appearance, meaning, connotation or commercial impression. Similarity of the marks, and the relatedness of the compared goods and/or services are generally considered to be the most important. Without admission that the marks were confusingly similar without amending the goods, Applicant has amended the goods (as presented above) and believes that in view of these amendments there would be even less consumer confusion between Registrants' goods and Applicant's goods because the goods are now related to only to goods using "solid state" technology, and in particular cooling small electronic devices using "solid state" technology.

*Confusion with the Mark "ICE"*

Applicant acknowledges that the mark is identical to Reg. No. 3123077 (ICE) but no likelihood of confusion, mistake or deceit would occur since Applicant's goods and Registrant's goods are in totally unrelated channels of trade. Registrant's goods are found in trade channels related to "Electronic products, namely a filter set to be used with power conditioners for the filtering of electrical noise from an AC power source."<sup>1</sup> (Emphasis added). (See Exhibit A for the definition of "power conditioners.") In other words, Registrant's goods are related to a particular subset of electrical products, those related to electrical noise reduction from power sources. Applicant's good are related to cooling systems for solid state devices.

Case law is replete with examples of similar or even identical marks that have been held not to be confusingly similar, even when applied to similarly related or even identical goods or services. Courts have also found no likelihood of confusion for much more closely related goods

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<sup>1</sup> "Power conditioners" are not related to "air conditioners," and are not related to cooling systems at all. Power conditioners protect against voltage spikes and acts a buffer between an outlet and a system. (See <https://www.techopedia.com/definition/1750/power-conditioner>)

using an identical mark where the channels of trade were found to be only slightly different and even overlapping. See, *Sunenblick v. Harrell*, 895 F. Supp. 616, 629 (SDNY 1995). In *Sunenblick*, Plaintiff and Defendant used the mark “UPTOWN” for musical recordings. The court stated “[Plaintiff’s] products are addressed to a somewhat esoteric market, viz., purchasers interested in lost or forgotten jazz artists, in the ‘straight ahead jazz’ category, whereas defendants sell rap recordings...[T]hey are not sold side-by-side; rather, they are featured in different sections of the stores..., according to genre and not by label name.” The two record companies used the identical mark to sell records to the same retail customers in different sections of the same store. By comparison, there should be less likelihood that purchasers of Registrant’s goods for power conditioner electrical noise filtration goods, and purchasers of Applicant’s goods for cooling devices for solid state devices, would be confused as to whether the sources of goods are the same.

In our instant application, Registrant’s goods are limited to a select group of purchasers, namely, namely sophisticated engineers interested in electrical noise filtration. On the other, hand, Applicant’s purchasers are companies that wish to include components inside of their consumer goods to cool the inner electrical components in the consumer goods using solid state technology. (See Exhibit B for the definition of solid state technology). Accordingly, the channels of trade are markedly separate. A person seeking out Registrant’s goods would not encounter Applicant’s goods for cooling of solid-state electronic products.

*Comparison of the Mark “GT ICE JUST COOLER”*

With respect to the second registration cited, Reg. No. 4,569,686 (GT ICE JUST COOLER), Registrant’s mark is a logo and consists of “a letter G with gradient of hot to cool

colors in yellow, orange, red, purple and light blue into an arrow shape. The letter T and ICE are in a rounded font in the color light blue. The wording JUST COOLER is in block capital letters in dark blue underneath the wording GT ICE.” Applicant only uses a single word “ICE,” which only is a small part of the entirety of Registrant’s four-word color logo (shown below).



Aside from the differences in the marks, and even if Applicant’s mark were identical to Registrant’s mark, the marks would not be confusingly similar because Registrant’s goods are not the same trade channels as Applicant’s goods.

Registrant and Applicant would not be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. See *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). TMEP §1207.01(a)(i). Registrant’s goods are related to air filters and air conditioning for “industrial installations.” Consumers for these types of goods are interested having the products cool things outside of the products themselves, such as an air conditioner’s use for cooling individuals in a building.

In contrast, Applicant's goods are not for cooling things outside of the goods, but for cooling in inner components of small consumer electronics products (using solid state technology, as addressed above), in order to prevent overheating of electrical components. The purchasers of Applicant's goods would be sophisticated electronics companies interested in having safer and longer lasting products by incorporating Applicant's particular products for cooling solid state devices.

As discussed in the previous section, case law for allowing similar, or even identical marks is routinely allowed if the trade channels are found to be only slightly different, and even overlapping. Here, there is not even any overlapping of the channels of trade at all, as the types of goods are vastly unrelated and not likely to be sold in conjunction with one another.

Due to the foregoing, Applicant asserts that its mark ICE is not likely to be confused with Registration Nos. 3,123,077 or 4,569,686 and urges that Applicant's mark be allowed and pass to publication.

### **3. SPECIMEN REFUSAL**

The Examiner refused the specimen because it did not show the mark associated with Applicant's goods that is separate from the word "Ventiva," and does not show sufficient means for ordering the goods. Applicant concurrently is submitting new specimens that are in accordance with specimen rules, showing the mark ICE on the product, separate from the word "Ventiva."

### **CONCLUSION**

It is believed that this application is now in condition for passage to publication, notice

whereof is hereby solicited.

Respectfully Submitted,

Dated: August 8, 2020

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**Exhibits:**

Exhibit A: Definition of Power Conditioners,  
<https://www.techopedia.com/definition/1750/power-conditioner> (last visited  
August 7, 2020).

Exhibit B: Definition of Solid-State Technology,  
<https://www.phononic.com/resources/reference-guide/solid-state> (last visited  
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**Exhibit A**

Definition of Power Conditioners

<https://www.techopedia.com/definition/1750/power-conditioner>

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# Power Conditioner

Last Updated: December 28, 2016



## Definition - What does *Power Conditioner* mean?

A power conditioner is an electrical component designed to improve the quality of power supplied to a computer component by supplying voltage at the level that allows that component to operate properly. Although technically there is no single correct definition for a power conditioner, it is often associated with a voltage regulator, which improves the quality of power through transient impulse protection, power factor correction or noise suppression.

A power conditioner has the ability to regulate and clean AC power by delivering dynamic power adjustments and removing spikes, surges, noise, sags and frequency irregularities, which may damage or adversely affect the performance of any equipment load.

Power conditioning is recognized by the IEEE, NEMA and other standards. Power conditioners are used by both individual users and large corporations.

A power conditioner may also be known as a power line conditioner or a line conditioner.



## Techopedia explains *Power Conditioner*

Two of the various types of power conditioners are alternating current (AC) power conditioners and power line conditioners. AC power conditioners deliver clean AC power to their dedicated electrical gear. These have 10 or more outlets or repositories for surge protection and noise filtering, and are often found in homes and offices. Power line conditioners absorb and modify power and should be designed for the needs of specific components. During power storms or other main power line failures when voltage spikes are prevalent, surge protection shuts off the power source to protect electronic equipment.

Well-designed power conditioners include internal filter banks. This feature removes cross-talk between devices.

Power conditioners vary in size and features. Some supply nominal voltage regulations, while others provide protection against an array of power quality issues. A small device may fit on a printed circuit board, while a large device could safeguard a manufacturing plant.

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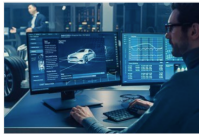
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**Synonyms:**

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**Exhibit B**

Definition of Solid-State Technology

<https://techterms.com/definition/solidstate>

(last visited August 7, 2020)

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Solid State Definition

# Solid State

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Solid state, at its most basic level, means "no moving parts." Therefore, solid state electronic devices are made up of solid components that do not move. Some examples include computer motherboards and integrated circuits. Devices that use only solid state parts, such as television sets, speakers, and digital watches, are often referred to as solid state products.

Flash memory devices are solid state products, while hard drives are not. This is because hard drives use a spinning disk and moving drive head to read and write data, while flash memory uses electric charges to perform the same functions. For this reason, flash memory devices are seen as more durable than hard drives. This is why flash memory is often used in products such as portable MP3 players and digital cameras.

Because solid state devices have no moving parts, they are less likely to break down than devices that have mobile mechanisms. For this reason, it is often more worthwhile to buy an extended warranty on electronics that have moving parts than those that do not. That is something you may want to think about next time you are shopping.

<https://techterms.com/definition/solidstate>