

PTO Form 1957 (Rev 9/2005)

OMB No. 0651-0050 (Exp. 04/2008)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78754685
LAW OFFICE ASSIGNED	LAW OFFICE 104
MARK SECTION (no change)	
ARGUMENT(S)	
<p>REQUEST FOR RECONSIDERATION</p> <p>Applicant is seeking to register "SILENCER" for "internal cooling fans for computers, power supplies, and voltage stabilizing power supplies".</p> <p>Registration of "SILENCER" as to "internal cooling fans for computers" has been refused under Trademark Act Section 2(e)(1) as being merely descriptive of a characteristic of the goods.</p> <p>Applicant respectfully disagrees with this assessment with respect to these goods and asserts that the "SILENCER" mark is not merely descriptive for "internal cooling fans for computers."</p> <p>Looking first at the definition of SILENCER:</p> <p>Miriam Webster's Collegiate Dictionary, tenth edition, Springfield, Massachusetts, USA, 1996, defines "silencer" as "one that silences"; "a muffler for an internal combustion engine"; "a silencing device for small arms".</p> <p>DICTIONARY.COM (First Office Action, email attachments SR-1 & SR-2) defines "silencer" as "one that silences, especially a device attached to a firearm to muffle the sound of firing"; "a short tube attached to the muzzle of a gun that deadens the sound of firing"; "a tubular acoustic device inserted in the exhaust system that is designed to reduce noise".</p> <p>DICTIONARY.COM (Second Office Action Attachment "defsilen-1" through "defsilen-3") defines "silencer" as "a person or thing that silences", "a device for deadening the report of a firearm"; "the muffler for an internal combustion engine".</p> <p>Thus, by definition, a "silencer" is a device added to a noise producer, such as a gun or internal combustion engine, to muffle or to decrease the sound emitted by the noise-producer. Thus, one can add a silencer to the barrel of a gun to reduce the noise of the blast, to the exhaust system of an automobile to reduce the exhaust noise.</p>	

Applicant's use of SILENCER on computer fans is suggestive of a silencer on a gun or car in that it is generally thought desirable to have a quieter computer. However, applicant's fans are not silencers and do not function at all as a silencer because they are not added to a noise producer to muffle the noise of the noise producer, but, rather, applicant's fans are added for their cooling effect and they produce noise and add to the overall noise of whatever they are added to.

The evidence provided in the First and Second Office Actions fall into two categories: first, "silencer" is used in a descriptive sense to describe silencers; and, second, in one instance, "silencer" is used by, what applicant considers an infringer of its trademark rights.

"Silencer" is used in the descriptive sense in First Office Action Attachment "silen" for "fan silencers". These are indeed "fan silencers"; that is they are attached to a fan to muffle the noise of the fan. "Silencer" is not used to name or describe a fan.

"Silencer" is used in the descriptive sense in First Office Action Attachments "silencer-1"- "silencer-3" for "rubber fan silencer". These too are "fan silencers"; that is they are added to a fan to muffle the noise of a fan. "Silencer" is not used to name or describe a fan.

"Silencer" is used in the descriptive sense in Second Office Action Attachments "sil-1"- "sil-2" for "aluminum hard drive silencer". This is a "silencer" for a hard drive; that is it is added to a hard drive to muffle the noise of the hard drive. There is no fan. "Silencer" is not used to name or describe a fan.

"Silencer" is used in the descriptive sense in Second Office Action Attachments "s-1"- "s-5" for a "'silencer' power connector" for a fan. This power connector is a silencer in that it is added to silence the electronic noise to the fan. "Silencer" is not used to name or describe a fan.

Of course, anyone may market such an add-on device that muffles the sound and call it a silencer, which it is. However, the fact that a feature of the good is that the good is quiet does not preclude the use of SILENCER as a trademark on the good as a whole. For example, the trademark SILENCER should be registrable for an automobile (e.g. the FORD SILENCER). Or SILENCER for an electric car. That is because the goods themselves are not a silencer. The goods are not added to something to silence it.

And when one is buying applicant's 99mm "SILENCER" one is not buying a silencer to quiet another good, rather one is buying a fan for cooling the other good. Applicant's fans are not silencers because they are not added to silence the computer, they are added to cool the computers.

"Silencer" is used in a trademark sense in Second Office Action Attachments "arcticsil-1"- "arcticsil-2" for Arctic Cooling Company's "SILENCER NV5 video card" for a computer. The card includes a fan. Applicant considers this use an infringement of its trademark rights and is planning appropriate action. Such trademark use by an infringer does not support a finding of descriptiveness.

Thus, the evidence does not show that the term "silencer" is commonly used in conjunction with fans to describe fans. Fans are not silencers.

In view of the remarks, it is seen that applicant's SILENCER mark is inherently distinctive of applicants goods, and it is requested that the refusal be withdrawn and allowance be granted with respect to all of the goods for which registration is sought.

In the alternative of a finding that the mark is inherently distinctive, applicant requests the application be amended with regard to the goods "internal cooling fans for computers" to a Section 2 (f) application.

Applicant of owner of U.S. Trademark Registration 1,778,764 for SILENCER (stylized) for "power supplies for personal computers" registered in 1993 with a first claimed use in 1985. This substantially the same mark on related goods. Applicant's SILENCER mark has become distinctive of the goods as evidenced by this registration on the Principal Register for the substantially the same mark on closely related goods.

Attached is a DECLARATION INCLUDING SECTION 2(f) CLAIM wherein applicant declares that the mark has become distinctive through applicant's substantially exclusive and continuous use in commerce for at least five years.

Applicant has been selling fans bearing the SILENCER mark since 1985 and, according to the attached 2(f) DECLARATION, has sold "at least as many as 500,000 'internal cooling fans for computers' bearing the mark".

In view of the evidence and remarks, it is seen that applicant's SILENCER mark has become distinctive in commerce for "internal cooling fans for computers" and is entitled thereby to registration on the Principal Register and such registration is requested.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	\\TICRS2\EXPORT13\787\546\78754685\xml1 \ROA0002.JPG
DESCRIPTION OF EVIDENCE FILE	Section 2(f) Declaration

GOODS AND/OR SERVICES SECTION (current)

INTERNATIONAL CLASS	009
DESCRIPTION	Central processing unit (CPU) fans; Internal cooling fans for computers; Power supplies ; Voltage stabilizing power supply
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 05/21/1985
FIRST USE IN COMMERCE DATE	At least as early as 05/21/1985

GOODS AND/OR SERVICES SECTION (proposed)

INTERNATIONAL CLASS	009
DESCRIPTION	Internal cooling fans for computers; Power supplies ; Voltage stabilizing power supply
FILING BASIS	Section 1(a)

FIRST USE ANYWHERE DATE	At least as early as 05/21/1985
FIRST USE IN COMMERCE DATE	At least as early as 05/21/1985
SIGNATURE SECTION	
DECLARATION SIGNATURE	/califtervo/
SIGNATORY'S NAME	Calif Tervo
SIGNATORY'S POSITION	Attorney of Record
DATE SIGNED	06/11/2007
RESPONSE SIGNATURE	/califtervo/
SIGNATORY'S NAME	Calif Tervo
SIGNATORY'S POSITION	Attorney of Record
DATE SIGNED	06/11/2007
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Jun 11 17:40:28 EDT 2007
TEAS STAMP	USPTO/ROA-24.165.13.133-2 0070611174028331216-78754 685-370bb8a36efe459159231 022928e0f155-N/A-N/A-2007 0611171126827936

PTO Form 1957 (Rev 9/2005)

OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **78754685** has been amended as follows:

Argument(s)

In response to the substantive refusal(s), please note the following:

REQUEST FOR RECONSIDERATION

Applicant is seeking to register "SILENCER" for "internal cooling fans for computers, power supplies, and voltage stabilizing power supplies".

Registration of "SILENCER" as to "internal cooling fans for computers" has been refused under Trademark Act Section 2(e)(1) as being merely descriptive of a characteristic of the goods.

Applicant respectfully disagrees with this assessment with respect to these goods and asserts that the "SILENCER" mark is not merely descriptive for "internal cooling fans for computers."

Looking first at the definition of SILENCER:

Miriam Webster's Collegiate Dictionary, tenth edition, Springfield, Massachusetts, USA, 1996, defines "silencer" as "one that silences"; "a muffler for an internal combustion engine"; "a silencing device for small arms".

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Applicant's use of SILENCER on computer fans is suggestive of a silencer on a gun or car in that it is generally thought desirable to have a quieter computer. However, applicant's fans are not silencers and do not function at all as a silencer because they are not added to a noise producer to muffle the noise of the noise producer, but, rather, applicant's fans are added for their cooling effect and they produce noise and add to the overall noise of whatever they are added to.

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Thus, the evidence does not show that the term "silencer" is commonly used in conjunction with fans to describe fans. Fans are not silencers.

In view of the remarks, it is seen that applicant's SILENCER mark is inherently distinctive of applicants goods, and it is requested that the refusal be withdrawn and allowance be granted with respect to all of the goods for which registration is sought.

In the alternative of a finding that the mark is inherently distinctive, applicant requests the application be amended with regard to the goods "internal cooling fans for computers" to a Section 2(f) application.

Applicant of owner of U.S. Trademark Registration 1,778,764 for SILENCER (stylized) for "power supplies for personal computers" registered in 1993 with a first claimed use in 1985. This substantially the same mark on related goods. Applicant's SILENCER mark has become distinctive of the goods as evidenced by this registration on the Principal Register for the substantially the same mark on closely related goods.

Attached is a DECLARATION INCLUDING SECTION 2(f) CLAIM wherein applicant declares that the mark has become distinctive through applicant's substantially exclusive and continuous use in commerce for at least five years.

Applicant has been selling fans bearing the SILENCER mark since 1985 and, according to the attached 2(f) DECLARATION, has sold "at least as many as 500,000 'internal cooling fans for computers' bearing the mark".

In view of the evidence and remarks, it is seen that applicant's SILENCER mark has become distinctive in commerce for "internal cooling fans for computers" and is entitled thereby to registration on the Principal Register and such registration is requested.

Evidence

Evidence in the nature of Section 2(f) Declaration has been attached.

Evidence-1

Classification and Listing of Goods/Services

Applicant hereby amends the following class of goods/services in the application as follows:

Current: Class 009 for Central processing unit (CPU) fans; Internal cooling fans for computers; Power supplies ; Voltage stabilizing power supply

Original Filing Basis: 1(a).

Proposed: Class 009 for Internal cooling fans for computers; Power supplies ; Voltage stabilizing power supply

Filing Basis: 1(a).

Declaration Signature

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii). If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date. 37 C.F.R. Secs. 2.34(a)(1)(i). The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. §1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /califtervo/ Date: 06/11/2007

Signatory's Name: Calif Tervo

Signatory's Position: Attorney of Record

Response Signature

Signature: /califtervo/ Date: 06/11/2007

Signatory's Name: Calif Tervo

Signatory's Position: Attorney of Record

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Serial Number: 78754685

Internet Transmission Date: Mon Jun 11 17:40:28 EDT 2007

TEAS Stamp: USPTO/ROA-24.165.13.133-2007061117402833
1216-78754685-370bb8a36efe45915923102292
8e0f155-N/A-N/A-20070611171126827936

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
APPLICATION FOR TRADEMARK REGISTRATION

Re: Application for U.S. Trademark Registration
Applicant: P. C. Power & Cooling, Inc.
Word mark: "SILENCER"
Goods: Central Processing Unit Fans, Internal cooling fans for computers; Power
supplies; voltage Stabilizing Power Supplies
Serial No. 78754685 Filed: 11/15/2005

DECLARATION INCLUDING §2(f) CLAIM

I declare that:

I am an Officer of applicant corporation and am authorized to make this declaration on behalf of the corporation;

I believe said corporation to be the owner of the mark sought to be registered;

To the best of my knowledge and belief, no other person, firm, corporation, or association has the right to use said mark in commerce, either in the identical form or in such near resemblance thereto as may be likely, when applied to the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive;

The mark does not relate to any living person;

The mark has become distinctive of the applicant's goods/services in commerce through the applicant's substantially exclusive and continuous use in commerce for at least five years immediately before the date of this statement;

The mark has become distinctive of applicant's goods/services in commerce before enactment of the North American Free Trade Agreement Implementation Act;

At least as many as 500,000 "internal cooling fans for computers" bearing the mark have been sold by applicant; and

That I have been warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

For: P.C. Power & Cooling, Inc.



Douglas Dodson, ~~President~~ CTO

6-7-2007

Dated