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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	87025123
Applicant	Pure Storage, Inc.
Applied for Mark	FLASHSTACK
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UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Serial No.:	87/025,123
Filed:	May 4, 2016
Mark:	FLASHSTACK
Applicant:	Pure Storage, Inc.
Examining Attorney:	Jordan A. Baker, Esq., Law Office 102

APPEAL: APPLICANT'S BRIEF

The Examining Attorney refused registration of Applicant's mark FLASHSTACK (the "Mark") on the basis that the Mark merely describes features or characteristics of the applicant's goods under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 et seq.

Applicant respectfully submits that the term FLASHSTACK is not descriptive of its computer hardware and software goods and services and, accordingly, based on the reasoning below, respectfully requests the Board reverse the Examining Attorney's refusal and approve the Mark for publication.

INTRODUCTION

The foundational question in determining descriptiveness is whether the term immediately and merely provides the consuming public with information regarding the goods with which it is used. In contrast, a suggestive mark requires imagination, thought, or perception by the consumer to reach a conclusion regarding their nature. *See Colgate-Palmolive Co. v. The House for Men, Inc.*, 143 U.S.P.Q. 159 (T.T.A.B. 1964). The Examining Attorney bears the burden of showing that a mark is merely descriptive of the identified goods or services. *See In re Merrill, Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 4 U.S.P.Q.2d 1141 (Fed. Cir. 1997).

Applicant submits that the mark FLASHSTACK is (at least) suggestive, and thus protectable as a composite mark. That is, while the individual terms may be descriptive, the portmanteau they create is suggestive when properly viewed as a whole.

As described more fully below, and along with the reasons proffered in its prior response to the original refusal, Applicant respectfully requests that the Examining

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Attorney reconsider his position that the Mark is merely descriptive. Applicant requests the application proceed to publication.

I. Applicant's Mark is a Unitary, Composite Mark, and is Valid and Distinctive When Viewed as a Whole.

As a threshold matter, the Examining Attorney's refusal should be reversed because, as discussed below, the term FLASHSTACK, as applied to Applicant's goods, may be properly classified as either fanciful, arbitrary, or suggestive. Whatever such determination, the Examining Attorney's refusal should be reconsidered because: (i) the Examining Attorney's adopted definitions of "flash," "stack," and "flashstack" are arbitrary and ignore other definitions, and, more importantly, (ii) the Examining Attorney failed to proffer evidence regarding consumer understanding and meaning of the composite mark FLASHSTACK as a whole, let alone in connection with goods of the genus as Applicant's goods.

1. FLASHSTACK is a Fanciful Trademark.

Applicant's FLASHSTACK mark is a fanciful trademark. Pursuant to TMEP § 1209.01(a), fanciful trademarks "comprise terms that have been invented for the sole purpose of functioning as a trademark or service mark. Such marks comprise words that are either unknown in the language […] or are completely out of common usage." *See also Lane Capital Management, Inc. v. Lane Capital Management, Inc.*, 192 F.3d 337, 344 (2d Cir. 1999) (holding a "fanciful mark is not a real word at all, but is invented for its use as a mark"); 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 11:5 (4th ed., 2014) ("If, in the process of selecting a new mark, a seller sits down and invents a totally new and unique combination or letters or symbols that results in a mark that has no prior use in the language, then the result is a 'coined' or 'fanciful' mark"). The

Examining Attorney has proffered definitions for "flash" and "stack" to support his disclaimer requirement. He did not, however, provide a definition for "flashstack." Indeed, he was not able to do so because "flashstack" is not a real word. Rather, Applicant coined the unique phrase "flashstack," and then used same as a source identifier in the marketplace for its highly-regarded and sought after products. In fact, a simple Internet search for "botvac" reveals that consumers uniquely associate FLASHSTACK with Applicant's goods provided thereunder. As such, Applicant's FLASHSTACK mark should properly be classified as a fanciful trademark, i.e., a term without meaning, and on that basis be forwarded for publication.

2. FLASHSTACK is an Arbitrary Trademark.

The term FLASHSTACK, as applied to Applicant's goods may also be properly classified as an arbitrary trademark. Arbitrary trademarks "comprise words that are in common linguistic use but, when used to identify particular goods or services, do not suggest or describe a significant ingredient, quality, or characteristic of the goods or services." TMEP § 1209.01(a). Applicant has established that the terms "flash" and "stack" have multiple meanings. However, none of these combinations of "flash" and "stack" actually identify or describe Applicant's data-monitoring hardware and software.. Accordingly, Applicant's use of "flashstack" is arbitrary and uncommon. Based on the foregoing, the term FLASHSTACK mark may also be properly classified as an arbitrary trademark as applied to Applicant's goods.

3. FLASHSTACK is a Suggestive Trademark.

The Examining Attorney's descriptiveness determination should alternatively be reconsidered because the term is a suggestive trademark when applied to Applicant's

goods. As discussed above, Applicant's prior response establishes that "flash" has numerous definitions and common understandings. Thus, even if consumers are familiar with Applicant's products, when they encounter Applicant's Mark in the marketplace, they are just as likely to assume that FLASHSTACK suggests goods related to speed. Thus, upon encountering FLASHSTACK in the marketplace, consumers must momentarily pause, work through the numerous potential definitions and meanings of FLASHSTACK, and then take a mental leap in order to correctly determine the nature and characteristics Applicant's products. See TMEP § 1209.01(a) (Suggestive trademarks "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 those goods or services"); *see also In re David P. Cooper*, 2013 WL 5407254, *2 (TTAB, June 10, 2013) ("If, however, when goods or services are encountered under a mark, a multistage reasoning process, or resort to imagination, is required in order to determine the attributes or characteristics of the product or services, the mark is suggestive rather than merely descriptive").

As the Board held in *In re James Stanfield and Asso'n.*, 2007 WL 3336387, *1 (TTAB, Oct. 12, 2007): "A term is deemed to be suggestive, not merely descriptive (and thus not barred from registration under Section 2(e)(1)), if it does not immediately inform the purchaser of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services, but instead conveys such information only after giving the purchaser mental pause, requiring the exercise of thought or imagination to determine the significance of the term as applied to the goods or services." *See also In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) (SPEEDI BAKE for frozen dough found to fall

within the category of suggestive marks because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread); and *In re The Noble Co.*, 225 USPQ 749 (TTAB 1985) (NOBURST for liquid antifreeze and rust inhibitor for hot-water-heating systems found to suggest a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute). The term FLASHSTACK, as applied to Applicant's goods, qualifies as a suggestive trademark.

4. The Examining Attorney Failed to Carry His Burden of Establishing that FLASHSTACK is Merely Descriptive of Applicant's Goods.

To the extent the Examining Attorney disagrees that FLASHSTACK may be classified as a fanciful, arbitrary, or suggestive trademark as applied to Applicant's goods, then the determination turns on whether the Examining Attorney can produce sufficient evidence to support his disclaimer requirement on the grounds of mere descriptiveness. Applicant contends he cannot. Here, Applicant seeks registration of the coined term FLASHSTACK. To carry his burden, the Examining Attorney must establish four factors showing that FLASHSTACK is merely descriptive as applied to Applicant's goods. *See, e.g. In re Siemens Aktiengesellschaft*, 2014 WL 986174, *4 (TTAB, March 4, 2014) citing *In re Harco Corp.*, 220 U.S.P.Q. 1075, 1076 (TTAB 1984). First, the Examining Attorney must establish the individual definitions and meanings of "flash" and "stack." Second, the Examining Attorney must establish the definition and meaning of FLASHSTACK. *See In re Whitewave Services, Inc.*, 2015 WL 496138, *2 (TTAB, Jan. 27, 2015) (reversing the mere descriptiveness finding with regard to CLASSICMAC for a typical macaroni and cheese dish; holding that "[w]e need to analyze each portion of the composite [CLASSICMAC] mark to determine whether such portion is merely

descriptive of the goods and then look at the composite mark in its entirety"); *see also In re Wisconsin Tissue Mills*, 173 U.S.P.Q. 319 (TTAB, 1972) ("It does not follow as a matter of law that because component words of a mark may be descriptive, the composite [mark] is unregistrable. The established rule is that a composite mark must be considered in its entirety and the question then is whether the entirety is merely descriptive."). Third, the Examining Attorney must establish that FLASHSTACK (as defined in step two (2)) merely describes Applicant's goods and services. Fourth, the Examining Attorney must provide sufficient evidence to prove that a relevant consumer encountering the FLASHSTACK mark in the marketplace would immediately recognize and understand it as describing the nature, quality, or characteristics of Applicant's goods and services. *See In re Shutts*, 217 U.S.P.Q. 363, 364 (T.T.A.B. 1983) (mark is merely descriptive when it "readily and immediately evoke[s] an impression and understanding" of the goods identified by the mark); and *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976) (accord); see also *Oreck Holdings, LLC v. Bissell Homecare, Inc.*, 2010 WL 985352, at *5 (TTAB, Feb. 16, 2010) ("the question is whether someone who knows what the goods or services are will understand the mark to convey information about them"; holding HEALTHY HOME VACUUM suggestive for vacuum cleaners.).

With respect to the first factor, the Examining Attorney's definition of "flash" is arbitrary because it ignores altogether the other definitions and meanings of the term. Furthermore, because multiple definitions and meanings—many of which could apply when considered in connection with Applicants products—Applicant respectfully submits

that arriving at a single definition or meaning of "flash" is impossible. Accordingly, the first factor weighs against a finding of descriptiveness.

For the second factor, the Examining Attorney contends in the Final Office Action that FLASHSTACK "merely describes a feature, characteristic, or attribute of applicant's goods." However, like its definition of "flash," the Examining Attorney's definition of FLASHSTACK is arbitrary because it ignores altogether that the numerous definitions and meanings of "flash," in turn, create numerous definitions and meanings of FLASHSTACK. Accordingly, because a precise definition or meaning of FLASHSTACK cannot be established on this record, it follows that the Examining Attorney cannot evaluate the third factor— whether the Examining Attorney is correct that the definition and meaning of FLASHSTACK merely describes Applicant's goods. Thus, the second and third factors further weigh against the finding of descriptiveness.

Finally, assuming arguendo that the Examining Attorney is correct that the definition and meaning of FLASHSTACK is "flash storage hardware organized in a converged stack," the Examining Attorney should nonetheless reconsider his refusal because he failed to consider consumer recognition or understanding of FLASHSTACK in the marketplace. For example, in *In re Future Ads LLC*, 103 U.S.P.Q.2d 1571 (TTAB, 2012), the Examining Attorney issued a disclaimer requirement based on the alleged mere descriptiveness of ARCADEWEB and focused on the plain meanings of the terms "arcade" and "web," and created a definition of the composite therefrom.

The Board reversed the Examining Attorney's finding of descriptiveness holding:

> the "examining attorney did not submit any evidence with her two Office actions showing the term 'arcadeweb' or 'arcade web' used or referenced in connection with services of the type identified in applicant's application […] [n]or has the examining attorney submitted any evidence that the mark, used in conjunction

with the identified services, immediately and directly conveys to consumers that the services involve arcade games." *Id*. at 3, 11.

Here, like the Examining Attorney in *In re Future Ads LLC*, the Examining Attorney has not considered consumer understanding or recognition of Applicant's applied-for mark in the marketplace. While referring to excerpted materials in which "flash" and to "stack" are used in connection with computer hardware, but does not evidence any consumer understanding of the composite term. Applicant does not dispute that the evidence cited by the Examining Attorney demonstrates consumers are familiar with the terms "flash" and "stack" used in connection with computer hardware. But Applicant Applicant seeks registration of the coined term FLASHSTACK. The Examining Attorney's evidence is devoid of any reference to that term. Accordingly, the fourth factor, like the others, weighs against the descriptiveness finding.

5. Any Doubt Regarding Whether FLASHSTACK is a Suggestive or Descriptive Trademark When Applied to Applicant's Goods Must be Resolved in Applicant's Favor.

The line between a descriptive and suggestive finding is very thin. With that in mind, the Board has made clear that even if the Examining Attorney is not convinced by Applicant's arguments, his finding may still require reversal. In fact, if he has any doubt regarding whether FLASHSTACK descriptive as applied to Applicant's goods, such doubt must be resolved in Applicant's favor. *In re Morton-Norwich Prods., Inc.*, 209 U.S.P.Q. 791 (TTAB 1981) ("[W]here reasonable [persons] may differ, it is the Board's practice to resolve the doubt in the applicant's favor and publish the mark for opposition") referencing *In re The Gracious Lady Service, Inc.*, 175 U.S.P.Q. 380 (TTAB 1971) and *In re Gourmet Bakers*, 173 U.S.P.Q. 565 (TTAB, 1972); *In re Tofasco of America, Inc.*, 2013 WL 5407234 at *1 ("To the extent there is any doubt in drawing the

line of demarcation between a suggestive mark and a merely descriptive mark, such doubt is resolved in applicant's favor"); *In re David P. Cooper*, 2013 WL 5407254 at *2 (accord); and *In re Atavio Inc.*, 25 U.S.P.Q.2d 1361 (TTAB 1992) (accord). As the Board held in *Oreck Holdings, LLC v. Bissell Homecare, Inc.*, *9 (TTAB, Feb. 16, 2010): "[t]here is often a fine line between merely descriptive marks and those which are just suggestive. These determinations are often subjective […] The determination of whether a mark is descriptive or suggestive is not an exact science. *Id.* at *9. The Board cited the *In re Nett Designs, Inc.*, 57 U.S.P.Q. 1564, 1566, where the Federal Circuit held

> [i]n 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., 57 USPQ2d at 1566. The Board then went on to hold in *Oreck Holdings, LLC* that:

> The mark at issue, HEALTHY HOME VACUUM, is typical of so many marks that consumers encounter in the marketplace: a highly suggestive mark that tells consumers something general about the product, without being specific or immediately telling consumers anything with a degree of particularity. The information given by the mark is indirect and vague. The mark here conjures up indirect mental associations in the consumer's mind; the thought process beginning with the mark HEALTHY HOME VACUUM and leading to a characteristic or feature of a vacuum cleaner is neither immediate nor direct."

Oreck Holdings, LLC, 2010 WL 985352 at *9.

Here, like the mark HEALTHY HOME VACUUM, Applicant's FLASHSTACK mark is "suggestive [because it] tells consumers something general about [Applicant's] products, without being specific or immediately telling consumers anything with a degree of particularity." Indeed, as discussed above, consumers must take a mental leap in order to correctly determine the nature and characteristics of Applicant's goods because

FLASHSTACK suggests numerous different definitions and meanings. As a result of this mental leap, FLASHSTACK, when applied to Applicant's goods, is suggestive, not descriptive, and any doubt regarding this distinction must be resolved in Applicant's favor.

CONCLUSION

Based on the foregoing, Applicant respectfully requests that the Examining Attorney's refusal based on FLASHSTACK's alleged mere descriptiveness of Applicant's goods be reversed.

Respectfully submitted,

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Date: December 1, 2017

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