

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
September 4, 2007  
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American Power Conversion Corporation

Serial Nos. 78534217 and 78598147

Stephen J. Holmes of Barlow Josephs & Holmes, Ltd. for  
American Power Conversion Corporation.

Gene V.J. Maciol, II, Trademark Examining Attorney, Law  
Office 103 (Michael Hamilton, Managing Attorney).

Before Walters, Bucher and Cataldo, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

American Power Conversion Corporation seeks registration  
on the Principal Register  
of the mark **BLADE READY**  
(*in standard character  
format*) as well as a second  
mark shown in this special  
form drawing. Both forms  
of the mark will allegedly  
be used in connection with  
goods identified as  
follows:



"voltage surge protectors for sensitive electronic equipment and computers; computer software programs for use with power protection devices for monitoring and automatic shutdown of computer systems; uninterruptible electrical power supplies, electrical power supplies, modular electric power supplies, AC power supplies, DC power supplies, DC-DC converters, inverters, batteries, electrical transformers and electrical distribution devices in the nature of boxes, consoles and electrical power outlet strips; computer and computer networking cables in the nature of ethernet networking cables, thin ethernet networking cables, universal serial bus cables, token ring cables, V.35 cables, coaxial cables, parallel printer cables, serial cables, fiber optic cables for computer networking, keyboard cables, monitor cables, mouse cables, multimedia cables, audio cables, phone, modem and fax cables, ribbon cables, and SCSI cables; computer networking devices in the nature of hubs, switches, routers, and controllers; and interface devices in the nature of computer interface boards and universal peripheral interface hardware; rack enclosures for housing computer and power protection equipment and accessories"<sup>1</sup> in International Class 9.

In each application, applicant has disclaimed the exclusive right to use the word "Blade" apart from the respective marks as shown.

These cases are now before the Board on appeal from the final refusals of the Trademark Examining Attorney to

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<sup>1</sup> Application Serial No. 78534217 [**BLADE READY** and design] was filed on December 17, 2004 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. Application Serial No. 78598147 [**BLADE READY**] was filed on March 30, 2005 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

register these designations under Section 2(e)(1) of the Trademark Act based upon the ground that this combined literal term is merely descriptive when considered in relation to applicant's identified goods, i.e., that the term "Blade Ready" immediately informs potential purchasers about the characteristic, feature, purpose and use of applicant's goods. In Application Serial No. 78534217, the refusal to register is based upon applicant's failure to disclaim, as required, the merely descriptive term "Blade Ready" apart from the mark as shown, under Trademark Act Section 6, 15 U.S.C. § 1056.

Applicant and the Trademark Examining Attorney submitted briefs on the appeals in both cases. The marks, the legal issues, the procedural histories, the overall records and the appeal briefs are nearly identical in these two appeals. Accordingly, these cases are considered together and determined in a single opinion. We affirm both refusals to register.

***Is term merely descriptive?***

A mark is merely descriptive, and therefore unregistrable pursuant to the provisions of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), if it immediately conveys "knowledge of a quality, feature,

function, or characteristics of the goods or services." *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) [ASPIRINA is merely descriptive of analgesic product]. See also *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987) [APPLE PIE merely descriptive of potpourri mixture]; and *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980) [QUIK-PRINT is merely descriptive of "same day" services of printing, photocopying, collating, binding, cutting, drilling, folding, padding, stapling, and perforating]. To be "merely descriptive," a term need only describe a single significant quality or property of the goods. *Gyulay*, 3 USPQ2d at 1009. Descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or services for which registration is sought. That is, when we analyze the evidence of record, we must keep in mind that the test is not whether prospective purchasers can guess what applicant's goods are after seeing applicant's mark alone. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) [GASBADGE merely descriptive of a "gas monitoring badge"; "Appellant's abstract test is deficient - not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the

goods' as required by statute"]. Hence, the ultimate question before us is whether the term **BLADE READY** conveys information about a significant feature or characteristic of applicant's goods with the immediacy and particularity required by the Trademark Act.

A mark is suggestive, and therefore registrable on the Principal Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. "Whether 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.'" (citation omitted)

*In re Gyulay*, 3 USPQ2d at 1009]; *In re Home Builders*

*Association of Greenville*, 18

USPQ2d 1313 (TTAB 1990) [NEW

HOME BUYER'S GUIDE merely descriptive of "real estate

advertisement services"]; and *In re American Greetings Corp.*,

226 USPQ 365, 366 (TTAB 1985) [APRICOT is merely descriptive

of apricot-scented dolls]. Rather, the proper test in

determining whether a term is merely descriptive is to

consider the applied-for mark in relation to the goods or



services for which registration is sought, the context in which the mark is used, and the significance that the mark is likely to have on the average purchaser encountering the goods or services in the marketplace. See In re Omaha

National Corp., 819 F.2d 1117,

2 USPQ2d 1859 (Fed. Cir. 1987)

[the term "first tier"



describes a class of banks]; In re Intelligent

Instrumentation Inc., 40 USPQ2d 1792 (TTAB 1996) [the term

VISUAL DESIGNER is merely descriptive of "computer programs for controlling the acquisition of data from measurement

devices"]; In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991) [MULTI-VIS is merely descriptive of "multiple viscosity

motor oil"]; In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986) [DESIGN GRAPHIX merely descriptive of computer

graphics programs]; and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979) [COASTER-CARDS merely descriptive of a coaster suitable for direct mailing].

In arguing for registrability, applicant contends that its mark is suggestive at worst, arguing that the term "Blade Ready" gives no indication to consumers that the goods offered are solely available for immediate use with specialized computer servers. Furthermore, applicant argues that both words "Blade" [see footnotes 3 & 4] and "Ready"

have each been registered when appearing in other composite marks in this field. Finally, applicant argues that there is no critical need for others in the industry to be able to use this unique combination of terms.

### ***The word "Blade"***

According to the Trademark Examining Attorney, the word "Blade" immediately identifies a special type of computer tied together with clusters of other computers, traditionally found in large data centers.

This setup requires advanced power distribution, heat removal and modular placement of the "blades." In addition to applicant's disclaimer of the word "Blade," the Examining Attorney points to additional evidence in the record, including applicant's own brochure, seen above.



The Trademark Examining Attorney also produced web pages discussing various Intel blade server products with their processor features and configurations,<sup>2</sup> the HP BladeSystem

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<sup>2</sup> <http://www.intel.com/>

server blades,<sup>3</sup> and the IBM BladeCenter products and systems.<sup>4</sup> In addition to issues of power distribution, heat removal and modular placement, each vendor places different degrees of emphasis on high speed I/O connectivity, redundancy, and saving space with dense clusters of computers placed in a Storage Area Network (SAN) or a Local Area Network (LAN).

### ***The word "Ready"***

Applicant and the Trademark Examining Attorney have submitted various definitions for the word "Ready":

**"Ready:** finished and available for use: finished or completed and so able to be used immediately."<sup>5</sup>

**"Ready:** "prepared or available for service."<sup>6</sup>

**"Ready:** "prepared or available for service, action or progress."<sup>7</sup>

The word "Ready" is used by applicant as an adjective, following and modifying the term "Blade." The Trademark Examining Attorney points to third-party registrations where the term "Ready" is similarly modifying other merely descriptive terms, resulting in phrases like "Fiberready,"

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<sup>3</sup> <http://h71028.www7.hp.com/enterprise/cache/>

<sup>4</sup> <http://www-03.ibm.com/>

<sup>5</sup> MSN Encarta® dictionary.

<sup>6</sup> <http://www.dictionary.com>

<sup>7</sup> AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE, Fourth Ed. 2000.

Servo-Ready," "Web-Redi," "Network-Ready" and "Grid Ready"  
being found to be merely descriptive of class 9 goods:

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**FIBERREADY**

for "electrical raceway and fittings therefor, namely corners, elbows and tee fittings suitable for accommodating fiber optic cable" in International Class 9;<sup>8</sup>

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**SERVO-READY**

for "brushless DC motors and linear actuators for use with drives and controllers" in International Class 9;<sup>9</sup>



for "computer software used to convert analog radio signals into digital signals; computer chips that convert analog radio signals into digital signals; computer software used to decode digital transmission signals into audio, all sold as components of radios" in International Class 9;<sup>10</sup>

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**WEB-REDI SOLUTIONS**

for "computer software for web site and database integration" in International Class 9;<sup>11</sup>

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<sup>8</sup> Registration No. 2371803 issued on the Supplemental Register on July 25, 2000.

<sup>9</sup> Registration No. 2652924 issued on the Supplemental Register on November 19, 2002.

<sup>10</sup> Registration No. 2832781 issued on April 13, 2004 with a disclaimer of the terms "HD" and "Radio Ready."

<sup>11</sup> Registration No. 2858893 issued on June 29, 2004 with a disclaimer of the words "Web-Ready."

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**INTELLIGENT.  
NETWORK-READY.  
READS ANY TAG.**

for "radio frequency identification (RFID) tag reader apparatus; operating system software used in connection with an RFID tag reader apparatus" in International Class 9;<sup>12</sup> and

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**Grid Ready Cabling**

for "telecommunications cabling and hardware, namely, telecommunications hardware and cabling systems comprising copper and fiber cable, outlets, connectors, adapters, plugs, patch cords, patch panels, connecting blocks, faceplates, surface mount boxes, cable management racks" in International Class 9.<sup>13</sup>

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We find, for example, that applicant's goods enumerated herein bear the same relationship to a "blade" that the **FIBERREADY** goods ("... fittings suitable for accommodating fiber optic cable") bear to fiber cabling.

Similarly, as seen in applicant's brochure, the phrase "Blade-Ready Solutions" appears above a paragraph explaining that applicant's goods can be specifically designed to accommodate the requirements of enterprise blade servers.

We must consider the applied-for term in relation to the identified goods. We also assume that the average consumer

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<sup>12</sup> Registration No. 2988380 issued on the Supplemental Register on August 23, 2005.

<sup>13</sup> Registration No. 3030832 issued on the Supplemental Register on December 13, 2005 with a disclaimer of the word "Cabling."

of these goods is knowledgeable about their use and functioning. Applicant's goods are rack enclosures and components of computerized networks such as electronic management equipment and peripherals such as power supplies, distribution devices, networking and interface devices. Any such component or device that is not "blade-ready" may well not work in this specialized environment. On seeing this term, the IT professional knows immediately that applicant's array of goods is designed for the special needs of the blade server environment. Thus, the mark **BLADE READY** is merely descriptive of applicant's enumerated goods.

Applicant makes the argument that this term is at most suggestive because the goods are not "solely" for immediate use with blade servers. Of course, as noted above, a term need not describe all of the purposes, functions, characteristics or features of the goods to be merely descriptive -- it is enough that the term describes one significant function, attribute or property of the involved goods. *Gyulay*, 3 USPQ2d at 1009. The fact that many of these components may well work in LAN or SAN systems that do not qualify as blade servers does not detract from the merely descriptive nature of the mark. We agree with the Trademark Examining Attorney that applicant's own literature makes

clear that at least one feature of its goods is that they are available for use in connection with blade servers.

Applicant argues that there appears to be no critical need for others in this industry to be able to use this particular combination of terms, and that this further corroborates applicant's contention that the mark is not merely descriptive.

However, the fact that applicant may be the first, and perhaps currently the only, user of a descriptive designation does not justify registration if the only significance conveyed by the term is merely descriptive. See In re National Shooting Sports Foundation, Inc., 219 USPQ 1018 (TTAB 1983) [SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE is descriptive for conducting and arranging trade shows in hunting, shooting, and outdoor sports products field]. Similarly, the failure of the Trademark Examining Attorney to uncover third-party examples of the "blade-ready" combination does not detract from the fact that these two words when placed together will be perceived as merely descriptive by those in the IT industry when used in connection with applicant's enumerated computer components.

Decision: As to the refusal in application Serial No. 78598147 [BLADE READY], the refusal to register under Section 2(e)(1) of the Lanham Act is hereby affirmed. As to the refusal in application Serial No. 78534217, the refusal to register absent applicant's compliance with the Trademark Examining



Attorney's requirement to disclaim the words "Blade Ready" (on the ground that this phrase is merely descriptive in connection with the identified goods), is also affirmed.<sup>14</sup> Nonetheless, in accordance with Trademark Rule 2.142(g), this decision will be set aside with respect only to application Serial No. 78534217, and this application will be returned to the Trademark Examining Attorney to place in condition for publication for opposition, if applicant, no more than thirty

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<sup>14</sup> In its response of October 16, 2006, applicant suggested it might be willing, in the alternative, to agree separately to disclaimers of the words "Blade" and "Ready" apart from the mark as shown. However, a disclaimer of individual components of a descriptive term is improper when it should be disclaimed as a composite. See *In re Wanstrath*, 7 USPQ2d 1412, 1413 (Comm'r Pats. 1987) [GLASS TECHNOLOGY is a unitary descriptive phrase as applied to automobile windshield repair kits and must be disclaimed as a composite, not as separate words]; *In re Medical Disposables Co.*, 25 USPQ2d 1801 (TTAB 1992) [MEDICAL DISPOSABLES is a unitary descriptive expression which must be disclaimed as a composite]; *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798, 804 n.3 (TTAB 1984) [CERTIFIED HEARING AID AUDIOLOGIST "clearly is a unitary expression that should be disclaimed in its entirety"]; *In re Surelock Mfg. Co., Inc.*, 125 USPQ 23 (TTAB 1960) [THE RED CUP for red-colored hydraulic wheel cylinder brake cups must be disclaimed as a composite). In the present case, the clear requirement is to disclaim the unitary phrase "Blade Ready" apart from the mark as shown.

days from the mailing date of this decision, submits an appropriately worded disclaimer, namely:

No claim is made to the exclusive right to use the words "Blade Ready" apart from the mark as shown.

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