

THIS DISPOSITION IS NOT
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NOV. 18, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re UtiliCorp Holdings, Inc.

Serial No. 74/710,159

Robert E. Marsh of Blackwell, Sanders, Matheny, Weary &
Lombardi for UtiliCorp Holdings, Inc.

Lori S. Schulman, Trademark Examining Attorney, Law Office
103 (Michael Szoke, Managing Attorney).

Before Sams, Cissel and Hanak, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

UtiliCorp Holdings, Inc. (applicant) seeks registration
of CUSTOM POWER PARK in typed capital letters for the
services listed below. The intent-to-use application was
filed on August 2, 1995.

Class 37 - installation of operating
equipment and systems relating to the
enhancement of power quality for energy
customers concentrated in a particular
industrial or commercial zone.

Class 42 - consulting, engineering and design services relating to the enhancement of power quality for energy customers concentrated in a particular zone; integration by various methods, including computer software, computer hardware and electricity distribution networks, of operating equipment and systems relating to the enhancement of power quality for energy customers concentrated in a particular industrial or commercial zone.

The Examining Attorney refused registration pursuant to Section 2(e)(1) of the Lanham Trademark Act on the basis that applicant's mark is merely descriptive of applicant's services. In addition, the Examining Attorney refused registration of applicant's Class 42 "application" on the basis that applicant failed to insert the words "computer services, namely" before the words "integration by various methods" in the recitation of services for Class 42. It is the position of the Examining Attorney that "applicant's recitation of services in International Class 42 is unacceptable as indefinite." (Examining Attorney's brief page 5).

When the refusal was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

As has been stated repeatedly, "a term is merely descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or

services].” In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)(emphasis added); Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976). Moreover, the immediate idea must be conveyed forthwith with a “degree of particularity.” In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1978); In re Entenmann’s Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff’d 90-1495 (Fed. Cir. February 13, 1991).

The Examining Attorney has made of record excerpts of six articles from the NEXIS database showing that the term “power park” refers to an area where electric power is generated, usually from the sun or wind. (In point of fact, the Examining Attorney made of record 24 excerpts. However, 18 of the 24 were from foreign publications, were duplicates or were simply not uses of “power park” as a composite term. An example of the latter type of excerpt appears in The Idaho Statesmen of March 9, 1995, and it reads as follows: “Reservations are no longer taken at Idaho Power parks in the canyon.”).

Despite the fact that the Examining Attorney made of record only six excerpts showing that the term “power park” refers to an area where electric power is generated, applicant has not taken issue with the Examining Attorney that the term “power park” does refer to an area where electric power is generated. (Applicant’s brief page 3).

However, applicant notes that its services do not encompass the generation of any type of power. Moreover, applicant notes that its services, as described in its application, are not rendered to entities which generate power, nor are they rendered in power parks.

In response, the Examining Attorney does not take issue with applicant's statements that its services are not rendered to entities which generate power and that applicant's services are not rendered in "power parks," as that term is utilized in the NEXIS evidence made of record by the Examining Attorney. Rather, the Examining Attorney articulates her contention that the term "power park" is descriptive of applicant's services in the following manner: "Although the evidence supports descriptive use of the term 'power park' in relation to power generating areas, power distribution is the logical next step in power generation. Therefore, it appears that applicant's use of the term 'power park' is merely expanding upon its generally understood meaning within the energy industry." (Examining Attorney's brief page 3).

We have two problems with the reasoning of the Examining Attorney. First, neither applicant's services in Class 37 nor applicant's services in Class 42 involve power distribution per se. Applicant's Class 42 services are consulting, engineering and design services, not power

distribution services. While it is true that applicant's Class 42 consulting, engineering and design services involve, among many other things, "electricity distribution networks," this does not mean that applicant's Class 42 services (or Class 37 services) are power distribution services.

Second, even assuming for the sake of argument that some of applicant's services could be very broadly construed so as to encompass some form of power distribution, the fact remains, as conceded by the Examining Attorney, that all of the NEXIS evidence made of record shows that the term "power park" is descriptive of certain power generating areas. None of the NEXIS evidence made of record by the Examining Attorney in any way remotely indicates that the term "power park" is descriptive of power distribution. This Board has held that "the fact that a term may be descriptive of certain types of goods [or services] does not establish that it is likewise descriptive of other types of goods [or services], even if the goods [or services] are closely related (e.g. hats and boots). Abercrombie & Fitch, 189 USPQ at 766 ." In re The Stroh Brewery Co., 34 USPQ2d 1796, 1797 (TTAB 1994). Thus, even assuming for the sake of argument that power generating services and power distribution services are closely related, the fact that the Examining Attorney has proven that "power park" is

descriptive of the former services does not mean that this proof, by itself, establishes that the term "power park" is likewise descriptive of the latter services. Accordingly, we find that the Examining Attorney has simply not met her burden of establishing that applicant's mark CUSTOM POWER PARK is, in its entirety, descriptive of any of the services set forth in the application.

However, having said the foregoing, we are nevertheless forced to "affirm" the refusal to register because applicant has not submitted a disclaimer of the term "power" in its mark. Obviously, the term "power" clearly describes a significant characteristic of both applicant's Class 37 services and applicant's Class 42 services. However, applicant is allowed thirty days from the mailing date of this decision to submit a disclaimer of the word "power" in its mark CUSTOM POWER PARK. Upon the receipt of this disclaimer, this decision will be set aside and applicant's mark will be passed to publication. See In re Interco Inc., 29 USPQ2d 2037, 2039 (TTAB 1993).

Finally, as for the Examining Attorney's refusal to register on the basis that applicant's "recitation of services is indefinite in Class 42," we simply disagree and reverse the refusal on this ground.

Decision: The refusal to register on the basis that applicant's Class 42 recitation of services is indefinite is

reversed. The refusal to register on the basis that applicant's mark CUSTOM POWER PARK is in its entirety descriptive of applicant's services is likewise reversed. However, the refusal to register is nevertheless "affirmed" because, as explained above, applicant, through no fault of its own, has not submitted a disclaimer of the clearly descriptive term "power." However, applicant is allowed 30 days from the mailing date of this decision to submit a disclaimer of the word "power" in its mark CUSTOM POWER PARK. As previously noted, upon receipt of this disclaimer, this decision will be set aside and applicant's mark will be passed to publication.

J. D. Sams

R. F. Cissel

E. W. Hanak
Administrative
Trademark Judges,
Trademark Trial and
Appeal