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BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Manhattan Scientifics, Inc.

Serial No. 75/477,259

James C. Wray, Esq. for Manhattan Scientifics, Inc.

Heather D. Thompson, Trademark Examining Attorney, Law
Office 103 (Mike Hamilton, Managing Attorney).

Before Cissel, Chapman and Drost, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

An application has been filed by Manhattan
Scientifics, Inc. to register on the Principal Register the
mark MICROFUEL CELL for the following goods, as amended:
"fuel cells and fuel cell tanks for producing electrical
energy; fuel cell chemical fuel provided as a unit with the
foregoing" in International Class 9.¹

¹ Application Serial No. 75/477,259, filed April 30, 1998, based
on applicant's assertion of a bona fide intention to use the mark
in commerce.

Citing Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), the Examining Attorney has finally refused registration on the ground that if applicant's mark were used on or in connection with the goods identified in the application, it would be merely descriptive thereof.

Applicant has appealed, and both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

Applicant contends that the mark MICROFUEL CELL is not merely descriptive of a fuel cell or of fuel cell fuel or of fuel cell tanks which hold the fuel; that the stories retrieved from Nexis and made of record by the Examining Attorney are generally distinguishable because they refer to oxygen sensors, or to fuel injectors and pumps for diesel engines, or to fuel crystals, none of which are applicant's goods; that other evidence submitted by the Examining Attorney is not relevant; that a combination of two or more descriptive terms may result in a composite mark which is not merely descriptive; that it is inappropriate to dissect applicant's mark into separate words, without considering the mark as a whole; that the Examining Attorney has not met her burden of establishing a prima facie case that the mark conveys an immediate idea about the goods with a degree of particularity; that the

combination of words is capable of different meanings, and might be seen as "micro fuel" and "cell" or as "micro" and "fuel cell"; that the significance of the mark as a whole is ambiguous and it is therefore suggestive in relation to applicant's goods; that there is no evidence that others in the relevant field need to use MICROFUEL CELL to describe their goods; and that doubt on the issue of mere descriptiveness is resolved in applicant's favor.

The Examining Attorney argues that the terms "cell" and "fuel cell" are interchangeable, either referring to units or devices in which electrical energy is produced; that in the context of applicant's goods, it is clear that applicant refers to "fuel cells"; that "micro" is defined as "basic or small-scale"; that the term "MICROFUEL CELL" describes the primary feature of the goods, namely, small-scale fuel cells; that even if, as argued by applicant, the combination of words may be capable of different meanings, the question of descriptiveness must be determined not in the abstract, but in the context of purchaser perception in relation to the involved goods; and that the evidence clearly shows that MICROFUEL CELL is merely descriptive of applicant's "fuel cells and fuel cell tanks for producing electrical energy; fuel cell chemical fuel provided as a unit with the foregoing."

As evidence in support of the refusal to register, the Examining Attorney submitted (i) dictionary definitions of the involved words; (ii) printouts of several stories and several excerpted stories retrieved from Nexis regarding "micro fuel cell" technology; (iii) copies of several pages from applicant's website referring to "miniature" or "micro" sized fuel cells; (iv) copies of several pages from third-party websites; (v) a printout of nine pages from applicant's U.S. Patent No. 5,759,712 for "Surface replica fuel cell for micro fuel cell electrical power pack"; and (vi) copies of several third-party registrations, all of which include the word "MICRO" in the mark, and all of which issued with a disclaimer thereof, or under Section 2(f) of the **Trademark Act**, or on the Supplemental Register.

Not only does the dictionary define "micro" as "basic or small-scale" (adjective), or "small" (prefix), but applicant's website and its patent also utilize the term "micro" to relate to a small size. For example, applicant's website includes such statements as the following (emphasis added):

"Conventional batteries are becoming inadequate for the increasing power and complexity of portable electronic devices such as cell phones, laptop computers, and video recorders.... Micro Fuel Cells may eventually obsolete small batteries. Better,

smaller, less-costly, environmentally safe, and much more efficient,..."; and

"[Robert] Hockaday has developed a new *miniature* power source with the potential to obsolete conventional rechargeable batteries. [Applicant] owns the world rights to the micro fuel cell activity of ERD. The patented *miniature fuel cell* is environmentally safe and can be recharged instantly by a few drops of alcohol or methanol."

Applicant's patent (No. 5,759,712) includes the following statements (emphasis added):

From the Abstract--"A *miniature* fuel cell system uses porous plastic membranes as substrates of fuel cells. ... That leads to printed circuit designs of *small fuel cells* systems integrated with rechargeable batteries..." ;

From the Background--"U.S. Pat. Nos. 5,364,711 and 5,432,023 describe *miniature fuel cells* to run OA (Office Automation) equipment, audio equipment, and radio equipment. Those patents describe advantages of using *miniature fuel cells* and a conglomeration of techniques to build fuel cells...." ; and

From the Summary of the Invention--"The present invention uses the fuel cells described in U.S. Pat. No. 4,673,624 and in co-pending Surface Replica Fuel Cell U.S. patent application Ser. No. 08/531,378 to form a *small* electrical supply, with or without an electrical storage device such as a rechargeable battery, with the objective of providing electrical power for portable electronics," and

The most obvious applications of a *small fuel cell* are in those that are currently powered by batteries, and especially the rechargeable batteries."

In addition to the meaning of the term "micro," it is also clear from this record that fuel cell technology is a specific type of power generating technology. First, we consider the following Webster Dictionary (1998) definitions of record herein:

Cell "5a(1): a receptacle (as cup or jar) containing electrodes and an electrolyte either for generating electricity by chemical action or for use in electrolysis. (2) FUEL CELL b: a single unit in a device for converting radiant energy into electrical energy for varying the intensity of an electrical current in accordance with radiation.

In addition, applicant's own identification of goods is for fuel cells and fuel cell tanks for producing electrical energy (as well as the fuel cell chemical fuel sold therewith). Thus, applicant's goods, as identified, encompass all types of fuel cells for producing electrical energy.

Moreover, the following are examples of the many stories retrieved from the Nexis database, showing use of the term "micro fuel cell" (emphasis added):

Headline: ETHANOL, METHANOL LOOK TO
MINI-FUEL CELLS TO BOOST MARKETS

Houston—With fuel cell powered cars on their way to mass production, both ethanol and methanol producers are looking to **"micro" fuel cells** to further impact market demand.

The automotive market may eventually provide a [sic-an] 800 billion gallon per year market for methanol, said Robert Hockaday, chief fuel cell scientist for Manhattan Scientifics, Inc. Household use of **"micro" fuel cells** may eventually provide a 1.4 trillion gallon per year market for methanol, Hockaday said.

...

Meanwhile, French ethanol producers have made headway on the development of the **"micro" fuel cell**. A fuel cell technological network, set up by the French Ministry of Research and Industry, launched a new phase of research designed to bring ethanol-powered batteries to market. ..., "OXY-FUEL NEWS," November 29, 1999;

Headline: SANDIA SEEKS FUEL CELL PARTNERS

Sandia, located in Albuquerque, N.M., is interested in developing new materials for conventional fuel cells that can reduce costs and increase operating efficiency. It also wants to produce **"micro" fuel cells**. ..., "Utility Environment Report," December 18, 1998;

Headline: Renewable Energy: Ready to Meet Its Promise?

...Rural, urban, and suburban areas will be radically affected by the advent of significant uses of renewable energy. All three types of communities are likely to be affected by two major changes: the restructuring of the electric industry and changes in the way people move about. ... Consumers will be able to generate electricity on

their own property, using wind, photovoltaic, or **micro-fuel-cell** technology, . . . , "The Washington Quarterly, 2000 Winter; and

Headline: A solid start to the millennium? Solid oxide fuel cells;
Cover story

. . . Other interesting areas under investigation include **micro fuel cells** to replace the tiny batteries in modern, computer-oriented vehicles, with a start-up company at Keele University looking to produce very small, cheap extruded tubular SOFCs to fulfill this function. . . . , "Chemistry and Industry," May 4, 1998.

The test for determining whether a mark is merely descriptive under Section 2(e)(1) of the Trademark Act is whether the term immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used or is intended to be used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Associates*, 226 USPQ 285 (TTAB 1985); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). The determination of mere descriptiveness must be made in relation to the goods or services for which registration is sought, the context in which the term or phrase is being or will be used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services.

See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991). That is, the question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

We agree with the Examining Attorney that the mark MICROFUEL CELL immediately and directly conveys information about a significant feature of "fuel cells and fuel cell tanks for producing electrical energy; fuel cell chemical fuel provided as a unit with the foregoing," specifically, that applicant's fuel cells are small in size. This record shows that the purchasing public would perceive this feature of applicant's goods regardless of whether the purchaser viewed applicant's mark as "microfuel" and "cell" or as "micro" and "fuel cell."² The combination of these words does not create an incongruous or creative mark. Rather, applicant's mark MICROFUEL CELL, if applied to

² We note that on applicant's own website the words generally appear as three separate words.

applicant's identified goods, would immediately describe, without conjecture or speculation, a significant feature of applicant's goods, as discussed herein. Nothing requires the exercise of imagination or mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's goods to readily perceive the merely descriptive significance of the term MICROFUEL CELL as it pertains to applicant's goods. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792 (TTAB 1996); and *In re Time Solutions, Inc.*, 33 USPQ2d 1156 (TTAB 1994).

Based on the record before us, applicant's arguments to the contrary do not persuade us of a different result herein.

Finally, even if applicant became the first (and/or only) entity to use the term "MICROFUEL CELL" in relation to fuel cells and fuel cell tanks and fuel cell chemical fuel sold therewith, such is not dispositive where, as here, the term unquestionably projects a merely descriptive connotation. See *In re Tekdyne Inc.*, 33 USPQ2d 1949, 1953 (TTAB 1994), and cases cited therein. We believe that competitors would have a competitive need to use this term.

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See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:18 (4th ed. 2000).

Decision: The refusal to register under Section 2(e)(1) is affirmed.