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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Automated Cell, Inc.

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Serial No. 75/864,736

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Ansel M. Schwartz, Esq. for Automated Cell, Inc.

Brendan Regan, Trademark Examining Attorney, Law Office 113  
(Odette Bonnet, Managing Attorney).

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Before Hanak, Chapman and Bucher, Administrative Trademark  
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On December 6, 1999, Automated Cell, Inc. (a  
Pennsylvania corporation) filed an application to register  
the mark AUTOMATED CELL on the Principal Register for  
services amended to read "automated cell biology services,  
namely analyzing living cells in regard to external  
stimuli, for therapeutic development" in International  
Class 42. The application is based on applicant's claimed

date of first use and first use in commerce of March 19, 1997.

The Examining Attorney refused registration on the ground that applicant's mark, AUTOMATED CELL, is merely descriptive of applicant's automated cell biology services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

When the refusal was made final, applicant appealed to this Board. Both applicant and the Examining Attorney have filed briefs; an oral hearing was not requested.

A mark is merely descriptive if it immediately describes the ingredients, qualities or characteristics of the goods or services with which it is used, or if it conveys information regarding a function, purpose or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978); and In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). See also, In re Eden Foods Inc. 24 USPQ2d 1757 (TTAB 1992); and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). One must look at the mark in relation to the goods or services, and not in the abstract, when considering whether the mark is merely descriptive. See In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); and Abcor, 200 USPQ at 218. It is well-settled

that, to be "merely descriptive," a term need only describe a single significant quality or feature of the goods. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987).

The Examining Attorney relies upon, *inter alia*, applicant's identification of goods "automated cell biology services, namely analyzing living cells in regard to external stimuli, for therapeutic development"<sup>1</sup>; applicant's specimen which states thereon "Cell Biology Tools and Informatics"; and one page from applicant's Web site which includes the following statement:

"The CytoWorks™ platform measures these functions through automated cell culture coupled with real-time digital analysis and automated manipulation of culture conditions."

The Examining Attorney submitted for the record (i) copies of a few third-party registrations which include the term "automated cell" within the identification of goods and/or services [e.g., "reagents and chemicals for use in automated cell and tissue staining..." (Reg. No.

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<sup>1</sup> While it is true, as applicant argues, that the Examining Attorney found the original identification to be indefinite or overbroad, and required a change to the identification, it is important to note that applicant's original identification of services read "automated cell biology services for therapeutic development." It was not due to a requirement of the Examining Attorney, but rather it was the applicant who originally identified its services as "automated cell biology services...."

1,938,268), and "solid state, computerized instrument for automated cell washing-decanting, addition of serum, agitation and centrifugation" (Reg. No. 982,524)]; and (ii) copies of several stories retrieved from the Nexis database to show that the wording "automated cell" is commonplace terminology in the field of biology, examples of which are reproduced below (emphasis added):

Headline: 1998 Science Fair  
Participants and Auxiliary Awards  
First: Keith Bonawitz, "**Automated cell**  
recognition using artificial neural  
networks...", "Intelligencer Journal  
(Lancaster, PA)," March 28, 1991; and

Headline: Baxter, VIMRX Subsidiary to  
Market Cell Therapy Products  
...In development is an **automated cell**  
expansion platform that will enable  
sterile growth for numerous cell types,  
including stem cells, T-cells and  
dendritic cells for therapeutic use....,  
"Medical Industry Today," February 26,  
1998.

Applicant argues that the mark AUTOMATED CELL is not merely descriptive as the term "cell" suggests a predefined area and could refer to a cellular telephone system or a prison cell; that the mark creates an ambiguity or incongruity because there is no certainty "what cell is being automated" (brief, p. 3); that a mental leap is required for consumers to figure out what services are involved; and that certain of the articles submitted by the

Examining Attorney could indicate that the company therein is copying applicant's mark.<sup>2</sup>

Upon careful consideration of this record and the arguments of the attorneys, we conclude that the Examining Attorney has satisfactorily demonstrated that the asserted mark AUTOMATED CELL immediately describes a characteristic or feature of the services with which applicant uses its mark. The term immediately informs consumers that applicant's services are in the field of automated cell biology. Moreover, the term does not create an incongruous or creative or unique mark. Rather, applicant's mark, AUTOMATED CELL, when used in connection with applicant's identified services, immediately describes, without need of conjecture or speculation, the nature of applicant's services, as discussed above. 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 services to readily

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<sup>2</sup> In addition, applicant argued for the first time in its brief on appeal referencing a patent and arguing that applicant's services are "based on U.S. Patent No. 6,008,010 (a technique for analyzing an individual cell over time)" (brief, p. 3). The Examining Attorney objected to applicant's reference to a patent as untimely offered evidence, and if the objection was overruled, the Examining Attorney alternatively offered photocopies of a few pages from Patent No. 6,008,010. We agree with the Examining Attorney that the reference to a patent for the first time in its brief is untimely. Accordingly, pursuant to Trademark Rule 2.142(d), this argument by applicant has not been considered.

perceive the merely descriptive significance of the phrase AUTOMATED CELL as it pertains to applicant's services. See *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792 (TTAB 1996); and *In re Time Solutions, Inc.*, 33 USPQ2d 1156 (TTAB 1994).

Finally, we find that here the phrase unquestionably projects a merely descriptive connotation, and we believe that competitors have a competitive need to use this term. See *In re Tekdyne Inc.*, 33 USPQ2d 1949, 1953 (TTAB 1994), and cases cited therein. See also, 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:18 (4th ed. 2000).

**Decision:** The refusal to register on the ground that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act is affirmed.