

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

1/12/01

Hearing:
September 21, 2000

Paper No. 20
EJS

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Manhattan Scientifics, Inc.**

Serial No. 75/478,091

James C. Wray for Manhattan Scientifics, Inc.

Heather D. Thompson, Trademark Examining Attorney, Law Office 103 (Michael A. Szoke, Managing Attorney)

Before Seeherman, Walters and Holtzman, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Manhattan Scientifics, Inc. has applied to register GREEN CELL as a trademark for "fuel cells, fuel cell fuel tanks, and fuel cell fuel."¹ Registration was finally refused on two bases: that the mark is merely descriptive of applicant's identified goods, and is therefore prohibited from registration by Section 2(e)(1) of the

¹ Application Serial No. 75/478,091, filed April 30, 1998, asserting a bona fide intention to use the mark in commerce.

Trademark Act, 15 U.S.C. 1052(e)(1); and that the identification of goods is indefinite.

Applicant has appealed. The appeal was fully briefed,² and applicant and the Examining Attorney appeared at an oral hearing before the Board.

We turn first to a consideration of the identification of goods. On July 20, 1999, in response to the final Office action requiring an acceptable identification of goods, applicant requested an interview with the Examining Attorney and indicated that the identification could be amended to add the phrase "for use in connection with fuel cells, in Class 9" if that would make the identification

² In its reply brief applicant claims that because the Examining Attorney first set out quotes from certain articles taken from the NEXIS data base in her brief, "those elements are new grounds of rejection presented in the Appeal Brief and should not be considered by the Board." (p. 1.) Applicant's position is incorrect. The Section 2(e)(1) ground for refusal to which the NEXIS excerpts pertain was first raised in the initial Office action and was reiterated in the second action and in the final Office action. Further, the articles were properly made of record with the second Office action. Accordingly, they have been considered.

It is also noted that applicant, in its July 20, 1999 response to the final Office action, stated that the "request for an amendment to a new description of goods raises a new issue that makes the final refusal to register premature." However, the requirement for an acceptable identification of goods was made in the April 5, 1999 Office action, at which point the Examining Attorney specifically noted that this raised a new issue, such that the action was non-final. The Examining Attorney repeated and made final the requirement for an acceptable identification of goods in the May 25, 1999 Office action, and therefore the final action was not premature.

acceptable. Following a telephone interview, the Examining Attorney issued an Office action indicating that applicant could adopt as an identification, "fuel cells and fuel cell tanks for producing electrical energy; fuel cell chemical fuel provided as a unit with the foregoing." Applicant did not respond to this suggestion, and instead filed its notice of appeal. In its appeal brief applicant again stated that the amendment it offered in its July 20, 1999 response could be made, i.e., the addition of the phrase "for use in connection with fuel cells, in Class 9," if that were acceptable. The Examining Attorney, in her brief, stated that this proposed amendment is still unacceptable.³

The basis for the Examining Attorney's objection to the identification of goods, "fuel cells, fuel cell fuel tanks, and fuel cell fuel" or, if we assume that applicant's amendment is not conditional, "fuel cells, fuel cell fuel tanks, and fuel cell fuel for use in connection

³ Inexplicably, applicant states in its reply brief, at p. 3, that "the Examining Attorney has not commented on that offer." It should be noted that the proper procedure, if applicant wished to amend its identification at the time of filing its appeal brief, would have been to file a request for suspension of the appeal and remand of the application to the Examining Attorney to consider the proposed amendment. However, because the Examining Attorney considered and rejected the amendment in her brief, applicant's failure to follow proper procedure had no effect on the present case.

with fuel cells, in Class 9," is that the identification is indefinite because the goods may fall into more than one class. Applicant has focused its argument in showing that its goods should be in only one class.

However, although it is possible for applicant's goods to be classified in a single class, as the Examining Attorney's suggested identification shows, because of the manner in which the goods are presently identified, the goods could fall in more than one class. The addition of the phrase "in Class 9" to the identification does not serve to change a Class 4 good, "fuel cell fuel" into a Class 9 item. One cannot define one's goods merely by indicating the class number, since that would not provide adequate notice to the public, which is not always privy to the class number. The Examining Attorney indicated that fuel cell fuel and fuel cell tanks would fall into Class 9 if each of these items were sold as a unit with the fuel cells which are classified in Class 9. We have no explanation as to why applicant chose not to accept the Examining Attorney's suggestion. To the extent that applicant rejected it because it intends to sell fuel cell fuel separately, that would clearly show that its current identification is unacceptable because its goods fall, inter alia, in Class 4. Accordingly, because the

identification of goods is indefinite and encompasses goods in more than one class, the requirement for an acceptable identification is affirmed.

The second basis for refusal is that applicant's mark GREEN CELL is merely descriptive of fuel cells and related components. In support of this refusal, the Examining Attorney has made of record dictionary definitions, as follows:

Fuel cell: an electrochemical cell in which the energy of a reaction between a fuel, such as liquid hydrogen, and an oxidant, such as liquid oxygen, is converted directly and continuously into electrical energy.⁴

Cell: *Electricity.* A single unit for electrolysis or conversion of chemical into electric energy, usually consisting of a container with electrodes and an electrolyte. Also called *electrochemical cell*.⁵

Green: concerned with or supporting protection of the environment as a political principle⁶; supporting or concerned with the conservation of the environment, especially as a political issue; environmentalist, ECOLOGICAL. Hence also (of a product, a process, etc.) not harmful to the environment; environment-friendly⁷;

⁴ The American Heritage Dictionary of the English Language, 3d ed. © 1992.

⁵ The American Heritage Dictionary of the English Language, 3d ed. © 1992.

⁶ The Oxford Dictionary and Thesaurus, American ed. © 1996.

⁷ The Oxford Dictionary of New Words, © 1992.

environmentally sound or beneficial:
*green computers.*⁸

The Examining Attorney has also submitted a large sample of the results of a search of the NEXIS data base in which the word "green" is used in connection with the term "fuel cell." Eighty-seven stories were retrieved by the search, and the Examining Attorney made of record 41 of them, including the following:

...all-electric vehicles of today and tomorrow's ultimate green car—which probably will be powered by a fuel cell that chemically converts gasoline or hydrogen into electricity without combustion.
"Business Week," February 8, 1999

Watch for still more "green cars" - powered by electricity, fuel cells and other clean energy sources...
"Newsday," January 17, 1999

...it also wants more collaboration with other companies on such "green" technologies as fuel cells. The environment is every company's business, Okuda said, calling on other automakers to create a global association aimed at improving the environment.
"The Plain Dealer," January 17, 1999

Instead of fulfilling the clean-and-green fuel-cell dream, in which superefficient, zero-polluting vehicles would hit the road...
"Newsweek," December 14, 1998

⁸ Random House Unabridged Dictionary, 2d ed., addendum, © 1993.

Can electric, hybrid, or fuel cell vehicles be built in quantities that make money? If "green" vehicles are light enough to reduce emissions that satisfy pollution regulators, would they be heavy enough for the safety regulators?

"The Detroit News," November 22, 1998

The push to bring fuel cell technology as well as other green energy solutions to the commercial marketplace is praiseworthy.

"Fleet Owner," November 1998

Among the green technologies automakers are considering:

Fuel cells, which convert hydrogen into electricity to power a vehicle and yield water vapor as the only by-product.

"The Detroit News," September 29, 1998

No longer strictly space-age technology, fuel cells are poised to take their place as a significant factor in the electric utility equation. Fuel cells are environmentally clean, quiet, and efficient. Called the "Great Green Hope" is a New York Times headline, proponents claim that the fuel cell has the potential to help decentralize the power industry, protect the environment, reduce dependence on fossil fuels...

"Energy User News," September, 1998

Because the fuel cells are considered "green energy" producers, the state has pledged \$958,000 in funding.

"Ventura County Star," August 12, 1998

For fuel cells, the slim advantage provided by deregulation plans is that some states, such as Connecticut, have specifically included fuel cells in

their list of acceptably "green"
generation technologies.
"Electrical World," July 1998

Its capacity of 72 megawatts eclipses
the 11 megawatts of other non-hydro
green sources—solar, wind and fuel
cells.
"Sacramento Bee," May 22, 1998

The merger of Chrysler with German's
Daimler-Benz will hasten development of
"green" cars powered by efficient fuel
cells that extract hydrogen from liquid
fuels...
"The Houston Chronicle," May 15, 1998

The great green dream of replacing the
petroleum-powered internal combustion
engine is hydrogen fuel cells.
"The Cincinnati Enquirer," April 18,
1998

...a small company in Burnaby, near
Vancouver, British Columbia, that is
bringing to market what many consider
the hottest green technology in the
transportation field: the hydrogen
fuel-cell engine.
"Automotive News," February 23, 1998

A term is merely descriptive, and therefore prohibited
from registration by Section 2(e)(1) of the Trademark Act,
if it immediately conveys knowledge of the ingredients,
qualities, or characteristics of the goods with which it is
used. **In re Gyulay**, 820 F.2d 1216, 3 USPQ2d 1009 (Fed.
Cir. 1987). The question is not decided in a vacuum, but
in relation to the goods on which, or the services in

connection with which, it is used. **In re Venture Lending Associates**, 226 USPQ285 (TTAB 1985).

The evidence submitted by the Examining Attorney shows that GREEN has the meaning of environmentally friendly. We note that in its brief applicant argued that the definition of "green" as meaning environmentally friendly is obscure, and asserted that Webster's Third New International Dictionary does not include such a definition. Applicant further argued that the word "green," as used in applicant's mark GREEN CELL, referred to just the color. However, the articles submitted by the Examining Attorney amply demonstrate that "green" is used to indicate that products are environmentally friendly. Although "green" may not have had this meaning when the Webster's dictionary cited by applicant was published in 1976, the newer dictionaries made of record by the Examining Attorney, and the NEXIS evidence, show that "green" has this meaning today, and that there has been widespread public exposure to it. Moreover, at the oral hearing, applicant's attorney conceded that "green" means environmentally friendly. Certainly, in the context of a fuel cell and fuel cell fuel, it is this meaning that would be ascribed to the word, rather than that of the color.

At the oral hearing applicant's attorney also conceded that "cell" is an equivalent term for fuel cell. Thus, applicant has acknowledged the descriptive meanings of the individual words. However, applicant asserts that when these words are combined in the mark GREEN CELL, the mark as a whole is not merely descriptive.

We are not persuaded by this argument. The two words, combined as the mark GREEN CELL, immediately tell consumers that the product is an environmentally friendly (GREEN) fuel cell.⁹ No imagination, thought or perception is required to reach this conclusion. Simply because applicant characterizes the combination as a fanciful mark does not make it so. The mark GREEN CELL is merely descriptive of fuel cells, one of the items in applicant's identification of goods, and therefore prohibited from registration by Section 2(e)(1).

In reaching this conclusion we have noted applicant's argument that because the Examining Attorney was unable to

⁹ As noted above, applicant has conceded that CELL is an equivalent term for "fuel cell." Even without that concession, GREEN CELL is merely descriptive even though it does not include the additional explanatory word "fuel." The word FUEL would be readily understood in the context of the mark and the goods. See, **In re Abcor Dev. Corp.**, 588 F.2d 811, 200 USPQ 215 (CCPA 1978) (GASBADGE generic for gas monitoring badge); **DeWalt, Inc. v. Magna Power Tool Corp.**, 289 F.2d 656, 129 USPQ 275 (CCPA 1961) (POWER SHOP a short form of "power workshop" and merely descriptive of woodworking saws).

find any use of the term "green cell" per se in her search of the NEXIS data base, this shows that the term is not in common use. However, in order to show that a mark is merely descriptive it is not necessary to show that others are using it. It is well-established that a term may be merely descriptive even if the applicant is the first or is the only entity currently using it. See **In re Pennzoil Products Co.**, 20 USPQ2d 1753 (TTAB 1991). As indicated above, consumers seeing the mark GREEN CELL in connection with fuel cells would immediately understand the nature of the fuel cells, namely that they help, or are not harmful to, the environment. Accordingly, the mark is merely descriptive of applicant's goods.

Decision: The refusal based on the ground that the mark is merely descriptive is affirmed; the refusal based on the requirement for an acceptable identification of goods is affirmed.¹⁰

¹⁰ Because in both the August 23, 1999 Office action and her brief the Examining Attorney has indicated an identification of goods which would be acceptable, applicant could, if it wished to adopt this identification, file a petition to the Commissioner to reopen prosecution with respect to this particular refusal.