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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re IdaTech, LLC

Serial No. 76369815

David S. D'Ascenzo of Kolisch Hartwell, P.C. for IdaTech, LLC.

Carolyn Pendleton Cataldo, Trademark Examining Attorney,
Law Office 103 (Michael Hamilton, Managing Attorney).

Before Hanak, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On February 11, 2002, IdaTech, LLC (an Oregon limited liability company, located in Bend, Oregon) filed an application to register the mark ADVANCED FUEL CELL SOLUTIONS on the Principal Register for the following goods (as amended), and services:

"electrical power generation equipment, namely, fuel cells, proton exchange membrane fuel cells, fuel cell stacks, fuel cell conversion components, fuel cell integrators, and electrical power

management modules, namely, power inverters, power converters, power conditioners, power controllers and load regulators; fuel cell systems and components for stationery and portable electric power generation comprised of fuel cell stacks, fuel processors, fuel cell integrators and electrical power management modules, namely, power inverters, power converters, power conditioners, power controllers and load regulators" in International Class 9;

"hydrogen-generation equipment and components, namely, hydrogen generators, hydrogen purifiers, hydrogen purification membranes, fuel processors, and steam reformers" in International Class 11;

"custom manufacture of hydrogen-generation and electrical-power-generation products and equipment, namely, fuel processors, steam reformers, fuel cells, fuel cell stacks, hydrogen generators, hydrogen purifiers, hydrogen purification membranes, electrical power management modules, namely, power inverters, power converters, power conditioners, power controllers and load regulators" in International Class 40; and

"design for others of hydrogen-generation and electrical-power-generation products and equipment, namely, fuel processors, steam reformers, fuel cells, fuel cell stacks, hydrogen generators, hydrogen purifiers, hydrogen purification membranes, electrical power management modules, namely, power inverters, power conditioners, power converters, power controllers and load regulators; scientific research, design and product development for others" in International Class 42.

The application is based on applicant's assertion of a bona fide intention to use the mark in commerce on or in connection with the identified goods and services. Applicant has offered a disclaimer of the words "fuel cell," but this has been rejected by the Examining Attorney.

The Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that the mark ADVANCED FUEL CELL SOLUTIONS, when used on or in connection with the goods and services of applicant, is merely descriptive of them.

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.

The Examining Attorney contends that the proposed mark merely describes a primary function, purpose, use, feature or characteristic of applicant's various fuel cell goods and services; that the wording "fuel cell solutions" is recognized as referring to fuel cell technology--a more efficient energy system for generating heat and electricity, and thus, those words describe the purpose or a primary characteristic of applicant's goods and services; that the relevant meaning of the term "advanced" in the context of applicant's goods and services is "highly

developed or complex," and for the word "solutions" the relevant meaning is "the method or process of solving a problem, the answer to or disposition of a problem"; and that the mark, considered as a whole, immediately conveys that applicant's goods and services provide customers with highly developed or advanced solutions in the fuel cell industry. The Examining Attorney offers as an alternative argument, that applicant has conceded the term "fuel cell" is merely descriptive by offering a disclaimer thereof; that when the words "advanced" and "solutions" are considered in connection therewith, the entire phrase ADVANCED FUEL CELL SOLUTIONS describes a feature, function and characteristic of applicant's goods and services; and that the combination of descriptive terms does not create a unitary mark with a separate, non-descriptive meaning.

In support of the refusal, the Examining Attorney submitted the following definitions from The American Heritage Dictionary (Third Edition 1992):

- (1) "**advanced** adjective 1. Highly developed or complex. 2. Being at a higher level than others: an advanced text in physics. 3. Ahead of the times; progressive: advanced teaching methods. 4. Far along in the course of time: an advanced stage of illness; a person of advanced age."; and

- (2) "**solution** noun 1. a. A homogenous mixture of two or more substances, which may be solids, liquids, gases or a combination of these. b. The process of forming such a mixture. 2. The state of being dissolved. 3. a. The method or process of solving a problem. b. The answer to or disposition of a problem. 4. Law. Payment or satisfaction of a claim or debt. 5. The act of separating or breaking up; dissolution."

The Examining Attorney also submitted (i) printouts of several excerpted stories retrieved from the Nexis database to show that "applicant provides highly complex, or advanced, custom manufacture and design of hydrogen-generation and electrical power generation products for fuel cell solutions" (first Office action, unnumbered p. 2); and (ii) two sets of third-party registrations covering a wide variety of goods and services,¹ wherein either the word "advanced" or the word "solution(s)" is disclaimed. Examples of the excerpted stories retrieved from the Nexis database are set forth below (emphasis in excerpts):

Headline: Statoil, Methanex, NPS to
Study Fuel Methanol

¹ The third-party registrations do not cover the goods and services involved herein, but cover, for example, telecommunication services, namely,...; legal services...; computer services, namely,...; leasing of office equipment,...; retouching of artwork...; manual airfield lighting control panels...; mail processing, namely,...; educational services, namely,...; non-metal swimming pools; motorcycle engine valves,...; hosting the web sites of others on computer servers...; physical therapy and rehabilitation services.

The tripartite fuel-cell venture embraces two pilot projects and aims primarily to establish the suitability of such **fuel cell solutions** for households.

Several homes in the town of Bend, Oregon, are being disconnected from the electricity grid and fitted with methanol-based fuel cells capable of generating both heat and electricity. The second pilot project will employ methanol reformer technology... "Today's Refinery," December 1999;

Headline: 100-kW System Moved, Restarted

...Fuel cells will play an important role within the development. RWE aims to provide **fuel cell solutions** for its various customer groups and is investing in a broad range of research and development activities. ..., "Fuel Cell Technology News," September 2001;

Headline: Politics and Oil a Toxic Mix
The way out of this mess in the long-term is to change U.S. energy policy, with an emphasis on energy conservation and with aggressive investment in alternative fuels, including expeditious research and development toward a **fuel-cell solution** for the transportation sector. The energy goal ought to be to reduce America's dependency on foreign sources of oil so that the nation's consumers are no longer held captive by Big Oil marketing strategies or the whims of the Organization of Petroleum Exporting companies... "The Oregonian," September 23, 2000;

Headline: Gas Executives' Forum:
Gas.Com Inc? A Smokestack Industry Faces the E-Future...

...where we become the aggregator of solutions and services and market

access for fuel cells and distributed generation. We have gone as far as reserving our domain names and locking those down to be one of the premier sites of managing the market space and information around **fuel cell solution** services, as well as distributed generation. ..., "Utilities Fortnightly," April 15, 2000; and

Headline: Sixth Grove Fuel Cells Symposium

...stations and vehicles are both major contributors of "greenhouse gases" ([CO.sub.2] and also [NO.sub.x]) to atmosphere. In addition to the supply of electric power to homes, domestic and municipal space heating is a further major generator of greenhouse emissions. **Fuel cell solutions** to all of these dilemmas are not so much just round [sic] the corner, they are practically here now.

Fuel cells are inherently much more efficient energy converters than gas turbine power generators based on fossil fuels and give off far less... "Nitrogen & Methanol," November 1, 1999.

Finally, the Examining Attorney later submitted one excerpted story retrieved from the Nexis database "in which the phrase 'advanced fuel cell solutions' is used." (Denial of applicant's request for reconsideration, unnumbered p. 2.) It is reproduced below (emphasis in excerpted story):

Headline: IdaTech Debuts Commercial Model

...Demonstrating its commitment to customer service, IdaTech offers a comprehensive service package,

including engineering and support services to development partners working with the fuel processor module. IdaTech continues to expand its product offering through the development of **advanced fuel cell solutions** for a variety of applications. Combining its family of fuel processors with a variety of PEM fuel cell modules, Ida Tech develops fully integrated systems with outputs ranging from 1 kW to 5 kW. ..., "Fuel Cell Technology News," September 2002.

Applicant acknowledges that the term "fuel cell" has a descriptive meaning,² and applicant is not asserting that its mark is arbitrary or fanciful. (Brief, p. 3).

However, applicant argues that its mark does not merely and immediately describe its identified goods and services; and that "the mark possesses sufficient suggestiveness for registration on the Principal Register" (brief, p. 3).

Applicant argues that the terms "advanced" and "solutions" have a variety of meanings, even within the context of applicant's goods and services; that none of the many meanings of either term is specifically or immediately directed to or associated with applicant's goods and services; that these terms have no immediate or specific

² As explained previously, applicant offered a disclaimer of the words "fuel cell," but this was not accepted by the Examining Attorney. In light of our decision on the issue of mere descriptiveness, the Board accepts applicant's disclaimer of the words "fuel cell," and the disclaimer has been entered in the application file.

meaning and are "not merely descriptive of [applicant's] hydrogen- and power-generation goods and services" (brief, p. 7); and that therefore, the terms "advanced" and "solutions" are each only suggestive of the involved goods and services.

Specifically citing the cases of *In re Hutchinson Technology*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988); *In re Automatic Radio Mfg. Co., Inc.*, 404 F.2d 1391, 160 USPQ 233 (CCPA 1969); and *In re Intelligent Medical Systems Inc.*, 5 USPQ2d 1674 (TTAB 1987); applicant contends as follows:

"the terms 'advanced' and 'solutions' are such broad terms that they are not capable of merely describing the goods or services for which they are used. This decision is reinforced when these terms are used together, with a composite mark containing both of these terms being more suggestive, or requiring more thought or imagination, than a mark containing only a single one of these words." (Brief, p. 4.)

Applicant also contends that there are numerous registrations containing examples of analogous marks in which the terms "advanced" or "solutions" are not disclaimed.³ With regard thereto, applicant argues the

³ Applicant had submitted printouts from the USPTO's Trademark Electronic Search System (TESS) database of several registrations on the Principal Register without disclaimers of the words "advanced" or "solutions" (e.g., DELIVERING ADVANCED MARKETING SOLUTIONS for "computer software and programs for use in the

prior registration practice of the USPTO demonstrates that these two terms are more suggestive than descriptive, and specifically arguing the following (brief pp. 8-9):

While neither Applicant's citations nor the Examining Attorney's citations are dispositive of the issue at hand, they still merit some consideration when determining the registrability of Applicant's ADVANCED FUEL CELL SOLUTIONS mark. Applicant submits that the relative volume of these marks is particularly compelling, with the vast majority of registered marks that contain either or both of these terms being Principal register registrations in which the terms are not disclaimed.

In its reply brief, applicant contends that the refusal to register is not sufficiently supported by evidence, particularly in light of the case law previously cited by applicant; that the Examining Attorney argues the mark should not be dissected into its individual terms when considering mere descriptiveness, but she then proceeds to argue that each term is merely descriptive and that collectively the composite mark is also merely descriptive;

field of advertising...," and "marketing and advertising services, namely,..."; ADVANCED SOLUTIONS FOR TODAY'S NEEDS for "installing, retrofitting and maintaining services for others in the field of integrated interactive home wiring network and hub for..."; ADVANCED TECHNOLOGY. ADVANCED SOLUTIONS for "medical and surgical gloves"; and ADVANCED AIR SOLUTIONS ("air" disclaimed) for "air purifying units for commercial, domestic and industrial use." (Obviously, like those submitted by the Examining Attorney, none of these third-party registrations are for the same or related goods and services as those involved in the application now before us.)

and that the cases cited by the Examining Attorney are distinguishable as all involve composite marks comprised entirely of merely descriptive or even generic terms that represent the common commercial names of the goods or services at issue or components thereof.⁴

A mark is merely descriptive if it "forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]." *Abercrombie & Fitch Company v. Hunting World, Incorporated*, 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976) (emphasis added). See also, *In re Abcor Development Corporation*, 616 F.2d 525, 200 USPQ 215 (CCPA 1978). Moreover, in order to be merely descriptive, the mark must immediately convey information as to the ingredients, qualities or characteristics of the goods or services with a "degree of particularity." See *In re TMS Corporation of the Americas*, 200 USPQ 57, 59 (TTAB

⁴ The Examining Attorney relied on the following cases on this point: *In re Tower Tech Inc.*, 64 USPQ2d 1314 (TTAB 2002)(SMARTTOWER merely descriptive of commercial and industrial cooling towers and accessories therefor, sold as a unit); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001)(AGENTBEANS merely descriptive of computer software for use in the development and deployment of application programs on the Internet); *In re Putnam Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996)(FOOD & BEVERAGE ON-LINE merely descriptive of a news and information service contained in a database updated daily for the food processing industry); *In re Copytele Inc.*, 31 USPQ2d 1541 (TTAB 1994)(SCREEN FAX PHONE merely descriptive of facsimile terminals employing electrophoretic displays); and *In re Entenmann's Inc.*, 15 USPQ2d 1750 (TTAB 1990)(OATNUT merely descriptive of bread), *aff'd unpub'd*, Fed. Cir., February 13, 1991.

1978); and In re Entenmanns Inc., supra, 15 USPQ2d at 1751. Further, it is well established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, 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).

The Examining Attorney bears the burden of showing that a mark is merely descriptive of the identified goods or services. See In re Merrill, Lynch, Pierce, Fenner, and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

It has long been acknowledged that there is often a very narrow line between terms which are merely descriptive and those which are suggestive, and the borderline between the two is hardly a clear one. See In re Atavio Inc., 25 USPQ2d 1361 (TTAB 1992). We find this to be a particularly close case.

The terms "advanced" and "solutions" are both general, vague terms, and each term has several meanings, more than one of which could relate to the identified goods and services herein. Moreover, these terms are very broad in

scope and could include many categories of goods and services. See *In re Hutchinson Technology*, supra. Neither term ("advanced" or "solutions") conveys an immediate idea of the specific identified goods and services (electrical power generation equipment, electrical power management modules, fuel cell systems and components for stationery and portable electric power generation; hydrogen-generation equipment and components; design of and custom manufacture of hydrogen-generation and electrical-power-generation products and equipment; and scientific research, design and product development for others). The wide-breadth and general nature of these terms would require a mental pause and thought that renders the terms suggestive rather than merely descriptive of applicant's identified goods and services.

Likewise, the entire mark, ADVANCED FUEL CELL SOLUTIONS, does not immediately impart with any "degree of particularity" and without the exercise of some degree of thought or imagination, information about these hydrogen- and electrical-power generation goods and services. The mark, as a whole, may be seen by consumers as relating to an "advanced fuel cell" and how it becomes a "solution" to various problems requiring a power source; or it may be seen, as shown by the Examining Attorney, as "advanced" or

highly developed and complex as that concept relates to "fuel cell solutions." Even if consumers see the mark as the Examining Attorney presents it -- "advanced" and "fuel cell solutions," the excerpted stories retrieved from the Nexis database submitted by the Examining Attorney showing uses of "fuel cell solutions" do not generally provide any information about the specific goods and/or services being written about, except that they involve fuel cells. Thus, the excerpted articles do not prove that the phrase "fuel cell solutions" immediately conveys information about the features, characteristics or purposes of the goods and/or services being discussed. The only use of "advanced fuel cell solutions" of record is an excerpted story retrieved from the Nexis database which clearly refers to applicant. The fact that in this single use by a journalist (or even if the story was based on a press release by applicant) the words are not capitalized or in some way indicate that applicant is claiming trademark and service marks rights in the mark is not dispositive. See *In re First Union National Bank*, 223 USPQ 278 (TTAB 1984).

With regard to the third-party registrations, neither those submitted by the Examining Attorney which include disclaimers of the terms "advanced" and/or "solutions," nor those few submitted by applicant without disclaimers of

those terms relate to the goods and services involved herein. In general, we acknowledge that the treatment of each of the terms "advanced" and "solution(s)" by the United States Patent and Trademark Office has been mixed. Nonetheless, we have no evidence regarding the prior registration practice of the USPTO regarding the terms "advanced" and "solutions" when used on the involved or closely related goods and services.

This record does not establish that the mark ADVANCED FUEL CELL SOLUTIONS as a whole is merely descriptive of the identified goods and/or services. See *Bose Corp. v. International Jensen Inc.*, 963 F.2d 1517, 22 USPQ2d 1704 (Fed. Cir. 1992); *In re Classic Beverage Inc.*, 6 USPQ2d 1383 (TTAB 1988); and *Manpower, Inc. v. The Driving Force, Inc.*, 212 USPQ 961 (TTAB 1981), *aff'd* 538 F.Supp. 57, 218 USPQ 613 (EDPA 1982). That is, based on the record now before us, it has not been established that applicant's mark, when used on or in connection with its goods and services recited above, conveys an immediate idea about the goods and/or services with any degree of particularity. The significance of the mark and specifically what it describes about the goods and/or services, when applied to the goods or used in connection with the services, is ambiguous.

Finally, the Board has noted many times that if there is doubt about the "merely descriptive" character of a mark, that doubt is resolved in applicant's favor, allowing publication of the mark so that any third party may file an opposition to develop a more comprehensive record. See *In re Atavio*, supra; and *In re Gourmet Bakers Inc.*, 173 USPQ 565 (TTAB 1972).⁵

Decision: The refusal to register under Section 2(e)(1) of the Trademark Act is reversed.

⁵ In addition, we note that this application is based on applicant's assertion of a bona fide intention to use the mark in commerce, and that there are no specimens or any other evidence to show how applicant plans to or is using the involved mark. Applicant noted (brief, p. 10) that it has commenced use of the mark. If this application is either not opposed or survives any opposition(s), and if applicant ultimately submits a Statement of Use, the Examining Attorney is free to re-examine the application with respect to the issue of mere descriptiveness if applicant's specimens of use so warrant.