

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed:October 30, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

In re Hella KGaA Hueck & Co.

---

Serial No. 79018209

---

Robert C. Haldiman of Husch Blackwell Sanders LLP, for  
Hella KGaA Hueck & Co.

Daniel Capshaw, Trademark Examining Attorney, Law Office  
110 (Chris A. F. Pedersen, Managing Attorney).

---

Before Seeherman, Taylor, and Ritchie de Larena,  
Administrative Trademark Judges.

Opinion by Ritchie de Larena, Administrative Trademark  
Judge:

Hella KGaA Hueck & Co., applicant herein, seeks  
registration on the Principal Register of the mark "BI-  
XENON," in standard character format, for "lighting devices  
for motor vehicles, namely, headlamps, lamps and  
switchgears thereof," in International Class 11.<sup>1</sup> The  
trademark examining attorney refused registration on the

ground that applicant's mark is merely descriptive of the identified goods under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). Applicant appealed the final refusal. Both applicant and the examining attorney filed briefs. After careful consideration of all of the arguments and evidence of record, we affirm the refusal to register.

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *See, e.g., In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593

---

<sup>1</sup> Serial No. 79018209, filed on September 15, 2005, under Trademark Act Section 66(a), 15 U.S.C. §1141f(a).

(TTAB 1979). Moreover, it is settled that "[t]he 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. *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); *See also In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985).

The examining attorney submitted evidence of dozens of Internet articles, advertisements, and car reviews showing that the term "bi-xenon" is used to describe a type of headlamp for motor vehicles. A sampling of this evidence includes the following web excerpts:

"Glossary - Bi-Xenon: Bi-xenon headlamps use a single xenon lamp to produce both the high beam and the low beam. The full light output is used to produce the high beam, while the low beam is formed by moving a shutter between the bulb and the lens, thus blocking off a portion of the light." *Land Rover Glossary*.

"Bi-xenon headlamps: Xenon headlamps use xenon gas and metallic salts to create light. An electrically generated arc replaces the filament used in conventional light bulbs

. . . This technology produces twice the light output of a halogen bulb . . ." *Carlist.com Glossary*.

"Development of the bi-xenon lights: Saab worked closely with lamp supplier Valeo to develop the necessary performance required by a Saab engineer." *The Saab Network, www.saabnet.com*.

"HID Xenon Headlamp Conversion Kits BIXENON LOW and HIGH BEAM for H4 bulbs" *ucables.com*.

"Mercedes E-class sedan just feels right: . . . Active Curve bi-xenon headlights (a \$900 option) improve illumination by as much as 90 percent, compared to fixed halogen lights, . . ." *The San Diego Union Tribune, October 22, 2005*.

Applicant argues that the examining attorney's evidence is inapposite. In particular, applicant submitted a declaration from its Chief Intellectual Property Counsel, Juergen Meyer, asserting that applicant has licensed its mark to auto makers Porsche, Land Rover, and Saab. Apparently applicant takes the position that the uses of "bi-xenon" in the web excerpts refer to its own products. However, whether or not the references are to applicant's goods (and we note that the declaration makes no mention of a license to the maker of Mercedes, described in a review as having "bi-xenon headlights"), the manner in which the

term in used is not as a trademark, but as a description of a type of headlamp.

We find that applicant's arguments and evidence do nothing to rebut the evidence submitted by the examining attorney that the relevant public understands the term "BI-XENON" to refer to a feature or characteristic of applicant's goods. See *In re Gyulay*, 3 USPQ2d at 1009; *In re Abcor Development Corp.*, 200 USPQ at 217-18. In particular, no imaginative step is required for consumers to understand "bi-xenon" as descriptive of a type of headlamp, i.e., "a single xenon lamp to produce both the high beam and the low beam," as described by applicant's own licensee.

In sum, it is clear that a consumer would understand "BI-XENON" used in connection with applicant's goods as conveying information about them. Therefore we find that the mark is merely descriptive of the identified goods.<sup>2</sup> See *In re Tower Tech Inc.*, 64 USPQ2d at 1316-17. Accordingly, we affirm the refusal to register.

---

<sup>2</sup> We note that applicant has argued that people recognize the term "BI-XENON" as referring to its products. Such an argument would be appropriate to a claim that the mark has acquired distinctiveness. However, applicant has not sought registration pursuant to the provisions of Section 2(f) of the Trademark Act, and therefore such arguments, or evidence in connection therewith, have no relevance to our determination herein.

Ser. No. 79018209

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