

In response to the Official Communication from the Trademark Trial and Appeal Board (hereinafter "Board") dated September 15, 2004, regarding the refusal by the Trademark Examining Attorney to reconsider the January 29, 2004 final refusal to register the proposed mark in the above-identified trademark registration application, Applicant hereby requests the Board to reinstate the appeal proceeding in this application.

The Appeal Brief, as filed with the Board on May 14, 2004, is hereby resubmitted under the provisions of 37 CFR §2.142(b)(1), in support of the Notice of Appeal filed on May 13, 2004 with the Trademark Trial and Appeal Board, appealing from the decision of the Trademark Examiner dated January 29, 2004 finally refusing to register the above-identified mark.

**I. Satisfaction of Requisites for Appeal**

This Brief is timely resubmitted within sixty days from the mailing date of the September 15, 2004 Official Communication of the Board.

In light of the withdrawal of the requirement for a more definite identification of goods by the Trademark Examination Attorney as stated in the August 31, 2004 Official Communication, all requirements made by the Examiner during the examination of the Appellant's trademark registration application have been complied with prior to the reinstatement of this appeal, and the record of the application is complete, in compliance with the requirements of 37 CFR §2.142.

**II. The Issue on Appeal**

The examining attorney has refused registration under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1) based on her contention that the mark “MICROCELL,” for which registration is sought, is merely descriptive of the identified goods.

The goods for which the mark is sought to be registered are “power source and energy supply devices, namely, fibrous fuel cells, fibrous batteries, and energy storage fuel cells, in International Class 9.”

The appertaining evidence and case law compel the conclusion that Appellant’s mark, “MICROCELL,” is a suggestive mark meriting registration.

### **III. Appellant’s Arguments for Registration of the Mark “MICROCELL”**

In the January 29, 2004 Office Action, the Examiner asserted that the mark “MICROCELL” is merely descriptive of the designated goods, on the basis that the term “micro” is merely descriptive of goods that are sold and produced in miniature form, citing *In re Tekdyne, Inc.*, 33 USPQ2d 1949 (TTAB 1995).

Appellant vigorously disagrees, for the following reasons:

First, the designated goods of the present application are “power source and energy supply devices, namely, fibrous fuel cells, fibrous batteries, and energy storage fuel cells.” Such fuel cells and batteries have a fibrous form. It is important to note that the term “fibrous” describes the form of an article, while the term “micro” describes the size of an article, and that a “fibrous” article is not necessarily “micro.”

Enclosed herewith in Appendix A is a picture of an illustrative fibrous fuel cell placed side by side with a pencil to show its macroscopic scale. Further enclosed herewith in Appendix B is a picture of another fibrous fuel cell manufactured by the Appellant placed side by side with a ruler. The fibrous fuel cells in both pictures are approximately twelve (12) to fifteen (15) inches long, which is **NOT small in size or “micro.”**

Additionally, fibrous fuel cells and batteries of the present application will be commercialized in various forms, such as those shown in Appendix C, which are approximately twelve (12) to fifteen (15) inches in length and six (6) to twelve (12) inches in diameter. Such fuel cell and batteries are **NOT miniature or “micro” in character.**

Therefore, it is clear that **the fuel cells and batteries to be commercialized by Appellant are not small in size; nor are they produced, used, or sold in miniature form. The term “micro” thus does not “merely” describe the designated goods of the present application.**

The present case is thus distinguishable on its facts from *In re Tekdyne, Inc.*, 33 USPQ2d 1949 (TTAB 1995), in which the term “MICRO-RETRACTOR” was found descriptive of small or miniature retractors.

In *In re Union Carbide Corp.*, 171 USPQ 510 (TTAB 1971), the Board specifically stated the descriptiveness of the term “MINI,” which would be recognized by the purchasing public and others as a designation commonly used to signify something small in size, must be assessed with consideration of whether or not the particular product involved is, in fact, produced and marketed in miniature form or size. **If the product is not of a type that is produced and encountered in**

the appropriate market place in miniature form, a designation consisting of the name of the goods modified by the word “MINI” can be suggestive of the size of the goods.

The Board held in *In re Brundage*, 180 USPQ 274 (TTAB 1973) that the mark “MINI-STORAGE” is not merely descriptive of Appellant’s storage and warehouse and the services provided thereto, because such storage and warehouse “are not miniature in size”; instead, such mark is suggestive as it conveys the suggestion that Appellant’s storage and warehouse facilities are of a “small” size. In *In re Champion International Corp.*, 178 USPQ 639 (TTAB 1973), the Board consistently held that the mark “MINITRIM” is suggestive instead of merely descriptive of Appellant’s moldings for rooms and furniture, because molding or trim is not produced or marketed in the trade in miniature form or size, and all that “MINITRIM” conveys is the suggestion that Appellant’s molding or trim is of a small size.

Such holdings by the Board regarding the descriptiveness of the term “MINI” equally applies to the term “micro” that is currently in issue, because both terms would be recognized by the purchasing public in a similar manner.

Therefore, the proposed mark “MICROCELL”, which consists of the name of the goods (i.e., “cell” for “fuel cell”) modified by the word “micro,” is suggestive rather than merely descriptive for the designated goods of the present application (i.e., fibrous fuel cells and batteries), which are not produced or sold in miniature form or size, consistent with the Board’s reasoning and decisions in the above-cited cases.

Thirdly, Appellant has conducted a search in the Trademark Database at the website of the United States Patent and Trademark Office, for third-party registrations containing the prefix

“micro,” and located more than one thousand hits in which there are numerous instances of such prefix used in combination with the name of the designated goods.

Specifically, set out below is a list of exemplary third-party registrations on the Principal Register that contain the prefix “micro” used in combination with the name of the designated goods:

Reg. No.	Mark	Goods and Services	Disclaimer
2828340	MICROHELIX	Coaxial wires, micro-coils, etc. (IC 009, 010, and 040)	None
2797949	MICRO MIXER	Kitchen utensil in the nature of a non-electrical plastic or silicone rubber mixing paddle used in connection with microwave ovens... (IC 021)	No claim is made to “Mixer”
2741907	MICRO AEROSOL	Dispensing unit for air fresheners and deodorizers (IC 011); Air fresheners and deodorizers (IC 005)	No claim is made to “Aerosol”
2648328	MICRO-MOLD	Plastic injection molding machines (IC007); metal molds, namely, thermoplastic injection molds (IC 006)	None
2611804	MICROGRID	Standalone power systems, namely, custom-engineered power systems that principally produce DC power for use local to the system (IC 007)	None
2591716	MICRO-TIP	Swabs and applicators for industrial or medical use (IC 003 and 005)	None
2574782	MICROIONSPRAY	Ion sources which ionize samples to be analyzed, for use in mass spectrometers (IC 009)	None
2427353	MICRO BUBBLES	Bubble blowing toys (IC 028)	No claim is made to “Bubbles”
2422094	MICROBATCH	Ovens for curing electronic components (IC 011)	None
2420344	MICROFIBRES	Fabrics for use in the manufacture of upholstered furniture sold to the upholstery industry (IC 024)	None



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