Hearing:
July 22, 2010

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August 27, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Corporate Fuel Partners, LLC

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Serial No. 78705685

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Timothy D. Pecsenye of Blank Rome LLP for Corporate Fuel Partners, LLC.

Maria-Victoria Suarez, Trademark Examining Attorney, Law Office 102 (Karen M. Strzyz, Managing Attorney).

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Before Zervas, Kuhlke and Taylor, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Corporate Fuel Partners, LLC, has filed an application to register as a trademark on the Principal Register the standard character mark CORPORATE FUEL for "business management and advisory services; consultation services in the fields of business succession planning,

sales of businesses, and acquisitions and mergers of businesses" in International Class 35.[1]

The examining attorney refused registration pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), based on applicant's failure to comply with the requirement to disclaim the word CORPORATE on the ground that it is merely descriptive of applicant's services within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1).

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a). Merely descriptive terms are unregistrable, under Trademark Act Section 2(e)(1) and, therefore, are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. See In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); In re Richardson Ink Co., 511 F.2d 559, 185 USPQ 46 (CCPA 1975); In re Ginc UK Ltd., 90 USPQ2d 1472 (TTAB 2007); In re National Presto

[1] Application Serial No. 78705685, filed on September 1, 2005, based on allegations of first use on July 15, 2004 and first use in commerce on August 15, 2004 under Trademark Act Section 1(a), 15 U.S.C. §1051(a).

Industries, Inc., 197 USPQ 188 (TTAB 1977); and In re Pendleton Tool Industries, Inc., 157 USPQ 114 (TTAB 1968).

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 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982); In re MBAssociates, 180 USPQ 338 (TTAB 1973).

It is the examining attorney's position that the term CORPORATE "describes the intended users of applicant's services and must be disclaimed." Br. p. 3. Further, she argues that the proposed mark CORPORATE FUEL is not a unitary mark such that a disclaimer is not necessary.

In traversing the refusal, applicant argues that:

> [T]he terms taken as a whole create a unique unitary phrase which does not merely convey knowledge of or describe Applicant's business

> consultation and financial services. As there is no such thing as "corporate fuel," Applicant's unusual combination of the adjective "CORPORATE" to modify the noun "FUEL" creates a coined phrase which has no specific meaning other than to playfully hint to Applicant's consumers that its services will provide the unique fuel or energy needed to launch them past their competitors. Thus, the unitary composite CORPORATE FUEL is a distinguishing mark even though its component "CORPORATE" individually may not be. ... Applicant ... combined the seemingly incongruous terms "CORPORATE" and "FUEL" to coin the phrase CORPORATE FUEL using the phrase to suggest that Applicant possesses the fictional FUEL that will keep its consumers moving forward in their fields. While diesel is a type of fuel, corporate certainly is not. Thus, notwithstanding the fact that purchasers of Applicant's services more or less recognize the dictionary meanings of "CORPORATE," the term "CORPORATE" in Applicant's mark serves an additional function as an arbitrary modifier of the term "FUEL" creating the fictional, CORPORATE FUEL. The fact that some of Applicant's consumers may be corporations is irrelevant. ... In this instance however the adjective "CORPORATE," is not merely descriptive as it is used to modify the incompatible noun "FUEL" thus becoming a salient feature of the unitary arbitrary phrase CORPORATE FUEL.

Br. pp. 9-11.

A mark is unitary if it creates a single, distinct commercial impression. If the matter that comprises the mark or relevant portion of the mark is unitary, no disclaimer of an element, whether descriptive, generic, or otherwise, is required. TMEP §1213.05 (6th ed. 2nd rev. 2010). See also Dena Corp. v. Belvedere International, Inc., 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991). The

commercial impression is determined by various factors, including the meaning of the terms in the mark in relation to each other. See Dena Corp., 21 USPQ2d 1047. Where a mark comprises two or more terms that create an incongruity the mark is unitary and no disclaimer is necessary.

The examining attorney argues that there is no incongruity because:

> [T]he term "incongruous" is defined as "not in keeping with what is [...] logical." There is nothing incongruous or illogical about applicant's mark. The addition of the wording "FUEL" does not change the descriptive meaning of the wording "CORPORATE." Again, applicant states in its brief that its mark "merely suggests applicant will provide its consumers with the fuel or energy needed to propel them past their competitors."

Br. p. 4 (citation omitted).

First, it is not necessary that the meaning of a term be changed in order for an incongruity to exist. See In re Hampshire-Designers, Inc., 199 USPQ 383, 384 (TTAB 1978) ("However, some of these same dictionary words may be used in association with words or terms so as to create a notation which, as a whole, serves to suggest the well-known significance of the term rather than describe with any degree of particularity some quality or characteristic of the goods in connection with which it is used. "DESIGNERS PLUS+" is such a notation. It suggests that

applicant's sweaters possess something more than a designer quality or characteristic, but what that is must necessarily rest with the imagination of the beholder. It is a unitary phrase, it has a unitary connotation, and it must be considered as such in determining its registrability"). One example of an incongruous mark provided in the Trademark Manual of Examining Procedure is URBAN SAFARI. TMEP §1213.05(d). The descriptive meaning of URBAN is not changed but the combination with something that is not associated with cities creates an incongruity. Similarly, here, with the mark CORPORATE FUEL, the meaning of CORPORATE (either as meaning the prospective consumers or the nature of the services) combined with something that is not associated with corporate customers or services, namely, FUEL, creates an incongruity.

Unlike the case in In re Taylor & Francis (Publishers), Inc., 55 USPQ2d 1213 (TTAB 2000) where the Board found that "the four words PSYCHOLOGY PRESS ALERE FLAMMUM make no sense as a single or unitary phrase," here the words CORPORATE FUEL do create a single unitary phrase that is the name of an imaginary thing. The word CORPORATE does not stand alone creating its own separate commercial impression. Rather, consumers would receive the phrase

CORPORATE FUEL as a play on actual types of fuel, like jet fuel or diesel fuel.

In view of the above, and considering that the registration of CORPORATE FUEL and the presumptions afforded registrations under Section 7(b) pertain to the mark as a whole rather than to its components, per se, and that the registration thereof cannot serve to preclude others from making fair use of the term CORPORATE in describing their services, the requirement for a disclaimer of CORPORATE is unnecessary. Hampshire-Designers, 199 USPQ at 384.[2]

Decision: The refusal to register based on the requirement for a disclaimer of CORPORATE is reversed.

[2] With regard to the third-party registrations submitted by applicant and the examining attorney to show that the USPTO has alternatively treated the word CORPORATE by sometimes requiring a disclaimer of the term and sometimes not requiring a disclaimer, the most that can be said of this evidence is that it is inconclusive. In fact, these registrations highlight why prior decisions in other applications are not binding on the Board and underscore the need to evaluate each case on its own record. In re Nett Designs Inc., 57 USPQ2d 1564.