

This Opinion is not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re New Energy Technologies, Inc.
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Serial No. 85673541
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John J. Dresch of Dresch IP Law PLLC,
for New Energy Technologies, Inc.

Linda E. Blohm, Trademark Examining Attorney, Law Office 110,
Chris A.F. Pedersen, Managing Attorney.

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Before Bucher, Wolfson, and Masiello,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

New Energy Technologies, Inc. (“Applicant”) seeks registration on the Principal
Register of the stylized mark depicted below:



The image shows a stylized trademark for "Motion POWER". The word "Motion" is in a bold, italicized, sans-serif font, and "POWER" is in a bold, all-caps, sans-serif font. Both words are white and set against a black rectangular background. The entire graphic is enclosed in a thin black border.

for “generators of electricity, namely, generators that generate electricity by capturing and converting kinetic energy into electricity,” in International Class 7.¹

The Trademark Examining Attorney has refused registration of Applicant’s mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), having determined that the applied-for mark merely describes the goods as “generators [that] utilize MOTION as a source to generate POWER.”² Registration was also refused on the ground of *res judicata*, based on the Board’s earlier affirmance of the refusal of the mark MOTIONPOWER (in standard characters) to Kinetic Energy Corporation, one of Applicant’s wholly-owned subsidiaries, on the ground of mere descriptiveness.³ Although in her Office Actions the Examining Attorney submitted evidence supporting the Section 2(e)(1) refusal, in her appeal brief she contends that the issue of descriptiveness of the literal portion of the applied-for mark has already been adjudicated, making the “sole issue” on appeal “whether or not the stylization of the applicant’s applied-for mark ‘MOTIONPOWER’ creates a commercial impression that is separate and distinctive so as to overcome the descriptive nature

¹ Application Serial No. 85673541 was filed on July 10, 2012, based on an allegation of Applicant’s *bona fide* intent to use the mark in commerce under Trademark Act § 1(b). There is a description of the mark that reads: “The mark consists of the word ‘Motion’ in light colored letters on a dark background followed by the word ‘Power’ in dark letters on a light background.” Color is not claimed as a feature of the mark.

² Office Action November 7, 2012.

³ *In re Kinetic Energy Corporation*, Serial No. 77707733 (TTAB May 31, 2011). The application in that case was for the following goods and services: “AC generators; electric generators; electricity generators; generators of electricity” (in International Class 7); and “energy recycling services, namely, capturing and conversion of wasted energy into electricity and useful steam; generation of electricity; generation of energy; generation of power; generation of power through operation of power generation equipment and facilities; leasing of energy generating equipment” (in International Class 40).

of the mark itself.”⁴ Applicant, on the other hand, argues that the literal portion of its mark is not merely descriptive, that the stylization of the mark is “enough to overcome the Section 2(e)(1) refusal,”⁵ and that the doctrine of *res judicata* should not be applied because the marks are not the same.

When the refusal was made final, Applicant appealed and filed a request for reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. 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. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). It is not necessary that a term describe all of the properties or functions of the goods and/or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient that the term describes one significant attribute, function or property of the goods or services. *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1332 (TTAB 2014); *In re H.U.D.D.L.E.*, 216 USPQ 358, 359 (TTAB 1982). Determining the descriptiveness of a mark is done in relation to an applicant’s goods and/or services for which registration is sought, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. *In re Bayer Aktiengesellschaft*, 488

⁴ Examining Attorney’s Appeal Brief, 9 TTABVue 5.

⁵ Appeal Brief, p. 1, 7 TTABVue 3.

F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003).

With respect to the Examining Attorney's invocation of the doctrine of "*res judicata*," we note that, in the context of an *ex parte* proceeding, the more appropriate consideration is the principle of "*stare decisis*." This is because the question before us is not whether the parties to an earlier case ought to be barred from re-litigating a claim or issue based on whether it involves the same set of transactional facts. Rather, it is whether Applicant should be precluded by an adverse judicial determination of its right to registration in an *ex parte* proceeding from seeking registration in a second application. Generally, an applicant is not so precluded "if the applicant can show that facts or circumstances have changed since the rendering of the adverse final decision in the first application." *In re Hotels.com L.P.*, 87 USPQ2d 1100, 1103 (TTAB 2008) (newly submitted survey evidence constituted a change in facts sufficient to avoid application of the doctrine).⁶ See also *In re Honeywell Inc.*, 8 USPQ2d 1600 (TTAB 1988); *In re Johanna Farms Inc.*, 8 USPQ2d 1408, 1411 (TTAB 1988) (prior Board decision finding LA YOGURT for yogurt incapable of distinguishing source did not preclude registration of LA YOGURT under the doctrine of *stare decisis*; application of the doctrine "would be inappropriate in view of the *prima facie* showing by applicant of changed facts

⁶ We note that in *Hotels.com*, the marks involved were quite different, yet the Board did not rely on the differences in the marks in finding that *stare decisis* did not apply. In the first case, applicant sought registration for the design mark, **hotels.com**; in the later-filed case applicant applied to register the mark HOTELS.COM in typed format. The Board gave no consideration to the differences in the marks, finding changed circumstances on the basis of the survey evidence alone.

and/or circumstances” based on newly submitted evidence of consumer letters and a survey dealing with purchaser perception of LA YOGURT); *In re Bordo Products Company*, 188 USPQ 512, 514 (TTAB 1975) (applicant demonstrated change in factual circumstances such that circumstances that existed at time of original decision, twenty-five years earlier, had become so exacerbated that the decision “has no viability at the present time”). In the case at hand, Applicant does not contend that the circumstances have changed, except that it is now seeking registration of its mark in a stylized form.

We find that the holding of the prior decision is *stare decisis* on the issue of whether the wording MOTIONPOWER is merely descriptive, and that the minimal stylization added to the term MOTIONPOWER in the subject mark does not constitute a change in circumstances sufficient to avoid application of the doctrine of *stare decisis*. In any case, because the evidence of record shows that MOTIONPOWER is merely descriptive of Applicant’s goods, and inasmuch as the stylization does not render the present mark registrable, we find the mark is merely descriptive under Section 2(e)(1).

Applicant’s goods are “generators of electricity, namely, generators that generate electricity by capturing and converting kinetic energy into electricity.” As stated on its website, Applicant’s innovative technology “generates electricity from the motion of vehicles.” Identified therein as “novel MotionPower™ energy harvesting systems,” the products “generate sustainable electricity by capturing the excess kinetic energy produced by moving cars, small trucks, and heavy commercial

vehicles.”⁷ A third-party website also describes Applicant’s technology as “roadway systems for generating electricity by capturing the kinetic energy produced by moving vehicles.”⁸ Applicant’s goods are generators that produce electricity by capturing the surplus energy created from the motion of vehicles such as cars and trucks. Considering the literal portion of Applicant’s mark, it is readily apparent that it is a composite of two terms, “motion” and “power.” The word “motion” means “the act or process of changing position or place.”⁹ The word “power” is defined as “to provide something with the energy it needs to operate.”¹⁰ The evidence also shows that, as a noun, “power” means “energy.”¹¹ Applicant contends that because each of the words “motion” and “power” has a variety of meanings, when considering the mark as a whole, “imagination, reflection, or a ‘mental pause’ is required to deduce a quality or characteristic of the goods.”¹² Applicant further contends that the mark is used in the manner of a trademark, is followed by the TM symbol, and is not in use by competitors to describe their similar products. None of these arguments is persuasive. That the words comprising the mark may have other, non-descriptive meanings does not erase the descriptive meaning it has vis-à-vis these goods. The fact that Applicant uses the mark in the manner of a trademark and follows it with a TM symbol cannot convert an otherwise descriptive term into a

⁷ At <http://www.newenergytechnologiesinc.com>, dated 2006, attached to Office Action dated November 7, 2012.

⁸ At <http://investorshub.advfn.com>, attached to Office Action dated November 7, 2012.

⁹ At <http://education.yahoo.com>, attached to Office Action dated November 7, 2012.

¹⁰ At <http://dictionary.cambridge.org>, attached to Office Action dated November 7, 2012.

¹¹ *Id.*

¹² Appeal Brief, p. 11, 7 TTABVue 12.

trademark. And while competitive need can be a relevant factor in a descriptiveness analysis, here it has not been shown to have any impact.

In view of the evidence submitted by the Examining Attorney, we find that the individual terms “motion” and “power” have descriptive significance as used in connection with the identified goods. We further find that the combination of these two descriptive terms, i.e., the composite term “MotionPower,” is still merely descriptive of the goods and would still be perceived by prospective purchasers as describing the power that Applicant’s generators produce from vehicles in motion. Because each component retains its merely descriptive significance in relation to the goods or services, the result is a composite that is itself merely descriptive. *See, e.g., In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004) (PATENTS.COM held merely descriptive of computer database management software); *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) (SMARTTOWER held merely descriptive of commercial and industrial cooling towers); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer programs); *In re Gagliardi, Bros., Inc.*, 218 USPQ 181, 184 (TTAB 1983) (BEEFLAKES for frozen thinly sliced beef merely descriptive).

Thus we come to the question of whether the stylization forming the composite mark, as shown above, creates a separate and inherently distinctive commercial impression, apart from the wording, such that the mark as a whole is not merely descriptive. The stylization must be sufficiently distinctive so as to “create an impression on purchasers separate and apart from the impression made by the

words themselves.” *In re Am. Academy of Facial Plastic & Reconstructive Surgery*, 64 USPQ2d 1748, 1753 (TTAB 2002). *See also In re Sadoru Group, Ltd.*, 105 USPQ2d 1484, 1485 (TTAB 2012) (finding that the stylization of the mark **SADORU** for motorcycle seats did not create a separate and inherently distinctive commercial impression); *In re Guilford Mills Inc.*, 33 USPQ2d 1042, 1044 (TTAB 1994) (holding the mark *microdenier* for microfiber fabrics “insufficiently stylized to create an inherently distinctive display that is registrable, without more, on the Principal Register.”). The determination regarding whether stylization is sufficiently distinctive in character to “rescue” the designation as a whole is “a necessarily subjective one,” *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224, 1227 (TTAB 1987), and “must be determined based on a viewer’s first impression.” *In re Grande Cheese Co.*, 2 USPQ2d 1447, 1449 (TTAB 1986) (marks comprising stylized lettering of generic terms MOZZARELLA and ITALIAN CHEESES, some including background displays, do not create separate commercial impressions over and above that made by the generic words themselves).

We agree with the Examining Attorney that the degree of stylization in Applicant’s mark is not sufficiently distinctive so as to create a commercial impression separate and apart from the merely descriptive meaning of the accompanying words. Applicant contends that the visual elements of the mark create the unique impression of something in motion (“motion” being “the first stylistic word”) being stopped by a “solid, powerful, and immovable second stylistic

word.”¹³ We are not persuaded that consumers will stop and analyze the mark in this manner and therefore reach the conclusion that Applicant asserts. We agree with the Examining Attorney that the stylization of the word “motion,” to the extent it may connote movement in the direction that the letters slant, does not create a commercial impression that is separate or different than that created by the meaning of the word “motion” itself, or that the stylization of the word “power” is so distinctive that it suggests the feeling of power beyond that conveyed by the word itself. Overall, the appearance of the entire composite mark **MotionPOWER** does not create a commercial impression different from that conveyed by the meaning of the words. *Cf., In re Miller Brewing Co.*, 226 USPQ 666, 669-70 (TTAB 1985) (evidence submitted by applicant was sufficient to show that the **Lite** mark did in fact function as a trademark although “the features of applicant’s configuration of the disclaimed word ‘LITE’ are not of such nature that they would inherently serve to distinguish applicant’s mark sought to be registered in its entirety.”).

Decision: The holding of the Board’s prior decision is *stare decisis* on the issue of whether the literal portion of Applicant’s mark, i.e., “MotionPower,” is merely descriptive when used in connection with Applicant’s goods, and the stylization does not present changed circumstances sufficient to avoid application of the doctrine. In addition, the evidence of record confirms that the literal portion of Applicant’s mark is merely descriptive, and because the stylization does not create a separate and

¹³ Reply Brief, p. 11-12.

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inherently distinctive commercial impression apart from the words MOTION POWER, such that the mark as a whole is not merely descriptive, the refusal to register applicant's mark **MotionPOWER** under Trademark Act § 2(e)(1) is affirmed.

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Masiello, Administrative Trademark Judge, concurring in the result.

I agree with the Board's determination that Applicant's mark, in its entirety, is merely descriptive of Applicant's goods within the meaning of Section 2(e)(1). However, I believe it was unnecessary for the Board to rely on the principle of *stare decisis* with respect to the literal portion of the mark at issue. The Board's analysis of the mark as a whole fully considered the literal portion of the mark (including the evidence of record relating to its significance) together with the style and design portions of the mark. In my view this analysis rendered superfluous any recourse to the principle of *stare decisis*.