

**THIS OPINION IS NOT A
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cochlear Limited

Serial Nos. 77634585, 77634587 and 77634590

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Before Seeherman, Bucher and Kuhlke, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Cochlear Limited has applied to register three
applications, all for HYBRID in standard characters, for
the following goods and services:

Medical software in the field of audiology,
namely, clinical programming software, software
managing clinical data, and software for fitting,
diagnosing and programming prosthetic hearing

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devices and implants and associated speech processors, in Class 9;¹

Medical electronic apparatus, namely, implantable prosthetic hearing devices and associated accessories and monitoring equipment, namely, programmable prosthetic hearing implants, multi-channel implantable hearing prosthesis; interface devices for programming prosthetic hearing implants in the nature of computerized diagnostic programming systems comprised primarily of medical electrode arrays and receiver-stimulator modules, promontory stimulators, speech processors, audio input selectors, cables, headsets, headset coils, headset magnets, headset inserts, headset earhooks, headset microphones, and telephone adaptors, in Class 10²

Audiologist services, namely, hearing aid services and prosthetic hearing device services; speech and hearing therapy; surgical services, namely, the implantation of prosthetic hearing devices and components thereof, in Class 44.³

The examining attorney has refused registration for all three applications pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that HYBRID is merely descriptive of the identified goods and services. In particular, the examining attorney asserts that "hybrid" identifies a type of hearing aid system, and that, with respect to the Class 9 application, HYBRID

¹ Application Serial No. 77634585, filed December 16, 2008, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

² Application Serial No. 77634587, filed December 16, 2008, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

³ Application Serial No. 77634590, filed December 16, 2008, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

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describes a feature and use of the software for this system; with respect to the Class 10 application, describes the components that are combined to create the system; and with respect to the Class 44 application, describes the purpose or use of the services, namely, that the services feature a hybrid hearing aid or hearing aid system.

Applicant has appealed the refusal of each application. Because the appeals involve the same issue and similar records, we hereby consolidate the appeals and decide each in this single opinion.

We turn first to an evidentiary point. In his brief the examining attorney has objected to a listing of the registration numbers and goods/services of certain third-party registrations for HYBRID marks that applicant recited in its appeal brief. Although the examining attorney recognizes that applicant submitted the identical list with its request for reconsideration, the examining attorney asserts that such a listing is not the proper procedure for making third-party registrations of record. Applicant did not file a reply brief, so it has not responded to this objection.

We sustain the objection. It is well established that mere listings of registrations are not sufficient to make the registrations of record. In re Duofold Inc., 184 USPQ

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638 (TTAB 1974). See also *In re Classic Media Inc.*, 78 USPQ2d 1699, 1700 (TTAB 2006). In certain circumstances, if an applicant includes a listing of registrations in a response to an Office action, and the examining attorney does not advise the applicant that the listing is insufficient to make the registrations of record at a point when the applicant can correct the error, the examining attorney will be deemed to have stipulated the registrations into the record. However, an improper listing of third-party registrations will not be considered if the list is submitted at a point where the applicant cannot correct the format of the submission, and the examining attorney does not treat the registrations as of record. See TBMP §1208.02, and cases cited at Note 8. Because applicant included the listings of the third-party registrations with its request for reconsideration, i.e., at a point where applicant could not submit a further response that would correct the format of the submission by submitting copies of the registrations or the electronic version thereof, taken from the Office's database, the listing of registrations has been given no consideration.⁴

⁴ We add that, given the different goods and services indicated in the listing, even if the registrations had been properly made of record they would not affect our decision herein.

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This brings us to the substantive issue on appeal, whether HYBRID is merely descriptive of the identified goods and services in the applications. A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(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 Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (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 to be merely descriptive; rather, it is sufficient that the term describes one significant attribute, function or property of the goods or services. In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982); In re MBAssociates, 180 USPQ 338 (TTAB 1973). 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 the 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-

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Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Moreover, if the mark is descriptive of any of the goods or services for which registration is sought, it is proper to refuse registration as to the entire class. In re Analog Devices Inc., 6 USPQ2d 1808 (TTAB 1988), aff'd without pub. op., 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989).

In support of his position that HYBRID is merely descriptive of applicant's goods and services, the examining attorney has submitted evidence to show that "hybrid" is a term used to describe a hearing aid system which combines both a cochlear implant and an external hearing aid.

Headline, New Hybrid Hearing Device Combining Advantages Of Hearing Aids, Implants
A new hybrid hearing aid/cochlear implant device designed for patients who can benefit from both is being evaluated by UT Southwestern Medical Center otolaryngologists...
Science Daily, www.sciencedaily.com

Hybrid hearing aids what are they? [title]
Hybrid hearing aids what are they? These are hearing aids that combine a cochlear implant with that of an inbuilt conventional hearing aid.
www.topix.com/med/otolaryngology

Cochlear Implant Hybrids: Who Is a Candidate? You May be Surprised [title]
... Expanding criteria have led to an increased number of patients who can now benefit from cochlear implantation, specifically the use of cochlear implant/hearing aid hybrids.
May 20, 2006, AudiologyOnline,
www.audiologyonline.com

Hybrid Cochlear Implant [heading]

In June 2007, Dr. Herzog was interviewed regarding a new type of cochlear implant. The hybrid cochlear implant is an investigational device which blends a hearing aid with a modified cochlear implant.

The Center for Hearing and Balance Disorders,
www.stlouiseear.com

'Hybrid implants' give more help for aging ears
[title]

Cochlear implants may not be just for the profoundly deaf anymore; Iowa scientists are developing the next generation, a "hybrid implant" to combine the best of bionics with regular hearing aids for age-related hearing loss.

...

Make the electrode [of the cochlear implant] shorter, so it only substitutes for the hearing that's already lost. Pair it with a regular hearing aid to amplify their remaining low-frequency hearing, and people just might hear again more like they did years earlier. So far, about 60 patients have received the hybrid implant, manufactured by Cochlear Americas.

MSNBC, March 14, 2006, www.msnbc.msn.com

In addition, the examining attorney has submitted excerpts from applicant's website, www.cochlear.com, that show that applicant's hearing system uses the hybrid technology described in the foregoing articles:

Discover how Hybrid seamlessly integrates cochlear implant and hearing aid technology.

The brilliance is in the mix--merging technologies to restore hearing

...

It does this by seamlessly integrating electronic stimulation provided by a cochlear implant with acoustic amplification provided by a hearing aid. The cochlear implant provides the high frequency

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information and the hearing aid provides the low frequency information.

The foregoing evidence is sufficient to demonstrate that consumers of applicant's goods would immediately understand, when seeing HYBRID used in connection with them, that applicant's identified software for fitting and programming prosthetic hearing devices and implants are used in connection with a hybrid hearing aid system consisting of a cochlear implant and conventional hearing aid, and that applicant's identified implantable prosthetic hearing devices and associated accessories and monitoring equipment are products used as part of such a hybrid hearing aid system. Therefore, applicant's mark is merely descriptive of the goods in application Serial Nos. 77634585 (Class 9) and 77643587 (Class 10). Moreover, when the mark is used in connection with audiologist services, namely hearing aid services and prosthetic hearing device services, as well as surgical services, namely the implantation of prosthetic hearing devices and components thereof, consumers will understand HYBRID to refer to a characteristic of the services, i.e., that the audiologist services pertain to hybrid hearing aids and devices, and the surgical services are for the implantation of components of hybrid hearing devices.

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In reaching this conclusion, we have considered applicant's arguments, but have not found them to be persuasive. First, applicant cites *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) for the proposition that to be merely descriptive the mark must do nothing other than immediately convey an understanding of the goods for which registration is sought. It is true that if a mark has a second, non-descriptive meaning, or double entendre, it will not be considered merely descriptive. This was the case in Colonial Stores, in which the mark SUGAR & SPICE not only described the ingredients of that applicant's bakery products, but also referenced the well-known nursery rhyme. In the present case, however, applicant has not put forth a second non-descriptive meaning of HYBRID from which we could conclude that the mark conveys a double entendre.

Second, applicant points to the dictionary definition of "hybrid" made of record by the examining attorney: "something of mixed origin or composition,"⁵ and states that its goods are not of mixed composition and therefore "hybrid" does not describe its goods. Whether or not the dictionary definition would be sufficient on its own to

⁵ The American Heritage Dictionary of the English Language, 4th ed. (2000).

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prove that HYBRID is merely descriptive of applicant's goods and services, the records in these three applications show that "hybrid" is a term used to describe a hearing aid system comprised of a cochlear implant and an external hearing aid, which are referred to as "hybrid hearing devices."⁶

Applicant argues that thought or imagination is required to reach a conclusion regarding the exact nature of its goods and services. With respect to its software, applicant contends that "[c]onsumers must use their imagination to determine whether 'HYBRID' refers to the characteristics of Applicant's goods (is the software a mixed composition of other software products?) or the purpose for Applicant's goods (is the software used to combine two things?) or something else entirely." Brief, p. 5. However, given the evidence that "hybrid" is a term used to describe a hearing aid system consisting of a cochlear implant and external hearing aid, consumers viewing the mark HYBRID in connection with medical software for fitting and programming prosthetic hearing devices and implants will immediately understand that a major

⁶ We add that, with respect to applicant's goods in Class 10, the very definition of "hybrid" shows that this term, when applied to implantable prosthetic hearing devices with an external hearing aid, describes a significant characteristic of such goods.

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characteristic of the software is that it is used in conjunction with hybrid hearing devices.

Applicant makes a similar argument with respect to its application in Class 10 for implantable prosthetic hearing devices and associated accessories and monitoring equipment, viz.: "Consumers must use their imagination to determine whether 'HYBRID' refers to the characteristics of Applicant's Goods (are the goods made of a mixed composition of constituent elements, such as metal and plastic?) or the purpose for Applicant's Goods (are the goods used to combine two things?) or something else entirely." Brief, p. 5. Again, applicant's argument ignores the fact that the term used to describe a hearing aid system comprising a cochlear implant and an external hearing aid is "hybrid," and that applicant itself uses the phrase "hybrid hearing devices" to describe such equipment. See page 5 of applicant's brief.

Applicant makes the same argument with respect to its application for services: "Consumers must use their imagination to determine whether 'HYBRID' refers to the characteristics of Applicant's services (are they a mixed composition of other services generally provided individually?) or the purpose for Applicant's services (are they used to combine two things?) or something else

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entirely." Brief, p. 5. However, we must consider the question of descriptiveness of applicant's mark in connection with the identified services, and because the evidence shows that hearing aid systems that are comprised of cochlear implants and external hearing aids are referred to as hybrid hearing devices, consumers seeing the mark HYBRID in connection with hearing aid services and prosthetic hearing device services, and surgical services consisting of the implantation of prosthetic hearing devices, will immediately understand the mark as referring to audiologist services and surgical services relating to such hybrid hearing devices. Put another way, if a patient seeking surgery in order to have a hybrid hearing device saw that a surgeon was offering HYBRID hearing device implantation, he or she would immediately know that the surgical services would implant a hybrid hearing device.

We recognize that we have discussed the descriptiveness of HYBRID for certain of the goods and services identified in each of the applications, rather than for all of the goods and services. However, as stated above, if a mark is descriptive of any of the goods or services for which registration is sought, it is proper to refuse registration as to the entire class. Thus, our findings that the mark is merely descriptive for at least

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one of the identified goods or services in each of the applications are a sufficient basis for us to find that the refusal of registration should be affirmed with respect to the entire application.

Decision: The refusals of registration in Application Serial Nos. 77634585, 77634587 and 77634590 are affirmed.