PTO Form (Rev 4/2000)
OMB No. 0651-.... (Exp. 08/31/2004)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77634587
LAW OFFICE ASSIGNED	LAW OFFICE 115
MARK SECTION (no change)	
ARGUMENT(S)	
Please see the actual argument text attached within the Evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_12141226-135931747_._Request_for_Reconsideration_-_HYBRID_Class_10.pdf
CONVERTED PDF FILE(S) (6 pages)	\\TICRS\EXPORT11\IMAGEOUT11\776\345\77634587\xml2\RFR0002.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\776\345\77634587\xml2\RFR0003.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\776\345\77634587\xml2\RFR0004.JPG
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DESCRIPTION OF EVIDENCE FILE	PDF attachment of argument
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Tracie Siddiqui/
SIGNATORY'S NAME	Tracie Siddiqui
SIGNATORY'S POSITION	Attorney of record, DC bar member
DATE SIGNED	11/10/2010

AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Nov 10 14:46:12 EST 2010
TEAS STAMP	USPTO/RFR-12.1.41.226-201 01110144612120070-7763458 7-470335a183989b278276f38 18d116da7d16-N/A-N/A-2010 1110135931747977

PTO Form (Rev 4/2000)
OMB No. 0651-.... (Exp. 08/31/2004)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **77634587** has been amended as follows:

ARGUMENT(S)
In response to the substantive refusal(s), please note the following:

Please see the actual argument text attached within the Evidence section.

EVIDENCE
Evidence in the nature of PDF attachment of argument has been attached.
Original PDF file:
evi_12141226-135931747_._Request_for_Reconsideration_-_HYBRID_Class_10.pdf
Converted PDF file(s) (6 pages)
Evidence-1
Evidence-2
Evidence-3
Evidence-4
Evidence-5
Evidence-6

SIGNATURE(S)
Request for Reconsideration Signature
Signature: /Tracie Siddiqui/ Date: 11/10/2010

Signatory's Name: Tracie Siddiqui
Signatory's Position: Attorney of record, DC bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77634587
Internet Transmission Date: Wed Nov 10 14:46:12 EST 2010
TEAS Stamp: USPTO/RFR-12.1.41.226-201011101446121200
70-77634587-470335a183989b278276f3818d11
6da7d16-N/A-N/A-20101110135931747977

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant: Cochlear Limited

Serial No: 77/634,587

Filed: December 16, 2008

Mark: **HYBRID**

Our Ref: 62367-393985

REQUEST FOR RECONSIDERATION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

This is in response to the Office Action mailed on May 10, 2010 making final the refusal to register the mark under Section 2(e)(1). Applicant has simultaneously filed a Notice of Appeal with a request to suspend the appeal pending the outcome of this Request for Reconsideration.

In the Final Office Action, the Trademark Examining Attorney refused registration of Applicant's HYBRID mark because, in the Examining Attorney's view, the mark merely describes the goods set forth in the application and is therefore not inherently registrable under Section 2(e)(1) of the Trademark Act. Applicant respectfully requests reconsideration of this conclusion.

In order for a mark to be non-registrable because of descriptiveness, it must not only be descriptive, but must be "merely" descriptive of the goods or services to which it relates. TMEP § 1209.01(b). In other words, the mark must do nothing other than immediately convey an understanding of the goods for which registration is sought. In re Quik-Print Copy Shops, 205

U.S.P.Q. 505 n.7 (C.C.P.A. 1980) ("merely" descriptive means "only" descriptive); In re Colonial Stores, Inc., 157 U.S.P.Q. 382, 385 (C.C.P.A. 1968) (holding the mark non-descriptive because it "does not tell the potential purchaser *only* what the goods are, their function, their characteristics or their use, or . . . their ingredients." (emphasis in original)).

Even if the mark has an association with the goods, this does not necessarily render the mark unregistrable, since "a designation does not have to be devoid of all meaning in relation to the goods and services to be registrable." TMEP § 1209.01(a); See In re George Weston Ltd., 228 USPQ 57 (T.T.A.B. 1985) (SPEEDI BAKE for frozen dough found to fall within the category of suggestive marks because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread); In re The Noble Co., 225 USPQ 749 (T.T.A.B. 1985) (NOBURST for liquid antifreeze and rust inhibitor for hot-water-heating systems found to suggest a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute). Such a mark may be "suggestive," and not merely descriptive, where some degree of imagination, thought, or perception is required to reach a conclusion as to the nature of the services offered in connection with the mark. See id.

Moreover, it is the Examining Attorney who bears the burden of proof that the mark is merely descriptive. In re Penwalt Corp., 173 U.S.P.Q. 317 (T.T.A.B. 1972). In the absence of such proof, the application should be passed to publication.

In the present instance, the Examining Attorney argues that "[a] hybrid is something of mixed composition. In the context of the applicant's goods identified as '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 receive-stimulator modules, promontory stimulators, speech processors, audio input selectors, cables, headsets, headset coils, headset magnets, headset inserts, headset earhooks, headset microphones, and telephone adaptors,' it describes a type of hearing aid that combines a cochlear implant with an inbuilt conventional hearing aid and the devices and software that are used as an integral part of the hearing system." Through this statement the Examining Attorney appears to equate the goods in the application with the Applicant's Hybrid Cochlear System, of which the identified goods are a portion, apparently due to the Examining Attorney's independent review of Applicant's website, which discusses the System. However, the word HYBRID could not be used to describe either the system or the stated goods as neither are of mixed composition.

In response to Applicant's argument that, although intended for use in connection with other devices, the goods themselves are not a "hybrid," the Examining Attorney states that the proposed mark is merely descriptive in relationship to hybrid hearing devices and system and the associated accessories and equipment necessary in its application and function." Applicant does not believe that this statement (that the goods are a necessary part of a system, of which one component is of mixed composition) is an accurate recitation of the test for mere descriptiveness. Instead, as stated above, to be merely descriptive, the mark must immediately convey a full understanding of the services without further thought being required. "HYBRID" does not immediately convey the idea of "implantable prosthetic hearing devices" and related goods or any particular aspect of these goods to consumers, even if such goods may be used with other goods and services to create a system and a portion of that system is composed of multiple components.

Indeed, the term "HYBRID" does not describe, in any way, any aspect of Applicant's identified goods. Therefore, Applicant contends that the mark is arbitrary and subject to the highest

level of protection and registrability. Alternatively, even if the expression makes an indirect reference to use along with Applicant's other products, the HYBRID mark is, at least, suggestive with respect to Applicant's implantable prosthetic hearing devices and associated accessories and monitoring equipment and interface devices for programming same. Use of Applicant's HYBRID mark for these goods still requires imagination, thought and perception to reach a conclusion regarding the exact nature of the services for which the mark is used. Because "HYBRID" does not immediately convey anything about Applicant's goods, consumers are left to ponder what, if anything, the mark suggests about Applicant's goods. 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. Therefore, the mark does not immediately convey a single, specific meaning, but rather leaves the consumer wondering about the goods and their characteristics and purpose.

The Trademark Office has often found that the mark HYBRID alone is not descriptive for a variety of goods and services, including the following, which are registered on the Principal Register:

- Reg. No. 3859522 for "electronic knife sharpeners"
- Reg. No. 3848606 for "soccer balls"
- Reg. No. 3635067 for "golf putters"
- Reg. No. 3050188 for "personal care products for men and women, namely, facial cleansing cream lotion; face and body cleansing lotions and gels; anti-wrinkle cream, skin moisturizer, facial moisturizer, facial moisturizer with sun protection factor, skin moisturizer with sun protection factor, eye cream, facial lotion, facial

mask, facial cosmetics, namely, foundation, foundation with sun protection factor, blush and eye shadow, mascara, lip cream, lip balm, lip balm with sun protection factor, lip stick, lip gloss, eye cream, sun screen preparations, and self tanning lotion"

- Reg. No. 3236894 for "guitar parts; guitar tremolo devices"
- Reg. No. 3380657 for "nasal ventilation interface and respirators for medical purposes; continuous positive airway pressure (CPAP) compressors and monitors; bi-level positive airway pressure compressors and monitors; and respiratory facial masks for use in connection with nasal ventilation interface and respirators, continuous positive airway pressure (CPAP) compressors, and bi-level positive airway pressure compressors, for medical purposes"
- Reg. No. 3358588 for "retail pet cages; pet supplies, namely, artificial terrarium landscapes and terrarium ornaments"
- Reg. No. 3436898 for "bottles sold empty"
- Reg. No. 3198786 for "electronic financial transaction and information services, namely, debit and credit card verification and transaction process services, banking and check verification services"
- Reg. No. 3304435 for "exercise machines"
- Reg. No. 3401695 for "financial services, namely conducting a securities and derivatives exchange"
- Reg. No. 2211372 for "sound reinforcement apparatus, namely, loudspeakers; crossover networks for loudspeakers, and parts and fittings for all the aforesaid goods"

- Reg. No. 1649229 for "floor cleaning or waxing preparations"

TESS records for the above-listed registrations are attached hereto. When consumers see Applicant's goods, they are no more likely to immediately know any characteristic of the product than they are to know how the use of HYBRID would relate to any of the above-listed goods and services. As such, clear prior practice of the USPTO indicates that the mark is simply not descriptive of Applicant's goods.

Applicant reiterates that it is the Trademark Office that bears the burden of proving a mark merely descriptive. In this case, the clear weight of the evidence supports Applicant's position that the mark is inherently registrable on the Principal Register. Accordingly, applicant respectfully requests that the Examining Attorney withdraw the Section 2(e)(1) refusal and pass the Application to publication.

Respectfully submitted,

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