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Sent: 12/6/2010 2:15:47 PM

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Subject: U.S. TRADEMARK APPLICATION NO. 77634587 - HYBRID - 22409-00711- - Request for Reconsideration Denied - Return to TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77634587

MARK: HYBRID



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APPLICANT: Cochlear Limited

CORRESPONDENT'S REFERENCE/DOCKET NO:

22409-00711-

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 12/6/2010

Applicant is requesting reconsideration of a final refusal issued/mailed May 7, 2010.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

Section 2(e)(1) Refusal – Merely Descriptive

Registration was refused because the applied-for mark merely describes a feature, function use and/or characteristic of applicant's goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. TMEP §1209.01(b); *see In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987).

The determination of whether a mark is merely descriptive is considered in relation to the identified goods, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b); *see, e.g., In re Polo Int'l Inc.*, 51

USPQ2d 1061 (TTAB 1999) (finding DOC in DOC-CONTROL would be understood to refer to the “documents” managed by applicant’s software, not “doctor” as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (finding CONCURRENT PC-DOS merely descriptive of “computer programs recorded on disk” where relevant trade used the denomination “concurrent” as a descriptor of a particular type of operating system). “Whether consumers could guess what the product is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

“A mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if the term describes only one significant function, attribute or property. *In re Oppedahl*, 373 F.3d at 1173, 71 USPQ2d at 1371; TMEP §1209.01(b).

As stated in the FINAL Office action a “hybrid” is something of mixed composition. The dictionary definition was previously attached. Applicant’s goods are 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 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 the context of the applicant’s identified goods the proposed mark merely describes a feature, use and/or characteristic of the goods which are HYBRID hearing aids and associated equipment and accessories for use therewith.

The hearing aids are a type of hearing aid that combines a cochlear implant with an inbuilt conventional hearing aid. The goods identified here are such type hearing aids and equipment and accessories as part of the HYBRID hearing system. (See previously attached material from the applicant’s web site describing the hearing aids, software and hearing system). Applicant intends to use the proposed mark to identify its 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, which are cochlear hybrid implant hearing devices and associated equipment and accessories for the hybrid hearing system.

Applicant argues that “the goods themselves are not ‘HYBRID’”. Applicant's mark is intended for use in connection with hybrid hearing devices combined of a cochlear implant with an inbuilt conventional hearing aid. This in and of itself is a hybrid or combination of two hearing aid devices and systems. Applicant states in its Request for Reconsideration that “...The examining attorney appears to equate the goods in the application with applicant’s HYBRID Cochlear System, of which the identified goods are a portion...” (see applicant’s request for reconsideration, page 3). Additionally, in the applicant’s 9/24/09 response Applicant stated for the record that the term HYBRID appearing in the mark means or signifies the practice of combining multiple modes of aural stimulation in the relevant trade or industry or as applied to the goods/services listed in the application. The term, therefore, is descriptive in relation to the identified goods. Additionally, in the applicant’s response of 4/15/10 applicant admits “that one among several applications for the goods happen to be hybrid hearing aid devices.” (response of 4/15/10) It has long been held that “A mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if the term describes only one significant function, attribute or property. *In re Oppedahl*, 373 F.3d at 1173, 71 USPQ2d at 1371; TMEP §1209.01(b).

Lastly, the applicant’s website discusses the use of the hybrid hearing system. (previously attached) The applicant’s website states:

The Hybrid system is a unique combination of solutions to overcome your high frequency hearing loss in a way not possible with hearing aids alone. It is designed to help you truly enjoy the quality and clarity of hearing by effectively adding back the high frequency sounds that you have been missing – completing your hearing experience.

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 information and the hearing aid provides the low frequency information.

Quite simply, Hybrid can enable a person with severe to profound high frequency hearing loss to hear sounds at close to normal levels. And that includes the consonant sounds vital for understanding speech.

Material obtained from the Internet is generally accepted as competent evidence in examination and ex parte proceedings. See *In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (Internet evidence accepted by the Board to show genericness); *In re White*, 80 USPQ2d 1654, 1662 (TTAB 2006) (Internet evidence accepted by the Board to show false connection); *In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305, 1308-09 (TTAB 2006) (Internet evidence accepted by the Board to show geographic significance); *Fram Trak Indus. v. WireTracks LLC*, 77 USPQ2d 2000, 2006 (TTAB 2006) (Internet evidence accepted by the Board to show relatedness of goods); *In re Consol. Specialty Rest. Inc.*, 71 USPQ2d 1921, 1927-29 (TTAB 2004) (Internet evidence accepted by the Board to show that geographic location is well-known for particular goods); *In re Gregory*, 70 USPQ2d 1792, 1793 (TTAB 2004) (Internet evidence accepted by the Board to show surname significance); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002) (Internet evidence accepted by the Board to show descriptiveness); TBMP §1208.03; TMEP §710.01(b).

Here the term HYBRID is merely descriptive of goods identified and the associated accessories and equipment by applicant's own admissions. The mark immediately conveys information regarding a feature, function use and/or characteristic of the goods.

Accordingly, applicant's request for reconsideration is *denied*. The time for appeal runs from the date the final action was issued/mailed. 37 C.F.R. §2.64(b); TMEP §715.03(c). If applicant has already filed a timely notice of appeal, the application will be forwarded to the Trademark Trial and Appeal Board (TTAB).

Advisory - Generic

Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods and/or services. TMEP §1209.01(c); see *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001); *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986). Generic terms are by definition incapable of indicating a particular source of the goods and/or services, and cannot be registered as trademarks and/or service marks; doing so "would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are." *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1569, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987); see TMEP §1209.01(c).

A word or term that is the name of a key ingredient, characteristic or feature of the goods and/or services can be generic for those goods and/or services and thus, incapable of distinguishing source. A term does not need to be the name of the goods and/or services to be found incapable of serving as an indicator of origin. *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718 (C.C.P.A. 1970) (holding CUSTOM BLENDED generic for gasoline); *In re Helena Rubenstein, Inc.*, 410 F.2d 438, 161 USPQ 606 (C.C.P.A. 1969) (holding PASTEURIZED generic for face cream); *Roselux Chem. Co. v. Parsons Ammonia Co.*, 299 F.2d 855, 132 USPQ 627 (C.C.P.A. 1962) (holding SUDSY generic for ammonia); *In re Eddie Z's Blinds & Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005)

(holding BLINDSANDDRAPERY.COM generic for online retail store services featuring blinds, draperies and other wall coverings); *In re Candy Bouquet Int'l, Inc.*, 73 USPQ2d 1883 (TTAB 2004) (holding CANDY BOUQUET generic for “retail, mail, and computer order services in the field of gift packages of candy”); *In re Reckitt & Colman, N. Am. Inc.*, 18 USPQ2d 1389 (TTAB 1991) (holding PERMA PRESS generic for soil and stain removers); *In re Ricci-Italian Silversmiths, Inc.*, 16 USPQ2d 1727 (TTAB 1990) (holding ART DECO generic for flatware); *In re Hask Toiletries*, 223 USPQ 1254 (TTAB 1984) (holding HENNA ‘N’ PLACENTA generic of ingredients for hair conditioner); *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 1 USPQ2d 1364 (3d Cir. 1986) (holding CHOCOLATE FUDGE generic for diet sodas); *see* TMEP §§1209.01(c) *et seq.*

Procedural Discrepancy:

Please be advised that the applicant states in its Request for Reconsideration that “The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.” However, the applicant has filed an Appeal with the Trademark Trial & Appeal Board. The applicant may wish to clarify this contradiction for the record.

Status Check:

Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

/Jeffrey S. DeFord/

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