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

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**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 :

APPLICANT'S APPEAL BRIEF

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I. INTRODUCTION

COMES NOW Applicant Cochlear Limited (“Applicant”) to appeal the final refusal of registration of its HYBRID mark in connection with Application Serial No. 77/634,587 filed on December 16, 2008.

The Examining Attorney has made Final the refusal to allow registration of the mark HYBRID on the ground that the proposed mark is merely descriptive of Applicant’s goods, “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” (“Applicant’s Goods”). For the reasons set forth below, Applicant respectfully requests that this Board reverse the refusal and allow this application to proceed to publication.

II. DESCRIPTION OF THE RECORD

Applicant filed its application to register the HYBRID mark for Applicant's Goods on December 16, 2008. The first Office Action issued on March 12, 2009 in which the Examining Attorney enclosed information regarding a prior pending application and requested information as to the meaning/significance of the word "hybrid." In Applicant's response, filed September 14, 2009, Applicant informed the Examining Attorney that the pending application had been amended to the Supplemental Register. In a supplemental response dated September 24, 2009, Applicant stated that "HYBRID appearing in the mark means or signifies the practice of combining multiple modes of aural stimulation." On October 15, 2009, the Examining Attorney issued a Non-Final Office Action on the basis that the HYBRID mark is merely descriptive of Applicant's Goods. Applicant filed a Response on April 15, 2010, in which Applicant argued that the HYBRID mark "creates, at most, a suggestive commercial impression." The Examining Attorney issued a Final Refusal on May 10, 2010 (the "Final Refusal"). On November 10, 2010, Applicant filed a Request for Reconsideration and concurrently a Notice of Appeal to the Trademark Trial and Appeal Board. On December 6, 2010, the Examining Attorney issued a letter denying Applicant's Request for Reconsideration and continuing the final refusal (the "Reconsideration Letter").

III. ARGUMENT

Applicant respectfully requests that the Board reverse the Examining Attorney's finding that the mark HYBRID is merely descriptive of Applicant's Goods. 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/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 . . . 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.” (“Final Refusal”). 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 Applicant's 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." ("Final Refusal"). 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 goods 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 Applicant's 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 Goods. 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 goods 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 processing 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 already of record in the present appeal, as they were submitted in connection with the Applicant’s Request for Reconsideration filed on November 10, 2010. 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.

IV. CONCLUSION

Applicant submits that its arguments demonstrate that the HYBRID mark is not merely descriptive of Applicant's Goods. For the reasons set forth in this Brief, as well as in Applicant's previous Responses, Applicant respectfully requests that this Board reverse the refusal and allow this application to proceed to publication

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

This is to certify that this APPEAL BRIEF was deposited filed electronically with the Trademark Trial and Appeal Board via transmission through ESTTA this 7th day of February, 2011.

/Tracie R. Siddiqui/