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Subject: U.S. TRADEMARK APPLICATION NO. 77634587 - HYBRID - 22409-00711- - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77634587

MARK: HYBRID



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Cochlear Limited

CORRESPONDENT'S REFERENCE/DOCKET NO:

22409-00711-

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant:	Cochlear Limited	BEFORE THE
Trademark:	HYBRID	TRADEMARK TRIAL
Serial No.:	77634585	AND
Attorney:	Tracie R. Siddiqui, Esq.	APPEAL BOARD
Address:	Kilpatrick Stockton, LLP 31 West 52 nd Street, 14 th Floor New York, New York 10019	ON APPEAL

Applicant has appealed the Examining Attorney's final refusal to register the proposed trademark HYBRID for use with "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.” The Examining Attorney refused registration on the grounds that the mark HYBRID is merely descriptive of the identified goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e).

FACTS

On December 16, 2008, Applicant applied to register the mark HYBRID for “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 telephone1.

On March 12, 2009, the Examining Attorney issued a first action and on October 14, 2009 refused registration under Trademark Act Section 2(e)(1) based on the proposed mark’s descriptive nature as applied to the identified goods.

On May 7, 2010, the examining attorney made Final the refusal to register the proposed mark. Applicant filed its Notice of Intent to Appeal concurrently with its Request for Reconsideration on November 10, 2010. The Request was denied on December 6, 2010 and the Applicant filed its Appeal Brief on February 7, 2011.

ARGUMENT

As an initial matter, the Examining Attorney objects to the applicant's inclusion of a listing of alleged registrations on pages 5 and 6 of the Applicant's Brief. The Trademark Trial and Appeal Board (TTAB) does not take judicial notice of registrations residing in the office, *In re Lar Mor International, Inc.* 221 USPQ 180 (TTAB 1983). Applicant must proffer copies of the registrations from the register. *In re Duofold*, 184 USPQ 638, 641 (TTAB 1984). Applicant must submit copies of the registrations, or the electronic equivalent thereof, e.g., printouts of the electronic records of the P.T.O. *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). Applicant states in its Brief that these registrations were made of record in the Request for Reconsideration. However, in the Request for Reconsideration the applicant merely provided an identical list without the copies of the actual registrations. As such, the alleged registrations and any arguments based thereon should not be considered.

APPLICANT'S PROPOSED MARK IS MERELY DESCRIPTIVE OF THE GOODS IDENTIFIED UNDER SECTION 2(E)(1) OF THE TRADEMARK ACT.

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Applicant's proposed mark HYBRID merely describes a feature, function, use and/or characteristic of the applicant's 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.

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). The dictionary definition of the word “HYBRID” means “something of mixed origin or composition.” See Office Action dated October 14, 2009 pages 1 and 13. Therefore, in relationship to the identified goods HYBRID identifies a type of hearing aid and the components used as part of a HYBRID hearing aid system. A HYBRID hearing aid is a hearing aid of mixed components featuring a cochlear implant, a conventional hearing aid and computer software and hardware for the manipulation, amplification, buffering and production of sound. In support of this conclusion, the Examining Attorney provided evidence from the Applicant’s website discussing the HYBRID type of hearing aids that combine a cochlear implant with an inbuilt conventional hearing aid and the software and other components used to create sound in a HYBRID hearing system. See exhibits from the Final Office Action dated May 7, 2009, at pages 2-7. Additional evidence was provided from several other Internet articles and websites discussing cochlear HYBRID hearing aids in general. See exhibits from the Office Action dated October 14, 2009, at pages 3-12 and 15-25; Final Office Action dated May 7, 2009, at pages 8-26.

In arguing against the refusal the applicant in its Brief states that "...the term 'HYBRID' does not describe Applicant's goods." See Applicant's Brief, at page 4. However, on the same page Applicant contradicts itself stating "...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." See Applicant's Brief, at page 4. In fact, Applicant has stated on multiple occasions in its responses that the goods identified are "HYBRID" but not exclusively. See Applicant's Responses dated April 15, 2010, at page 1; November 10, 2010, at page 4. Applicant also stated

"Applicant's mark is intended for use in connection with hearing aids and accessories, the goods identified in the application are not exclusively "hybrid" (the term has no significance with regard to most of the accessories), nor is it specifically and/or exclusively intended for use with hybrid hearing devices (although hybrid devices will likely comprise some of the identified goods in connection with which the mark will be used)."

See Applicant response dated April 15 2010 at page 1.

The applicant's website also discusses the HYBRID hearing aid system and HYBRID hearing aid components including associated speech processors, all of which are components of a HYBRID hearing aid. 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.

See attached evidence Office Action dated May 7, 2010, at page 29-30.

Additionally, in Applicant's response of September 24, 2009, applicant stated 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." See applicant's Response of September 24, 2009. This is exactly what the goods do. The goods identified here are the several components that are combined to create a HYBRID hearing aid system and the HYBRID device itself which processes the multiple modes of aural stimulation using the listed components. Furthermore, the applicant admitted "that one among several applications for the goods happen to be hybrid hearing aid devices." See Applicant's Response dated April 15, 2010, at page 1. This is the referenced application. Applicant's use of the term HYBRID is totally descriptive in nature as it does in fact describe a feature, function, use and/or characteristic of the hearing aid goods identified.

"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).

Here, the proposed mark HYBRID describes at least one significant aspect of Applicant's goods, namely, the combination of 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 for use with HYBRID hearing aids and as part of a HYBRID hearing system. Therefore, inasmuch as consumers may not perceive all the aspects of the applied-for mark when blindfolded, they will undoubtedly recognize the descriptive nature of the proposed mark when they encounter the word HYBRID used in connection with the identified goods.

THE PROPOSED MARK HAS A CLEAR & PLAIN MEANING

Applicant also argues that the term is suggestive. Applicant is again reminded that one must consider a mark not in the abstract, but in relation to the goods for which registration is sought, in the context in which the designation is being used, [emphasis added] and the possible significance that the term would have to the average prospective purchaser in determining whether designation is merely descriptive. *In re Abcor Dev. Corp.*, 588 F2d. 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b).

As previously discussed, it is not necessary that the term describes all the purposes, functions, characteristics or features of the goods to be merely descriptive. It is enough if the term or terms describe one attribute of the goods. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982). The fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness. *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984). Here the word HYBRID has a clear and plain meaning when applied to hearing aid software and software used with the HYBRID hearing aid. No thought, imagination and/or perception is needed or required to clearly understand the meaning of the proposed mark in relationship to the identified goods.

This is especially true here where the goods identified are part of a highly sophisticated hearing aid system comprised of multiple components and services. Consumers of such hearing devices and the related and required diagnostic and programming components are more than used to seeing the term HYBRID used to describe these hearing devices systems and their related components, without which they could not operate or function correctly. In support of the above statements and the descriptiveness refusal in general, the examining attorney previously provided printouts from multiple websites showing the descriptive use of HYBRID in connection with hearing devices and related programming or listening software and components. See Office Action dated October 14, 2009, at pages 3-12 and 15-25; Final Office Action dated May 7, 2009, at pages 8-26. These websites all show use of the term HYBRID by multiple third party sources in connection with hearing implants and hearing aids and hearing systems. In arguing that some multi-stage reasoning process is required the Applicant has ignored the evidence of record.

In this case, the mark is merely descriptive of a feature, function, use and/or characteristic of the “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.” The proposed mark has a clear and plain meaning which takes no imagination, thought or perception to understand in the context of the goods identified. Accordingly, the mark is merely descriptive.

CONCLUSION

For the reasons set forth above, the refusal to register under Section 2(e)(1) of the Trademark Act should be affirmed.

Respectfully submitted,

/Jeffrey S. DeFord/

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