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	85088266
LAW OFFICE ASSIGNED	LAW OFFICE 111
MARK SECTION (no change)	
ARGUMENT(S)	

REQUEST FOR RECONSIDERATION

In the Final Office Action dated February 1, 2011, registration was refused under 15 U.S.C. § 1052(e)(1) stating that Applicant's mark, MINI-HYBRID, merely describes the primary purpose of Applicant's goods identified in this application. Applicant seeks to register the mark MINI-HYBRID for use in connection with "cooling fan systems for engines" in International Class 7 ("Applicant's Goods"). Applicant respectfully disagrees with the analysis in the Office Action, and requests reconsideration of the refusal based on the following remarks and supporting evidence presented herewith.

Definitions Relied Upon by Examiner

The Feb. 1, 2011 Office Action defined "hybrid" as "anything made up of two or more elements" and "mini" as "anything that is miniature, or smaller than is usual." Applicant respectfully disagrees with the definitions relied upon by the Examining Attorney and how the defined terms are applied to Applicant's goods.

Hybrid

The Office Action relied upon a definition listed in the Oxford Dictionaries for "hybrid" as "a thing made by combining two different elements." This definition is overbroad when taken in context and applied literally would render virtually anything in existence that is comprised of more than one atomic

element a "hybrid." For example, under the referenced definition, water would be a "hybrid" of hydrogen and oxygen. Taken further, every machine (defined as "an assemblage of parts that transmit forces, motion, and energy one to another in a predetermined manner") would be a "hybrid" and the term would lose all of its meaning, especially in the context of engines used in vehicles. Thus, a more narrow definition of "hybrid" is appropriate for the purposes of the present descriptiveness analysis.

The Society of Automotive Engineers ("SAE") is a standards development organization for the engineering of self-powered vehicles of all kinds, including cars, trucks, buses, boats, aircraft, and others. SAE provides a forum for companies, government agencies, educational institutions and consultants to agree on technical standards for the worldwide vehicle mobility industry. SAE publishes more than 1,600 technical standards that are widely used in the transportation industry. One such standard is "(R) Hybrid Electric Vehicle (HEV) & Electric Vehicle (EV) Terminology," a copy of which is submitted herewith. *SAE J1715, Rev. Feb. 2008*. The standard's purpose "is to provide a record of commonly used terminology established by the technical community involved in writing practices and information reports for HEVs and EVs." *Id.* Section 4 of the standard is titled "Hybrid Electric Vehicle (HEV) Terminology." *Id.* It defines "Hybrid" as "[a] vehicle with two or more energy storage systems both of which must provide propulsion power – either together or independently." *Id.* The most common type of hybrid vehicle is one in which power is delivered to the driven wheels by a combination of an internal combustion engine and electric motors powered by a series of batteries.

Here, the product being sold under the MINI-HYBRID mark is installed on a bus with a traditional, single propulsion system involving an internal combustion engine. The MINI-HYBRID cooling fan system does not provide any propulsion power to the bus. Nor does the installation of the MINI-HYBRID system cause the bus to have more than one system providing propulsion to the bus. Rather, the MINI-HYBRID cooling system reduces the energy load on the single propulsion engine by replacing a cooling system that runs on the bus's hydraulic system with one that runs through a more efficient electrical, non-propulsive, system. It should also be noted that although busses have hydraulic systems, the hydraulic system does not provide propulsion to the vehicle, so the presence of the hydraulic system does not render the bus a hybrid. Hydraulic systems on busses typically control things like the brakes, and systems allowing the bus to "kneel" by lowering the front suspension of the bus to allow passengers to easily enter and exit the bus. Thus, busses that have the MINI-HYBRID system

installed do not fall under the SAE definition of "Hybrid." Applicant's use of the term HYBRID does not describe an aspect or characteristic of the product because the MINI-HYBRID system does not convert a traditional bus into a hybrid bus, and vehicles where the MINI-HYBRID system is installed are not, nor will ever be, hybrid vehicles under the SAE definition.

Mini

The Oxford Dictionaries definition of "mini" relied upon in the Office Action does not include the phrase "smaller than is usual." The definition listed in the Oxford Dictionaries reads in full: "denoting a miniature version of something." Applicant did not find any definitions of "mini" that include the phrase "smaller than is usual."

The Office Action relied on the "smaller than is usual" language to highlight the difference in size between the single, hydraulically driven fan present on many existing bus cooling systems, and the multiple, smaller fans present in the MINI-HYBRID system. Cooling fans come in a wide variety of sizes, however, and to suggest that the single, hydraulically driven fan present on many existing bus cooling systems is a "usual" size cooling fan does not accurately describe cooling fan sizes. There is no such thing as a "usual" size cooling fan. Indeed, cooling fans are used in a wide variety of applications where it is advantageous to cool one or more components of a system. For example, some very large cooling fans may be found on heavy equipment such as construction or mining trucks. Such fans may be several feet in diameter, much larger than the single cooling fan the MINI-HYBRID system replaces. On the other hand, nearly all computer systems include at least one cooling fan. Even the thinnest and smallest laptop computers include cooling fans, many with diameters less than 2", much smaller than the fans present in the MINI-HYBRID system. The fans present in the MINI-HYBRID cooling system are somewhat smaller than the single fan being replaced, but to characterize them as "mini" is not a precise description.

Thus, it is clear that the applied for MINI-HYBRID mark for a cooling fan system is not merely descriptive. The MINI-HYBRID system does not convert a non-hybrid bus into a hybrid bus, nor are the vehicles where the MINI-HYBRID system is installed hybrids, and the cooling fans present in the MINI-HYBRID system are not miniature. If anything, the term MINI-HYBRID merely suggests that the product will produce some of the benefits (better fuel economy) of a hybrid bus, without the great expense of purchasing a new expensive hybrid bus.

CONCLUSION

In view of the above remarks, Applicant believes that the application is now in condition for publication and requests notification of same. Applicant respectfully requests that the Examining Attorney telephone counsel for Applicant in the event that a telephone conference would expedite the processing of the application.

EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_675213130-101359837_._Surface__Vehicle_Info_Report.pdf
CONVERTED PDF FILE(S) (22 pages)	\\TICRS\EXPORT11\IMAGEOUT11\850\882\85088266\xml7\RFR0002.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\850\882\85088266\xml7\RFR0003.JPG
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DESCRIPTION OF EVIDENCE FILE	SAE Surface Vehicle Information Report: (R) Hybrid Electric Vehicle (HEV) & Electric Vehicle (EV) Terminology.
SIGNATURE SECTION	
RESPONSE SIGNATURE	/acl/
SIGNATORY'S NAME	Andrew C. Landsman
SIGNATORY'S POSITION	Attorney of record, Wisconsin bar member
DATE SIGNED	07/20/2011
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Jul 20 12:07:32 EDT 2011
TEAS STAMP	USPTO/RFR-67.52.13.130-20 110720120732913143-850882 66-48031843017f26fea8661f 039f4ae268c45-N/A-N/A-201 10720101359837695

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Request for Reconsideration after Final Action
To the Commissioner for Trademarks:

Application serial no. **85088266** has been amended as follows:

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

REQUEST FOR RECONSIDERATION

In the Final Office Action dated February 1, 2011, registration was refused under 15 U.S.C. § 1052(e)(1) stating that Applicant's mark, MINI-HYBRID, merely describes the primary purpose of Applicant's goods identified in this application. Applicant seeks to register the mark MINI-HYBRID for

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