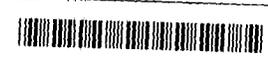


TTAB

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

In the Matter of Trademark Application Serial No. 76/398138
For the Mark: "REGISTERED SURGICAL TECHNOLOGIST (RST)"
Published in the Official Gazette: January 28, 2003



05-30-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

LIAISON COUNCIL ON)
CERTIFICATION FOR THE)
SURGICAL TECHNOLOGIST,)
Opposer,)
v.)
ASSOCIATION OF SURGICAL)
TECHNOLOGISTS, INC.,)
Applicant.)

Opposition No. _____

CERTIFICATE OF MAILING
I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS
BEING DEPOSITED WITH THE UNITED STATES POSTAL
SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE
ADDRESSED TO THE COMMISSIONER FOR
TRADEMARKS, BOX TTAB/EE 2900 CRYSTAL DRIVE,
ARLINGTON, VA 22202-3513 ON May 27, 2003.
BY: *Ginger Dorenkamp*
SHERIDAN ROSS P.C.

NOTICE OF OPPOSITION

Opposer, Liaison Council on Certification for the Surgical Technologist ("Opposer"), a corporation organized and existing under the laws of the state of Colorado, and having a place of business at 128 South Tejon Street, Suite 304, Colorado Springs, Colorado 80903, believes that it will be damaged by registration of the mark "REGISTERED SURGICAL TECHNOLOGIST (RST)" for a certification mark for certifying that a person meets the minimum qualifications established by the Certifier or its designate for highly skilled and specialized assistive services to surgeons and others in a surgical setting and for "surgical assistance services" as shown in U.S. Application Serial No. 76/398138, and hereby opposes the same.

As grounds for this Opposition, Opposer alleges:

- 1. Opposer's filing of this Notice of Opposition is timely. Applicant's U.S.

Application Serial No. 76/398138 for "REGISTERED SURGICAL TECHNOLOGIST (RST)"

published for opposition in the January 28, 2003 U.S. Patent and Trademark Office Official Gazette; Opposer filed a First Request for 30 Day Extension of Time to Oppose on February 25, 2003, a Second Request for 30 Day Extension of Time to Oppose on March 21, 2003; and a Third Request for 30 Day Extension of Time to Oppose on April 8, 2003. As such, the present deadline to file a Notice of Opposition is May 28, 2003, and this document is being filed prior to the present deadline.

2. Opposer is Liaison Council on Certification for the Surgical Technologist, a corporation organized and existing under the laws of the state of Colorado, and having a place of business at 128 South Tejon Street, Suite 304, Colorado Springs, Colorado 80903. Opposer is the owner of U.S. Certification Registration No. 1825663 for "CST" for a certification mark that certifies that a person has completed a year-long educational training program in surgical knowledge and skills and passed a national certifying examination and for "surgical techniques and skills utilized by individuals displaying the mark," and U.S. Certification Registration No. 2293913 for "CERTIFIED SURGICAL TECHNOLOGIST" for a certification mark that certifies that the utilizing individual has successfully passed the National Certifying Examination for Surgical Technologists and for "printed materials, namely, printed examinations, printed study guides, and printed educational books and booklets dealing with surgical techniques and surgical skills." TESS/TARR documentation regarding these two registrations is attached hereto as Exhibit 1.

3. Opposer has used the marks "CST" and "CERTIFIED SURGICAL TECHNOLOGIST" continuously since 1979 for certifying surgical services, namely skills and techniques utilized by individuals displaying the mark.

4. Opposer has devoted substantial time, money and effort in establishing and maintaining a high standard of quality for all certification services offered under and in connection with the "CST" and "CERTIFIED SURGICAL TECHNOLOGIST" marks. As a consequence, Opposer's "CST" and "CERTIFIED SURGICAL TECHNOLOGIST" marks have become widely and favorably known to the relevant public. By virtue of the public's recognition of Opposer's "CST" and "CERTIFIED SURGICAL TECHNOLOGIST" marks, Opposer has developed substantial goodwill in the marks.

5. Upon information and belief, Association of Surgical Technologists, Inc. ("Applicant") is the owner of U.S. Certification Application Serial No. 76/398138 for the mark "REGISTERED SURGICAL TECHNOLOGIST (RST)" for a certification mark for certifying that a person meets the minimum qualifications established by the Certifier or its designate for highly skilled and specialized assistive services to surgeons and others in a surgical setting and for "surgical assistance services," said application being filed on an intent-to-use basis on April 19, 2002.

6. Upon information and belief, Applicant has not used "REGISTERED SURGICAL TECHNOLOGIST (RST)", including any use on certification services for surgical skills in commerce in the United States.

7. Upon information and belief, as a result of the public's association of the "CST" and "CERTIFIED SURGICAL TECHNOLOGIST" marks with Opposer, Applicant's intended use and registration of the mark "REGISTERED SURGICAL TECHNOLOGIST (RST)", because of the similarity of the marks and the identical nature of the certification services, channels of trade, conditions under which and buyers to whom sales are made and other factors, is likely to cause

confusion, mistake or deception as to the source, origin or affiliation of Applicant's certification services for surgical skills.

8. If U.S. Certification Application Serial No. 76/398138 for "REGISTERED SURGICAL TECHNOLOGIST (RST)" is permitted to issue, despite this likelihood of confusion, Opposer's right to exclusive use of its "CST" and "CERTIFIED SURGICAL TECHNOLOGIST" marks will be impaired and Opposer will be damaged.

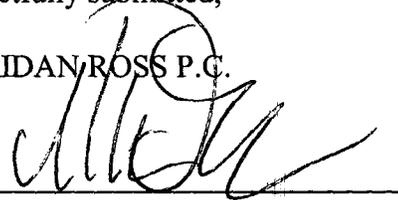
9. Opposer's "CST" and "CERTIFIED SURGICAL TECHNOLOGIST" marks are famous marks under 15 U.S.C. § 1125(c) for certifying surgical services, namely skills and techniques utilized by individuals displaying the mark.

10. Applicant's registration and use of "REGISTERED SURGICAL TECHNOLOGIST (RST)" will cause dilution of the distinctive quality of Opposer's famous "CST" and "CERTIFIED SURGICAL TECHNOLOGIST" marks under 15 U.S.C. § 1125(c).

WHEREFORE, Opposer prays that this Opposition be sustained and that the application for registration of U.S. Certification Application Serial No. 76/398138 for "REGISTERED SURGICAL TECHNOLOGIST (RST)" be denied and refused. A duplicate copy of this Notice of Opposition and the filing fee of \$300.00 is enclosed. Please debit or credit any under or overpayment to our Deposit Account No. 19-1970.

Respectfully submitted,

SHERIDAN ROSS P.C.

By: 

Sabrina C. Stavish, Esq.
Miriam D. Trudell, Esq.
Attorneys for Opposer
1560 Broadway, Suite 1200
Denver, Colorado 80202-5141
Phone: (303) 863-9700
Fax: (303) 863-0223

Date: 5/27/03

J:\3710\3\10\1\notice of opposition.wpd

EXHIBIT 1



UNITED STATES PATENT AND TRADEMARK OFFICE

Trade mark Electronic Search System (TESS)

TESS was last updated on Fri May 23 04:16:04 EDT 2003

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICTIONARY BOTTOM HELP

Logout Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

Check Status (TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark	CST
Goods and Services	IC B . US B . G & S: surgical techniques and skills utilized by individuals displaying the mark. FIRST USE: 19790101. FIRST USE IN COMMERCE: 19790101
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	74282940
Filing Date	June 9, 1992
Published for Opposition	December 14, 1993
Registration Number	1825663
Registration Date	March 8, 1994
Owner	(REGISTRANT) Association of Surgical Technologists, Inc. CORPORATION NEW YORK 7108-C South Alton Way Englewood COLORADO 80112 (LAST LISTED OWNER) LIAISON COUNCIL ON CERTIFICATION FOR THE SURGICAL TECHNOLOGIST CORPORATION BY ASSIGNMENT COLORADO 7790 EAST ARAPAHOE ROAD SUITE 240 ENGLEWOOD COLORADO 80112-127
Assignment Recorded	ASSIGNMENT RECORDED
Type of Mark	CERTIFICATION MARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Other Data	The certification mark, as used by authorized persons, certifies that a person has completed a year-long educational training program in surgical knowledge and skills and passed a national certifying

examination.

**Live/Dead
Indicator**

LIVE

[PTO HOME](#) [TRADEMARK](#) [TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DICT](#) [TOP](#) [HELP](#)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-05-23 10:58:34 ET

Serial Number: 74282940

Registration Number: 1825663

Mark (words only): CST

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2000-06-01

Filing Date: 1992-06-09

Registration Date: 1994-03-08

Law Office Assigned: TMEO Law Office # 07

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2001-10-15

CURRENT APPLICANT(S)/OWNER(S)

1. LIAISON COUNCIL ON CERTIFICATION FOR THE SURGICAL TECHNOLOGIST

Address:

LIAISON COUNCIL ON CERTIFICATION FOR THE SURGICAL TECHNOLOGIST
7790 EAST ARAPAHOE ROAD SUITE 240
ENGLEWOOD, CO 80112-127
United States

State or Country of Incorporation: Colorado

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

surgical techniques and skills utilized by individuals displaying the mark

International Class: B

First Use Date: 1979-01-01

First Use in Commerce Date: 1979-01-01

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2001-09-28 - Section 8 (6-year) and Section 15 Filed

2000-06-01 - Section 8 (6-year) accepted & Section 15 acknowledged

2000-03-10 - Section 8 (6-year) and Section 15 Filed

1994-03-08 - Registered - Principal Register

1993-12-14 - Published for opposition

1993-11-12 - Notice of publication

1993-04-26 - Approved for Pub - Principal Register (Initial exam)

1992-09-24 - Non-final action mailed

1992-09-03 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

SABRINA C. STAVISH
SHERIDAN ROSS P.C.
1560 BROADWAY
SUITE 1200
DENVER, CO 80202-5141
United States



UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Electronic Search System (TESS)

TESS was last updated on Fri May 23 04:16:04 EDT 2003

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Logout Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

Check Status (TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark CERTIFIED SURGICAL TECHNOLOGIST

Goods and Services IC B . US B . G & S: printed materials, namely, printed examinations, printed study guides, and printed educational books and booklets dealing with surgical techniques and surgical skills. FIRST USE: 19790000. FIRST USE IN COMMERCE: 19790000

Mark Drawing Code (1) TYPED DRAWING

Serial Number 75349326

Filing Date August 29, 1997

Published for Opposition August 31, 1999

Registration Number 2293913

Registration Date November 23, 1999

Owner (REGISTRANT) Liaison Council on Certification for the Surgical Technologist CORPORATION COLORADO 7790 East Arapahoe Road, Suite 240 Englewood COLORADO 801121274

Attorney of Record ROBERT R BRUNELLI

Type of Mark CERTIFICATION MARK

Register PRINCIPAL-2(F)

Other Data The certification mark, as used by authorized persons, certifies that the utilizing individual has successfully passed the National Certifying Examination for Surgical Technologists.

Live/Dead Indicator LIVE

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT TOP HELP

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-05-23 10:56:41 ET

Serial Number: 75349326

Registration Number: 2293913

Mark (words only): CERTIFIED SURGICAL TECHNOLOGIST

Current Status: Registered.

Date of Status: 1999-11-23

Filing Date: 1997-08-29

Registration Date: 1999-11-23

Law Office Assigned: TMO Law Office 114

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 1999-11-23

CURRENT APPLICANT(S)/OWNER(S)

1. Liaison Council on Certification for the Surgical Technologist

Address:

Liaison Council on Certification for the Surgical Technologist
7790 East Arapahoe Road, Suite 240
Englewood, CO 801121274
United States

State or Country of Incorporation: Colorado

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

printed materials, namely, printed examinations, printed study guides, and printed educational books and booklets dealing with surgical techniques and surgical skills

International Class: B

First Use Date: 1979-00-00

First Use in Commerce Date: 1979-00-00

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

1999-11-23 - Registered - Principal Register
1999-08-31 - Published for opposition
1999-07-30 - Notice of publication
1999-01-05 - Published for opposition
1998-12-04 - Notice of publication
1998-09-01 - Published for opposition
1998-07-31 - Notice of publication
1998-06-03 - Approved for Pub - Principal Register (Initial exam)
1998-06-01 - Examiner's amendment mailed
1998-05-22 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

ROBERT R BRUNELLI (Attorney of record)

ROBERT R BRUNELLI
SHERDIAN ROSS PC
1700 LINCOLN ST STE 3500
DENVER CO 80203
United States
