

To prevail on summary judgment, the moving party has the burden of establishing that there is no genuine issue of material fact. Federal Rule of Civil Procedure ("FRCP") 56(c); *University Book Store v. University of Wisconsin Board of Regents*, 33 U.S.P.Q.2d 1385, 1389 (TTAB 1994). Summary judgment is overcome by the non-movant only if a dispute exists as to a material fact – that is, a fact "that may affect the decision in the case." *University Book Store*, 33 U.S.P.Q.2d at 1389. A genuine issue of material fact exists if sufficient evidence is presented that a reasonable finder of fact could decide the issue in favor of the non-movant. *Id.* (citing *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847 (Fed. Cir. 1992)). Factual disputes on summary judgment are construed in a light favorable to the non-movant – here Applicant. *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 U.S.P.Q.2d 1030, 1034-35 (TTAB 1996) (citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986)). Doubts about likelihood of confusion, however, are resolved in favor of the Opposer in an Opposition Proceeding such as this. *Hewlett-Packard Co.*, 281 F.3d at 1265 (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1209 (Fed Cir. 1993)).

B. The Parties' Marks are Confusingly Similar.

Applicant asserts that an issue of material fact exists as to the similarity of Opposer's mark DA VINCI ("Opposer's Mark")¹ and Applicant DaVinci Radiology Associates, P.L.'s ("Applicant") designation DAVINCI DIAGNOSTIC IMAGING & Design ("Applicant's Mark") (collectively referred to as the "Parties' Marks") because: (i) the Parties' Marks differ in appearance and sound when viewed in their entireties; (ii) Opposer has offered no evidence of the connotation of the Marks; and (iii) the commercial impression of the Marks is dissimilar.

¹ Opposer bases its Opposition here on its marks DA VINCI and DA VINCI S HD SURGICAL SYSTEM (Stylized) but refers herein only to DA VINCI for simplicity.

Applicant's Response to Motion for Summary Judgment ("Applicant's Response") at p. 11.

Applicant is simply incorrect with regard to all three contentions.

1. The Parties' Marks are Confusingly Similar in Appearance and Sound.

Applicant asserts that the Parties' Marks differ because Opposer's Mark is a word mark consisting of two words ("DA" and "VINCI"), with a capitalized "V" and sometimes a capitalized "D" whereas Applicant's Mark is a "stylized, graphically designed" mark consisting of three words ("DAVINCI", "DIAGNOSTIC" and "IMAGING"), with no space in the "DAVINCI" term and a consistently capitalized "D" in "DAVINCI", and because the terms "DIAGNOSTIC" and "IMAGING" create a distinct sound from that of "DA VINCI" alone. Applicant's Response at pp. 6-7. Applicant ignores, however, that the only portion of its Mark capable of functioning as a source indicator is essentially identical to Opposer's Mark.

As described more fully in Opposer's Motion for Summary Judgment ("Opposer's Motion"), the dominant term of both Parties' Marks is the term "DA VINCI". *See* Opposer's Motion at pp. 13-15. Applicant has not stated otherwise. Both the terms "DIAGNOSTIC" and "IMAGING" in Applicant's Mark are descriptive of its services² and the term "DIAGNOSTIC" has been disclaimed on that basis. *Id.* at 13-14; Declaration of Michelle J. Hirth in Support of Motion for Summary Judgment ("Hirth Decl."), submitted previously, at ¶ 30 and Exhibits A, G, L & M thereto. Moreover, Applicant's licensee, Medical Specialists of the Palm Beaches ("MSPB"), refers to its facility and services offered under Applicant's Mark simply as "DaVinci", thereby illustrating it is the "DAVINCI" term that is promoted to consumers and associated by consumers with MSPB's services. Opposer's Motion at p. 14; Hirth Decl. at ¶¶ 27 & 29 and

² By its statement that the "literal meaning" of its Mark "convey[s] a commercial impression of physicians, radiologists, x-rays, CAT scans, PET scans, ultrasound, MRI and other diagnostic imaging services", Applicant concurs that "DIAGNOSTIC" and "IMAGING" are descriptive of its services. Applicant's Response at p. 11.

Exhibits K & M thereto. Here, the dominant term, and only term capable of functioning as an indicator of source, is "DAVINCI". A subsequent user may not avoid likelihood of confusion by appropriating another's entire mark and adding descriptive or non-distinctive matter to it.

Electropix v. Liberty Livewire Corp., 178 F. Supp.2d 1125, 1132 (C.D. Cal. 2001) (quoting Thomas J. McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 23.50 (4th ed.)).

Further, similarities of marks are weighed more heavily than differences and the Board should give the greatest weight to the dominant feature of the Parties' Marks – "DA VINCI".

GoTo.com, Inc. v. Walt Disney Co., 202 F.3d 1199, 1205-06 (9th Cir. 2000); *Plantronics Inc. v. Starcom Inc.*, 213 U.S.P.Q. 699, 702 (TTAB 1982). Neither capitalization nor the presence or absence of a space obviate the similarity of the "DA VINCI" terms in the Parties' respective Marks. *See Lisa Frank, Inc. v. Impact Int'l Inc.*, 799 F. Supp. 980, 998 (D. Az. 1992) (likelihood of confusion is not based on whether "marks can be differentiated when subjected to a side-by-side comparison but, rather, whether they create the same general overall impression").

2. The Parties' Marks also are Confusingly Similar in Meaning.

Applicant asserts its Mark "connotes a high level of sophistication and intelligence" and that Opposer has failed to address the similarity of the connotations, or meanings, of the Parties' respective Marks thereby creating a genuine issue of material fact. Applicant's Response at p. 11 (emphasis added). To the contrary, Opposer has indicated that the term "DA VINCI" refers to the 16th Century Renaissance man Leonardo Da Vinci and, as such, "embodies artistry, scientific innovation, precision, intelligence, sophistication and versatility, particularly when used in association with goods or services in the medical field[.]" Opposer's Motion at pp. 14-15 (emphasis added). As evidenced by the statements in their respective briefs, the Parties expressly agree that their Marks have similar connotations and, therefore, no genuine issue of material fact exists as to this issue.

3. The Parties' Marks are Similar in Overall Commercial Impression.

As recognized by the Federal Circuit, "the phrase 'commercial impression' is occasionally used as a proxy for the ultimate conclusion of similarity or dissimilarity of marks resulting from a comparison of their appearance, sound and meaning." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372 (Fed. Cir. 2005) (citing *Hewlett-Packard Co.*, 281 F.3d at 1266-67; *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 355 (Fed. Cir. 1992) ("in light of the appearance, sound and meaning of the marks PLAY-DOH and FUNDOUGH, consumers may receive the same 'commercial impression' from the marks"); *Morton-Norwich Prods., Inc. v. S.C. Johnson & Son, Inc.*, 531 F.2d 561, 562 (CCPA 1976)). Contrary to Applicant's assertion, Opposer has indicated that its Mark, as used with its computerized surgical systems, connotes scientific innovation, precision, intelligence, sophistication and versatility thereby creating a commercial impression that goods offered under the Mark are the most advanced and sophisticated technologies available. Opposer's Motion at p. 15. Applicant's assertion that its Mark is intended to convey a commercial impression of a "high-end imaging center that emphasizes state-of-the-art imaging in an elegant setting" simply confirms the similarity of the overall commercial impressions conveyed by the Parties' Marks – sophisticated, intelligent and technologically advanced medical goods and services. See Applicant's Response at p. 11; Response to Interrogatory No. 2 of Applicant's Responses to Opposer's First Set of Interrogatories to Applicant (Exhibit D to Hirth Decl.).

Further, Applicant erroneously attempts to distinguish the cases cited by Opposer and asserts that whether "DaVinci" can be equated with the marks at issue in those cases is a material question of fact. Applicant's Response at pp. 13-14. First, Applicant's asserts that the "prominence" or "natural fame" of "daVinci" in the surgical field cannot be equated with "HEWLETT-PACKARD'S involvement in technology-based goods", "the natural prominence of

the U.S. ARMY as a branch of the U.S. military" and "the national fame of VEUVE CLIQUOT (sic)" in the champagne and sparkling wine market, thereby suggesting that a finding of confusing similarity of marks requires that the senior user's mark be famous. Applicant's Response at pp. 13-14. It does not. *See, e.g., In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357 (CCPA 1973).

Second, Applicant's attempt to distinguish the cited cases as finding confusing similarity because the senior marks involved were famous or well-known in the relevant industry is misplaced.³ For example, in *Palm Bay Imports, Inc.*, the Federal Circuit analyzed the similarity of the applicant's mark VEUVE ROYALE and the opposer's marks VEUVE CLICQUOT and VEUVE CLICQUOT PONSARDIN. 396 F.3d at 1372. In upholding the Board's determination that the parties' marks were similar, the Court stated:

The Board correctly weighed the relative importance of VEUVE and CLICQUOT. VEUVE is an arbitrary term as applied to champagne and sparkling wines, and thus conceptually strong as a trademark. . . . To be sure, CLICQUOT is an important term in the mark, but VEUVE nonetheless remains a "prominent feature" as the first word in the mark and the first word to appear on the label. Not only is VEUVE prominent in the commercial impression created by [opposer's] marks, it also constitutes "the dominant feature" in the commercial impression created by [applicant's] mark. *Veuve Clicquot Ponsardin*, slip op. at 31-31 (VEUVE is first word in mark; significance of ROYALE is more laudatory and less source-indicating than VEUVE or "widow"; arbitrary term VEUVE contributes more to commercial impression of product than ROYALE). The presence of this strong distinctive term as the first word in both parties' marks renders the marks similar, especially in light of the largely laudatory (and hence non-source identifying) significance of the word ROYALE.

Id. at 1372-73 (citations omitted). Here, as in *Palm Bay Imports, Inc.*, the only distinctive term in Applicant's Mark, and the sole term in Opposer's Mark, is "DA VINCI". "DAVINCI" is the

³ In addition, contrary to Applicant's contention, a case need not be an "appeal from summary judgment" to be on point and/or citable for a legal proposition pertinent to a motion for summary judgment as here.

dominant feature in both Marks and, as the first word and the often-used short hand reference for Applicant's Mark and services offered thereunder, is the most prominent feature in the commercial impression created by both Parties' Marks. The Parties' respective Marks are therefore confusingly similar as a matter of law.

C. The Goods and Services Offered Under the Respective Marks are Related.

Applicant asserts that: (i) an issue of material fact is raised as to the similarity of the goods and services offered under the Parties' respective Marks because Opposer offers goods classified in International Class 10 and Applicant offers services classified in International Class 44; and (ii) no reasonable consumer would assume Applicant's radiology services would emanate from the natural expansion of Opposer's activities. Applicant's Response at pp. 17-18. Applicant is incorrect on both points and has provided no evidence in support of either proposition.

The International Classes in which goods and services are categorized are irrelevant for purposes of a likelihood of confusion analysis. *See Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971 (Fed. Cir. 1993); *National Football League v. Jasper Alliance Corp.*, 16 U.S.P.Q.2d 1212, 1216 n.5 (TTAB 1990). Similarly, goods and services are not distinguished for purposes of a likelihood of confusion analysis. *See, e.g., In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463 (Fed. Cir. 1988) (BIGG'S (Stylized) for retail grocery and general merchandise store services is likely to be confused with BIGGS & Design for furniture); *In re H.J. Seiler Co.*, 289 F.2d 674 (CCPA 1961) (SEILER for catering services likely to be confused with SEILER'S for smoked and cured meats); *In re U.S. Shoe Corp.*, 229 U.S.P.Q. 707 (TTAB 1985) (CAREER IMAGE (Stylized) for retail women's clothing store services and clothing likely to be confused with CREST CAREER IMAGES (Stylized) for uniforms). The International Class and goods versus services distinctions do not raise a genuine issue of material fact here.

The Parties' goods and services need not be identical or even competitive for consumer confusion to be likely. *Barbara's Bakery Inc. v. Landesman*, 82 U.S.P.Q.2d 1283, 1286 (TTAB 2007). Instead, "[i]t is sufficient that the goods [or services] be related in some manner" or that a relationship exist between their respective channels of distribution or classes of purchasers such that consumers will mistakenly assume the senior user is the source of the applicant's services. *Id.* Here, it is undisputed that both Opposer's goods and Applicant's services are in the medical and health care field. *See* Hirth Decl. at ¶¶ 22 & 27-29 and Exhibits K, L & M thereto; Responses to Interrogatory Nos. 13 & 16 of Responses to Applicant's Interrogatories to Opposer (Exhibit E to Hirth Decl.); Response to Interrogatory No. 16 of Applicant's Responses to Opposer's Interrogatories to Applicant (Exhibit D to Hirth Decl.). It is further undisputed that Opposer's computerized surgical systems include a master control, an immersive video display, camera processing equipment and system software, provide high resolution images of the surgical field during a wide variety of surgical procedures, and incorporate optics, imaging and display technologies. Hirth Decl. at ¶¶ 17-20 & 31-32 and Exhibits H, I & N thereto; Response to Interrogatory Nos. 5 and 13 of Responses to Applicant's Interrogatories to Opposer (Exhibit E to Hirth Decl.). It also is undisputed that Applicant's licensee offers diagnostic imaging services under Applicant's Mark, including digital mammography, MRI, PET scans and CT scans, and, as described more fully in Opposer's Motion, these diagnostic imaging services all produce images of portions of the human body and are computerized. Applicant's Response at pp. 3 & 14; Hirth Decl. at ¶¶ 28 & 29 and Exhibits L, M & P thereto; Response to Interrogatory No. 3 of Applicant's Supplemental Response to Opposer's First Set of Interrogatories to Applicant (Exhibit G to Hirth Decl.); Opposer's Motion at p. 19. By virtue of their use in the medical and health care industries and incorporation of similar technologies, the Parties' goods and services are related. Further, as described in Opposer's Motion and in Sections I.D. and I.E. below, the

consumers of both Parties' respective goods and services include surgeons and both Parties' market their respective goods and services via the Internet,⁴ thereby enhancing the relatedness of their respective goods and services.

A senior user, such as Opposer, can preclude junior use of the same or similar mark for any goods or services that might reasonably be assumed to emanate from the senior user in the normal expansion of its business under the mark. *Eikonix Corp. v. C.G.R. Medical Corp.*, 209 U.S.P.Q. 607, 613 (TTAB 1981). Applicant contends that no reasonable consumer would assume Applicant's professional radiology services would emanate from Opposer, a "design[er] and manufactur[er]" of surgical goods.⁵ Applicant's Response at p. 18. As the Parties' goods and services are offered in the same industry, employ overlapping technology and are offered under an identical arbitrary term (and, as described below, are marketed via overlapping trade channels to overlapping classes of consumers), it is not unreasonable for consumers to assume both Opposer's surgical systems and Applicant's medical diagnostic imaging services emanate from the same source.

In fact, the Board's ruling in *Eikonix Corp.*, which Applicant attempts to distinguish, supports Opposer's point. 209 U.S.P.Q. 607 (TTAB 1981). In *Eikonix Corp.*, the senior registrant held a registration for products and services related to optics and photography and the junior registrant held a registration for a medical x-ray television camera and related control unit. 209 U.S.P.Q. at 608. The Board determined that a relationship existed between the technique

⁴ Applicant has asserted that physicians, including surgeons, are not consumers of the services offered under its Mark but has failed to submit any evidence of that assertion. See Section I.E. below.

⁵ Contrary to Applicant's contention, a consumer need not assume that Opposer "employs licensed physicians, rents or builds diagnostic imaging centers, rents or buys diagnostic imaging equipment, [and] submits billing to insurance companies and the government for reimbursement" for likely confusion as to source. See Applicant's Response at p. 18. The services for which registration is sought here are medical diagnostic imaging services. They do not include employment of physicians, renting of imaging centers, purchasing of equipment and submission of billing to insurance or the government, none of which are services offered to the consuming public under Applicant's Mark. Accordingly, whether consumers are likely to assume Opposer engages in such activity is irrelevant.

and equipment used by the senior registrant to study and evaluate photographic images and by the junior registrant in equipment necessary to study and evaluate images obtained by x-ray equipment. *Id.* at 614. Even though, unlike here, the industries in which the parties' respective goods were offered were entirely different, the Board noted that "[i]t would be a natural expansion of [the senior registrant's] activities in designing and manufacturing equipment for recording, analyzing, and measuring images to move into the field of x-ray imagery." *Id.* Similarly, it would be natural for Opposer to move into the design and manufacture of diagnostic imaging devices and/or diagnostic imaging services.

Further, the examples of a single entity producing goods and related services within a single industry under a single mark are legion. By way of merely one example, the mark PETRO STAR INC. & Design is registered in the name of Petro Star Inc. for petroleum products and for oil and fuel refining services. A true and correct copy of the record of the United States Patent & Trademark Office TARR database for Registration No. 3064065 for PETRO STAR INC. & Design is attached to the Hirth Reply Decl. as Exhibit A.

D. The Channels of Trade for the Parties' Respective Goods and Services Overlap.

Applicant asserts that Opposer's goods are "likely to continue" to move through trade channels that include, among others, direct sales calls to physicians, surgeons and administrators of hospitals and surgical centers, workshops for and training or other education of surgeons and physicians, the Internet and distribution of promotional materials such as brochures, that Applicant's licensee is "likely to continue" to use trade channels such as the Internet, brochures and visits and presentations at doctor's offices, and, erroneously, that therefore the trade or marketing channels used by the Parties' are disparate. Applicant's Response at p. 18. Applicant's contentions are neither based on competent evidence nor factually accurate.

First, absent restrictions in a party's application or registration, the party's goods or services are presumed to be marketed in all customary trade channels to all customary classes of consumers. *Hewlett-Packard Co.*, 280 F.3d at 1268 (citing *CBS, Inc. v. Morrow*, 708 F.2d 1579, 1581 (Fed. Cir. 1983)); *Barbara's Bakery Inc.*, 82 U.S.P.Q.2d at 1287; *Eikonix Corp.*, 209 U.S.P.Q. at 613-14. It is undisputed that neither Applicant's application nor Opposer's registration and application at issue here contain restrictions on the trade or marketing channels that the Parties' may use. Exhibits A, H & I to Hirth Decl. Accordingly, whether the trade or marketing channels recited by Applicant are "likely to continue" is irrelevant. Moreover, Applicant has submitted no competent evidence regarding the trade or marketing channels used by Applicant's licensee. The Declaration of Thomas P. Boyle, M.D. in Support of Applicant's Response to Opposer's Motion for Summary Judgment ("Boyle Decl."), submitted in this Proceeding, states that "upon information and belief" MSPB is "likely" to continue to use the Internet and brochures for marketing of its services and is "unlikely" to advertise its services in journals or publications that target physicians, health care professionals and administrators of hospitals and surgical centers or to engage in certain other marketing activities. Boyle Decl. at ¶ 10. Competent evidence in the form of a declaration must be based upon the declarant's personal knowledge. FRCP 56(e)(1); 37 Code of Federal Regulations ("C.F.R.") § 2.116 (unless otherwise provided, the Federal Rules of Civil Procedure apply to *inter partes* proceedings before the Board). Here, Dr. Boyle has based his statements upon information and belief rather than personal knowledge. These declaratory statements, therefore, are not competent evidence and should not be considered by the Board.

Second, even if Dr. Boyle's declaratory statements were made based upon personal knowledge and were competent evidence in this Proceeding, they simply further support the undisputed evidence that the trade or marketing channels used by the Parties overlap. It is

undisputed that Opposer markets goods under its Mark via, among other things, the Internet, brochures, and direct sales calls to physicians, surgeons and administrators of hospitals and surgical centers. Hirth Decl. at ¶ 23; Responses to Interrogatory Nos. 5 & 13 of Responses to Applicant's First Set of Interrogatories to Opposer (Exhibit E to Hirth Decl.). It also is undisputed that MSPB markets its services under Applicant's Mark via, among other things, the Internet, brochures and visitation and presentations by Applicant to doctors' offices. Applicant's Response at p. 18; Boyle Decl. at ¶ 10; Hirth Decl. at ¶¶ 27-29 and Exhibits K, L & M thereto; Supplemental Responses to Interrogatory Nos. 5 & 11 of Applicant's Supplemental Responses to Opposer's First Set of Interrogatories to Applicant (Exhibit G to Hirth Decl.). Accordingly, it is undisputed that goods and services offered under the Parties' respective Marks are marketed via the Internet, brochures and "visits" or "sales calls" to physicians, therefore overlap, and thereby enhance the likelihood of confusion.

E. The Consumers of the Parties' Respective Goods and Services Overlap.

Applicant asserts there is a "factual issue of whether Applicant's buyers are patients or the intermediary, referring doctors" and that a genuine issue of material fact exists regarding the similarity of the consumers of the goods and services offered under the Parties' respective Marks. Applicant's Response at p. 19. All of the competent evidence before the Board, however, shows that physicians, including surgeons, are consumers of the goods and services offered under both Parties' Marks and, therefore, no issue of material fact exists.

Consumers of goods and services include "users" of those goods and services and those to whom the goods and services are marketed and offered, whether or not monetary payment is made. *Karl Storz Endoscopy-America v. Surgical Technologies Inc.*, 62 U.S.P.Q.2d 1273, 1277 (9th Cir. 2002) (doctors who use endoscopes but do not themselves purchase them are consumers); *ProQuest Information and Learning Co. v. Island*, 83 U.S.P.Q.2d 1351, 1356

(TTAB 2007) (classes of consumers of both applicant's and opposer's software include the ultimate users of the goods as well as the initial purchasers). It is undisputed that neither Opposer's registration and application nor Applicant's application contain restrictions pertaining to the consumers of the covered goods and services. *See* Exhibits A, H & I to Hirth Decl. Accordingly, all customary consumers of the goods and services offered under the Parties' Marks is presumed. *Hewlett Packard Co.*, 281 F.3d at 1268.

In this case, there is evidence in the record of the relevant classes of consumers. It is undisputed that the consumers of Opposer's surgical systems are medical and health care professionals, including surgeons and other physicians. Hirth Decl. at ¶ 23; Responses to Interrogatory Nos. 13 & 16 of Responses to Applicant's First Set of Interrogatories to Opposer (Exhibit E to Hirth Decl.). Despite Applicant's statements to the contrary, it also is undisputed that consumers of services under Applicant's Mark include both patients and physicians. First, as acknowledged by Applicant, physicians refer patients to providers of medical diagnostic imaging services and such referrals may include the name of a single source of those services, such as Applicant's licensee. Applicant's Response at p. 20. Even though the patient or its insurer may ultimately pay for the services and decide to obtain those services, it is undisputed that the physician – not the patient – "orders" the necessary services, refers the patient to the source of those services and uses the diagnostic imaging to aid in the diagnosis of disease, illness or injury, to devise medical treatment plans and to treat patients. The use by physicians, including surgeons, of these services is evidenced by the statement on the Internet website of Applicant's licensee that "[t]he Medical Specialists of the Palm Beaches operates two state-of-the-art Diagnostics centers that provide you and your physician with one comprehensive source for diagnostics, medical testing and laboratory procedures[]" and the statements in its brochures that

the services "give physicians more complete information[.]" "allow[] doctors to make more precise diagnoses[.]" "[a]id[] doctors in determining the proper course of treatment" and "[h]elp[] guide surgeons to the exact location of the cancer[.]" See Exhibits K & L to Hirth Decl. (emphasis added). Whether the Internet websites of Applicant or its licensee are "aimed at the patient" is immaterial.⁶ Moreover, it is undisputed that services offered under Applicant's Mark are marketed directly to physicians through "visiting and presenting at doctor's offices."⁷ Applicant's Response at p. 8; Boyle Decl. at ¶ 10. Accordingly, the consumers of the goods and services offered under the Parties' respective Marks overlap, exacerbating the likelihood of confusion here.

F. The Protection Afforded Opposer's Marks is Not Narrowed as a Result of the Third Party Registrations of "DA VINCI" Marks Cited by Applicant.

Third party registrations are probative evidence that a term may not be particularly distinctive in a field and has a readily understood suggestive meaning in that field. *Bost Bakery, Inc. v. Roland Indus. Inc.*, 216 U.S.P.Q. 799, 801 n.6 (TTAB 1982). Evidence of third party use of similar marks for similar goods or services is relevant to show a mark is weak and entitled only to narrow protection. *Palm Bay Imports Inc.*, 396 F.3d at 1373. In this case, the third-party registrations referred to by Applicant simply do not suggest a crowded field or obviate the likelihood of confusion.

⁶ In addition, the only "evidence" offered by Applicant to support its proposition that only patients are consumers of services offered under its Mark are Applicant's interrogatory response that "to the best of its knowledge and belief, MSPB's consumers are medical patients" and Dr. Boyle's declaration that "[u]pon information and belief, the website, www.mspb.md, to the extent it is devoted to diagnostic imaging services, is directed toward patients, not doctors." Response to Interrogatory No. 16 of Applicant's Responses to Opposer's First Set of Interrogatories to Applicant (Exhibit D to Hirth Decl.); Boyle Decl. at ¶ 8. Neither of these statements is based upon personal knowledge and, therefore, neither is competent evidence to be considered by the Board. FRCP 56(e)(1).

⁷ Whether or not "any of Applicant's members" are likely to "run into one of Opposer's sales force at another doctor's office" is irrelevant as it is the overlap of consumers, not a possible meeting of the Parties, at issue here. See Applicant's Response at p. 8; Boyle Decl. at ¶ 10.

First, it is undisputed that the term "DA VINCI" is arbitrary (rather than suggestive) for computerized surgical systems and for diagnostic imaging services, and is therefore a conceptually strong mark. Opposer's Motion at pp. 11 & 13; Applicant's Response at p. 2; Response to Interrogatory No. 2 of Applicant's Response to Opposer's First Set of Interrogatories to Applicant (Exhibit D to Hirth Decl.).

Second, Applicant has submitted no evidence of third-party use of the term "DA VINCI" for goods or services in the medical and health care field. Registrations and applications for registration of trademarks are not evidence of use of such marks in the marketplace and merely evidence registration or that registration is sought. Accordingly, Applicant has offered no evidence that Opposer's Mark is weak and deserving of a narrowed scope of protection.

Third, even if *arguendo* Applicant's assertion of a crowded field were based on competent evidence, it is nonetheless erroneous. Applicant refers to 115 live records in the U.S. Patent & Trademark Office's TARR database that contain the term "DA VINCI", of which 67 are for trademark registrations (rather than pending applications), and 38 live records that contain the term "DAVINCI", of which 27 are for trademark registrations. Opposer's Response at pp. 8-9 & 21-22. Pending applications do not necessarily indicate use of the marks that are the subjects of those applications and consequent crowding of the field. Further, only those registrations and applications for marks that are confusingly similar to Opposer's Marks – that is, for use on or in association with goods or services sufficiently related to Opposer's goods to be likely to cause confusion as to source – are relevant here.

Applicant has pointed to sixteen registrations or applications for registration of marks that consist of or include the terms "DA VINCI" or "DAVINCI[.]" Applicant's Response at pp. 9 & 21-22; Declaration of Matthew T. Vanden Bosch in Support of Applicant's Response to Opposer's Motion for Summary Judgment ("Vanden Bosch Decl.") at ¶ 13 and Exhibit J thereto.

Most of these registrations and applications are for goods or services wholly unrelated to those of Opposer. For example, the registrations cited include DA VINCI registered in the name of SEZ AG Corporation (Registration No. 2941295) for machines for producing semiconductors and microelectronic semiconductor products, DA VINCI registered in the name of Honeywell International Inc. (Registration No. 2547768) for, among other similar goods, "operator station consisting of application software which accesses information regarding web or sheet characteristics, and control functions implemented in software for modifying paper machine control", and DAVINCI (Stylized) in the name of Rauland-Borg Corporation (Registration No. 3276496) for graphical user interface software. The applications cited by Applicant include DAVINCI TEXAS INSTRUMENTS & Design in the name of Texas Instruments Inc. (Application Serial No. 76656731) for semiconductor integrated circuit microchips and DA VINCI in the name of Texas Instruments Inc. (Application Serial No. 78565344) for, among other similar goods, digital video semiconductors and digital video integrated circuits. *Id.* These registrations and applications, even if they were to establish use of the marks, which they do not, are irrelevant to the strength of Opposer's Mark.

The remaining registrations and applications cited by Applicant also do not illustrate a crowded field. The applications for registration of DA VINCI CENTER & Design and DA VINCI CENTER both in the name of Da Vinci Center, LLC (Application Serial Nos. 78/710291 and 77/321258, respectively) for post medical doctorate degree educational services are, respectively, the subjects of a pending Opposition Proceeding initiated by Opposer and an extension of time to oppose filed by Opposer. Hirth Reply Decl. at ¶ 5. The application for registration of DA VINCI in the name of BioMerieux B.V. (Application Serial No. 76/248,902, which matured into Registration No. 2870790) for discrete photometric analyzers for clinical use was the subject of an Opposition Proceeding initiated by Opposer and was informally resolved

via a coexistence agreement that protected the rights of Opposer in its Mark. Hirth Reply Decl. at ¶ 6. The remaining registrations cited by Applicant are for marks for use in association with ceramics for use in cosmetic dentistry, dental ceramics, manufacturing of custom dental porcelain veneers and dental laboratory services. See Exhibit J to Vanden Bosch Decl. These goods are solely for use in the dental industry by dentists. Dentists do not perform the types of surgical procedures for which Opposer's goods are used, Opposer does not market its goods under the Mark to dentists and dentists are not consumers of goods offered under Opposer's Mark. Hirth Decl. at ¶¶ 21-23; Responses to Interrogatory Nos. 3-5, 13 & 16 of Responses to Applicant's First Set of Interrogatories to Opposer (Exhibit E to Hirth Decl.). These latter marks simply are not confusingly similar to Opposer's Mark and, if in use, do not crowd the field.

G. The Issue of Fame of Opposer's Marks is Irrelevant Here.

Applicant erroneously asserts that no evidence of the fame of Opposer's Mark has been offered here and, therefore, no consumer confusion is likely in this case. Applicant's Response at p. 21. Applicant wholly misstates the applicable law. Fame of a senior mark simply is not necessary for a determination of likelihood of confusion. See, e.g., *E.I. DuPont DeNemours & Co.*, 476 F.2d 1357 (CCPA 1973).

H. Actual Confusion is Not Necessary for a Showing of Likelihood of Confusion.

Applicant suggests that the absence of actual consumer confusion despite concurrent use of the respective Marks by the Parties is a compelling fact in this case. However, contrary to Applicant's assertion, evidence of actual confusion is not necessary for a showing of a likelihood of confusion and to prevail in an Opposition Proceeding such as this. *GoTo.com, Inc.*, 202 F.3d at 1208; *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549 (Fed. Cir. 1990).

II. CONCLUSION

For the foregoing reasons and those set forth in its Motion for Summary Judgment submitted in this Proceeding, Opposer Intuitive Surgical, Inc. respectfully requests that this Board grant its motion for summary judgment and preclude registration on the Principal Register of Applicant DaVinci Radiology Associates, P.L.'s mark DAVINCI DIAGNOSTIC IMAGING & Design.

Dated: May 23, 2008

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By



Michelle D. Kahn
Michelle J. Hirth
Attorneys for Opposer
INTUITIVE SURGICAL, INC.

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San Francisco, CA 94111
TEL: (415) 434-9100
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CERTIFICATE OF SERVICE

Intuitive Surgical Inc. v. DaVinci Radiology Associates, P.L.
Opposition No. 91175319

On May 23, 2008 I hereby certify that I served a copy of the following:

1. **Reply in Support of Opposer intuitive Surgical, Inc's Motion for Summary Judgment**

by U.S. Mail to:

Matthew T. Vanden Bosch, Esq.
301 Clematis Avenue, Suite 3000
West Palm Beach, Florida 33401

Attorneys for Applicant

Executed on May 23, 2008, at San Francisco, California.



Miranda Lewis

CERTIFICATE OF SERVICE

Intuitive Surgical Inc. v. DaVinci Radiology Associates, P.L.
Opposition No. 91175319

On May 23, 2008 I hereby certify that I served a copy of the following:

1. **Declaration of Michelle J. Hirth in Support of Reply in Support of Opposer intuitive Surgical, Inc's Motion for Summary Judgment**

by U.S. Mail to:

Matthew T. Vanden Bosch, Esq.
301 Clematis Avenue, Suite 3000
West Palm Beach, Florida 33401

Attorneys for Applicant

Executed on May 23, 2008, at San Francisco, California.



Mironda Lewis

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

INTUITIVE SURGICAL, INC.,)

Opposer,)

v.)

DAVINCI RADIOLOGY ASSOCIATES,)
P.L.,)

Applicant.)

Opposition No. 91175319

Serial No. 78/728,786

Published: December 19, 2006

DECLARATION OF MICHELLE J. HIRTH IN SUPPORT OF REPLY IN SUPPORT OF
OPPOSER INTUITIVE SURGICAL, INC.'S MOTION FOR SUMMARY JUDGMENT

I, Michelle J. Hirth, declare:

1. I am an attorney with the law firm of Sheppard, Mullin, Richter & Hampton, LLP, counsel for Opposer Intuitive Surgical, Inc. ("Opposer") and am one of the attorneys responsible for representing Opposer in this Opposition Proceeding.

2. The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of her own knowledge are true and all statements on information and belief are believed to be true.

3. If called as a witness, I could and would competently testify to the following:

4. On May 23, 2008, I logged onto the Internet website of the U.S. Patent & Trademark Office, www.uspto.gov, and accessed the U.S. Patent & Trademark Office's TARR database. At that time, I searched for the status and record of U.S. Trademark Registration No. 3064065 for PETRO STAR INC. & Design and printed the resultant record. A true and correct copy of the record of the United States Patent & Trademark Office TARR database for Registration No. 3064065 for PETRO STAR INC. & Design in the name of Petro Star Inc. is attached hereto as Exhibit A.

5. On December 18, 2007, the mark DA VINCI CENTER & Design in the name of Da Vinci Center, LLC, U.S. Trademark Application Serial No. 78710291, was published for opposition in the *Official Gazette*. On January 14, 2008, Intuitive Surgical, Inc., Opposer in this action, filed a request for extension of time to oppose Application Serial No. 78710291. On February 19, 2008, Intuitive Surgical, Inc. filed a Notice of Opposition initiating an Opposition Proceeding against Application Serial No. 78710291. That Opposition Proceeding is currently pending. I am one of the attorneys responsible for representing Intuitive Surgical, Inc. in that Opposition Proceeding.

6. On September 30, 2003, the mark DA VINCI in the name of BioMerieux B.V., then U.S. Trademark Application Serial No. 76248902, was published for opposition in the *Official Gazette*. On November 4, 2003, Intuitive Surgical, Inc., Opposer in this action, filed a request for extension of time to oppose Application Serial No. 76248902. December 8, 2003, Intuitive Surgical, Inc. filed a Notice of Opposition initiating an Opposition Proceeding against Application Serial No. 76248902. I was one of the attorneys responsible for representing Intuitive Surgical, Inc. in that Opposition Proceeding. On behalf of Intuitive Surgical, Inc., I personally negotiated a co-existence agreement with BioMerieux B.V. protected the rights of Intuitive Surgical, Inc. in its DA VINCI mark through specific terms set forth in the co-existence

agreement. The co-existence agreement also, among other things, allowed for registration of DA VINCI in the name of BioMerieux B.V. for "discrete photometric analyzer for clinical use: and dismissal of the Opposition Proceeding. The Opposition Proceeding against BioMerieux B.V. was terminated on June 23, 2004 and DA VINCI for "discrete photometric analyzer for clinical use" was registered in the name of BioMerieux B.V. on August 10, 2004.

I declare under penalty of perjury under the laws of the State of California and the United States of America that the foregoing is true and correct.

Executed this 23 day of May 2008, at San Francisco, California.

A handwritten signature in black ink, appearing to read "Michelle J. Hirth", written over a horizontal line.

Michelle J. Hirth

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

This page was generated by the TARR system on 2008-05-23 15:49:29 ET

Serial Number: 76458750 Assignment Information Trademark Document Retrieval

Registration Number: 3064065

Mark

PETRO STAR INC.



(words only): PETRO STAR INC.

Standard Character claim: No

Current Status: Registered.

Date of Status: 2006-02-28

Filing Date: 2002-10-17

Transformed into a National Application: No

Registration Date: 2006-02-28

Register: Principal

Law Office Assigned: LAW OFFICE 116

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: 2006-01-19

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Petro Star Inc.

Address:

Petro Star Inc.
3900 C Street, Suite 401

Anchorage, AK 995035966
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Alaska
Phone Number: 206-695-1715
Fax Number: 206-224-0779

GOODS AND/OR SERVICES

International Class: 004
Class Status: Active
petroleum products distributed in wholesale channels of trade, namely, fuel, oil, gasoline, diesel fuel, and crude oil
Basis: 1(a)
First Use Date: 1986-01-00
First Use in Commerce Date: 1986-01-00

International Class: 035
Class Status: Active
wholesale distributorships featuring petroleum products, namely, fuel oil, gasoline, diesel fuel, and crude oil
Basis: 1(a)
First Use Date: 1986-01-00
First Use in Commerce Date: 1986-01-00

International Class: 040
Class Status: Active
oil and fuel refining services
Basis: 1(a)
First Use Date: 1986-01-00
First Use in Commerce Date: 1986-01-00

ADDITIONAL INFORMATION

Disclaimer: "PETRO" and "INC."

Design Search Code(s):
01.01.03 - Star - a single star with five points
01.15.12 - Cyclones; Tornadoes; Whirlpools
27.03.05 - Objects forming letters or numerals

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document

Retrieval" shown near the top of this page.

2007-11-09 - Attorney Revoked And/Or Appointed
2007-11-09 - TEAS Revoke/Appoint Attorney Received
2006-02-28 - Registered - Principal Register
2006-01-18 - Law Office Registration Review Completed
2006-01-13 - Assigned To LIE
2006-01-12 - Allowed for Registration - Principal Register (SOU accepted)
2005-12-14 - Statement of use processing complete
2005-11-14 - Amendment to Use filed
2005-11-16 - PAPER RECEIVED
2005-05-17 - Notice of allowance - mailed
2005-01-14 - Opposition terminated for Proceeding
2005-01-14 - Opposition dismissed for Proceeding
2004-03-26 - Opposition instituted for Proceeding
2004-01-14 - Extension Of Time To Oppose Received
2003-12-16 - Published for opposition
2003-11-26 - Notice of publication
2003-10-15 - Approved for Pub - Principal Register (Initial exam)
2003-10-15 - Examiner's amendment mailed
2003-09-30 - Assigned To Examiner
2003-08-25 - Assigned To Examiner
2003-07-21 - Communication received from applicant
2003-08-08 - Case File In TICRS
2003-07-21 - PAPER RECEIVED
2003-02-10 - Non-final action mailed
2003-02-05 - Assigned To Examiner

2003-01-14 - TEAS Preliminary Amendment Received

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Nigel Avilez

Correspondent

Nigel Avilez

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Seattle WA 98101

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Fax Number: (206) 757-7700

CERTIFICATE OF EXPRESS MAIL UNDER 37 CFR § 2.197

I hereby certify that this correspondence is being deposited with the United States Postal Service as "Express Mail" postage prepaid in an envelope addressed to: Commissioner of Trademarks, U.S. Patent and Trademark Office, P.O. Box 1451, Alexandria, Virginia 22313-1451 on May 23, 2008



Signature

Mironda Lewis

Name

May 23, 2008

Date

"Express Mail" Mailing Label Number:

EB 582736583

Declaration of Michelle Hirth i/s/o
Reply i/s/o Opposer Intuitive Surgical,
Inc.'s Motion for Summary Judgment
(3 pgs)

Exhibit A to Declaration (4 pgs);