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

Proceeding	91175319
Party	Plaintiff Intuitive Surgical, Inc.
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Attachments	DAVINCIDIAGOpptomotiontostrike.pdf ( 4 pages )(78627 bytes )

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

INTUITIVE SURGICAL, INC.,	)	
	)	
Opposer,	)	Opposition No. 91175319
	)	
v.	)	Serial No. 78/728,786
	)	
DAVINCI RADIOLOGY ASSOCIATES,	)	Published: December 19, 2006
P.L.,	)	
	)	
Applicant.	)	
	)	

OPPOSER INTUITIVE SURGICAL, INC.'S OPPOSITION TO MOTION TO STRIKE

Opposer Intuitive Surgical, Inc. ("Opposer") hereby submits this opposition to Applicant's Motion to Strike.

**I. STATEMENT OF FACTS**

On May 23, 2008, via Express Mail, Opposer timely filed a reply in support of its motion for summary judgment in this Proceeding. At the time of filing, Opposer's counsel believed that it had obtained leave from the Board to exceed the 10-page limit applicable to reply briefs. As filed at that time, Opposer's reply brief was 18 pages long. Thereafter, Opposer's counsel learned that no such leave to exceed the page limit had been obtained (or sought) and that the mistaken belief was due to an internal miscommunication in the office of Opposer's counsel.

Opposer's counsel immediately contacted the Interlocutory Attorney assigned to this matter and left a telephone message informing her of the error and inquiring whether the error could be cured by seeking leave after the fact to file its non-conforming reply or file a substitute and conforming reply brief. As of the filing of this opposition, Opposer has not received a

response to it inquiries. Also at that time, counsel for Opposer informed counsel for Applicant that it was attempting to cure its error and was considering the filing of a substitute reply brief.

Opposer hereby opposes Applicant's Motion to Strike and requests that the Board, in its discretion, either: (i) consider the entirety of Opposer's reply as filed on May 23, 2008; or (b) consider a substitute reply that complies with the 10-page limit and is being filed concurrently herewith.

## II. ARGUMENT

The Board has discretion in this case to consider the reply brief originally filed or the substitute brief filed by Opposer. The Trademark Trial and Appeal Board Rules applicable to opposition proceedings were modified in 2007. Certain of the amended Rules were made applicable to cases pending before the Board as of their effective date. The remaining amended rules, including 37 C.F.R. § 2.127(e), were made applicable only "in cases commenced on or after the effective dates of the respective amendments." *Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 72 Fed. Reg. 42,242 (August 1, 2007). Since 37 C.F.R. § 2.127(e) became effective on November 1, 2007 in cases initiated on or after that date and Opposer initiated this Proceeding on January 18, 2007, the pre-November 1, 2007 version of 37 C.F.R. § 2.127(e) applies here. *Id.* That version of 37 C.F.R. § 2.127(e)(1) states: "The Board may, in its discretion, consider a reply brief." Accordingly, this Board may within its discretion consider the entirety of the reply brief filed by Opposer on May 23, 2008 or, instead, consider the substitute reply brief filed by Opposer herewith.

Moreover, the Board should consider the reply brief filed by Opposer in this case. The Board may consider reply briefs to assist it in making a ruling and should have all facts and law necessary for it to rule on the matter before it. Further, Opposer's error in filing a brief that exceeded the 10-page limit was made in good faith, was made due to an internal

miscommunication in the office of Opposer's counsel and was not an effort by Opposer to gain any unfair advantage. In fact, the Board's consideration of Opposer's reply brief in this case will not prejudice Applicant. Opposer timely filed its original reply brief. The substitute brief filed herewith by Opposer raises no new arguments and asserts no new facts from those in the original reply. Instead, the substitute reply is simply Opposer's original reply edited to reduce its length, including the deletion of arguments posed in the original reply. Applicant is not entitled to file a surreply and therefore is not prejudiced by the Board's consideration of a substitute reply filed at this time.

### III. CONCLUSION

For the foregoing reasons, Opposer respectfully requests that this Board deny Applicant's Motion to Strike and, in its discretion, consider Opposer's reply brief in its entirety as originally filed on May 23, 2008 or, in the alternative, consider the substitute reply brief submitted by Opposer herewith.

Dated: May 30, 2008

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By



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**CERTIFICATE OF SERVICE**

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

On May 30, 2008 I hereby certify that I served a copy of the following:

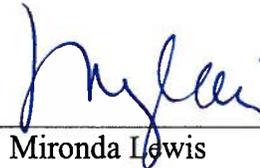
1. **Opposer Intuitive Surgical, Inc's Opposition To Motion To Strike**

by U.S. Mail to:

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301 Clematis Avenue, Suite 3000  
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Attorneys for Applicant

Executed on May 30, 2008, at San Francisco, California.



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Mironda Lewis