

ESTTA Tracking number: **ESTTA214720**

Filing date: **05/30/2008**

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	DAVINCIDIAGsubstreplyisomsj.pdf (11 pages)(217456 bytes)

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

REPLY IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT

Opposer Intuitive Surgical, Inc. hereby submits this reply in support of its motion for summary judgment and the Declaration of Michelle J. Hirth in Support of Reply in Support of Motion for Summary Judgment ("Hirth Reply Decl."), submitted previously.

I. ARGUMENT

A. The Standard on Summary Judgment.

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." *Id.* 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.*

B. The Parties' Marks are Confusingly Similar.

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

Applicant asserts that DA VINCI ("Opposer's Mark") and DAVINCI DIAGNOSTIC IMAGING & Design ("Applicant's Mark") (collectively, the "Parties' Marks") differ in their appearance and sound by virtue of their different number of words, capitalization and spacing. Applicant's Response to Motion for Summary Judgment ("Response") at pp. 6-7. Applicant ignores that the only portion of its Mark capable of functioning as a source indicator is essentially identical to Opposer's Mark.

The dominant term of both Parties' Marks is "DA VINCI". See Opposer's Motion for Summary Judgment ("Motion") at pp. 13-15. Applicant has not stated otherwise. "DIAGNOSTIC" and "IMAGING" are descriptive of services offered under Applicant's Mark and "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. See Response at p. 11 (the "literal meaning" of Applicant's Mark "convey[s] a commercial impression of . . . diagnostic imaging services"). 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 and associated by consumers with MSPB's services. Motion at p. 14; Hirth Decl. at ¶¶ 27 & 29 and 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 matter to it. *Electropix v. Liberty Livewire Corp.*, 178 F. Supp.2d 1125, 1132 (C.D. Cal. 2001). 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).

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

Applicant asserts its Mark "connotes a high level of sophistication and intelligence" and that a genuine issue of material fact exists because Opposer failed to address the similarity of the connotations of the Parties' respective Marks. Response at p. 11 (emphasis added). To the contrary, Opposer has stated 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[.]" Motion at pp. 14-15 (emphasis added). The Parties expressly agree that their Marks have similar connotations. No genuine issue of material fact exists.

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

"[T]he 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 Fondee En 1772*, 396 F.3d 1369, 1372 (Fed. Cir. 2005). Opposer's 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. 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 and technologically advanced medical goods and services. *See* Response at p. 11; Exhibit D to Hirth Decl. (Response No. 2).

Applicant asserts that the cases cited by Opposer were decided on the basis of the fame of the senior marks involved. Response at pp. 13-14 & 21. They were not. First, a finding of confusing similarity of marks does not require that the senior user's mark be famous. *See, e.g., In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357 (CCPA 1973). Second, for example, in *Palm Bay Imports, Inc.*, the Federal Circuit upheld the Board's determination that the parties' marks were similar because the term VEUVE was prominent in the commercial impression created by both parties' marks and "[t]he 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 [other word in the applicant's mark]." 396 F.3d at 1372-73. Here, as in *Palm Bay Imports, Inc.*, "DAVINCI" is the 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 confusingly similar as a matter of law.

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

Applicant incorrectly and without evidence asserts that: (i) an issue of material fact exists as to the similarity of the Parties respective goods and services because of their International Classes and goods/services distinctions; and (ii) no reasonable consumer would assume Applicant's services would emanate from the natural expansion of Opposer's activities. Response at pp. 17-18.

First, the International Classes of goods and services are irrelevant for purposes of a likelihood of confusion analysis. *See Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971 (Fed. Cir. 1993).

Similarly, goods are not distinguished from services in assessing the likelihood of confusion. *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).

Second, for a likelihood of confusion to exist, "[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. *Barbara's Bakery Inc. v. Landesman*, 82 U.S.P.Q.2d 1283, 1286 (TTAB 2007). It is undisputed that: (i) both Opposer's goods and Applicant's services are in the medical field; (ii) Opposer's goods include a master control, an immersive video display, camera processing equipment and system software, provide high resolution images, and incorporate optics, imaging and display technologies; (iii) Applicant's licensee offers diagnostic imaging services under Applicant's Mark; and (iv) MSPB's diagnostic imaging services produce images of portions of the human body and are computerized. Motion at pp. 8-9; Response at p. 3. By virtue of their use in the medical industry and incorporation of similar technologies, the Parties' goods and services are related. This relatedness is enhanced by the overlap in the channels of trade and consumers of the Parties' goods and services. *See* Section I.D. below.

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. 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 (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.¹

In fact, the Board's ruling in *Eikonix Corp. v. C.G.R. Medical Corp.* supports Opposer's point. 209 U.S.P.Q. 607 (TTAB 1981). In *Eikonix Corp.*, the Board determined that a relationship existed between the technique 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.

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

Applicant asserts that the trade or marketing channels used by the Parties and the consumers of the Parties' respective goods and services are disparate. Response at p. 18. Applicant's contention is neither based on competent evidence nor factually accurate.

First, Applicant has submitted no competent evidence regarding the trade or marketing channels used by Applicant's licensee or regarding consumers of services offered under its Mark. The Declaration of Thomas P. Boyle, M.D. ("Boyle Decl.") states that "upon information and belief" MSPB is "likely" to continue to use the Internet and brochures for marketing of its services, MSPB is "unlikely" to advertise its services in journals or publications that target

¹ The examples of a single entity producing goods and related services within a single industry under a single mark are legion. For example, PETRO STAR INC. & Design is registered in the name of Petro Star Inc. for petroleum continued

physicians or to engage in certain other marketing activities, and MSPB's consumers are medical patients. Boyle Decl. at ¶¶ 8 & 10. Although competent evidence in the form of a declaration must be based upon the declarant's personal knowledge, Dr. Boyle has based his statements upon information and belief rather than personal knowledge. FRCP 56(e)(1); 37 C.F.R. § 2.116. His declaratory statements are not competent evidence and should not be considered by the Board.

Second, even if Dr. Boyle's declaratory statements were competent evidence, they simply further support the undisputed evidence that the trade or marketing channels used by the Parties overlap and enhance the likelihood of confusion. It is undisputed that: (i) Opposer markets goods under its Mark via, among other things, the Internet, brochures, and direct sales calls to physicians, including surgeons; and (ii) services under Applicant's Mark are marketed via, among other things, the Internet, brochures, and visitation and presentations by Applicant to doctors' offices. Response at p. 18; Boyle Decl. at ¶ 10; Hirth Decl. at ¶¶ 23 & 27-29 and Exhibits K, L & M thereto; Exhibit E to Hirth Decl. (Response Nos. 5 & 13); Exhibit G to Hirth Decl. (Response Nos. 5 & 11). The Parties' market their respective goods and services through overlapping channels of trade.

Third, Applicant asserts there is a "factual issue of whether Applicant's buyers are patients or the intermediary, referring doctors[.]" Response at p. 19. All of the competent evidence before the Board shows that physicians, including surgeons, are consumers of the goods and services offered under both Parties' Marks. 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

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 is attached to the Hirth Reply Decl. as Exhibit A.

not themselves purchase them are consumers); *ProQuest Information and Learning Co. v. Island*, 83 U.S.P.Q.2d 1351, 1356 (TTAB 2007). In this case, 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; Exhibit E to Hirth Decl. (Response Nos. 13 & 16). Despite Applicant's statements to the contrary, it also is undisputed that consumers of services offered under Applicant's Mark include both patients and physicians. As acknowledged by Applicant, physicians refer patients to providers of medical diagnostic imaging services. Response at p. 20. Even though the patient or its insurer may ultimately pay for 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 statements, among others, 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 services "give physicians more complete information[.]" See Exhibits K & L to Hirth Decl. (emphasis added). Moreover, it is undisputed that services offered under Applicant's Mark are marketed directly to physicians through "visiting and presenting at doctor's offices." 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.

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

Applicant refers to third party registrations and applications to suggest a crowded field exists in this case. It does not. 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. Motion at pp. 11 & 13; Response at p. 2; Exhibit D to Hirth Decl. (Response No. 2).

Second, Applicant has submitted no evidence of third-party use of the term "DA VINCI" for goods or services in the medical field. The registrations and applications referred to by Applicant are not evidence of use in the marketplace and therefore, are not evidence of the commercial strength of Opposer's Mark. *Palm Bay Imports Inc.*, 396 F.3d at 1373 (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); *Bost Bakery, Inc. v. Roland Indus. Inc.*, 216 U.S.P.Q. 799, 801 n.6 (TTAB 1982) (third party registrations are probative evidence that a term has a readily understood suggestive meaning and may not be distinctive in a particular field).

Third, even if *arguendo* Applicant's assertion of a crowded field were based on competent evidence, it is nonetheless erroneous. Only marks used with goods or services sufficiently related to Opposer's goods to be likely to cause confusion as to source are pertinent. Applicant asserts that 16 registrations and applications (of the 153 containing "DA VINCI" or "DAVINCI") are for goods or services "similar" to Opposer's. Response at pp. 8-9 & 21-22; Declaration of Matthew T. Vanden Bosch ("Vanden Bosch Decl.") at ¶ 13 and Exhibit J thereto. However, most of these registrations and applications are for goods or services wholly unrelated to those of Opposer and are irrelevant to the strength of Opposer's Mark. *Id.* 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 (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 (Application Serial No. 76/248,902) for discrete photometric analyzers was the subject of an Opposition Proceeding initiated by Opposer, which 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 with goods solely for use in the dental industry. See Exhibit J to Vanden Bosch Decl. 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; Exhibit E to Hirth Decl. (Response Nos. 3-5, 13 & 16). No crowded field exists here.

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 30, 2008

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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:

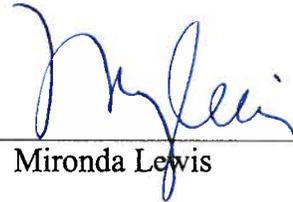
1. **Reply In Support of Motion For Summary Judgment**

by U.S. Mail to:

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

A handwritten signature in blue ink, appearing to read "Mironda Lewis", is written above a horizontal line.

Mironda Lewis