

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

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Mailed: October 27, 2008

Opposition No. 91175319

Intuitive Surgical, Inc.

v.

DaVinci Radiology Associates, P.L.

Before Walters, Zervas, and Mermelstein,
Administrative Trademark Judges.

By the Board:

DaVinci Radiology Associates, P.L. ("applicant") seeks
to register the mark DAVINCI DIAGNOSTIC IMAGING and design
as displayed below:



for "medical diagnostic imaging services" in International
Class 44.¹

¹Application Serial No. 78728786, filed on October 7, 2005, based
on an allegation of use in commerce under Trademark Act Section
1(a), 15 U.S.C. Section 1051(a), claiming dates of first use
anywhere and first use in commerce since August 1, 2005.

On January 18, 2007, Intuitive Surgical, Inc. ("opposer") filed a notice of opposition to registration of applicant's mark. As grounds for the opposition, opposer alleges: (1) false suggestion of a connection; (2) priority of use; and (3) that applicant's mark, when used on the identified opposed services, so resembles opposer's previously used and registered DA VINCI mark, as to be likely to cause confusion, mistake or to deceive. Opposer's pleaded registration is for the following goods in International Class 9:

computerized surgical manipulation system comprised of surgeon's console, master control, immersive video display, camera image processing equipment, surgical manipulation system software and instructional manuals provided as a unit, patient-side cart with set-up arms and manipulator slave arms, sterile adaptors to connect arms to instruments, and a full line of resposable, in other words, limited re-use tools, namely, laparoscopes, endoscopes, tocars, cannulas, cutters, clamps, elevators, gouges, knives, scope preheaters, light sources, cables and component parts, electrosurgical instruments, electrocautery instruments, laser instruments, ultrasound instruments, lens cleaning, scrub and biopsy brushes, clip applies and clips, tack applicators and tacks, applicators, ligature carriers, needle holders, clamps, hemostats, graspers, curettes, instrument guides, ligature passing and knotting instruments, needle, retractors, snares, tylets, forceps, dissectors, calipers, scissors, suction and irrigation probes, sterile drapes, hemostats, amputation hooks, osteotomes, saws, retainers, suturing apparatus, measuring tapes, chisels and contractors, files, skin graft expanders, lancets, mallets, pliers, hammers, rasps, spatulas, and strippers; a full line of FDA Classes I and II exempt surgical instruments, namely, scalpels, scalpel blades and handles, staplers, tackers, clip applicators,

electrocautery tools, forceps, needle holders, guides and drivers, graspers and kitners.²

Applicant, in its answer, has denied the salient allegations of the notice of opposition.

This case now comes up for consideration of opposer's motion for summary judgment (filed March 11, 2008) solely on opposer's claim of likelihood of confusion. The motion is fully briefed.³

For purposes of this order, we presume the parties' familiarity with the pleadings, the history of the proceeding and the arguments and evidence submitted with respect to opposers' motion for summary judgment.

Summary judgment is an appropriate method of disposing of cases that present no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *Lloyd's Food Products, Inc. v. Eli's, Inc*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*

²U.S. Reg. No. 2628871, issued October 1, 2002, claiming first use and first use in commerce since July 7, 2000. Section 8 and 15 affidavits filed on September 12, 2008.

³The Board notes that opposer's allegation of priority of use of its pleaded mark has not been contested by applicant in its response to opposer's motion for summary judgment.

Opposition No. 91175319

Inc. v. The Great American Music Show, Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

Here, opposer, as the moving party, has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

After reviewing the arguments and supporting evidence, and drawing all inferences with respect to the motion in favor of applicant as the nonmoving party, we find that opposers have failed to meet their burden of establishing that there are no genuine issues of material fact for trial.

At issue in this proceeding is, *inter alia*, whether there is a likelihood of confusion between applicant's mark and opposer's pleaded registered mark. At a minimum, the record reveals that genuine issues of material fact exist as to the relatedness between opposer's identified goods and applicant's identified services and the channels of trade associated therewith. Additionally, a genuine issue of material fact exists in regard to the strength or weakness of opposer's pleaded mark.

In view thereof, opposer's motion for summary judgment with regard to its claim of likelihood of confusion is hereby denied.⁴

Proceedings herein are resumed. Discovery is closed. Trial dates are reset as follows:

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| DISCOVERY PERIOD TO CLOSE: | CLOSED |
| Testimony period for party in position of plaintiff to close: (opening thirty days prior thereto) | 12/30/2008 |
| Testimony period for party in position of defendant to close:(opening thirty days prior thereto) | 2/28/2009 |
| Rebuttal testimony period to close: (opening fifteen days prior thereto) | 4/14/2009 |

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

⁴ The fact that we have identified certain genuine issues of material fact as a sufficient basis for denying opposers' motion for summary judgment should not be construed as a finding that such issues necessarily are the only issues that remain for trial. Also, the parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of the motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400 (TTAB 1998); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>