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

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| Proceeding | 91175319 |
| Party | Defendant DaVinci Radiology Associates, P.L. |
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| Submission | Motion to Strike |
| Filer's Name | Matt Vanden Bosch |
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| Date | 05/15/2009 |
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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

APPLICANT'S MOTION TO STRIKE OPPOSER'S
NOTICE OF TESTIMONIAL DEPOSITION UPON WRITTEN QUESTIONS
OF BENJAMIN GONG

Applicant DaVinci Radiology Associates, P.L. ("Applicant"), respectfully moves the Trademark Trial and Appeal Board (the "Board") to strike the Notice of Testimonial Deposition Upon Written Questions of Benjamin Gong, dated May 7, 2009 (the "Notice"), of Opposer Intuitive Surgical, Inc. ("Opposer"), and hereby submits its memorandum brief in support of its motion to strike. Opposer's Notice is tardy and rebuts nothing introduced by Applicant during its testimony period.

Tardiness of Notice

A party desiring to take a testimonial deposition upon written questions shall serve notice thereof upon each adverse party within ten days from the opening date of the testimony period of the party who serves the notice. 37 CFR § 2.124(b)(1). Opposer's rebuttal testimony period began May 1, 2009. Opposer's Notice is dated May 7, 2009. The Notice was not filed within ten days of the opening of its rebuttal testimony period. Therefore, the Notice must be stricken.

Lack of Rebuttal.

On March 24, 2009, during its Testimony Period, Applicant filed its Notice of Reliance. In paragraph 2 of its Notice of Reliance, Applicant listed a series of U.S. Trademark Registrations containing the name “Da Vinci.” The purpose of the reliance was to show “the number and nature of similar marks in use on similar goods and services, and the weak and narrowly construed rights associated with a mark in a crowded field of similar marks.” See, Paragraph 2 of Applicant’s Notice of Reliance. The number and nature of similar marks in use on similar goods and services, along with the weak and narrowly construed rights associated with a mark in a crowded field of similar marks, are factors to be considered under the decision of *In re E.I. DuPont deNemours & Co.*, 476 F.2d 1357 (CCPA 1973). Other than its Notice of Reliance, Applicant introduced no other evidence during its testimony period.

Opposer’s written questions, attached, are aimed at discussing the circumstances behind Opposer’s Opposition Case No. 91158726 against Registration No. 2,870,790, “Da Vinci”, one of the registrations listed in paragraph 2 of Applicant’s Notice of Reliance. Having Applicant and Opposer explore this old opposition case upon written questions would waste an enormous amount of resources and time. On September 10, 2003, the Board filed a Notice of Publication for Registration No. 2,870,790, stating that it was entitled to registration. Opposer’s opposition proceeding number 91158726 is not relevant to this matter and does not rebut the purpose of Applicant’s Notice of Reliance here: “The number and nature of similar marks in use on similar goods and services, along with the weak and narrowly construed rights associated with a mark in a crowded field of similar marks.”

Furthermore, in paragraph 7 of Applicant’s Notice of Reliance, Applicant provides a definition of a “Discrete Photometric Chemical Analyzer for Clinical Use.” Applicant did this to

explain what the device being registered in Registration No. 2,870,790 was. Again, Opposer's attached written questions regarding the opposition proceeding against Registration No. 2,870,790 does not rebut the definition. Therefore, the Notice must be stricken.

Conclusion

For the foregoing reasons, Applicant respectfully demands that the Board strike the Notice.

Respectfully submitted,



Matthew T. Vanden Bosch
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Dated: May 15, 2009

CERTIFICATE OF SERVICE

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

On May 15, 2009, I hereby certify that I served a copy of Applicant's Motion to Strike
Opposer's Notice of Testimonial Deposition Upon Written Questions of Benjamin Gong.

By U.S. Mail to:

Michelle J. Hirth, Esq.
Embarcadero Four, 17th Floor
San Francisco, California 94111

Executed on May 15, 2009, at Boynton Beach, Florida.


Matthew T. Vanden Bosch

TESTIMONIAL DEPOSITION QUESTIONS TO BENJAMIN GONG

Pursuant to the Notice of Testimonial Deposition Upon Written Questions to Benjamin Gong, following are the written questions posed by Opposer Intuitive Surgical, Inc. on direct examination of Mr. Gong. The document to be marked as Exhibit 1 to the testimonial deposition upon written questions of Benjamin Gong is attached hereto as Exhibit A.

1. Please state your name for the record.
2. Who is your current employer?
3. Please state your current business address.
4. Please state your current job title.
5. What are your current job duties?
6. Have you held other positions with this employer?
7. Have you ever had job duties with your current employer other than your current job duties?
8. What job duties other than your current job duties have you had with your current employer?
9. Have your job duties with your current employer ever involved protection of your employer's trademark rights?
10. When did your job duties with your current employer involve protection of that employer's trademark rights?
11. Please describe your involvement in the protection of your current employer's trademark rights.
12. Have your job duties with your current employer ever involved entering into contracts on behalf of your employer?

13. Are you familiar with bioMerieux, B.V.?
14. In what context are you familiar with bioMerieux, B.V.?
15. Please review the document now provided to you and attached as Exhibit A to the Testimonial Deposition Questions to Benjamin Gong. Are you familiar with this document?
16. Please describe how you are familiar with this document.
17. What is this document?
18. Please turn to the last page of this document. What appears on the last page of this document?
19. Is that your signature on the last page of this document?
20. Did you review this document before you signed it?
21. To your knowledge, are the statements made in this document true and correct?
- 21A. Opposer Intuitive Surgical, Inc. offers this document as Exhibit 1 to this testimonial deposition on written questions to be marked by the Court Reporter as Exhibit 1 hereto.
22. Did you enter into the agreement that is now marked as Exhibit 1 on behalf of Intuitive Surgical, Inc.?
23. Please turn to the last paragraph on the first page of this document. Please read that paragraph aloud into the record.
24. To your knowledge, was the statement you just read aloud true and correct at the time you signed this document?
25. Do you have an understanding of why Intuitive Surgical, Inc. initiated an opposition proceeding against bioMerieux, B.V.'s application for registration of DA VINCI in the United States?

26. Why did Intuitive Surgical, Inc. initiate an opposition proceeding against bioMerieux, B.V.'s application for registration of DA VINCI in the United States?
27. Do you have an understanding of why Intuitive Surgical, Inc. entered into the Co-Existence Agreement that is Exhibit 1 to this testimonial deposition?
28. Why did Intuitive Surgical, Inc. enter into the Co-Existence Agreement that is Exhibit 1 to this testimonial deposition?
29. To what did bioMerieux, B.V. agree pursuant to the Co-Existence Agreement with Intuitive Surgical, Inc.?
30. To what did Intuitive Surgical, Inc. agree pursuant to the Co-Existence Agreement with bioMerieux, B.V.?
31. Do you have an understanding of why Intuitive Surgical, Inc. felt the Co-Existence Agreement that is Exhibit 1 was appropriate in this case?
32. Why did Intuitive Surgical, Inc. feel this Co-Existence Agreement that is Exhibit 1 was appropriate?
33. Is the Co-Existence Agreement that is Exhibit 1 still in effect?
34. In what countries do the terms of the Co-Existence Agreement that is Exhibit 1 have effect?
35. Do the terms of the Co-Existence Agreement that is Exhibit 1 also apply to the United States?
36. Do you have an understanding of what happened to Intuitive Surgical, Inc.'s and bioMerieux, B.V.'s respective marks after they entered into the Co-Existence Agreement that is Exhibit 1?
37. What happened after Intuitive Surgical, Inc. and bioMerieux, B.V. entered into the Co-Existence Agreement that is Exhibit 1?

EXHIBIT A

COEXISTENCE AGREEMENT

This Coexistence Agreement is entered into as of this 1st day of March 2004 ("Effective Date") between:

- (1) biomerieux B.V. (formerly 'Organon Teknika B.V.' and hereinafter "bioMérieux"), a Dutch corporation, with its principal place of business at 15, Boseind, NL-5281 Boxtel, The Netherlands

and

- (2) Intuitive Surgical, Inc. ('Intuitive'), a Delaware corporation with its principal place of business at , 950 Kifer Road, Sunnyvale, California, 94086 USA.

RECITALS

WHEREAS bioMérieux is the owner of International Registration No. 757 068, Argentine Registration No 1 876 517, Canadian Registration No 576 387, Columbian Registration No. 239 962, Mexican Registration No. 689 635, Israel Registration No. 143 700, Taiwan, Republic of China ('Taiwan') Registration No. 954885, Benelux Registration No. 676 811 and is seeking registration in Brazil under Application No. 823 402 444, in India under Application No. 968 240, in Thailand under Application No. 443 791, in South Africa under Application No. 2000/22 033 and in the USA under Application No. 76/248 902. Each of these applications and registrations is for the trademark DA VINCI in International Classes 09 and 10 and for (discrete) photometric analysers for clinical use and immunoanalysers.

WHEREAS Intuitive is the owner of United States Registration No. 2628871, Argentine Registration Nos. 1913591 and 1913592, Australian Registration No. 802048, Canadian Registration No. 575161, European Community Registration No. 001281450, Hong Kong Registration Nos. 141702002, 141712002 and 141722002, Japanese Registration Nos. 2572641 and 4585887 and Taiwan Registration Nos. 00159277 and 00164142, and owns applications for registration in Brazil, Canada, India, Saudi Arabia, Singapore, Taiwan (Application No. 089074799) and Turkey. Each of these registrations and applications is for the trademark DA VINCI in various International Classes and for a variety of goods and services, including computerized surgical manipulation systems, educational services, medical services and surgical treatment services.

WHEREAS Community Trade Mark Application no. 1281450 (in the name of Intuitive) has been raised as an objection against the extension of protection of International Registration No. 757068 to the United Kingdom and Spain (in the name of bioMérieux).

WHEREAS Taiwan Registration No. 954885 (in the name of bioMérieux) has been raised by the Taiwan Patent Office as an obstacle to Application No. 89074799 (in the name of Intuitive).

WHEREAS Intuitive has filed oppositions to bioMérieux DA VINCI trademark applications in the United Kingdom and in the USA.

Now, therefore, in consideration of the mutual promises, covenants and agreements made between the parties, the parties, intending to be legally bound, have decided to definitely settle and organise a worldwide peaceful coexistence, use and registration of their respective DA VINCI trademarks, as follows:

bioMérieux agrees:

- 1) Not to use, have used, register and/or have registered its mark DA VINCI in relation to goods/services other than those mentioned in paragraph 1 of the Recitals and related services and products connected to the in vitro diagnostic field (the "Goods").
- 2) never to object, oppose, challenge or otherwise threaten, whether directly or indirectly, (i) the registration and/or use of the mark DA VINCI by Intuitive or any authorised third party in connection with goods other than the Goods and (ii) any subsequent filing, registration and use of any derivative form of the mark DA VINCI by Intuitive in connection with goods other than the Goods.
- 3) to provide its written consent to the use and/or registration by Intuitive of the mark DA VINCI with respect to goods other than the Goods whenever necessary and requested by Intuitive. bioMérieux's reasonable costs related to the provision of such consent shall be borne by Intuitive.
- 4) to assign its Taiwan Registration No. 954885 for DA VINCI to Intuitive. All costs related to the registration, publication, filing and/or mention of the assignment with any relevant authority or administrative body in Taiwan shall be borne by Intuitive.
- 5) to take all steps necessary and to work with Intuitive to attempt to overcome the objection obstacle to registration of Intuitive's DA VINCI Taiwan Application No. 89074799.

Intuitive agrees:

- 1) not to use, have used, register and/or have registered its mark DA VINCI in relation to the Goods.
- 2) to never object, oppose, challenge or otherwise threaten, whether directly or indirectly, (i) the registration and/or use of the mark DA VINCI by bioMérieux or any authorised third party in connection with the Goods and (ii) any subsequent filing, registration and use of any derivative form of the mark DA VINCI by bioMérieux in connection with the Goods.
- 3) to provide its written consent to the use and/or registration by bioMérieux of the mark DA VINCI in connection with the Goods whenever necessary and if requested by bioMérieux. All Intuitive's reasonable costs related to provision of such consent shall be borne by bioMérieux.
- 4) to withdraw any oppositions filed against bioMérieux's DA VINCI trademark applications in any country of the world pending as of the Effective Date without any charge to bioMérieux.