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Filing date: **05/26/2009**

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	Intuitive REPLY.pdf ( 4 pages )(158094 bytes )



On May 18, 2009, Opposer requested a 15-day extension of its rebuttal period to take the testimonial oral deposition of Mr. Benjamin Gong in light of the Board's May 18, 2009 Order and the unavailability of Mr. Gong and Opposer's counsel during the remainder of the current rebuttal period, which closed on May 24, 2009.

## II. ARGUMENT

Applicant DaVinci Radiology Associates, P.L. now opposes Opposer's request for an extension of its rebuttal period on two grounds: (1) that Opposer has failed to show good cause for extension of its rebuttal period because it is "likely" the Board will exclude Mr. Gong's testimony; and (2) that "[a]s argued in Applicant's Motion to Strike", the proposed testimony of Mr. Gong "goes beyond the scope of Applicant's defense." Neither purported ground supports Applicant's position.

First, this Board already has ruled on Applicant's motion to strike and Applicant's request that Mr. Gong's deposition be taken orally. The issue of whether Opposer should be permitted to take Mr. Gong's deposition is not before the Board on Opposer's motion to extend its rebuttal period. Indeed, the Board has expressly ordered that the deposition of Mr. Gong may go forward orally. *See* May 18, 2009 Order. Further, whether the Board should exclude any testimony ultimately given by Mr. Gong has not been and cannot be fully briefed until after his testimony has been taken, is not a question appropriate for determination at this time, and is not now before the Board. Moreover, Opposer has shown good cause for extension of its rebuttal period. As set forth in its Motion, Mr. Gong and Opposer's counsel are unavailable during the period between May 18, 2009 and May 24, 2009 (the period provided by the Board in its May 18, 2009 Order) to take his deposition orally. Accordingly, Opposer seeks only a limited extension of 15 days to allow sufficient time when all parties are available to take Mr. Gong's deposition.

Second, contrary to Applicant's assertion, Mr. Gong's testimony is relevant to rebut the documentary evidence Applicant submitted in this Proceeding via its notice of reliance. As the Board is aware and as described in Applicant's Opposition to Opposer's Motion, Applicant submitted with its notice of reliance unofficial copies of registrations for marks that consist of or include the term "DAVINCI" and "DA VINCI", including that of DA VINCI in the name of bioMerieux, B.V (U.S. Trademark Registration No. 2,870,790). The history of that registration and its ownership – the subject of Mr. Gong's proposed testimony – is relevant to Opposer's protection of its rights in DA VINCI and whether that registration in any way contributes to the "crowded field of similar marks" asserted by Applicant. Accordingly, Mr. Gong's testimony is appropriate rebuttal testimony in this Proceeding. In any event, whether Mr. Gong's testimony is proper rebuttal testimony can only be determined by this Board after it has been taken and upon proper motion or objection, either separately or as part of Applicant's trial brief.

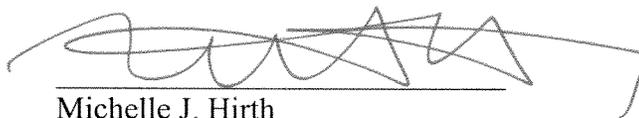
### III. CONCLUSION

For the foregoing reasons, Opposer respectfully requests that this Board grant its motion for extension of Opposer's rebuttal period to June 8, 2009 so Opposer may have sufficient time to take the oral deposition of Mr. Gong.

Dated: May 26, 2008

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By



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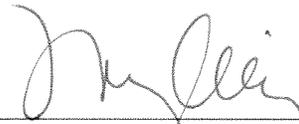
**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing **Reply in Support of Motion for Extension of Opposer's Rebuttal Period** was served on Applicant DaVinci Radiology Associates, P.L., by First Class U.S. Mail, postage prepaid to:

Matthew T. Vanden Bosch, Esq.  
301 Clemetis Avenue, Suite 3000  
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Attorneys for Applicant

This 26<sup>th</sup> day of May, 2009.

  
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Mironda Lewis