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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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Submission	Testimony For Plaintiff
Filer's Name	Michelle J. Hirth
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I N D E X

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EXHIBITS MARKED FOR IDENTIFICATION

No.	Description	Page
Exhibit 27	Document entitled .....	12
	"Coexistence Agreement," dated	
	3-1-04, between Intuitive Surgical	
	and bioMerieux	

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Deposition of BENJAMIN GONG, taken by the  
Opposer, at 1266 Kifer Road, Sunnyvale, California,  
commencing at 1:04 p.m., on Wednesday, June 3, 2009,  
before DEBRA ALLUSTIARTI, CSR, pursuant to notice.

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A P P E A R A N C E S

FOR THE OPPOSER:

SHEPPARD MULLIN RICHTER & HAMPTON LLP  
Four Embarcadero Center, 17th Floor  
San Francisco, CA 94111-4106  
415.434.9100

By: MICHELLE J. HIRTH, Attorney at Law

FOR THE APPLICANT TELEPHONICALLY:

LAW OFFICE OF MATTHEW T. VANDEN BOSCH  
301 Clematis Avenue, Suite 3000  
West Palm Beach, FL 33401  
561.736.4696

By: MATTHEW T. VANDEN BOSCH, Attorney at Law

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SUNNYVALE, CALIFORNIA; Wednesday, June 3, 2009

1:04 p.m.

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BENJAMIN GONG

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called as a witness by the Opposer, who, having been first duly sworn, was examined and testified as follows:

EXAMINATION BY MS. HIRTH

MS. HIRTH: Q. Mr. Gong, can you state your name for the record.

A. Benjamin Gong.

MS. HIRTH: Before we continue -- well, Matt, I'll put this on the record. Do you want to go ahead and do your objection now or when the first question comes up?

MR. VANDEN BOSCH: I'll put the objection on the record now.

MS. HIRTH: If you want to go ahead, that's fine.

MR. VANDEN BOSCH: Given opposer's notice of the testimonial deposition upon written questions of Benjamin Gong, I'm familiar with the questioning that will be taking place in this deposition. I'd like to put on the record an objection that will run throughout this deposition to all the questions and exhibits in

1 this deposition.

2           The objection is based on the fact that this  
3 deposition is beyond the scope of the defendant's  
4 defense, and that this deposition and all exhibits and  
5 questions in it do not rebut anything presented in the  
6 defendant's defense. And, finally, that it is  
7 irrelevant to any factual or legal issue presented in  
8 this matter including the DuPont factors or rights  
9 associated with a mark in a crowded field.

10           I would reserve the right to make any other  
11 objections during the course of this deposition, but  
12 this general objection I'd like to make now. And it's  
13 based primarily on the defendant's opposition to the  
14 opposer's motion for an extension of time, and also the  
15 defendant's motion to strike Mr. Gong's written question  
16 deposition, which I'll incorporate here by reference.

17           MS. HIRTH: I just want to place a very  
18 short response on the record that we'll explain further  
19 in any briefing or responses to objections that are  
20 filed with the Trademark Trial and Appeal Board that  
21 Mr. Gong's deposition and the testimony to be elicited  
22 in this deposition is related to the veracity of  
23 applicant's evidence admitted during applicant's  
24 testimony period, and that evidence was of third-party  
25 registrations of da Vinci and applications for da Vinci.

1           Also, on the record, I wanted to mention  
2           that, in fact, applicant -- referred to as "defendant"  
3           here -- did file a motion to strike the request for the  
4           notice of testimony deposition of Mr. Gong on written  
5           question, and the board did allow that to go forward and  
6           ruled on that motion.

7           So I will also make this response as a  
8           running response to any running objection that has been  
9           asserted, as Mr. Vanden Bosch has done, and we'll  
10          explore it further in any written papers submitted to  
11          the board.

12          Q. Okay. Mr. Gong, can you tell me who your  
13          current employer is?

14          A. Intuitive Surgical.

15          Q. Can you please state your current business  
16          address?

17          A. 1266 Kifer Road, Sunnyvale, California  
18          94086.

19          Q. Have you ever had your deposition taken  
20          before?

21          A. Yes.

22          Q. How many times have you had it taken?

23          A. Once.

24          Q. Have you ever given testimony at trial  
25          before?

1 A. No.

2 Q. This is a little different from either trial  
3 or deposition testimony because it is a Trademark Trial  
4 and Appeal Board matter. So we're taking your trial  
5 testimony, but we're doing it through a deposition-like  
6 proceeding.

7 I'm going to go through some ground rules.  
8 You've been given an oath, so, of course, we want your  
9 most truthful testimony and the testimony to the best of  
10 your recollection.

11 To make sure that the court reporter can  
12 hear everything and take everything down, and that  
13 Mr. Vanden Bosch, who is on the phone, can hear  
14 everything as well, we ask that you provide us with  
15 audible responses; not a nod of the head or shake of the  
16 head.

17 A. Okay.

18 Q. I would also ask that if anything comes up  
19 where you feel you need to estimate, that's fine. Just  
20 let us know that you're doing that. Certainly, don't  
21 guess. I'd rather have an honest response that you  
22 don't know or that you are estimating, rather than a  
23 guess that's just speculation.

24 A. Okay.

25 Q. If at any time you don't understand a

1 question or it's something that you need clarification  
2 on either from me or Mr. Vanden Bosch, please let us  
3 know that. If you don't let us know that, we'll assume  
4 that you're answering the question that was asked.

5 A. All right.

6 Q. If at any time you need a break, let us  
7 know. It's your deposition. If you need to take a  
8 moment, that's just fine. Just let us know and we'll  
9 stop.

10 Is all of that clear?

11 A. Understood.

12 Q. Have you taken any medication during the  
13 last 24 hours?

14 A. Yes.

15 Q. Is any of the medication that you have taken  
16 in the last 24 hours something that you believe would  
17 interfere with your ability to testify to the best of  
18 your recollection?

19 A. No.

20 Q. Is there anything else that you're aware of  
21 that might interfere with your memory or your ability to  
22 testify to the best of your recollection today?

23 A. No.

24 Q. Could you describe for us briefly your  
25 educational background?

1           A. I have a bachelor's in industrial  
2 engineering from Stanford University and an MBA from the  
3 University of California, Berkeley.

4           Q. Is there any other higher education that you  
5 have, other than what you've just told us about?

6           A. I -- at one point in time, I was a CPA;  
7 however, I have not maintained the adequate hours to  
8 maintain that for continuing education.

9           Q. Can you briefly describe your work history  
10 prior to joining Intuitive surgical?

11          A. Prior to joining Intuitive, I worked at a  
12 company called VLSI Technology. Prior to VLSI  
13 Technology, I worked at Sun Microsystems. And prior to  
14 that, I worked at Ernst & Young.

15          Q. Can you tell us what your position was --  
16 your job title -- at VLSI Technology?

17          A. I started there as a manufacturing  
18 controller, and when I left, I was a division  
19 controller.

20          Q. What were your job titles, if there's more  
21 than one, at Sun Microsystems?

22          A. I started there as a cost accountant, and  
23 when I left, I was an accounting manager.

24          Q. What were your job titles at Ernst & Young?

25          A. I was a management consultant.

1 Q. When did your employment with Intuitive  
2 Surgical start?

3 A. In November of 1997.

4 Q. And what was your job title at that time?

5 A. At that time, I was the corporate  
6 controller.

7 Q. What were your job -- excuse me -- job  
8 duties as the corporate controller?

9 A. At the time, we were a start-up company, and  
10 as a result, I had a variety of responsibilities.

11 Q. Can you give me some examples of what those  
12 responsibilities were?

13 A. I was responsible for the accounting  
14 activities of the company, various administrative  
15 activities of the company, and as there were only 75  
16 people in the company at the time, just a matter  
17 of various activities.

18 Q. Okay. What is your current position with  
19 Intuitive Surgical?

20 A. I am the vice president of finance.

21 Q. And when did you become the vice president  
22 of finance?

23 A. So my title has been vice president of  
24 finance, I believe, since, I would say, 2005.

25 Q. What are your current duties in that

1 position?

2 A. Today I am responsible for investor  
3 relations. I have responsibility for sales contracts  
4 that have to do with the sales of da Vinci systems, and  
5 I have responsibility for financial support for the  
6 sales and marketing organizations.

7 Q. Have you held any other positions with  
8 Intuitive Surgical, other than corporate controller and  
9 vice president of finance?

10 A. I have.

11 Q. What are those positions?

12 A. I have also been the treasurer. I have been  
13 the acting CFO. So those -- I think those have been my  
14 titles; however, the responsibilities over the past  
15 11-plus years have varied.

16 Q. What was your title, if you know, in the  
17 years 2003 and 2004?

18 A. In 2003 and 2004, I was -- I was the  
19 corporate controller, certainly, in 2003, and toward the  
20 latter part of that year, we hired someone else to be  
21 specifically corporate controller. But, also, at the  
22 same time, I was in charge of the treasury functions and  
23 financial planning functions. And, also, during that  
24 stint, there was a time period where we did not have any  
25 on-site legal counsel, and so I oversaw legal activities

1 for a period of time.

2 Q. When you say you "oversaw legal activities  
3 for a period of time," what types of legal activities  
4 did you oversee during that period?

5 A. I interfaced with our outside counsel on  
6 matters having to do with patents and trademarks.

7 Q. Have you ever heard of a company called  
8 bioMerieux?

9 A. I have.

10 Q. In what context have you heard of that  
11 company?

12 A. I signed an agreement -- coexistence  
13 agreement with bioMerieux, and the topic was da Vinci  
14 trademark.

15 Q. Did you read that agreement before you  
16 signed it?

17 A. Yes.

18 Q. So you were familiar with the contents of  
19 that agreement at the time that you signed it?

20 A. Yes.

21 MS. HIRTH: I'm going to hand you a document  
22 that we have marked as Exhibit 27, which is just the  
23 next in order of these transcripts.

24 (Whereupon, Deposition Exhibit 27 was marked  
25 for identification.)

1 MS. HIRTH: Q. If you could take a look and  
2 let me know when you're done, that would be great.

3 A. (Witness reviews document.) Okay.

4 Q. What is the document that I've handed you?

5 A. It's entitled "Coexistence Agreement."

6 Q. Have you seen this document before?

7 A. Yes, I have.

8 Q. Do you know who the parties were to this  
9 coexistence agreement?

10 A. Yes.

11 Q. Can you tell me who they were?

12 A. The parties were Intuitive Surgical and  
13 bioMerieux.

14 Q. Can you turn to the very last page of this  
15 agreement?

16 A. I have.

17 Q. Can you tell me what's on that page?

18 A. I see the signature blocks of myself and  
19 Thierry Bernard of bioMerieux.

20 Q. Did you sign this agreement?

21 A. I did.

22 Q. When you signed this agreement, did you sign  
23 it on behalf of yourself or some other entity?

24 A. I signed it on behalf of Intuitive Surgical.

25 Q. And to your knowledge, are the statements

1 made in this agreement true and correct?

2 A. Yes.

3 MS. HIRTH: So I want to offer this  
4 particular document that's already been marked as  
5 Exhibit 27 as evidence to this -- attached to this  
6 deposition transcript.

7 Q. Could you please turn to the first page of  
8 the agreement, and if you could look at the very last  
9 one-sentence paragraph on that page and read that aloud,  
10 I'd appreciate that.

11 A. "Whereas Intuitive has filed oppositions to  
12 bioMerieux da Vinci trademark applications in the United  
13 Kingdom and the USA."

14 Q. To your knowledge, did Intuitive Surgical  
15 file an opposition to an application in the name of  
16 bioMerieux for registration of da Vinci in the United  
17 States?

18 A. Yes.

19 Q. Do you have an understanding of why  
20 Intuitive initiated an opposition proceeding against  
21 bioMerieux's application for registration of da Vinci in  
22 the United States?

23 A. Yes.

24 Q. And what is that understanding?

25 A. We used the opposition as a means of

1 engaging bioMerieux in the use of da Vinci trademark in  
2 Taiwan.

3 Q. Were there any other reasons that Intuitive  
4 initiated the opposition proceeding against bioMerieux  
5 in the United States?

6 A. I believe it was to limit bioMerieux's use  
7 of da Vinci in the United States to certain uses.

8 Q. And why did, if you know, Intuitive feel  
9 that initiation of an opposition proceeding would get  
10 them the two things you just mentioned; that is,  
11 engaging with regard to Taiwan and limiting use of the  
12 mark in the United States?

13 A. I'm sorry. Can you repeat the question?

14 Q. Why did Intuitive believe that filing an  
15 opposition proceeding in the United States against  
16 bioMerieux would get them the two things that you said  
17 were the reasons that you did it; that would get them to  
18 that?

19 A. Well, I believe --

20 Q. If that makes sense?

21 A. Yes. So I believe, in filing the  
22 opposition, it would incentivize bioMerieux to work with  
23 Intuitive in obtaining what Intuitive wanted.

24 Q. Now, to your knowledge, what goods are  
25 covered by this coexistence agreement? You know what?

1 Let me retract that question and ask you a different  
2 one.

3 To your knowledge, what goods were covered  
4 by bioMerieux's application for registration of da Vinci  
5 in the United States that was opposed by Intuitive?

6 MR. VANDEN BOSCH: Objection, no foundation.

7 MS. HIRTH: Q. Let me ask you a question to  
8 see if you have foundation to answer this: Were you --  
9 you mentioned earlier you worked with outside counsel.  
10 Were you informed by outside counsel as to their  
11 activities with regard to this matter?

12 MR. VANDEN BOSCH: Objection, leading.

13 MS. HIRTH: Q. You can answer.

14 A. I may have. I don't specifically recall.

15 Q. Okay. Do you have an understanding as to  
16 the nature of bioMerieux's application for registration  
17 of da Vinci in the United States?

18 A. I'm not sure if I -- can you repeat the  
19 question? I'm not sure I understand it.

20 Q. I'll change it a little bit.

21 Do you have an understanding as to the goods  
22 that were covered by bioMerieux's application for  
23 registration of da Vinci in the United States?

24 A. I'm not sure.

25 Q. Okay. Let me see if I can make it a little

1 clearer.

2 Do you -- let me change the question -- do  
3 you have an understanding as to the goods of  
4 bioMerieux's that were the subject of the coexistence  
5 agreement?

6 A. Yes.

7 Q. How is it that you have that understanding?

8 A. It's described in the coexistence agreement.

9 Q. And you told us before you read the  
10 coexistence agreement, correct?

11 A. Yes.

12 Q. So to your knowledge, what are the goods  
13 that are covered by the coexistence agreement that we  
14 have marked as Exhibit 27?

15 A. For bioMerieux, it's photometric analyzers  
16 for clinical use and immunoanalyzers.

17 Q. And why did Intuitive want to limit  
18 bioMerieux's use of da Vinci to these goods?

19 A. We felt that those goods are different than  
20 the goods that Intuitive sells.

21 Q. Was Intuitive Surgical successful in  
22 limiting bioMerieux's use of da Vinci to the goods that  
23 are the subject of this coexistence agreement?

24 A. To my knowledge, yes.

25 Q. Could you turn to page 1 of this Exhibit 27

1 and read to yourself the first paragraph under the  
2 heading, "Recitals."

3 A. (Witness reviews document.) Okay.

4 Q. And then if you could read aloud into the  
5 record the very last sentence of that paragraph.

6 A. "Each of these applications and  
7 registrations for the trademark da Vinci in  
8 International Classes 09 and 10 and for (discrete)  
9 photometric analyzers for clinical use and  
10 immunoanalyzers."

11 Q. Based upon your review of the agreement, to  
12 whose applications and registrations does that sentence  
13 refer?

14 A. bioMerieux's.

15 Q. Now, if you could turn to the second page of  
16 this document and please read aloud from where it says  
17 in bold "bioMerieux agrees" near the top and read  
18 through paragraph 1 aloud into the record.

19 A. "Not to use, have used, register and/or have  
20 registered its mark da Vinci in relation to  
21 goods/services other than those mentioned in paragraph 1  
22 of the recitals and related services and products  
23 connected to the in vitro diagnostic field (the  
24 'goods')."

25 Q. Based upon your review of the coexistence

1 agreement, are the goods that are referred to here those  
2 that you just read to us from paragraph 1 of the  
3 recitals?

4 A. Yes.

5 MR. VANDEN BOSCH: Objection, leading.

6 MS. HIRTH: Q. Do you have a general  
7 understanding of what it is that bioMerieux agreed to by  
8 entering into this coexistence agreement?

9 A. Yes.

10 Q. Can you tell me what that is?

11 A. bioMerieux agreed to use its da Vinci mark  
12 only in relation to these products -- photometric  
13 analyzers and immunoanalyzers -- in, I believe, not just  
14 the United States, but worldwide.

15 Q. Is this coexistence agreement still in  
16 effect, to your knowledge?

17 A. Yes.

18 Q. Now, do you have an understanding as to what  
19 occurred as to the opposition proceeding against  
20 bioMerieux's application in the United States after the  
21 parties entered into this coexistence agreement?

22 A. Yes.

23 Q. What is that understanding?

24 A. So the opposition was withdrawn, and then  
25 Intuitive was able to obtain rights for da Vinci in

1 Taiwan.

2 Q. Do you have an understanding as to how it is  
3 that Intuitive obtained rights to da Vinci in Taiwan?

4 A. I believe so.

5 Q. Can you tell me what that is?

6 A. bioMerieux transferred its rights to  
7 Intuitive, and then Intuitive licensed back to  
8 bioMerieux da Vinci for the specific goods that we  
9 talked about before.

10 Q. And can you tell me what those specific  
11 goods were?

12 A. Photometric analyzers and immunoanalyzers.

13 Q. When you say that Intuitive licensed back  
14 da Vinci to bioMerieux for use with those goods, was  
15 that with regard to a specific -- was that worldwide?  
16 Was that with regard to a specific area?

17 MR. VANDEN BOSCH: Objection, leading.

18 THE WITNESS: Give me a moment. (Witness  
19 reviews document.)

20 I believe it was only to its use in Taiwan,  
21 as referenced in the coexistence agreement.

22 MS. HIRTH: Those are actually all of the  
23 questions I have, so I will open it up to cross.

24 EXAMINATION BY MR. VANDEN BOSCH

25 MR. VANDEN BOSCH: Q. Mr. Gong, you say now

1 that, as vice president of finance, part of your duties  
2 is to provide financial support for sales; is that  
3 right?

4 A. Correct.

5 Q. What do you mean by "provide financial  
6 support for sales"?

7 MS. HIRTH: I'm going to object. Outside  
8 the scope.

9 MR. VANDEN BOSCH: This is raised on your  
10 direct, what his duties were.

11 MS. HIRTH: You can go ahead and answer,  
12 though.

13 THE WITNESS: It would include tracking and  
14 reporting the expenses of the sales department and  
15 marketing department.

16 MR. VANDEN BOSCH: Q. Does Intuitive  
17 Surgical provide financing for customers purchasing its  
18 goods?

19 MS. HIRTH: Outside the scope. The scope of  
20 the questions that I asked were simply foundation for  
21 Mr. Gong's experience with the company. This question  
22 is outside the scope.

23 MR. VANDEN BOSCH: Q. You can answer it,  
24 please.

25 MS. HIRTH: No. Actually, it's outside the

1 scope and irrelevant.

2 MR. VANDEN BOSCH: This is -- this goes to  
3 your asking him questions about what his duties were as  
4 a vice president of finance, and part of it is providing  
5 financial support for sales. I'm entitled to explore a  
6 little bit of what his duties are, especially when you  
7 brought them up on direct.

8 MS. HIRTH: I'll let you answer only as to  
9 generalities as to what your duties are.

10 THE WITNESS: Can you repeat the question?

11 MR. VANDEN BOSCH: Q. Do you provide  
12 financing to your customers at Intuitive Surgical?

13 MS. HIRTH: That's not a generality as to  
14 what his duties are.

15 MR. VANDEN BOSCH: Q. Are you in charge of  
16 the financing provided by Intuitive Surgical to  
17 customers?

18 A. Generally, we do not provide financing to  
19 customers.

20 Q. So what does it mean -- again, if you could  
21 just state it one more time -- "financial support for  
22 sales"?

23 A. Maybe it would help you if I said the sales  
24 department, so --

25 Q. Okay.

1           A. -- as I mentioned before, my group will  
2 track the expenses incurred by the sales department.

3           Q. How do you provide financial support for  
4 your sales department?

5           MS. HIRTH: I think that is outside the  
6 scope; how Mr. Gong does his duties is not what his  
7 duties are.

8           MR. VANDEN BOSCH: Are you instructing him  
9 not to answer that, Counsel?

10          MS. HIRTH: I'm letting you know that you  
11 can rephrase that question, if you want to get to what  
12 his duties are, which is the scope of the direct.

13          MR. VANDEN BOSCH: Q. What is the duty of a  
14 vice president of finance in providing financial support  
15 for the sales department?

16          A. It includes tracking and reporting the  
17 expenses incurred by the sales and marketing  
18 departments.

19          Q. With respect to the coexistence agreement,  
20 was the United States Patent and Trademark Office  
21 involved in these negotiations?

22          A. I don't know.

23          Q. Do you know whether or not the board, in  
24 your opposition proceeding against bioMerieux, was  
25 involved in the negotiation of the coexistence

1 agreement?

2 MS. HIRTH: Can you just clarify -- vague  
3 and ambiguous. Can you just clarify what you mean by  
4 "board"?

5 MR. VANDEN BOSCH: The Trademark Trial and  
6 Appeal Board.

7 Q. Was that entity involved in negotiating the  
8 coexistence agreement?

9 A. I don't know.

10 Q. To your knowledge, bioMerieux was a party to  
11 the coexistence agreement, true?

12 A. Yes, to my knowledge.

13 Q. And bioMerieux was a party to the  
14 negotiations of the coexistence agreement, true?

15 A. I would -- I don't know that for a fact, but  
16 they did sign the coexistence agreement.

17 Q. Intuitive Surgical was a party in the  
18 negotiation of the coexistence agreement; is that true?

19 A. I assume that to be true, yes.

20 Q. The coexistence agreement -- do you know  
21 whether or not the coexistence agreement was filed with  
22 the Trademark Trial and Appeal Board?

23 A. I don't know.

24 Q. And I believe you stated on direct that  
25 after the coexistence agreement was signed by

1 bioMerricks and Intuitive Surgical, then Intuitive  
2 Surgical filed a motion or withdrew -- I'm sorry. Let  
3 me restate that. It's sloppy.

4 After the coexistence agreement was signed  
5 between bioMerricks and Intuitive Surgical, Intuitive  
6 Surgical withdrew its opposition; is that right?

7 MS. HIRTH: I just want to clarify for the  
8 record: You mean bioMerieux and not bioMerricks, right?

9 MR. VANDEN BOSCH: bioMerieux. I  
10 mispronounced it.

11 THE WITNESS: Yes. To my knowledge, after  
12 this coexistence agreement was signed, Intuitive  
13 withdrew its oppositions filed against bioMerieux.

14 MR. VANDEN BOSCH: That's all I have.

15 MS. HIRTH: Thank you. I believe we are  
16 done. We can go off the record.

17 --oOo--

18 (Whereupon, the deposition was adjourned at  
19 1:33 p.m.)

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CERTIFICATE OF REPORTER

I, DEBRA ALLUSTIARTI, a Certified Shorthand Reporter, hereby certify that the witness in the foregoing deposition was by me duly sworn to tell the truth, the whole truth and nothing but the truth in the within-entitled cause;

That said deposition was taken down in shorthand by me, a disinterested person, at the time and place therein stated, and that the testimony of the said witness was thereafter reduced to typewriting, by computer, under my direction and supervision.

That before completion of the deposition, review of the transcript was not requested. If requested, any changes made by the deponent (and provided to the reporter) during the period allowed are appended hereto.

I further certify that I am not of counsel or attorney for either or any of the parties to the said deposition nor in any way interested in the event of this cause and that I am not related to any of the parties thereto.

DATED: June 8, 2009

Debra Allustiarti

DEBRA ALLUSTIARTI CSR, No. 10929

# Merrill Legal Solutions



## INSTRUCTIONS FOR READING/CORRECTING YOUR DEPOSITION

To assist you in making changes and /or corrections to your deposition testimony, please follow the directions below. If additional pages are necessary, please furnish them and attach the pages to the back of the errata sheet.

Please read your transcript carefully. If you find any errors or changes you wish to make, insert the changes and/or corrections on the errata sheet by listing the page and the line number reference and then the change you wish to make.

Please do not make any changes and /or corrections on the face of the transcript.

Please do NOT change any of the questions.

After completing your review, please sign the last page of the errata sheet, above the designated "Signature" line and return the Errata sheets to Merrill Legal Solutions at 135 Main Street, 4<sup>th</sup> Floor, San Francisco, CA 94105 or fax them to (415) 357.4301.

### ERRATA SHEET

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\_\_\_\_\_ Subject to the above changes, I certify that the transcript is true and correct.

\_\_\_\_\_ No changes have been made. I certify that the transcript is true and correct.

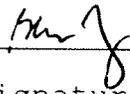
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I declare under penalty of perjury that  
the foregoing is true and correct. Subscribed at  
Sunnyvale, California, this 18 day of June,  
2009.



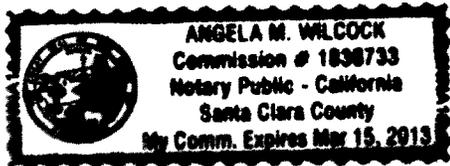
Signature of Witness

State of California  
County of Santa Clara

Subscribed and sworn to (or affirmed) before me, Angela M. Wilcock, on this 18th day of  
June, 2009, by Benjamin Gong proved to me on the basis of satisfactory evidence to be the  
person(s) who appeared before me.

(seal)

Signature 



## COEXISTENCE AGREEMENT

This Coexistence Agreement is entered into as of this 1<sup>st</sup> 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

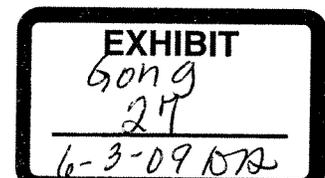
WHEREAS bioMérieux is the owner of International Registration No. 757 068, Argentine Registration No 1 876 517, Canadian Registration No 576 387, Columbian Registration No. 239 962, Mexican Registration No. 689 635, Israel Registration No. 143 700, Taiwan, Republic of China ('Taiwan') Registration No. 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.

- 5) to take all steps necessary and to work with bioMérieux to attempt to overcome the objection to the extension of protection of International Registration No. 757068 to the United Kingdom and Spain.
- 6) upon the assignment of bioMérieux's Taiwan Trade Mark Registration No. 954885 to Intuitive, to grant bioMérieux a royalty free exclusive license to use the mark DA VINCI in Taiwan in connection with the Goods. All reasonable costs related to the registration, publication, filing and/or mention of the license with any relevant authority or administrative body in Taiwan shall be borne by bioMérieux.

Each party agrees not to interfere, directly or indirectly, with the other party's rights, title and interest in and to its DA VINCI trademark as set forth in this Coexistence Agreement.

#### **Governing Law/Settlement of disputes**

This Coexistence Agreement is to have worldwide effect and shall be governed by and construed in accordance with the substantive laws of England without regard to its conflict of law principles. All disputes arising out of, in relation to or arising from this Coexistence Agreement, including any question regarding its validity, construction or performance, shall, unless solved through an amicable settlement, be finally settled under the Rules of Conciliation and Arbitration of the International Chamber of Commerce (ICC Paris) by three arbitrators appointed in accordance with said Rules. Arbitration shall be in English and shall take place in Paris, France.

#### **Miscellaneous**

**Effect on Heirs and Successors:** This Coexistence Agreement and each of its provisions shall be binding upon the parties and any parent, associated or subsidiary company of the same and shall inure to the benefit of their respective heirs, devisees, legatees, executors, administrators, trustees, successors and assignees.

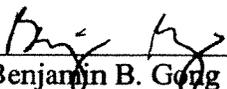
**Waiver, Amendment, Modification:** No waiver, amendment or modification, including those by custom, usage of trade, or course of dealing, of any provision of this Coexistence Agreement will be effective unless in writing and signed by the party against whom such waiver, amendment or modification is sought to be enforced.

**Severability:** If any provision of this Coexistence Agreement is found invalid or unenforceable under judicial decree or decision, the remainder shall remain valid and enforceable according to its terms and the parties shall make their best efforts to replace the invalid or unenforceable provision by a valid and enforceable provision that comes closest to the spirit of this Coexistence Agreement.

Each party to this Coexistence Agreement is authorised to obtain, at its own expense, all necessary registrations, publications, files and mentions with any authority or administrative body, where applicable, and to seek copies of any such registrations, publications, files and mentions from any authority or administrative body.

IN WITNESS WHEREOF, the parties have caused this Coexistence Agreement to be executed in two (2) original counterparts, one for each party, by their duly authorised representatives.

**For and on behalf of Intuitive Surgical, Inc:**

  
\_\_\_\_\_  
Name: Benjamin B. Gong  
Title: Vice President, Finance

**For and on behalf of bioMérieux B.V.:**

  
\_\_\_\_\_  
Name: Thierry BERNARD  
Title: Director