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

Proceeding	91175319
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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

OPPOSER INTUITIVE SURGICAL, INC.'S MAIN TRIAL BRIEF

Opposer Intuitive Surgical, Inc. ("Opposer") hereby presents its main trial brief in this Opposition Proceeding and requests the Trademark Trial and Appeal Board (the "Board") sustain Opposer's opposition for the reasons set forth below.

I. INTRODUCTION

Applicant DaVinci Radiology Associates, P.L.'s ("Applicant") mark DAVINCI DIAGNOSTIC IMAGING & Design ("Applicant's Mark") is confusingly similar to Opposer's marks DA VINCI, DA VINCI S, DA VINCI S HD SURGICAL SYSTEM and DA VINCI S HD SURGICAL SYSTEM (Stylized) (singly "Opposer's Mark" and collectively "Opposer's Marks"), among others, and Applicant's Mark should be denied registration on the Principal Register.

First, Applicant's Mark consists of Opposer's Mark DA VINCI as its first term with the addition of the disclaimed term "DIAGNOSTIC[,]" the term "IMAGING" and certain design elements. Similarly, DA VINCI is the dominant term in both Applicant's Mark and Opposer's Marks DA VINCI S, DA VINCI S HD SURGICAL SYSTEM and DA VINCI S HD

SURGICAL SYSTEM (Stylized). The "Da Vinci" terms in the parties' respective marks are virtually identical in appearance and are identical in sound and meaning, referring to and connoting the well-known Renaissance man Leonardo Da Vinci. Further, "Da Vinci" is arbitrary and distinctive as applied to Opposer's goods and Applicant's services offered under the respective marks. Since the dominant and distinctive term in both parties' marks are identical, the commercial impressions of the parties' respective marks are similar.

Second, the evidence of record shows that Opposer's Marks are registered and/or in use in association with computerized surgical systems and associated parts and instruments used to perform minimally-invasive robotic surgery in a variety of surgical applications. These goods incorporate multiple computer processors and are comprised of three main components, including a surgeon console. The surgeon console has a display screen through which the surgeon views the surgical field and can simultaneously view preoperative diagnostic imaging data or stills, such as magnetic resonance imaging or computed tomography scans. The evidence shows the outside images fed into and viewed through the display screen often are marked with the name and/or logo of the diagnostic imaging service that produced the image. The services offered under Applicant's Mark are medical diagnostic imaging services. Specifically, Applicant's licensee offers magnetic resonance imaging, computed tomography scans, positron emission tomography scans and digital mammography. Each of these diagnostic imaging techniques involves the rendition of an image of the human body and is computerized. The services offered under Applicant's Mark are used by surgeons, as well as other physicians, both preoperatively and during surgical procedures.

Both Opposer's goods and Applicant's services are in the medical and health care field and both utilize computer technology. More important, the images produced via the services offered under Applicant's Mark are used side-by-side with, by the same end-users as, and <u>in</u> the

goods offered under Opposer's Marks. The parties' respective goods and services therefore are related under a likelihood of confusion analysis.

Third, neither Opposer's registration or applications nor Applicant's application include any restrictions as to trade channels or marketing channels or as to consumers of the parties' respective goods and services. As a matter of law, therefore, the parties' goods and services are presumed to be promoted via all commonly used marketing channels and to all usual consumers of such goods and services. Both Opposer's goods and Applicant's services would in the normal course be marketed via solicitation of physicians' associations, through brochures and advertisements targeting physicians and patients, and through the Internet. In fact, in this case, both Opposer's goods and the services offered under Applicant's Mark are marketed via direct sales calls on physicians, attendance at medical society meetings, brochures and Internet websites. Further, the evidence shows that consumers of both Opposer's goods and Applicant's services offered under their respective marks are patients and physicians, including both surgeons and non-surgeons. The parties' trade channels and consumers overlap.

Moreover, Opposer's Marks are the only "DA VINCI" marks that occupy Opposer's niche in the medical/surgical field. Allowing registration of Applicant's Mark for related services in Opposer's niche would be tantamount to stripping Opposer of its rights in its Marks and opening the door to anyone who wishes to register similar marks for goods and services in that niche. Opposer would lose all the goodwill it has built through years of use, promotion and protection of its rights in Opposer's Marks.

Given the similarity of the parties' marks, the relatedness of the parties' goods and services offered under those marks and the overlap of the marketing channels and consumers of those goods and services, confusion as to source is likely here. Accordingly, and in light of the

great harm to Opposer should Applicant's Mark register, this Board should grant Opposer's opposition and refuse registration of Applicant's Mark.

II. DESCRIPTION OF THE RECORD

The record in this Opposition Proceeding consists of the following items.

A. Testimonial Deposition Transcripts

The record includes the transcripts of the testimonial depositions, with exhibits as noted, of the following witnesses, which were taken on the dates indicated below.

- January 19, 2009 Testimonial Deposition of Thomas Boyle, M.D., and Exhibits 1 through 13 thereto (referred to herein as IS-1 through IS-13, respectively).[1]
- January 27, 2009 Testimonial Deposition of Christopher Simmonds (including public and confidential volumes), and Exhibits 14- 24 thereto (referred to herein as IS-14 through IS-25, respectively).
- January 27, 2009 Testimonial Deposition of David Scott, and Exhibit 26 thereto (referred to herein as IS-26).
- January 28, 2009 Testimonial Deposition of Steven Annen.
- June 3, 2009 Testimonial Deposition of Benjamin Gong, and Exhibit 27 thereto (referred to herein as IS-27).

These transcripts will be cited in the following forms, respectively: Boyle Tr. at p.__; Simmonds Tr. at p. __; Scott Tr. at p. __; Gong Tr. at p. __.

[1] All exhibits to the testimonial depositions were numbered consecutively across all testimonial depositions. All exhibits to the testimonial depositions were marked and introduced into evidence by Opposer and are referred to herein as IS-1 through IS-27, where IS-1 corresponds to Exhibit 1 to the testimonial depositions, IS-2 corresponds to Exhibit 2 to the testimonial depositions, etc.

B. Opposer's First Notice of Reliance

Opposer Intuitive Surgical, Inc.'s First Notice of Reliance includes Exhibits 1 through 17 attached thereto, all of which Opposer has requested be made of record in this Proceeding. These exhibits are referred to herein as ISNR1-1 through ISNR1-17, respectively.

C. Applicant's First Notice of Reliance

Applicant DaVinci Radiology Associates, P.L.'s First Notice of Reliance includes Exhibits 1 through 7 attached thereto, all of which Applicant has requested be made of record in this Proceeding. These exhibits are referred to herein as DR-1 through DR-7, respectively.

D. Opposer's Second (Rebuttal) Notice of Reliance

Opposer Intuitive Surgical, Inc.'s Second (Rebuttal) Notice of Reliance includes Exhibits 1 through 5 attached thereto, all of which Opposer has requested be made of record in this Proceeding. These exhibits are referred to herein as ISNR2-1 through ISNR2-5, respectively.

E. Application File Wrapper

Pursuant to 37 C.F.R. § 2.122(a), the file of the trademark application that is the subject of this Opposition Proceeding, U.S. Trademark Application Serial No. 78/728,786 in the name of Applicant for DAVINCI DIAGNOSTIC IMAGING & Design, is deemed to be of record in this Proceeding. Applicant also requested it be made of record by way of Applicant's Notice of Reliance, to which the file wrapper was attached as Exhibit 3 and is referred to herein as DR-3.

III. STATEMENT OF THE ISSUES

Whether Applicant's proposed mark DAVINCI DIAGNOSTIC IMAGING & Design, when applied to the services recited in U.S. Trademark Application Serial No. 78/728,786 so resembles Opposer's marks DA VINCI, DA VINCI S, DA VINCI S HD SURGICAL SYSTEM and DA VINCI S HD SURGICAL SYSTEM (Stylized) as to be likely to cause confusion, cause mistake or deceive as to source, sponsorship or affiliation of Applicant's services offered under

Applicant's Mark. Opposer contends that confusion, mistake or deception would be likely and that it will be damaged if registration of DAVINCI DIAGNOSTIC IMAGING & Design is permitted. Opposer therefore opposes registration of DAVINCI DIAGNOSTIC IMAGING & Design and requests that Opposition No. 91175319 be sustained.

IV. RECITATION OF FACTS

A. Opposer and its Marks

"Da Vinci" is the surname of the 16th Century artist, scientist, innovator and Renaissance man Leonardo Da Vinci. Leonardo Da Vinci studied anatomy and made scientific drawings of the human body and its parts. He also was an engineer and inventor who designed numerous machines including the first robotics. ISNR1-11 at pp. 199 & 200a; Annen Tr. at 15:10-16:6. In light of Leonardo da Vinci's achievements, Opposer adopted the term "Da Vinci" for use in association with its robotic, computerized surgical systems. Annen Tr. at 15:10-16:6. Opposer owns a number of DA VINCI marks that are registered for and/or are in use with computerized surgical manipulation – or robotic – systems and associated parts, instruments and services.

Opposer's Mark DA VINCI is the subject of U.S. Trademark Registration No. 2,628,871 in the name of Opposer, Application Serial No. 75/982,190 filed on March 19, 1999 which registered on October 1, 2002, for use with:

> 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, trocars, 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 appliers and clips, tack appliers and tacks, applicators, ligature carriers, needle holders, clamps, hemostats, graspers, curettes, instrument guides, ligature passing and knotting instruments, needles, retractors, snares, stylets, 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 appliers, electrocautery tools, forceps, needle holders, guides and drivers, graspers, and kitteners.

(hereinafter these goods are referred to as Opposer's "Computerized Surgical System(s)" or the "System(s)"). ISNR1-1 at p. 2.[2] Opposer has continuously offered and sold Computerized Surgical Systems under the DA VINCI mark since at least as early as late 1999. Annen Tr. at 23:3-16.

Other of Opposer's DA VINCI marks, DA VINCI S,[3] DA VINCI S HD SURGICAL SYSTEM, DA VINCI S HD SURGICAL SYSTEM (Stylized) and DA VINCI Si HD SURGICAL SYSTEM (Stylized), are the subjects of U.S. Trademark Application Serial Nos. 76/672,142, 77/561,385, 76/665,748 and 76/687,738, respectively, filed on February 2, 2007, September 3, 2008, September 8, 2006 and March 14, 2008, respectively.[4] ISNR1-2 at p. 2; ISNR1-3 at pp. 2-3; ISNR1-4 at p. 5; ISNR1-6 at p. 5. Each of these applications was filed in the name of Opposer for use in connection with its Computerized Surgical Systems. *Id.* Opposer has continuously offered and sold the Systems under the DA VINCI S, DA VINCI S HD SURGICAL SYSTEM and DA VINCI S HD SURGICAL SYSTEM (Stylized) marks since at least as early as January 2006, January 2007 and January 2007, respectively. Annen Tr. at

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[2] Where pages within an exhibit are not consecutively numbered, the actual page number as counted from first to last is indicated.

[3] Since Opposer's First Notice of Reliance was filed in this Proceeding, the mark DA VINCI S has registered. *See* U.S. Trademark Registration No. 3,561,484.

[4] Although Opposer's prior filed and prior registered mark DA VINCI inexplicably was not cited by the United States Patent & Trademark Office against the subject Application, Applicant's Mark has been cited against Opposer's applications for registration of DA VINCI S HD SURGICAL SYSTEM, DA VINCI S HD SURGICAL SYSTEM (Stylized), and DA VINCI Si HD SURGICAL SYSTEM (Stylized). DR-3; ISNR1-3 at pp. 12-13; ISNR1-4 at p. 12; ISNR1-6 at pp. 8-9. In fact, the applications for registration of DA VINCI S HD SURGICAL SYSTEM (Stylized) and DA VINCI SI HD SURGICAL SYSTEM (Stylized) have been suspended pending final action on the subject Application. ISNR1-4 at pp. 21-22; ISNR1-6 at pp. 18-19.

23:17-25:3. None of the registrations or applications for registration of Opposer's Marks contain any restrictions on channels of trade or promotion. *See* ISNR1-1; ISNR1-2; ISNR1-3; ISNR1-4. Opposer's mark DA VINCI S HD SURGICAL SYSTEM (Stylized) appears as:

See ISNR1-4 at p. 1. Opposer's mark DA VINCI Si HD SURGICAL SYSTEM (Stylized) appears as:

See ISNR1-6 at p. 3. Opposer's marks DA VINCI, DA VINCI S, DA VINCI S HD SURGICAL SYSTEM and DA VINCI S HD SURGICAL SYSTEM (Stylized) are collectively referred to herein as "Opposer's Marks".

Opposer also is seeking registration of and is using other "DA VINCI" marks in connection with goods and services related to its Computerized Surgical Systems. For example, the mark DA VINCI SONICPRO is the subject of U.S. Trademark Application Serial No. 77/292,138 filed in the name of Opposer on March 14, 2008 for use with ultrasonic cleaning equipment for computerized surgical systems.[5] ISNR1-5 at p. 3. Opposer has continuously offered and sold goods under DA VINCI SONICPRO since at least November 2008. Annen Tr. at 18:12-19:13. As another example, DVSTAT DA VINCI SURGERY TECHNICAL

ASSISTANCE TEAM (Stylized) is the subject of U.S. Trademark Application Serial No. 77/568,958 filed in the name of Opposer on September 12, 2008 for use with both Opposer's Computerized Surgical Systems and for technical support for those Systems. ISNR1-7 at pp. 1-3.

1. Goods Offered Under Opposer's Marks

Goods offered under Opposer's Marks are Computerized Surgical Systems for minimally invasive, robotic-assisted surgery used in a wide variety of surgical applications including but not limited to cardiology, urology, general surgery, thoracic surgery, gynecology and pediatrics. Annen Tr. at 25:4-26:16; Simmonds Tr. at 12:19-14:9; DR-6 at Response Nos. 3 & 4. The highest volume of surgeries performed using Opposer's goods are in the specialty of urology, including prostatectomies. Opposer's Computerized Surgical Systems also are regularly used to perform hysterectomies and other gynecological procedures, cardiac procedures such as mitral valve repair and coronary bypass surgery, various pediatric surgeries and gastric bypass surgery, among others. Annen Tr. at 25:4-26:16; Simmonds Tr. at 13:10-14. Currently, the Systems are used in 60-100 specific surgical procedures and use of Opposer's Systems is considered the standard of care with regard to some of those procedures. Simmonds Tr. at 12:19-13:9.

Opposer's Computerized Surgical Systems consist of three components: a surgeon console, patient-side cart and vision cart. Annen Tr. at 11:3-13; Scott Tr. at 8:14-9:2. *See* IS-26 at intuitivesurgical.com/davinci_surgicalsystem/index;[6] Scott Tr. at 28:13-29:16; Simmonds Tr. at 11:4-20. The surgeon console, at which the surgeon sits, includes a video display and controls that allow the surgeon to manipulate and control the patient-side cart and its instruments. Annen Tr. at 11:3-13; Scott Tr. at 8:14-9:2, 10:6-23. The patient-side cart interfaces with the patient

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[5] Applicant's Mark also has been cited against Opposer's application for registration of DA VINCI SONICPRO and, as a result the DA VINCI SONICPRO application has been suspended pending final action on the subject Application. ISNR1-5 at pp. 9-10 & 17-18.

and houses the instruments controlled by the surgeon to perform the surgery. Annen Tr. at 11:3-13; Scott Tr. at 8:14-9:2. The patient side-cart also includes an endoscope through which the surgeon "sees" the visual field. Scott Tr. at 13:14-14:2. The vision cart houses the camera and lighting equipment for the imaging aspects of the system. *Id.* The surgeon console, patient-side cart and vision cart each include many levels of computer processors. *Id.* at 10:24-11:4.

Three different versions of the Computerized Surgical Systems are offered under Opposer's Marks.[7] Each System consists of the surgeon console, patient-side cart and vision cart. Annen Tr. at 10:2-11:13. The standard or "classic" System is offered under DA VINCI. *Id.* at 11:19-12:3. The Systems offered under DA VINCI S, DA VINCI S HD SURGICAL SYSTEM and DA VINCI S HD SURGICAL SYSTEM (Stylized) are upgraded versions of the classic System. Simmonds Tr. at 11:21-12:13; Annen Tr. at 13:1-14:19. The surgeon console of each System bears the Mark under which it is offered. *See* Scott Tr. at 28:13-29:16; IS-26 at products/davinci_surgicalsystem/index & products/davincisurgicalsystem/index; All three Systems are currently in use in the marketplace and continue to be manufactured, repaired and refurbished by Opposer. Annen Tr. at 10:20-11:2, 11:19-12:3, 14:20-15:7, 52:16-53:2; Scott Tr. at 8:3-13; Simmonds Tr. at 12:4-6.

The view of the surgical field in the display on the surgeon console three dimensional. Scott Tr. at 12:11-13:10. The three dimensionality of the System is achieved through the use of two separate camera video leads in the endoscope – the left-eye video and the right-eye video – located on the patient-side cart. These two channels of video are carried through the video processing system to the surgeon console. At the surgeon console, there is a left video display

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[6] Hereinafter, the primary website URL (i.e., "intuitivesurgical.com") will be omitted and only the specific webpage location will be included in a website page citation.

for the left-eye video and a right video display for the right-eye video. Scott Tr. at 12:11-13:10. The surgeon sees everything at which the endoscope is pointing in three dimensions. When the endoscope is inside the patient's body, the surgeon at the surgeon console sees a three-dimensional view of the anatomy inside the body. Scott Tr. at 10:6-23, 12:11013:10, 13:18-14:3.

The display on the surgeon console includes a feature – TilePro – that is loosely analogous to the "picture in picture" feature on modern televisions. This feature allows outside imaging video, data sets or still images to be fed into the display on the surgeon console. Scott Tr. at 13:18-14:3; Annen Tr. at 14:2-19. While the upper portion of the screen displays the live surgical view, the lower portion of the screen includes two windows that display the outside data sets. Scott Tr. at 16:9-22. Up to two different displays of outside video, data sets or still images can be piped in simultaneously. *Id.*. at 14:4-11. These images include prerecorded or preoperative data, and often consist of CT scan or MRI data sets from diagnostic imaging of the patient prior to the procedure. *Id.* at 16:23-17:14. The image or data set file that is fed into the System often is marked with the name and/or logo of the outside imaging service to inform the surgeon of the image's source. *Id.* at 19:10-20:12. This feed of outside imaging, particularly CT and MRI images, is routinely used with Opposer's Computerized Surgical Systems. *Id.* at 15:19-16:12, 17:22-18:15. Further, Opposer is currently devising a method by which preoperative data, such at CT data, can be manipulated on the System and oriented to the live surgical view, rather than simply viewed in the orientation in which the image was captured. *Id.* at 20:20-25, 22:14-21, 24:3-25:16.

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[7] In 2009, Opposer launched a fourth version of its System under DA VINCI Si HD SURGICAL SYSTEM (Stylized). As no evidence is in the record regarding use of the DA VINCI Si HD SURGICAL SYSTEM (Stylized) mark, it is not discussed herein for purposes of this Proceeding.

2. Opposer's Consumers and Promotion of Goods Under Opposer's Marks

Opposer's Systems are purchased primarily by hospitals and are used by surgeons. Annen Tr. at 30:21-31:9; Scott Tr. at 8:14-9:2, 10:6-23, 13:18-14:3, 16:9-17:4. The Systems are offered for sale to hospitals, surgical centers and physicians primarily through a direct sales force. Annen Tr. at 26:25-27:4; DR-6 at Response Nos. 13 & 16. Opposer's sales force consists of two groups: the Capital Equipment Sales Group and the Clinical Sales Group. Annen Tr. at 27:9-15. The Capital Equipment Sales Group acts as a direct sales force and markets the Systems directly to hospital administrators and surgeons throughout the United States. Annen Tr. at 26:25-27:4, 27:16-28:6.[8] Upon the sale of a System, Opposer provides the purchasing hospital with, among other things, a user's manual and reference guides, all of which display Opposer's Marks. Annen Tr. at 37:19-38:10, 38:18-25, 39:14-18. Once a System has been purchased by a hospital and installed, the Clinical Sales Group works to train surgeons to use the System and works with hospitals and surgeons on marketing and promoting the System to referring physicians and patients. Annen Tr. at 28:10-30:2, 32:16-33:6. *See* Sections IV.A.2.d-IV.A.2.e below.

After sale of a System, Opposer's Clinical Sales Group trains surgeons and operating room staff on the use of the System and assists those surgeons in marketing the System and themselves to the community. Annen Tr. at 27:4-14, 28:10-23, 32:6-16. Opposer's Clinical Sales Group has personnel throughout the United States, including in Boca Raton, Tampa and Orlando, Florida. *Id.* at 34:25-35:6. The training of practitioners by Opposer generally is offered at academic institutions throughout the country. Simmonds Tr. at 15:22-16:2, 56:6-15.

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[8] Opposer's Systems are installed in hospitals throughout the United States. In Florida alone, fifty-five Systems are currently in use, including numerous systems in Orlando, Tampa and Miami. Two Systems are in use in Palm Beach County, Florida: one at West Boca Medical Center and one at JFK Medical Center in Atlantis, Florida. Annen Tr. at 43:9-25, 44:21-45:6; Simmonds Tr. at 97:23-99:10; IS-21 at patientresources/hospitals_doctors/hospital-results.

Opposer promotes the training of surgeons using written materials, including brochures, and the Internet. *Id.* at 52:19-53:1, 53:7-54:17. Opposer produces these written materials, which it distributes at trade shows and medical association meetings and in response to inquiries by surgeons. These written materials also are distributed by the institutions offering or hosting the training courses. *Id.* at 52:19-53:1, 54:22-24, 56:4-11, 57:4-2, 56:12-20. For example, Opposer has distributed to surgeons a brochure promoting a "da Vinci Roux en-Y Gastric Bypass Training Program" offered at Stanford University and a brochure promoting a "da Vinci Prostatectomy Training Course" offered at the University of California, Irvine. *Id.* at 55:14-24, 56:4-11, 57:4-21; IS-15; IS-16. Other similar brochures also are used by Opposer to promote surgeon training on its Systems. Simmonds Tr. at 58:23-59:5.

Opposer's Computerized Surgical Systems are promoted and marketed to surgeons, referring physicians, patients and the general public. Simmonds Tr. at 16:3-25; Annen Tr. at 26:25-27:4, 46:20-47:7; DR-6 at Response Nos. 5 & 13. *See* Sections IV.A.2.a. – IV.A.2.e below. This marketing occurs through a variety of channels, including: (1) trade shows, medical congresses, and symposia; (2) "mobile events"; (3) direct marketing by Opposer including print advertising and Internet-based advertising and promotion; (4) post-sale marketing through hospitals; and (5) marketing assistance to physicians.

a. Trade Shows, Congresses and Symposia

Opposer promotes its goods under its Marks by attending trade shows, medical society meetings and symposia. Simmonds Tr. at 18:6-10:2. These trade shows range from regional meetings of medical associations at which Opposer has "pop-up booths" to large medical society meetings or "congresses" at which Opposer has a large presence to educational symposia specifically involving robotic surgery and Opposer's goods. Simmonds Tr. at 18:6-19:2.

Opposer has attended trade shows, congresses and symposia in the past and intends to continue to do so in the future. Simmonds Tr. at 28:25-29:19, 31:16-32:7, 34:9-35:24 & 36:5-19.

Conferences at which Opposer mans "pop-up booths" are generally meetings of regional chapters of medical associations such as the American Urological Association, among others. At such conferences, a sales representative of Opposer mans a small stand or table adorned with Opposer's Marks and provides to conference attendees brochures, DVDs and procedural guides for the Computerized Surgical Systems. Attendees of these conferences include surgeons and non-surgeon physicians. Simmonds Tr. at 18:6-16, 19:6-23, 20:4-5, 21:11-22:10, 22:24-23:20.

At congresses, or larger medical society meetings, Opposer mans a large booth adorned with Opposer's Marks. At these congresses, Opposer facilitates physician presenters of clinical papers and clinical data pertaining to use of Opposer's goods and often provides a System for attendees to "test drive" and a video feed that allows attendees to view a live surgery using Opposer's goods. *Id.* at 24:1-14, 25:3-26:11, 27:11-28:24. These congresses take place throughout the United States, often take place in cities such as San Francisco, Chicago, Orlando, Tampa and Fort Lauderdale, and are attended by both surgeons and non-surgeon physicians who hail from all over the United States. *Id.* at 28:25-30:14, 30:20-22, 31:3-15.

Opposer also attends symposia specifically related to robotic surgery. These include but are not limited to the World Robotic Urology Symposium ("WRUS"), the International Robotic Urological Symposium ("IRUS"), the World Robotic Gynecological Symposium ("WRGS") and similar symposia for cardiac, renal and other specialties. *Id.* at 32:8-21, 34:9-35:24, 36:5-19. These symposia generally consist of educational programs involving surgery using Opposer's goods. For example, the WRUS is held annually at Florida Hospital in Celebration, Florida and has surgeon attendees from around the United States. *Id.* at 32:8-21, 36:20-37:3, 39:8-21, 39:22-40:8. *See* IS-14.

b. Mobile Events

Opposer has five mobile Systems throughout the United States which are transported via truck to events at, among other places, hospitals, malls, sports centers, shops, metro stops and retirement communities ("mobile events").[9] The truck itself bears Opposer's Marks akin to a "rolling billboard". Simmonds Tr. at 43:19-44:1, 44:12-25; Annen Tr. at 30:2-20. Between approximately 150 and 200 such mobile events occur per year. Simmonds Tr. at 46:12-47:25. The mobile Systems are used at community events to familiarize potential patients with Opposer's Systems and the surgeries in which the Systems are used. Opposer generally mans a "pop-up booth" at these mobile events and provides to attendees brochures about Opposer's Systems written in a manner directed to patients. *Id.* at 44:12-25, 45:23-11, 48:1-49:25 & 50:1-10.. Opposer sends its mobile Systems to these events as part of its marketing assistance to surgeons qualified to use its Systems (""da Vinci" surgeons"). *See* Section IV.A.2.e below.

c. Direct Promotions by Opposer

Opposer promotes it Systems directly through the Internet, print advertisements, videos and general media coverage. The resultant promotions are intended to market the system and its use to patients and referring physicians. Annen Tr. at 29:20-30:2, 46:20-47:7; Simmonds Tr. at 16:3-25, 112:14-113:6.

First, Opposer maintains at least five Internet websites related to its Systems and their use. All of these sites target patients either entirely or in part. Simmonds Tr. at 16:3-25, 92:16-93:2, 96:9-22, 101:2-13, 103:15-18, 105:13-16 & 107:1-25. Opposer's Internet website www.intuitivesurgical.com provides information regarding Opposer's Systems and their basic components, surgical applications of the Systems, employment opportunities with Opposer, and investment and corporate information pertaining to Opposer. *See* IS-21; Simmonds Tr. at 95:10-

96:2, 96:23-97:22. This website targets patients as well as employees, potential employees, investors, surgeons and hospitals. Simmonds Tr. at 96:9-22. *See* IS-21. In fact, a section of this website is titled "Patient Resources" and includes an interactive screen that allows patients to search and locate hospitals that have a System (""da Vinci" hospitals") and "da Vinci" surgeons ("hospital/surgeon locator"). Simmonds Tr. at 96:23-97:22; IS-21 at patientresources & patientresources/hospitals-doctors/index.

Opposer has four Internet websites that are directed toward patients exclusively. The Internet website www.davincisurgery.com provides users with information about conditions whose treatment include a "da Vinci" surgery option, other common treatments, and surgery performed using Opposer's Systems. IS-22. In fact, the opening page of this website includes the statement:

> Welcome to da Vinci Surgery.com, a website designed to inform patients and their loved ones about what may be the most effective, least invasive surgical treatment option available today. Here, you can become better informed about different approaches to surgery. This knowledge will be valuable as you discus treatment options with your doctor.

IS-22 at davincisurgery.com/index; Simmonds Tr. at 101:7-13. Opposer's Internet website www.davinciprostatectomy.com provides information about prostate cancer and its treatment, the Systems, and use of Opposer's Systems to perform prostatectomies. *See* IS-23. Similarly, Opposer's Internet website www.davincihysterectomy.com provides information about gynecological conditions, symptoms and their treatment, Opposer's Systems, and use of those Systems to perform hysterectomies. *See* IS-24. These websites are directed to individuals seeking information about these respective conditions, suffering from these conditions and facing prostatectomies or hysterectomies. IS-23; IS-24; Simmonds Tr. at 103:15-18, 105:13-16. Each

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[9] One such event in 2008 occurred at a retirement community in Florida. Simmonds Tr. at 46:12-47:25.

of these websites also includes surgeon and patient testimonial videos, links to live surgery webcasts, patient seminars and a hospital/surgeon locator. Simmonds Tr. at 101:4-21, 103:19-25, 105: 17-23; IS-22 at procedures/gynecological/gyn-patient-seminars, gynecological/experiences, surgery/patients/index, procedures/da_vinci_surgery_webcasts & surgeons/index; IS-23 at experiences/meet_surgeons, experiences/meet_patients, davinci_prostatectomy/procedure_multimedia/index & locator/index; IS-24 at experiences/patients, experiences/surgeons, education/index & locator/index. A significant number of the users of each of these websites are recently diagnosed individuals. Simmonds Tr. at 108:15-109:24.

In December 2008, Opposer launched the Internet website www.davincistories.com. This website contains patient testimonials regarding their experiences with surgeries performed using Opposer's Systems. The website allows patients to review the testimonials of other patients and to add their own testimonials to the website. Simmonds Tr. at 107:1-25; IS-25. As such, this website is directed to potential patients, their friends and families, and those interested in "daVinci" surgery. Simmonds Tr. at 107:1-25.

Second, in addition to maintenance of its Internet websites, Opposer places print advertisements in regional and city newspapers and publications across the United States. These print advertisements are used both to promote among the public general awareness of its Systems and their use in particular procedures and to promote Opposer's activities at medical congresses to surgeons and referring physicians. Simmonds Tr. at 60:16-61:21.

Third, Opposer prepares and distributes videos to market its goods. Opposer produces clinical videos of procedures using its System, which it distributes on DVD to surgeons and non-surgeon physicians throughout the United States and which are available on Opposer's Internet websites as well as other Internet sites. Simmonds Tr. at 86:23-87:18, 88:3-89:2. Opposer also

produces patient and surgeon testimonial videos, intended for patients and their loved ones, which are available on Opposer's Internet websites and are provided to physicians and patient advocacy groups for distribution. Similarly, Opposer produces a DVD specifically directed to patients facing prostate cancer. Simmonds Tr. at 87:19-25, 89:9-25.

Finally, Opposer's Systems also have been promoted both to physicians and the general public via print articles and television and radio coverage. Simmonds Tr. at 69:4-70:7. A number of articles regarding Opposer's goods offered under its Marks have appeared in clinical publications and scientific journals. *Id.* at 69:9-23; 70:14-71:23; IS-18. In addition, articles and features about Opposer's Computerized Surgical Systems regularly appear in the general or popular press. In fact, in 2008, over 1,200 print articles, television spots and radio features on Opposer's goods offered under its Marks appeared in the general press in the United States. *Id.* at 69:24-70:13. This coverage included a special feature by Sanjay Gupta on CNN about prostatectomies performed using Opposer's Systems, a feature on the nationally syndicated health television program "The Doctors", and articles in *Time* and *Newsweek*. *Id.* at 70:8-11, 72:25-74:14, 75:3-76:6, 76:22-77:19, 78:15-79:1; IS-18; IS-19.

d. Post-Sale Marketing Assistance to Hospitals

Opposer's Clinical Sales Group works with its hospitals customers to promote the Systems and their use to referring physicians and patients. Annen Tr. at 27:9-28:6, 29:20-30:2. Opposer prepares and provides to hospitals marketing tool kits that include video for use in television commercials, sample press releases, and templates for invitations to patient seminars, invitations to referring physician seminars, presentations, brochures, billboards, newspaper and other print advertisements, radio advertisements and television commercials. Simmonds Tr. at 17:1-19; Annen Tr. at 35:22-36:14, 36:19-37:15. The resultant radio and television advertisements are run on local radio and television stations throughout the United States.

Simmonds Tr. at 61:22-62:12. Billboards based on the templates provided by Opposer are used by hospitals throughout the country to promote to local communities the Computerized Surgical Systems offered under Opposer's Marks and installed at the advertising hospitals. Simmonds Tr. at 63:5-64:1.

e. Promotional Assistance to Surgeons

Opposer's Clinical Sales Group also works directly with "Da Vinci" surgeons to promote the use of the System to referring physicians and patients in the community. Annen Tr. at 28:24-29:10, 29:20-30:20. Opposer's sales representatives provide to physicians to place on their waiting room walls posters created by Opposer that address patients and promote the use of Opposer's goods. Simmonds Tr. at 64:9-66:8, 67:14-20, 69:2-3; IS-17. For example, Opposer's poster pertaining to prostatectomies states, in part:

> If surgery is required to treat your prostate cancer, you may be a candidate for a new, less invasive approach to radical prostatectomy called the da Vinci prostatectomy. . . . Ask your doctor if you're a candidate for da Vinci prostatectomy.

IS-17; Simmonds Tr. at 67:23-69:1. Opposer provides to physicians brochures that Opposer creates for patients regarding its Systems and their use. Simmonds Tr. at 81:4-16, 83:16-20, 84:9-85:1, 85:22-86:22. *See* IS-20. For example, one such brochure pertaining to the use of Opposer's goods in gastric bypass surgery states:

> If your physician recommends surgery to control your weight, you may be a candidate for a new, less invasive surgical procedure called the da Vinci gastric bypass. This procedure uses a state-of-the-art surgical system designed to help your surgeon see vital anatomical structures more clearly and to perform a more precise surgical procedure.

IS-20 at ISI000564; Simmonds Tr. at 82:3-16. *See also* Simmonds Tr. at 84:9-85:1, 85:21-86:12. Opposer also provides specific guidance to physicians regarding the use of the posters and other marketing tools. Simmonds Tr. at 66:13-67:19.

B. Applicant and its Mark

Applicant is a group of radiologists located in Palm Beach County, Florida and employed as an independent contractor by the physician's association Medical Specialists of the Palm Beaches ("MSPB"). Boyle Tr. at 11:2-11; IS-13 at ¶¶ 4, 7; ISNR1-8 at Response No. 3 and Supplemental Response No. 3; ISNR1-10 at Response No. 1. In 2002, a member of Applicant "developed the concept of a high-end imaging center that emphasized state-of-the-art imaging in an elegant setting" and sought a trade name that "had public recognition, connoted a high level of sophistication and intelligence, and would be memorable for its dissonance in the context of a medical imaging center." ISNR1-8 at Response No.2. In late 2002, Applicant ultimately chose the term "DaVinci" because it had "renaissance implications" and is a "high-end name." *Id.*; Boyle Tr. at 87:4-88:7. In November 2003, using the U.S. Patent & Trademark Office's Trademark Electronic Search System ("TESS"), Applicant's counsel performed a search for the terms "DaVinci" and "Da Vinci[.]" ISNR1-8 at Supplemental Response Nos. 8 & 15. As a result, Applicant learned at that time of Opposer's registration of DA VINCI and application for DA VINCI S HD SURGICAL SYSTEM (Stylized). *Id.*

Nonetheless, on August 1, 2005, Applicant exclusively licensed Applicant's Mark to MSPB, which immediately opened the "DaVinci Diagnostic Imaging Center" (the "Center") in Palm Beach County, Florida[10] and MSPB began to use the mark DAVINCI DIAGNOSTIC IMAGING & Design in association with diagnostic imaging services. IS-13 at ¶ 9; ISNR1-8 at Supplemental Response Nos. 3 & 6; Boyle Tr. at 11:2-11, 90:10-23. At that time, Applicant began work at the Center as the radiologists for MSPB, offering imaging services under Applicant's Mark. Boyle Tr. at 90:10-23; IS-13 at ¶ 7. The Center and the building in which it is

[10] Applicant and the Center are located at 101 JFK Drive in Atlantis, Florida. ISNR1-8 at Supplemental Response No. 5.

housed are known as the "DaVinci Diagnostic Imaging Center" and are also referred to as the "DaVinci Imaging Center" and "DaVinci". Boyle Tr. at 92:13-23; IS-5; IS-6; IS-7; IS-10.

On October 7, 2005, Applicant filed with the U.S. Patent & Trademark Office U.S. Trademark Application Serial No. 78/728,786 (the "Application"). *See* DR-3 at pp. 17-19. The application is in the name of Applicant for registration of the mark DAVINCI DIAGNOSTIC IMAGING & Design, reproduced below:

See DR-3 at p. 22.

1. Applicant's Services

The Application covers "medical diagnostic imaging services" and includes Applicant's disclaimer of the term "DIAGNOSTIC" apart from the mark as shown. *Id.* The diagnostic imaging services offered under Applicant's Mark include magnetic resonance imaging ("MRI"), computed tomography ("CT") scans, positron emission tomography ("PET") scans, and digital mammography. ISNR1-8 at Supplemental Response No. 3; Boyle Tr. at 16:9-17:1. Each of these services is a type of medical imaging. *Id.*; ISNR1-9 at Response to No. 4. Specifically, MRI is a "medical imaging technology" that produces "highly refined images of the body's interior[.]" ISNR1-12 at p. 2309. "MRI is being used increasingly during operations . . . as well as for preoperative assessment and planning." *Id.* at p. 2310. A CT scan is "a combination of focused x-ray beams and computerized production of" three-dimensional images used "to image a wide variety of body structures and internal organs." ISNR1-13 at pp. 961-62; ISNR1-14 at 604. PET is a scanning method that uses radiolabeled compounds "to generate three-

dimensional cross-sectional images that represent the biological activity where the radiolabeled compound has accumulated." ISNR1-15 at pp. 2987-88. The resultant information is presented as "an image on a video screen." ISNR1-16 at p. 2205. "Digital mammography uses x-rays to create an image of the breast on a computer screen." ISNR1-17 at p. 81. Each of these diagnostic imaging services offered under Applicant's Mark are medical services offered within the health care field. Boyle Tr. at 94:23-95:9.

2. Applicant's Channels of Trade and Promotion of Services Under its Mark

The subject Application includes no limitation on channels of trade or provision of services under Applicant's Mark. DR-3. Applicant and MSPB have promoted and offered services under Applicant's Mark via Internet websites, brochures, visits to doctor's offices and business cards. Boyle Tr. at 15:6-23; ISNR1-8 at Supplemental Response Nos. 5 & 11.

First, Applicant promotes its services under the Mark via its Internet website www.davinci-imaging.com ("Applicant's Website"). Boyle Tr. at 77:8-78:10. *See* IS-12. Applicant's Mark appears on each page of Applicant's Website, which describes the services offered under the Mark. IS-12; Boyle Tr. at 76:10-14. Applicant's Website also uses the terms "DaVinci Diagnostic Imaging Center" and "DaVinci" in reference to the services offered under Applicant's Mark, the Center and MSPB's imaging business that offers the services. IS-12 at index & difference; Boyle Tr. at 76:22-77:7. Applicant has no plans to relinquish its davinci-imaging.com URL or Website, intends to continue to display Applicant's Mark on its Website and intends to continue to use its Website to promote services offered under the Mark. Boyle Tr. at 77:8-78:10.

MSPB also promotes services, including those offered under Applicant's Mark, via its own Internet website www.mspb.md (the "MSPB Website"). Boyle Tr. at 65:21-66:4. *See* Boyle Tr. 78:4-79:13. MSPB has in the past included on its Website references to the "DaVinci

Diagnostic Imaging Center" in association with the medical diagnostic imaging services offered under Applicant's Mark as well as a link to Applicant's Website. IS-9; Boyle Tr. at 68:3-12, 68:19-69:17. In response to this proceeding, MSPB removed the term "DaVinci" from its Website, which now uses the term "MSPB Diagnostic Imaging Center" but continues to include a link to Applicant's Website. IS-8; Boyle Tr. at 65:21-66:4; 66:19-69:17. MSPB is likely to continue to use the MSPB Website to promote services under Applicant's Mark. Boyle Tr. at 78:14-79:13; IS-13 at ¶ 10.

Second, MSPB has marketed and continues to market services under Applicant's Mark through the distribution of brochures. ISNR1-8 at Supplemental Response Nos. 5 & 11; Boyle Tr. at 41:23-42:3; IS-13 at ¶ 10. These brochures are intended to promote MSPB's high field MRI, 64-slice CT scanning, PET/CT Fusion and digital mammography. IS-5 at p. 1; IS-6 at p. 1; IS-7 at p. 1; IS-10 at p. 1; Boyle Tr. at 43:7-9, 50:1-6. Each brochure displays Applicant's Mark on both the front and back panels, includes the www.davinci-imaging.com URL and describes the particular medical diagnostic imaging technique that is the subject of the brochure. IS-5 at p. 1; IS-6 at p. 1; IS-7 at p. 1; IS-10 at p. 1; Boyle Tr. at 41:23-42:3, 45:19-46:6, 53:4-13, 57:20-58:4, 61:9-16. Each brochure also refers to "DaVinci's" services and uses the terms the "DaVinci Diagnostic Imaging Center" and "DaVinci Diagnostic Imaging" when referring to the Center and the entity offering services under Applicant's Mark. IS-5; IS-6; IS-7; IS-10. Each brochure also refers to "A Renaissance in Care". IS-5 at p. 2; IS-6 at p. 2; IS-7 at p. 2 IS-10 at p. 2; Boyle Tr. at 59:11-16, 60:6-12, 61:17-20. Although MSPB stopped publication of these particular brochures as a response to this Proceeding, the brochures are still available at the offices of MSPB physicians, are still available to patients, and may still be available at the Center. Boyle Tr. at 43:14-44:22, 49:5-14, 57: 1-3, 60:24-61:4, 85:9-19. According to Applicant, these brochures were intended to promote services under Applicant's Mark to patients and MSPB

physicians locally. Boyle Tr. at 50:1-19. However, up to 15 percent of the physicians to whom services under Applicant's Mark are offered may be outside the MSPB physician's group and may include surgeons. In fact, services under Applicant's Mark have been provided to physicians outside the MSPB group and outside Florida in the past. *Id.* at 51:3-23.

Third, Applicant's members give out business cards both to patients and to physicians, including surgeons, who want to order medical diagnostic imaging services for their patients. Boyle Tr. at 27:9-28:2, 28:7-12.; ISNR1-8 at Supplemental Response Nos. 5 & 11. Such business cards may also be given out by Applicant's members at conferences or meetings of physicians' groups. *Id.* at 25:23-26:21. In the past, Applicant's members have used business cards that displayed Applicant's Mark. *Id.* at 14:13-21, 21:18-21; IS-1; IS-2. In response to this Proceeding, Applicant's members were issued new business cards that do not display Applicant's Mark. *Id.* at 18:10-19:8, 23:18-22. Applicant's representative testified that he does not know whether the business cards displaying Applicant's Mark remain in use by any of Applicant's members. *Id.* at 25:11-22.

Finally, in the past, members of Applicant have visited both the offices of MSPB physicians and physicians outside the MSPB group to answer questions about the diagnostic imaging services offered under Applicant's Mark. Such visits to doctor's offices are likely to continue in the future. Boyle Tr. at 79:14-80:22, 83:11-20; IS-13 at ¶ 10.

3. Applicant's Consumers

Consumers of services offered under Applicant's Mark include both medical patients and their physicians, including surgeons. ISNR1-8 at Response No. 16. Services offered under Applicant's Mark are obtained either when patients contact the Center directly and themselves request certain diagnostic imaging services or when a physician refers a patient for such services. Boyle Tr. at 32:15-33:4, 33:7-10. Often physicians, including surgeons, expressly refer patients

to the Center for diagnostic imaging services. *Id.* at 33:22-34:5. Reports interpreting the resultant images are provided to the referring physician and the patient. *Id.* at 34:6-12. The images generated during the imaging process also may be provided to the referring physicians, including surgeons, who use these images to evaluate their patients' conditions. *Id.* at 35:4-14; 35:19-36:7. In fact, MSPB brochures promoting its services under Applicant's Mark target patients but indicate the services are provided to physicians as well, including surgeons. For example, the brochure pertaining to high field MRI states:

> The Benefits of DaVinci's High Field MRI: . . . give[s] physicians more complete information [and] . . . allows doctors to make more precise diagnoses. . . . Through the Avanto's advanced imaging tools, physicians are able to get better medical information on their patients and provide more accurate diagnoses.

IS-5 a p. 1; Boyle Tr. at 46:23-48:7. The brochure for PET/CT fusion states:

> The Benefits of DaVinci's PET/CT Fusion: . . . [a]ids doctors in determining the proper course of treatment [and] . . . helps guide surgeons to the exact location of the cancer. . . . PET/CT images can be used to guide a surgeon to the exact location of a malignancy and help the oncologist better localize treatment and follow response.

IS-7 at p. 1; Boyle Tr. at 58:23-59:16, 60:6-12.

Applicant's Website also is directed toward patients. Boyle Tr. at 86:1-15; IS-13 at ¶ 8; ISNR1-8 at Supplemental Response Nos. 5, 11 & 13. However, the language of the MSPB Website, which describes and provides a link to Applicant's Website, indicates both patients and physicians use the services offered under Applicant's Mark. *See* IS-8; IS-9; IS-11. Specifically, in referring to the Center, MSPB states on its Website: "[t]he Medical Specialists of the Palm Beaches operates two state-of-the-art Diagnostics centers that provide <u>you</u> and <u>your physician</u> with one comprehensive source for diagnostics, medical testing and laboratory procedures." IS-8 (emphasis added); IS-9 (emphasis added).

V. ARGUMENT

Registration of Applicant's Mark will damage Opposer by causing, in a niche currently inhabited only by Opposer, consumer confusion, deception or mistake as to the source, sponsorship or affiliation between Applicant's services offered under its Mark and Opposer's goods offered under its "DA VINCI" Marks. To avoid the complete erosion of Opposer's longstanding trademark rights in the DA VINCI marks, registration of Applicant's Mark should be refused.

Section 2(d) of the Lanham Act states:

> No trademark by which the goods of an applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it –
>
> (d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive . . . .

15 U.S.C. § 1052(d). While no litmus test exists for determining whether likelihood of confusion exists, the Board looks to several factors. *See In re E.I. DuPont deNemours & Co.*, 177 U.S.P.Q.2d 563, 567 (CCPA 1973) (enumerating thirteen factors). Several of these factors are salient here: (1) the similarity of the marks; (2) the similarity or relatedness of the goods and services offered under the parties' respective marks; (3) the channels through which the parties' respective goods or services are marketed; (4) the consumers of the parties' respective goods and services; and (5) the intent or knowledge of the junior user when it adopted its mark. *Id.* These factors are given varying weight depending upon the facts of record, and any one factor may control in a particular case. *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 1315, 65 U.S.P.Q.2d 1201, 1204 (Fed. Cir. 2003).

A. Opposer has Protected Rights in the DA VINCI Marks

Opposer's standing and priority of rights in its Marks are not at issue here. *See Barbara's Bakery Inc. v. Landesman,* 82 U.S.P.Q.2d 1283, 1285-86 (TTAB 2007). Opposer has rights in DA VINCI by virtue of its registration and use of the Mark. Registration of a trademark on the Principal Register is *prima facie* evidence of the validity of the mark, the registrant's ownership of the mark and the registrant's exclusive right to use the mark in commerce. 15 U.S.C. § 1057(b); *Russell v. Caeser*, 62 U.S.P.Q 1125, 1127 (N.D. Cal. 2001). Registered marks "should be afforded the utmost protection." *Russell*, 62 U.S.P.Q. at 1127. DA VINCI has been registered in the name of Opposer since October 1, 2002 and has been in continuous use since at least late 1999. ISNR1-1 at p. 2; Annen Tr. at 23:3-16.

Opposer also has protectable rights in its unregistered marks DA VINCI S,[11] DA VINCI S HD SURGICAL SYSTEM and DA VINCI S HD SURGICAL SYSTEM (Stylized), among others. A party has protectable rights in an unregistered trademark if it has acquired ownership rights in the mark and the mark is inherently distinctive or has acquired secondary meaning. *Glow Industr., Inc. v. Lopez*, 252 F. Supp.2d 962, 976-77 (C.D. Cal. 2002). The DA VINCI S, DA VINCI S HD SURGICAL SYSTEM and DA VINCI S HD SURGICAL SYSTEM (Stylized) marks have been in continuous use in interstate commerce since at least January 2006, January 2007 and January 2007, respectively, and Opposer filed applications for registration of these marks on February 2, 2007, September 3, 2008 and September 8, 2006, respectively. ISNR1-2 at

[11] DA VINCI S registered in the name of Opposer after Opposer's Testimony Period in this Proceeding closed. Since Opposer's application for registration of DA VINCI S, but not its registration, is of record, Opposer refers to and treats it herein as a pending application.

p. 2; ISNR1-3 at pp. 2-3; ISNR1-4 at p.3. As described below, the "Da Vinci" term is arbitrary[12] and therefore inherently distinctive as used with Computerized Surgical Systems.

MSPB began using Applicant's Mark for diagnostic imaging services on or about August 1, 2005 and Applicant filed the subject Application on October 7, 2005. Both Applicant's use and filing date post-date those of Opposer's mark DA VINCI. DR3 at p.17; ISNR1-1 at p. 2; ISNR1-9 at Response No. 5. Accordingly, Opposer has priority rights in its Marks.

B. <u>The Parties' Marks are Confusingly Similar</u>

In evaluating the likelihood of confusion, one must first look to the marks themselves for similarities in appearance, sound and meaning. *Al-Site Corp. v. VSI Int'l Inc.*, 50 U.S.P.Q.2d 1161, 1175 (Fed. Cir. 1991) (citing *E. Remy Martin & Co. S.A. v. Shaw-Ross Int'l Imports, Inc.*, 756 F.2d 1525, 1531 (11th Cir. 1985)); *In re E.I. DuPont deNemours & Co.,* 177 U.S.P.Q. at 1563; *In re Paper Doll Promotions, Inc.*, 54 U.S.P.Q.2d 1660, 1667 (TTAB 2007). Although no single factor predominates from case to case, similarity of the marks is a key factor and alone may suffice to defeat a potential registration. *See In re Lamson Oil Co.,* 6 U.S.P.Q.2d 1041, 1042 n.4 (TTAB 1987); *Interlego AG v. Abrams/Gentile Entm't, Inc.*, 63 U.S.P.Q.2d 1862, 1863 (TTAB 2002). Similarities of marks are weighed more heavily than differences. *GoTo.com, Inc. v. Walt Disney Co.*, 53 U.S.P.Q.2d 1652, 1656 (9th Cir. 2000).

In determining the similarities of trademarks, the marks must be compared in their entireties. *MarCon, Ltd. v. Avon Products, Inc.*, 4 U.S.P.Q.2d 1474, 1476 (TTAB 1987). However, the law is clear that the Board should give the greatest weight to the dominant features of the parties' marks. *Plantronics Inc. v. Starcom Inc.*, 213 U.S.P.Q. 699, 702 (TTAB 1982) ("similarity of dominant features must be accorded great weight"). *See also Hewlett Packard*

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[12] An arbitrary mark is a known word or term used in an unexpected or uncommon way. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772,* 73 U.S.P.Q.2d 1689, 1692 (Fed. Cir. 2005) (citing *Nautilus* continued

Co. v. Packard Press, Inc., 62 U.S.P.Q.2d 1001, 1003 (Fed. Cir. 2002) (citing *In re National Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985) (the Patent & Trademark Office may give less weight to a descriptive or generic portion of a mark) and *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570 (Fed. Cir. 1983) (it is permissible for the Patent & Trademark Office to give greater force and effect to a dominant feature of the marks)).

1. The Dominant Terms of the Parties' Respective Marks are Identical in Their Appearance, Sound and Meaning

The dominant portion of a composite mark is identified in a number of ways. First, descriptive terms are not deserving of trademark protection. Therefore, in a composite mark containing both descriptive and non-descriptive terms, the non-descriptive portion is considered dominant. *Hewlett Packard Co.*, 62 U.S.P.Q.2d at 1004 (the disclaimed term "technologies" is descriptive and, therefore, PACKARD is the dominant and distinguishing element of the applicant's mark PACKARD TECHNOLOGIES); *In re Dixie Restaurant, Inc.*, 49 U.S.P.Q.2d 1531, 1533-34 (Fed. Cir. 1997) (DELTA is the dominant portion of the mark THE DELTA CAFÉ where "café" is descriptive of the applicant's restaurant services). Second, the first part of a composite mark is the most likely to be impressed upon the mind of the consumer and is most often dominant. *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 U.S.P.Q.2d 1895, 1897 (TTAB 1988) (the term KID is dominant in the marks KIDWIPES and KID STUFF). Third, a portion of a composite mark that consumers are more likely to remember and use as indicating the source of the goods or services or by which the services are generally referred in the industry is considered the dominant portion of the mark. *Price Candy Co. v. Gold Medal Candy Corp.*, 105 U.S.P.Q. 256, 268 (CCPA 1955).

Group, Inc. v. Icon Health & Fitness, Inc., 372 F.3d 1330, 1340 (Fed. Cir. 2004)).

"DAVINCI" is the dominant and only non-descriptive term in Applicant's Mark. The term DAVINCI is arbitrary as used with medical diagnostic imaging services. "DaVinci" does not describe or even suggest a characteristic, function or component of such services. Conversely, "diagnostic" describes the function or purpose of the services offered under Applicant's Mark – that is, they are intended, at least in part, to diagnose illnesses, injuries and other medical ailments – and, as a result, has been disclaimed by Applicant. DR-3 at pp. 6 & 13. *See Hewlett Packard Co.,* 62 U.S.P.Q.2d at 1004. Similarly, the term "imaging" also is descriptive of Applicant's services. As indicated in the identification of goods in the Application, the services offered are "imaging services." DR-3 at p. 22. *See In re Gyulay*, 3 U.S.P.Q.2d 1009, 1009-10 (Fed. Cir. 1987); *In re MetPath, Inc.*, 223 U.S.P.Q. 88, 89 (TTAB 1984). Moreover, the specific services offered include MRIs, CT scans, PET scans and digital mammography. Each of these testing methods is considered an imaging technique and produces an image of body structures. Boyle Tr. at 16:9-17:1; ISNR1-9 at Response No. 4; ISNR1-12 at pp. 2309-10; ISNR1-13 at pp. 961-62; ISNR1-15 at pp. 2987-88; ISNR1-17 at p. 81. "Imaging" describes a quality of the services offered under Applicant's Mark.

DAVINCI also is the first term in Applicant's Mark. Consumers are therefore more likely to remember the DAVINCI term and to use it to refer to the services of Applicant's licensee. *Presto Products Inc.*, 9 U.S.P.Q.2d at 1897. Applicant's licensee refers in its promotional brochures to the Center at which services are offered under Applicant's Mark as "DaVinci", thereby encouraging consumers to associate the singular term "DaVinci" with Applicant's services. In fact, the Center and the building in which it is housed are known as the "DaVinci" Diagnostic Imaging Center. Boyle Tr. at 92:13-23. *See, e.g.,* IS-5. DA VINCI is therefore the dominant term in Applicant's Mark and the only term in the Mark capable of acting as a source identifier.

DA VINCI is the sole term comprising one of Opposer's Marks and is the dominant term in Opposer's Marks DA VINCI S, DA VINCI S HD SURGICAL SYSTEM and DA VINCI S HD SURGICAL SYSTEM (Stylized). The term is arbitrary as applied to Computerized Surgical Systems as it does not describe or suggest a function, component or purpose of those Systems and is the first term in each of these Marks. *See In re Gyulay*, 3 U.S.P.Q.2d at 1009-10; *In re MetPath, Inc.*, 223 U.S.P.Q. at 89. The terms "S" and "HD" in the marks are not likely to be remembered by consumers, and the terms "SURGICAL" and "SYSTEM" are descriptive of Opposer's Computerized Surgical Systems and cannot act as source identifiers. *See Presto Products, Inc.*, 9 U.S.P.Q.2d at 1897; *Hewlett Packard Co.*, 62 U.S.P.Q.2d at 1004. Therefore, DA VINCI also is the dominant term in each of Opposer's Marks.

The DAVINCI term in Applicant's Mark is identical in appearance, sound and meaning to the entirety of Opposer's Mark DA VINCI and to the dominant term in the remainder of Opposer's Marks. First, the number of letters and the order of the letters are identical in both terms. The presence of a space between "DA" and "VINCI" in Opposer's Marks and the lack of such a space in Applicant's Mark are unlikely to affect the similarity of these terms in the minds of consumers. Second, the terms each have three syllables and have the same pronunciation. Third, these terms are identical in meaning and connotation. "Da Vinci" is the commonly known surname of the famous 16th Century artist, scientist, innovator and Renaissance man Leonardo Da Vinci. Leonardo Da Vinci is well-known not just for his art but also for his inventions and scientific theories. He is commonly known to have made precise scientific observations and, among other things, for his studies of the skeleton, organs, blood circulation and action of the eye. He designed numerous machines, including the first robotics, and is known for his widely varying interests and talents. ISNR1-11 at pp. 199 & 200a; Annen Tr. at 15:10-16:6. The term "Da Vinci" therefore is arbitrary as applied to surgical systems and to medical diagnostic

imaging services. *See Palm Bay Imports, Inc.*, 73 U.S.P.Q.2d at 1692. Instead, the name "Da Vinci" connotes the classic Renaissance man and embodies artistry, scientific innovation, precision, intelligence, sophistication and versatility, particularly when used in association with goods or services in the medical field where patients and physicians seek the most advanced and sophisticated technologies available. In fact, Opposer adopted its DA VINCI marks in light of the accomplishments of the ultimate Renaissance man Leonardo Da Vinci and Applicant chose the term "DaVinci" in part to connote a high level of sophistication and because it has "[R]enaissance implications[.]" Boyle Tr. at 87:4-88:7; Annen Tr. at 15:10-16-6; ISNR1-11 at pp. 199 & 200a; ISNR1-8 at Response No. 2. MSPB has reinforced this connotation among consumers by its reference to "A Renaissance in Care" in its brochures. IS-5 at p. 2; IS-6 at p. 2; IS-7 at p. 2; IS-10 at p.2; Boyle Tr. at 59:11-16, 60:6-12. Accordingly, the dominant terms of Opposer's Marks and the dominant term of Applicant's Mark are identical in appearance, sound and meaning.

2. The Parties' Respective Marks in Their Entireties are Similar in Appearance, Sound and Meaning

The parties' respective marks also are similar when viewed in their entireties. The test for likelihood of confusion "is not whether the marks can be differentiated when subjected to a side-by-side comparison but, rather, whether they create the same general overall impression[.]" *Lisa Frank, Inc. v. Impact Int'l Inc.*, 799 F. Supp. 980, 998 (D. Az. 1992). Confusing similarity does not require that every word of a trademark be appropriated; it requires only that enough of a mark is used by a junior user to confuse the public. *Fleischmann Distilling Corp. v. Maier Brewing Co.*, 136 U.S.P.Q. 508 (9th Cir.), *cert. denied*, 374 U.S. 830 (1963). "The general rule is that a subsequent user may not avoid likelihood of confusion by appropriating another's entire mark and adding descriptive or non-distinctive matter to it." *Electropix v. Liberty Livewire*

Corp., 60 U.S.P.Q.2d 1346, 1351 (C.D. Cal. 2001) (quoting Thomas J. McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 23.50 (4th ed. 2005)).

In their entireties, the parties' respective marks differ in appearance and sound. That is, Opposer's Mark DA VINCI consists of two words with a total of three syllables, Opposer's Mark DA VINCI S consists of three terms and four syllables, and Opposer's Marks DA VINCI S HD SURGICAL SYSTEM and DA VINCI S HD SURGICAL SYSTEM (Stylized) each contain five terms and eleven syllables, with one presented in a stylized form. ISNR1-1; ISNR1-2; ISNR1-3; ISNR1-4. Applicant's Mark, on the other hand, consists of three words, with ten syllables and a design element. DR3. Nonetheless, the marks are similar in commercial impression.

The presence of the strongly distinctive term DA VINCI as the first or only word of the parties' marks renders them similar, especially in light of the descriptiveness of the other terms in Applicant's Mark and in three of Opposer's Marks. *See Palm Bay Imports, Inc.*, 73 U.S.P.Q.2d at 1692-93; *Hewlett Packard Co.*, 62 U.S.P.Q.2d at 1003-04 (PACKARD TECHNOLOGIES and HEWLETT PACKARD differ in sound and appearance but convey similar commercial impressions); *Century 21 Real Estate Corp. v. Sandlin*, 6 U.S.P.Q.2d 2034, 2036 (9th Cir. 1988) (the use of identical terms as the lead word in two marks could foster confusion among consumers). Further, although the design element of Applicant's Mark may be significant as to the appearance of the Mark, it does not affect the sound of the Mark or its meaning. Consumers are more likely to remember and use the term "DaVinci" alone to refer to services offered under the Mark. *In re Association of the United States Army,* 85 U.S.P.Q.2d 1264, 1261 (TTAB 2007) (UNITED STATES ARMY is the dominant feature regardless of design element because it is a well-recognized designation).

In *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, the Federal Circuit considered the similarity of the applicant's mark VEUVE ROYALE and the

opposer's marks VEUVE CLICQUOT PONSARDIN, VEUVE CLICQUOT and VEUVE CLICQUOT & Design, all used in association with champagne or sparkling wine. 73 U.S.P.Q.2d 1689 (Fed. Cir. 2005). The Court determined that the term VEUVE (meaning widow) was dominant in both parties' marks because VEUVE is arbitrary as applied to champagne and sparkling wine and is the first term in the marks, "Royale" in the applicant's mark is laudatory and less source identifying, and VEUVE is the term around which the opposer based its marketing efforts. *Id.* at 1692. The Court held that the presence in both parties' marks of the distinctive term VEUVE renders the parties' marks confusingly similar. *Id.*

As in *Palm Bay Imports, Inc.*, DA VINCI is arbitrary as applied to the parties' respective goods and services, is the first and dominant feature of Applicant's Mark, particularly in light of the descriptiveness of its other terms, and is the only or dominant term in all of Opposer's Marks. Further, MSPB's brochures, Applicant's Website and the MSPB Website refer to the Center and the services offered under Applicant's Mark as "DaVinci", reinforcing among consumers an association between the only real source identifier of Applicant's Mark – DAVINCI – and MSPB's services. Viewed in their entireties and based on the evidence of record, Applicant's Mark provides a similar commercial impression as and is confusingly similar to Opposer's Marks.

C. <u>The Goods and Services Offered Under the Parties' Respective Marks are Related</u>

Similarity of the goods covered by Opposer's registration and applications and the services covered by Applicant's Application is the second key factor in the *DuPont* likelihood of confusion analysis. *See Hewlett Packard Co.,* 62 U.S.P.Q.2d at 1004; *Interlego*, 63 U.S.P.Q.2d at 1863; *In re DuPont deNemours & Co.*, 177 U.S.P.Q. at 567; *In re Paper Doll Promotions Inc.*, 84 U.S.P.Q.2d at 1667. In considering the similarity of the goods and services:

> It is settled that it is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. That is, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. It is sufficient that the goods be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods.

Barbara's Bakery Inc., 82 U.S.P.Q.2d at 1286. A senior user can preclude junior use of the same or similar mark for any goods or services which might reasonably be assumed to emanate from the senior user in the normal expansion of its business under the mark. *Eikonix Corp. v. C.G.R. Medical Corp.*, 209 U.S.P.Q. 607, 613 (TTAB 1981). For such preclusion there need only be a relationship between the goods or services set forth in the application and registration or a relationship between their respective channels of distribution or classes of actual or potential consumers such that consumers will mistakenly assume the senior user has "bridged the gap" and is the source of the applicant's services. *Id.* "The trademark laws protect senior users' interest in being able to enter a related field at some future time." *Id.* (quoting *American Assn for the Advancement of Science v. The Hearst Corp.*, 206 U.S.P.Q. 605 (D.C. D.C. 1980)). *See also Kabushiki Kisha Hattori Seiko v. Satellite Int'l Ltd.*, 29 U.S.P.Q.2d 1317, 1319 (TTAB 1991) (while watches and shoes are non-competing goods, they are "not so remote as to foreclose the possibility that they come from the same source").

In *Eikonix Corp.*, the petitioner in a Cancellation Proceeding held a prior registration of the mark EIKONIX for products and services related to optics and photography. 209 U.S.P.Q. at 608. The respondent held a junior registration for ICONEX for a medical x-ray television camera and related control unit. *Id.* The Board determined that a relationship existed between the technique and equipment used by the petitioner to study and evaluate photographic images,

on the one hand, and the equipment necessary to perform the same function for images obtained by x-ray equipment, on the other hand. *Id.* at 614. The Board noted that "[i]t would be a natural expansion of petitioner's activities in designing and manufacturing equipment for recording, analyzing, and measuring images to move into the field of x-ray imagery." *Id.*

In this case, the evidence of record shows that Opposer's goods are Computerized Surgical Systems used in a wide variety of medical disciplines including but not limited to cardiology, urology, thoracics, general surgery, gynecology and pediatrics. The surgeon console component of the System bears Opposer's Mark and includes a display screen through which the surgeon user of the System views the visual or surgical field. The lower portion of the display screen contains two windows to which outside imaging video, data and images are fed allowing the surgeon to view these outside images while at the same time viewing the surgical field on the body of the patient. The camera, lighting, optics and computer processing capabilities of the System allow for this "picture in picture" type of viewing. The outside images fed into the System often are preoperative MRI or CT scan data, video or images of the patient and often are marked with the name and/or logo of the diagnostic imaging service that produced the images. Further, Opposer is in the process of developing a feature on its Systems whereby the outside image fed into the System can be manipulated by the surgeon or by the System itself to orient the MRI or CT image to coincide with the orientation of the area on the live patient's body being viewed on the display screen. Annen Tr. at 1:3-13, 14:2-19, 25:4-26:6; Simmonds Tr. at 12:19-14:9; Scott Tr. at 8:14-9:2, 10:6-23, 13:14-14:3, 16:9-17:14, 19:10-20:12, 20:20-25, 22:14-21, 24:3-25:16; DR-6 at Response to Nos. 3 & 4.

The evidence in this Proceeding also shows that the diagnostic imaging services offered under Applicant's Mark produce images of portions of the human body and utilize computerization to do so. For example, a CT scan is a radiographic technique that uses a

computer to assimilate multiple x-ray images into a three-dimensional image of body structures and organs. INSR1-12 at pp. 2309-10; INSR1-13 at pp. 961-62; ISNR1-14 at p. 604; ISNR1-15 at pp. 2987-88; ISNR1-16 at p. 2205; ISNR1-17 at p. 81. As acknowledged by Applicant at trial, the resultant reports and images produced as part of the diagnostic imaging services offered under Applicant's Mark are used by referring physicians, including surgeons. Boyle Tr. at 27:9-28:12, 32:15-33:10.

Given this evidence, it is easy to imagine the real-life situation encountered in the marketplace by end-users of both parties' goods and services. That is, a surgeon sitting at the surgeon console of a System embossed with Opposer's Mark and looking into the display screen on the surgeon console would see in the lower portion of the screen MRI or CT images also marked with the term "daVinci". The surgeon and operating room staff would encounter both "DA VINCIs" virtually side-by-side and being used in the same surgery – certainly resulting in a likelihood of confusion as to source. Moreover, Opposer's current development of a feature that will allow the surgeon or the System itself to manipulate the outside image data fed into the System – an area of reasonable expansion by Opposer – can only further exacerbate the likelihood of confusion.[13] *See Eikonix Corp.*, 209 U.S.P.Q. at 613.

As in *Eikonix Corp.*, the technology used in Opposer's goods and that is necessary to render Applicant's services are related. Both use computer, imaging and display technologies and both are used in the medical field by surgeons and other physicians. Even more important, the parties' goods and services are used side-by-side in the same operating rooms by the same

[13] Although Opposer's DA VINCI Mark was not cited against the subject Application, Applicant's Mark was cited against Opposer's applications for registration of DA VINCI S HD SURGICAL SYSTEM, DA VINCI S HD SURGICAL SYSTEM (Stylized) and DA VINCI Si HD SURGICAL SYSTEM (Stylized) on the basis of the information appearing on the face of the applications – that is, the appearance and connotation of the respective marks and the relatedness of the respective goods and services – supporting the existence of a likelihood of confusion in this case. *See* ISNR1-3 at pp. 12-13; ISNR1-4 at p. 12; ISNR1-6 at pp. 8-9.

surgeons and operating room staff, and the results of the services offered under Applicant's Mark are actually fed into and viewed in Opposer's goods. This relatedness of the parties' respective goods and services make confusion as to source likely.

D. The Marketing Channels and Consumers of the Goods and Services Offered Under the Parties' Respective Marks Overlap

The marketing and promotion of goods or services under the parties' respective marks and the classes of consumers of such goods and services are factors in the likelihood of confusion analysis. *E.I. DuPont deNemours & Co.*, 177 U.S.P.Q. at 567. Absent restrictions in a party's application or registration, the party's goods or services are presumed to be marketed in all customary trade channels to all customary classes of consumers. *Hewlett Packard Co.,* 62 U.S.P.Q.2d at 1005 (citing *CBS, Inc. v. Morrow*, 708 F.2d 1579, 1581 (Fed. Cir. 1983)); *Barbara's Bakery Inc.*, 82 U.S.P.Q.2d at 1287; *Eikonix Corp.*, 209 U.S.P.Q. at 613-14.

1. Marketing Channels for the Parties' Respective Goods and Services Overlap

The marketing channels used by the parties to promote goods and services under their respective marks overlap. Neither Opposer's registration and applications nor Applicant's Application at issue here contain restrictions on the trade or marketing channels that the parties' may use. *See* ISNR1-1; ISNR1-2; ISNR1-3; ISNR1-4; DR-3.

Surgical systems such as those offered under Opposer's Marks may be marketed in a variety of ways, including via marketing to hospitals and surgeons, trade shows and medical society meetings, community events, the Internet, brochures, videos and DVDs, print advertisements, marketing through "da Vinci" hospitals, marketing assistance to "da Vinci" surgeons and media coverage. In fact, the evidence of record shows that Opposer markets its goods under Opposer's Marks in each of these ways. *See* Sections IV.A.2.a-IV.A.2.e above.

Opposer's sales representatives make sales calls on hospitals and surgeons to persuade them to purchase Opposer's Systems. Annen Tr. at 26:25-28:6. Opposer also attends regional meetings of medical associations and larger medical society congresses, at which Opposer makes presentations and distributes materials, including brochures and DVDs regarding its Systems and their uses. Opposer sends mobile Systems in trucks adorned with Opposer's Marks to community events at hospitals, malls, sports centers, retirement communities and the like throughout the United States to familiarize the public with Opposer's Systems. At these "mobile events", Opposer distributes brochures to attendees and generally mans a booth adorned with Opposer's Marks. Opposer also maintains at least five Internet websites that promote Opposer's Systems offered under its Marks. Opposer distributes throughout the United States clinical videos of procedures and procedural techniques using its Systems, videos of patient and surgeon testimonials, and at least one DVD intended specifically for patients with prostate cancer. Opposer places print advertisements in local newspapers to promote its Systems to the public and its activities at trade shows. Through its hospital tool kits, which contain video for use in television commercials and templates for invitations to patient seminars, invitations to referring physician seminars, brochures, billboards, print advertisements and radio and television commercials, Opposer promotes its Systems by assisting "da Vinci" hospitals in their own marketing. Finally, Opposer provides marketing assistance and promotional materials, including brochures and posters, to "da Vinci" surgeons to assist them in expanding their network of referring physicians and patients. *See* Sections IV.A.2.a-IV.A.2.e above.

Medical diagnostic imaging services such as those offered under Applicant's Mark also may be marketed in a variety of ways, including direct calls on physicians, print advertising, attendance at medical society meetings, distribution of promotional materials such as brochures, business cards, videos and CDs, radio and television commercials, and the Internet. In this case,

the evidence indicates that Applicant and MSPB have marketed and continue to market services under Applicant's Mark via visits to physicians' offices, the distribution of brochures, attendance at medical association meetings, and two Internet websites. *See* Section IV.B.2 above.

At least one of Applicant's members has visited both MSPB physicians and physicians outside the MSPB group to promote the services offered under Applicant's Mark. Boyle Tr. at 79:14-80:22, 83:11-20; IS-13 at ¶ 10. Services under Applicant's Mark also are marketed through the distribution of brochures that display the Mark, describe the services offered thereunder, and refer to "daVinci's" services.[14] Applicant's members have business cards displaying Applicant's Mark and have given those business cards out at medical association meetings and to patients and referring physicians.[15] Applicant's Website describes and promotes the services offered under its Mark, which appears on every page of the Website. The MSPB Website also promotes the services offered under Applicant's Mark and at the Center, in the past referred to the Center using the term "daVinci", and continues to have a link to Applicant's Website. *See* Section IV.B.2 above.

The marketing channels commonly and customarily used for goods and services such as those offered under the parties' respective marks overlap. Where, as here, neither Opposer's registration or applications nor Applicant's Application restrict the marketing of the parties' respective goods and services, the parties may both use print advertisements, radio and television commercials, the Internet, direct sales visits to consumers, attendance at medical society

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[14] MSPB's brochures of record at IS-5, IS-6, IS-7 and IS-10 are no longer published by MSPB but remain available at physicians' offices, to patients and at the Center. Boyle Tr. at 43:14-44:22, 49:5-14, 57:1-3, 60:24-61:4, 85:9-19. MSPB ceased publication of these brochures in light of this Proceeding, suggesting its awareness of the likelihood of confusion in this case. *See id.*

[15] As a result of the initiation of this Proceeding, MSPB issued to Applicant's members new business cards that do not display Applicant's Mark. Applicant's representative however, testified that he does not know whether the "old" cards bearing Applicant's Mark are still in use by some of Applicant's members. Boyle Tr. at 18:10-19:8, 23:18-22, 25:11-22 . In any event, this issuance of new cards by MSPB suggests its awareness of the likelihood of confusion in this case.

meetings, and videos to promote their respective goods and services. *See Barbara's Bakery Inc.*, 82 U.S.P.Q.2d at 1207. Here, the marketing channels actually used by the parties' overlap as well. Both Opposer's sales representatives and Applicant's members visit physicians to promote and sell their respective goods and services. Both parties also attend meetings of medical associations and societies, at which Opposer's representatives man booths, showcase Opposer's goods and distribute brochures, videos and other materials and at which Applicant's members distribute business cards. Both Opposer and Applicant use brochures as part of their marketing efforts. Opposer prepares and distributes brochures promoting its Systems and their uses directly, through hospitals and through physicians. MSPB has prepared and distributes brochures promoting its services directly, through physicians and at the Center. Finally, both parties maintain Internet websites. The Internet has been recognized as particularly susceptible to a likelihood of confusion because it allows marks to be encountered simultaneously on the same screen. *GoTo.com, Inc.*, 53 U.S.P.Q.2d at 1657. *See also Brookfield Communication, Inc. v. West Coast Entertainment Corp.*, 50 U.S.P.Q.2d 1545, 1559-61 (9th Cir. 1999). Both the Internet websites of Opposer and Applicant prominently display the parties' respective marks and both describe and illustrate the parties' respective goods and services. The MSPB Website also promotes the services offered at the Center and includes a link to Applicant's Website. *See* Sections IV.A.2.a-IV.A.2.e and IV.B.2 above. Accordingly, the marketing channels through which the parties' goods and services under their respective marks are promoted overlap.

2. The Consumers of the Parties' Goods and Services Overlap

The consumers of Opposer's Systems and of the services offered under Applicant's Mark also overlap. Consumers of a parties' goods or services include not only purchasers of those goods or services but also non-purchasing end-users and the general public. *General Motors Corp. v. Keystone Automotive Industr. Inc.*, 79 U.S.P.Q.2d 1456, 1459-60 (6th Cir. 2006)

(confusion among the general public is likelihood of confusion under the Lanham Act); *Karl Storz Endoscopy- America v. Surgical Technologies Inc.*, 62 U.S.P.Q.2d 1273, 1276 (9th Cir. 2002) (confusion on the part of non-purchasing users, such as surgeons working at hospitals that own a product, can establish likelihood of confusion).

Neither Opposer's registration and applications nor the subject Application contains a restriction pertaining to the consumers of the parties' respective goods and services. Consumers of the parties' respective goods and services are therefore assumed to include all customary consumers. *See* ISNR1-1 through ISNR1-4; DR-3. Customary consumers of surgical systems are hospitals, surgeons and patients. Customary consumers of medical diagnostic imaging services are physicians, including both surgeons and non-surgeons, and patients. The customary consumers of the parties' goods and services overlap.

Moreover, the evidence in this case shows that consumers of Opposer's Computerized Surgical Systems in fact are hospitals, surgeons, referring physicians and patients and that consumers of services offered under Applicant's Mark are in fact surgeons, non-surgeon physicians and patients. *See* Sections IV.A.2.a-IV.A.2.e and IV.B.3 above. Opposer's Systems are sold to hospitals but are used by surgeons and operating room staff. Annen Tr. at 30:21-31:9. Further, Opposer markets its Systems and their use directly to hospitals, surgeons and patients through sales calls, trade shows and medical congresses, videos, brochures, print advertisements and its Internet websites. *See* Sections IV.A.2.a-IV.A.2.c above. Opposer also promotes its Systems and their use to non-surgeon referring physicians and patients through its hospital tool kits, and the marketing templates and materials therein, and through the marketing material and assistance it provides to "da Vinci" surgeons. *See* Sections IV.A.2.d & IV.A.2.e above. The evidence also shows that both surgeons and non-surgeon physicians as well as patients order and receive the results of the medical diagnostic services offered under Applicant's Mark. Boyle Tr.

at 23:15-33:10, 33:22-34:12, 35:5-36:7. Further, the reports and images generated by those services are used by surgeons and other physicians preoperatively, in the diagnosis of disease and illness, and during surgical procedures. *Id.* Both the parties' consumers include surgeons, non-surgeon physicians and patients. Therefore, their respective consumers overlap, exacerbating a likelihood of confusion.

Opposer anticipates that Applicant will assert its Mark is used only in Palm Beach County, Florida and/or is marketed only to MSPB physicians,[16] suggesting the parties marketing channels do not overlap. Any such assertion simply would be factually incorrect as shown by the evidence of record. First, if use of Applicant's Mark were limited to Palm Beach County, Florida – or all of Florida, for that matter – Applicant would have no basis upon which to obtain federal registration of its Mark, which requires that the Mark be used in interstate commerce. Trademark Manual of Examining Procedure § 901.03.

Second, the subject Application does not restrict use of Applicant's Mark to Palm Beach County. DR-3. For purposes of this Proceeding, Applicant's Mark is deemed used throughout the United States.

Third, in practice, use of Applicant's Mark is not limited to Palm Beach County, Florida. Applicant's Website displays Applicant's Mark in association with its medical diagnostic imaging services. *See* IS-12. Similarly, the MSPB Website describes the services offered under Applicant's Mark and includes a link to Applicant's Website. IS-8; IS-9; IS-11. Both of these Websites can be accessed by anyone anywhere in the United States and such Internet use is nationwide. Further, MSPB has offered and rendered services under Applicant's Mark to physicians outside the MSPB physician's group, outside Palm Beach County and outside Florida

[16] Applicant's representative testified that the MSPB physicians group currently includes no surgeons. Boyle Tr. at 50:1-6.

and to patients from outside Florida. Boyle Tr. at 51:1-52:8. *See Larry Harmon Pictures Corp. v. Williams Restaurant Corp.*, 18 U.S.P.Q.2d 1292, 1295 (Fed. Cir.), *cert. denied,* 502 U.S. 823 (1991) (mark used for services at single location where interstate travelers are served is "use in commerce" for purposes of the Lanham Act).

Finally, even in Florida, the parties' marketing channels and consumers overlap. Services provided under Applicant's Mark are provided at the Center located at 101 JFK Drive in Atlantis, Florida. One of Opposer's Systems is located at JFK Medical Center in Atlantis, Florida – right next to the Center – and another is located at West Boca Medical Center, both in Palm Beach County, Florida. IS-12 at index & contact; Annen Tr. at 44:21-45:6. MSPB promotes its services under Applicant's Mark directly to patients in Palm Beach County through brochures and the Internet and to referring physicians in Palm Beach County through brochures, office visits and business cards. *See* Section IV.B.2 above. Opposer also promotes its Systems to patients and referring physicians in Palm Beach County through its mobile events, videos, websites, brochures and media coverage as well as through its marketing materials and assistance provided to the two "Da Vinci" hospitals and the "Da Vinci" surgeons in Palm Beach County. Simmonds Tr. at 46:12-47:25; Annen Tr. at 44:21-45:26, 46:20-47:7. *See* Sections IV.A.2.a-IV.A.2.e above. The parties marketing channels and consumers overlap even in Palm Beach County, Florida.

E. <u>Applicant Adopted its Mark Despite Knowledge of Opposer's Marks and Prior Registration</u>

A junior user need not intend to confuse consumers for a likelihood of confusion to exist. *GoTo.com, Inc.*, 53 U.S.P.Q.2d at 1658. However, intent to deceive the public is presumed when a junior user knowingly adopts a mark similar to that of another. *Electropix*, 60 U.S.P.Q.2d at 1353.

Here, a member of Applicant sought a trade name for a "medical imaging center" and, in late 2002, chose the term "DaVinci". ISNR1-8 at Response No. 2; Boyle Tr. at 87:4-88:7. In November 2003, Applicant's counsel conducted a search of the records of the U.S. Patent & Trademark Office and, at that time, learned of Opposer's registration of DA VINCI and application for registration of DA VINCI S HD SURGICAL SYSTEM (Stylized). ISNR1-8 at Supplemental Response Nos. 8 & 15. Nonetheless, on August 1, 2005, Applicant exclusively licensed its Mark to MSPB, which immediately began using the Mark in association with medical diagnostic imaging services. IS-13 at ¶ 9; ISNR1-8 at Supplemental Response Nos. 3 & 6; Boyle Tr. at 11:2-11, 90:10-23. Thereafter, on October 7, 2005, Applicant filed the subject Application. DR-3 at pp. 17-18. Applicant undertook these actions with full knowledge of two of Opposer's Marks and Opposer's registration. "A party that knowingly adopts a mark similar to one used by another for the same or closely related goods or services does so at its peril and any doubt on the question of likelihood of confusion must be resolved against the junior user." *Gillette Canada Inc. v. Ranir Corp.*, 23 U.S.P.Q.2d 1768, 1774 (TTAB 1992). Applicant's prior knowledge of Opposer's Marks weighs in favor of Opposer here.

F. <u>Opposer's DA VINCI Marks Are The Only Marks Occupying Opposer's Medical/Surgical Niche</u>

Opposer anticipates that Applicant will rely on the alleged existence of third party registrations that incorporate the terms "DA VINCI" and/or "DAVINCI" to suggest Opposer's Marks are weak. Any such argument must fail. Preliminarily, evidence of third party registrations alone is not probative of the strength of a mark and, instead, evidence of third party <u>use</u> of similar marks for similar goods or services is required. *Palm Bay Imports, Inc.*, 73 U.S.P.Q.2d at 1693. Applicant has submitted <u>no</u> evidence of thirty party <u>use</u> of any similar marks for related goods or services. *See* DR-1 through DR-7, at DR-1, DR-2 & DR-5.

Given the connotations associated with the term "DA VINCI", it is not surprising that a plethora of DA VINCI marks are registered for a wide variety of goods and services. Applicant has made 93 U.S. Trademark registrations of record in this Proceeding, all of which include the terms "DAVINCI" or "DA VINCI". *See* DR-1; DR-2. Even assuming *arguendo* that the existence of registrations alone could be probative to the strength of the mark, which it is not, these registrations do not show the field here is crowded.

First, many of the registrations made of record are wholly dissimilar in appearance, sound and meaning from Opposer's Marks. *Id.* As one of many examples, the mark DAVINCI'S FLYING MEATBALL & Design is a depiction of a meatball with wings wearing an aviator's cap and aviator goggles suspended in a ring on which the stylized words "da Vinci's FLYING MEATBALL" appear. DR-2 at item 32. *See also* DR-1 at items 2, 6,7, 10, 11, 14, 17, 20-22 & 25; DR-2 at items 1, 4, 8, 13, 19-21, 23, 33, 34, 36, 39, 46, 48, 50-52, 55, 56 & 59.

Second, among the registrations offered by Applicant and upon which Opposer anticipates Applicant will rely are two of Opposer's Marks upon which Opposer relies in this Proceeding. *See* DR-2 at items 28 & 37. Opposer's own marks cannot crowd the field.

Third, none of the registrations made of record by Applicant cover goods or services within Opposer's medical/surgical niche. *See* DR-1; DR-2; DR-5. In fact, the vast majority of these registrations are for goods and services far afield from Opposer's Systems and do not even warrant discussion. For example, Applicant has offered the registrations of DA VINCI for machines used to produce semiconductors and microelectronic semiconductor products, for golf clubs and for wines and sparkling wines. *See* DR-2 at pp. 10, 21 & 30 thereof. *See also* DR-1 at items 1-29; DR-2 at items 1-27, 29-36 & 38-64.

Among the registrations offered is a registration of DA VINCI in the name of bioMerieux, B.V. for use with discrete photometric analyzers for clinical use. DR-2 at p. 27

thereof. Discrete photometric analyzers are "[l]aboratory [i]nstruments" that automatically perform various steps in the process of measuring a variety of analytes. DR-7. These goods, therefore, are used in laboratories. *Id.* They are not used in the medical/surgical field and are not within Opposer's niche. Further, Opposer opposed bioMerieux's application in part to prevent bioMerieux from expanding its use to encroach on Opposer's niche. Gong Tr. at 14:19-15:24, 17:12-24. As part of its resolution of that opposition proceeding, Opposer and bioMerieux entered into a coexistence agreement under which bioMerieux agreed to use the mark only for discrete photometric analyzers and, thus, would not enter Opposer's niche. *Id.* at 17:12-24, 18:10-19:17; IS-27 at p. 2, ¶ 1. The agreement between bioMerieux and Opposer remains in effect today. Gong Tr. at 19:15-17.

Applicant may also rely on certain DA VINCI registrations for use in association with ceramics for use in cosmetic dentistry, dental ceramics, manufacturing of custom dental porcelain veneers and dental laboratory services. DR-1 at item 20; DR-2 at items 4-7, 22-24, 34 & 55. The identification of goods and/or services covered by these registrations are expressly for use in the dental industry. *See id.* Dentists do not use Opposer's Systems and Opposer does not sell its Systems to dentists. Annen Tr. at 32:12-15, 58:1-10. The marks covered by these registrations, therefore, do not weaken Opposer's Marks.

Finally, Applicant has offered into evidence the file wrapper of the application for registration of DAVINCI FACELIFT for cosmetic and plastic surgery. DR-5. First, a pending application is not reliable evidence of use of a mark. *See Palm Bay Imports, Inc.,* 73 U.S.P.Q.2d at 1693. More important, cosmetic and plastic surgery services are not related in any manner to Opposer's Systems. Cosmetic and plastic surgery are elective procedures used to enhance one's appearance rather than medical and health related necessities. In fact, the United States Patent & Trademark Office concluded that the services covered by this application are cosmetic in nature

rather than medical by citing against it prior-filed DA VINCI applications for personal care products and cosmetics but not citing Applicant's Mark or any of Opposer's Marks. DR-5 at pp. 1-6.

The plethora of registrations in evidence for wholly unrelated goods and services and absence of registrations for related goods and services demonstrate that Opposer alone occupies the medical/surgical niche. Should Applicant nonetheless rely on those third party registrations in its trial brief, Opposer will address this matter in greater detail in its reply brief.

VI. CONCLUSION

For the foregoing reasons, Opposer Intuitive Surgical, Inc. respectfully requests that this Board protect the valuable rights of Opposer in its Marks by sustaining this opposition and precluding registration on the Principal Register of Applicant Mark DAVINCI DIAGNOSTIC IMAGING & Design.

Dated: August 7, 2009

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CERTIFICATE OF SERVICE

Intuitive Surgical Inc. v. DaVinci Radiology Associates, P.L.

Opposition No. 91175319

On August 7, 2009 I hereby certify that I served a copy of the following:

1. Opposer Intuitive Surgical, Inc.'s Main Trial Brief

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Executed on August 7, 2009, at San Francisco, California.

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