

ESTTA Tracking number: **ESTTA304843**

Filing date: **09/08/2009**

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

Proceeding	91175319
Party	Defendant DaVinci Radiology Associates, P.L.
Correspondence Address	Matthew Vanden Bosch DaVinci Radiology Associates, P.L. 301 Clematis Avenue , Suite 3000 West Palm Beach, FL 33401 UNITED STATES mvbosch@comcast.net
Submission	Brief on Merits for Defendant
Filer's Name	Matt Vanden Bosch
Filer's e-mail	mvbosch@comcast.net
Signature	/Matt Vanden Bosch/
Date	09/08/2009
Attachments	Trial Brief.pdf ( 35 pages )(11396098 bytes )

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

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APPLICANT DAVINCI RADIOLOGY ASSOCIATES, P.L.'S TRIAL BRIEF

Applicant Da Vinci Radiology Associates, P.L. ("Applicant") hereby presents its main trial brief in this Opposition Proceeding and requests the Trademark Trial and Appeal Board (the "Board") dismiss Intuitive Surgical, Inc.'s ("Opposer") opposition for the reasons set forth below.

**I. INTRODUCTION**

Opposer's word mark DA VINCI ("Opposer's Mark") differs from Applicant's mark and



design

("Applicant's Mark"), and

Applicant's Mark should be allowed registration on the Principal Register.

Second, the parties' goods and services are unrelated. Applicant's application is for medical diagnostic imaging *services*. Applicant has licensed Applicant's Mark to one licensee ("Applicant's Licensee", further identified below). Applicant's Licensee operates a free-standing imaging center, independent of any hospital. It offers medical patients a better way, outside of a hospital, of getting their MRI's, CT's, PET/CT's, and digital mammograms taken and interpreted by radiologists.

Opposer's sole registration at issue describes *goods*, namely, a very expensive, computerized surgical system made up of three large components and associated parts and instruments used to perform minimally-invasive surgery in a variety of surgical applications.

Third, the parties' purchasers do not overlap. Medical patients purchase the services of Applicant's Licensee. Applicant's Licensee only has non-surgeon physician working for it. These non-surgeons refer the vast majority of medical patients to Applicant's Licensee for its services. Physicians outside of Applicant's Licensee, including non-surgeons and surgeons, refer a small percentage of the medical patients.

Hospitals, through their administrators, purchase Opposer's goods. Sometimes, certain surgeons, or "Surgeon Champions" as Opposer calls them, help Opposer sell its goods to hospital administrators.

Fourth, even assuming, *arguendo*, that (i) hospital administrators and Surgeon Champions purchase diagnostic imaging from Applicant's Licensee for themselves and Surgeon Champions refer patients to Applicant's Licensee and (ii) make up more than a *de minimis* overlap of the parties' purchasers, hospital administrators and Surgeon Champions will not confuse the origins of the parties' goods and services. The conditions under which a hospital administrator and Surgeon Champion would approach the purchase of Opposer's expensive

surgical system differ completely from the conditions under which either would purchase diagnostic imaging from Applicant's Licensee or the Surgeon Champion would refer a patient to Applicant's Licensee. All these decisions require careful calculation and are not impulsive. Finally, hospital administrators and Surgeon Champions are sophisticated individuals who can tell health care providers and very expensive medical goods apart.

Fifth, there are 93 U.S. Trademark registrations with the text DA VINCI or DAVINCI in them. The parties inhabit a crowded field of marks containing the words DAVINCI or DA VINCI, and the rights associated with one of the marks in that field are weak and thus narrowly construed.

Sixth, there have been no actual cases of confusion and is no potential for confusion.

In summary, the parties' marks are not even close. Applicant's health care services are unrelated to Opposer's health care goods, and the parties do not share the same purchasers. Therefore, confusion as to source is unlikely.

## II. DESCRIPTION OF THE RECORD

Applicant identifies portions of the record herein the same way as Opposer does in its trial brief. Applicant stipulates to the Description of the Record as presented in Opposer's trial brief, except for the following:

**A. The June 3, 2009 Testimonial Deposition of Benjamin Gong, and Exhibit 27 thereto (referred to herein as IS-27) should be stricken from the record.**

To show a crowded field of DA VINCI/DAVINCI marks used on similar goods and services, the record includes U.S. Registration No. 2,870,790 for DA VINCI for "discrete photometric chemical analyzer for clinical use" in International Trademark Class No. 10. DR-2 at item 27. Opposer's goods are also classified in International Class No. 10. ISNR1-1 at page 2.

Opposer took Mr. Gong's deposition only to reveal its opposition to said U.S. Registration No. 2,870,790 and the settlement thereof in opposition proceeding number 91158726. Opposer took Mr. Gong's deposition over Applicant's objection. *See*, Applicant's Motion to Strike, filed May 15, 2009; Applicant's Brief in Opposition to Opposer's Motion for Extension of Time, filed May 19, 2009; Gong Tr. at 4:20-5:16.

The deposition is beyond the scope of Applicant's defense. It rebuts nothing of Applicant's defense. It is irrelevant to any issue in this matter. Why and how Opposer filed and settled its opposition proceeding is irrelevant to any issue in this matter, including what the Board would have decided had the matter proceeded to trial.

For the foregoing reasons, Applicant respectfully demands that Mr. Gong's deposition IS-27 be stricken and given no consideration.

**B. Opposer's First Notice of Reliance Exhibits 2-7 should be stricken from the record and given no consideration.**

Opposer's First Notice of Reliance attached copies of Opposer's applications as Exhibits 2-7, and identified as ISNRI-2 through ISNRI-7, respectively. These applications have no relevance in the analysis of likelihood of confusion between Opposer's registration for DA

VINCI and Applicant's application for . Applicant respectfully demands these applications be stricken and given no consideration.

**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 word mark DA VINCI 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. Applicant contends that confusion, mistake or deception would be unlikely and that Opposer will not be damaged if registration of DAVINCI DIAGNOSTIC IMAGING & Design is permitted. Applicant therefore requests that Opposition Proceeding No. 91175319 be dismissed.

#### IV. RECITATION OF FACTS

##### A. Applicant and its Mark

Applicant is a four-member group of radiologists, organized as a professional limited liability company under the laws of the State of Florida. IS-13 at ¶4. From 2003-2005, Medical Management of the Palm Beaches, LLC, a Florida limited liability company (“MMPB”), consisting at that time of the same members as Applicant, constructed a building (the “Building”) for Applicant’s diagnostic imaging business. IS-13 at ¶5.

However, instead of owning and operating the diagnostic imaging business itself, on August 1, 2005, MMPB leased the Building and subleased diagnostic imaging equipment to Applicant’s Licensee, Medical Specialists of the Palm Beaches, Inc., a Florida corporation, consisting of around 50+ *non-surgeon* physicians and operating exclusively within Palm Beach County, Florida. IS-13 at ¶6; ISRN1-8 at Supplemental Response No. 3; Boyle Tr. at 50:5-6.

Also on August 1, 2005, Applicant contracted with Applicant’s Licensee to provide diagnostic imaging services at the Building as an independent contractor. IS-13 at ¶7. Finally, on August 1, 2005, as part of the business arrangement with Applicant’s Licensee, Applicant exclusively licensed Applicant’s Mark to Applicant’s Licensee. ISRN1-8 at Supplemental Response No. 3

Applicant's Licensee opened the diagnostic imaging center on August 1, 2005 and began using Applicant's Mark to sell medical diagnostic imaging services. IS13 at ¶9; ISNR1-8 at Supplemental Response Nos. 3 and 6; Boyle Tr. at 90:10-23; ISNR1-9 at Admission No. 5. On that day, Applicant began working for Applicant's Licensee as radiologists, reading and interpreting the medical diagnostic images. Boyle Tr. at 90:10-23; IS13 at ¶7.

On October 7, 2005, Applicant filed with the U.S. Patent and Trademark Office U.S. Trademark Application Serial No. 78/728/786 (the "Application") under International Trademark Class 044, "(Medical, beauty & agricultural), Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services." *See*, DR-3. International Trademark Class 44 is a services classification.

### **1. Applicant's Services**

The Application covers "medical diagnostic imaging services." *Id.* Applicant's Licensee offers MRI, CT, PET/CT, and digital mammography. Boyle Tr. at 16:9-17:1; ISNR1-8 at Supplemental Response No. 3. However, there are other medical diagnostic imaging services such as x-rays. ISNR1-9 at Admission No. 4.

### **2. Applicant's Purchasers**

Only medical patients purchase medical diagnostic imaging services from Applicant's Licensee. ISNR1-9 at Admission No. 3; ISNR1-8 at Response 16. They can come to the Building on their own for certain procedures such as digital mammography, screening CT scans, and screening MRI scans. Boyle Tr. at 32:15-33:10.

Physicians refer medical patients to Applicant's Licensee to purchase medical diagnostic imaging services. *Id.* More than eighty-five percent (>85%) of these physician referrals are from the non-surgeon physicians of Applicant's Licensee. Boyle Tr. at 50:7-19 & 51:3-13.

Physicians outside of Applicant's Licensee, surgeons and non-surgeons, make up a small percentage of the referrals to Applicant's Licensee. *Id.* A physician's referral might influence a medical patient's decision to purchase Applicant's Licensee's services.

### **3. Applicant's Trade Channels**

The Application includes no limitation on channels of trade or provision of services under Applicant's Mark. *See*, DR-3. Applicant and Applicant's Licensee have



promoted and offered services under via internet websites, brochures, visits to doctor's offices and business cards. Boyle Tr. at I5:6-23; ISNR1-8 at Supplemental Response Nos. 5 & 11.

## **B. Opposer and Its Mark**

Opposer asserts ownership of U.S. Registration No. 2,628,871 (the "Registration") for the word mark DA VINCI. ISNR1-1 at p.2. Contrary to Opposer's assertion at page 7 of its brief, Opposer first used the word mark on July 7, 2000. *Id.* Mr. Annen's testimony did not establish use prior to July 7, 2000. Annen Tr. at 23:3-8. He stated that Opposer's first goods shipped in mid to late 1999. *Id.* Opposer uses the form "da Vinci" in promoting its mark. *See*, IS15-16 and IS19-20.

### **1. Opposer's Goods**

The Registration is for goods in International Trademark Class 10, "(Medical Apparatus), Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials." TMEP §1401.02(a). Trademark Class 10 is a goods classification. *Id.*

Opposer sells very expensive goods: A computerized surgical system made up of three large components and associated parts and instruments used to perform minimally-invasive surgery in a variety of surgical applications. ISNR1-1 at p.2. Opposer's system costs

Simmonds Tr. at 111:1-5.

It is noteworthy that Opposer's original application for the Registration also requested the following services marks:

“Education services, namely, conducting seminars, conferences, workshops, reference site training, and classes for physicians in the field of minimally invasive surgical procedures and in the use of minimally invasive surgical devices and distributing training manuals, white papers and journals in connection therewith in International Trademark Class 41.

Medical services, namely, conducting minimally invasive surgery in International Trademark Class 42.

DR-4. On September 18, 2001, Opposer divided its application for the Registration between the goods at issue here and the recited services portion. *Id.* On September 30, 2002, Opposer abandoned DA VINCI to the extent of the recited services. ISNR2-1

## **2. Opposer's Purchasers**

Only hospitals, through their administrators, purchase Opposer's expensive goods.

Annen Tr. at 58:1-10 (Q: Could you tell me what your understanding of what 'customer' is, Mr. Annen? A: My understanding of customer of the da Vinci system – the purchaser of the da Vinci system is a hospital. Q: Okay. And it's your testimony that only hospitals purchase – have purchased so far the da Vinci surgical systems; is that right? A: That is correct, to my knowledge.), 18:19-24, 26:24-27:8, 27:16-28:6, 30:21-25(Q: To whom are the da Vinci surgical systems sold? A: They are sold to hospitals...”), 32:16-18, 39:23-25 (Q: Now, you mentioned earlier that the da Vinci surgical systems are sold to hospitals. A: Yes.), & 57:14-16 (Q: And

the customers are hospitals; is that right? A: That is correct.); Simmonds Tr. at 16:8-14 & 112:2-5.

Sometimes, certain surgeon physicians, whom Opposer calls “Surgeon Champions”, help Opposer sell its expensive goods to hospital administrators. Annen Tr. at 27:16-28:6 (“Q: Can you describe for me how – I think you called it – the capital-equipment sales group works? A: Yes. So it’s a group of people that are focused in – again, we have the U.S. and outside the U.S. – and they, basically, have targeted hospitals that they work on. And they basically develop – it’s really two possible ways. One way is that they work with surgeon champions and have the surgeon champions help them sell the idea of buying a da Vinci to the administration. In other cases, our folks work directly with the administration – and there are many high-level executives at hospitals that feel very strongly about investing in the da Vinci – and then they, basically, convince the surgeons in the hospital to adopt da Vinci. So it works either of those two ways. Or everyone in the hospital wants to buy da Vinci, and it’s easier.”), 26:25-27:8, 32:7-11 (“Q: Now, other than what you’ve already mentioned, are there any health-care professionals to whom Intuitive sells its da Vinci surgical systems? A: Only – again, in the hospitals, to surgeons – to surgeons and to hospital administrators.”), & 46:20-22; Simmonds Tr. at 16:8-14.

Opposer does not sell its expensive goods to medical patients. Simmonds Tr. at 112:2-5 (Q: And it’s - - as the director of marketing, it’s not your intent to try to sell these expensive machines to patients; is it? A: Not the systems, no.); Annen Tr. at 58:7-10. Opposer does not sell its expensive goods to physicians. Annen Tr. at 57:17-19 (Q: Have you sold any of the da Vinci surgery systems to surgeons? A: Not to my knowledge.).

### **3. Opposer's Trade Channels.**

Mr. Simmonds, Opposer's senior director, marketing services, detailed how Opposer sells its goods to hospital administrators and surgeons. *See*, Simmonds Tr. at 14:16-16:2. Opposer gives a surgeon permission to develop a surgical procedure using Opposer's goods. *Id.* Opposer will evaluate that procedure to see if it is reasonably repeatable and teachable, and if there are enough patients requiring the surgery. *Id.* If Opposer likes the procedure, they develop marketing tools for it such as a video of the surgery, a procedural guide, a sales brochure, and an interactive demonstration (the "Marketing Tools"). *Id.*

Then Opposer presents its surgical system to surgeons and hospital administrators at trade shows, medical congresses and symposia. *Id.*; Simmonds Tr. at 16:3-9 & 18:6-19:2; Annen Tr. at 46:8-22 & 50:8-19. It hands out copies of the Marketing Tools, such as the sales brochure, procedural guide, and video of the surgery on DVD to surgeons and hospital administrators. Simmonds Tr. at 21:12-24. 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.

Opposer also uses [www.intuitivesurgical.com](http://www.intuitivesurgical.com) to market its goods to surgeons and hospital administrators. Simmonds Tr. at 96:9-16.

### **C. Opposer's Post-Purchase Marketing Assistance to Hospitals and Surgeons.**

After a hospital purchases Opposer's expensive surgical system, two things happen: 1. Opposer's clinical sales group<sup>1</sup> assists the hospital in advertising that it has one to the public; and 2. Opposer's clinical sales group assists surgeons trained on its system in advertising that training to the general public and physicians. Simmonds Tr. at 16:3-17:19; Annen Tr. at 28:7-30:2 & 35:22-36:14.

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<sup>1</sup>Not to be confused with Opposer's capital-equipment sales group discussed in section III.B.2., above.

Opposer erroneously relies on its post-purchase, advertising assistance to hospitals and surgeons to argue likelihood of confusion among the general public and physicians. *See*, Opposer trial brief at sections IV.A.2.b.-e & V.D. Post-purchase, Opposer's clinical sales group assists hospitals and surgeons with, among others, billboards, advertisements, commercials, brochures, websites, film, invitation letters, referral letters, and patient seminars. Simmonds Tr. at 16:3-17:19; Annen Tr. at 28:7-30:2 & 35:22-36:14. Even the mobile events are post-purchase attempts to create business for trained surgeons. Annen Tr. at 30:6-20.

The Registration does not include, nor can it be construed to include, post-purchase marketing *services* to hospitals and surgeons. Opposer has no trademark for DA VINCI in International Class No. 35 for post-purchase marketing assistance to hospitals and surgeons. It abandoned its service mark applications for DA VINCI in International Class Nos. 41 and 42. DR-4; ISNR2-1.

There is no evidence that Opposer's post-purchase, radio, TV, and billboard templates for hospital and surgeons use Opposer's Mark. Annen Tr. at 59:4-25 & 61:9-18.

**D. Weak mark in a crowded field.**

When Applicant filed its Notice of Reliance, there were 93 U.S. Trademark registrations with the term DA VINCI or DAVINCI. DR-1; DR-2. Like Applicant's Mark, many of them have a design as part of the registration, and Opposer admits that they "are wholly dissimilar in appearance, sound and meaning from Opposer's Marks." *See*, Opposer trial brief at page 46.

There are other registered trademarks with term DA VINCI or DAVINCI in the health care field, namely for 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. There are other registered DA VINCI trademarks for goods with robotic

features such as automated laboratory instruments and machines to make paper. *See*, DR2 at items 27 and 37.

**E. No Instances of Confusion.**

There have been no actual cases of confusion. ISNR1-8 at Response Nos. 17 & 18; DR-6 at Response Nos. 17 & 18; Boyle Tr. at 93:10-15.

**V. ARGUMENT**

The determination under 15 U.S.C. § 1052(d) is based on an analysis of all the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *In re Paper Doll Promotions, Inc.*, 84 U.S.P.Q.2d 1660 (T.T.A.B. 2007), *citing*, *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks"). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence. The relevant *du Pont* factors in the proceeding are discussed below.

**A. Dissimilarity of the marks.**

An applicant's mark and an opposer's mark are to be compared in regard to appearance, sound when spoken, connotation and overall commercial impression. *In re Paper Doll Promotions, Inc.*, 84 U.S.P.Q.2d 1660 (T.T.A.B. 2007), *citing*, *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). "[T]he test is not whether the marks can be distinguished when subjected to a side-by-

side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result.” *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1727 (TTAB 2008). In other words, the issue is whether consumers might logically believe that the goods have a common source because the marks are similar. *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989).

**1. Sound when spoken.**

The mark DA VINCI is pronounced differently from DAVINCI DIAGNOSTIC IMAGING and design, except for the texts “DA VINCI” and “DAVINCI.”

**2. Appearance.**

The marks look entirely different. Applicant’s mark looks like this:



Applicant’s mark is a highly stylized, graphically designed, and artistically distinct creation for the words “DAVINCI DIAGNOSTIC IMAGING.” Applicant’s Response to Office Action, dated October 11, 2006, describes Applicant’s Mark in the Description of the Mark and Color(s) Claimed fields:

“The mark consists of a white Vitruvian man silhouette image inside of a circle shaded brown in the lower portion blending to yellow in the upper portion, the right half of the circle is superimposed within the brown letter “D” in the brown text “DAVINCI”, the text DIAGNOSTIC is yellow and the text “iMAGING” is brown, the dot over the letter “i” is yellow.”  
“The color(s) white, brown and yellow is/are claimed as a feature of the mark.”

*See*, DR-3. The “i” in the text “iMAGING” is a large, emphasized letter.

Opposer’s registration is a word mark. It is spelled differently than Applicant’s stylized mark. Opposer’s mark has two words, “da” and “Vinci.” Applicant’s mark has three words, “DaVinci”, “Diagnostic”, and “Imaging.” Opposer’s registration has three syllables, and Applicant’s mark and design has ten syllables.

Opposer splits “da Vinci” into two words. Applicant keeps “DaVinci” together. Further, Opposer only capitalizes the “d” in its word mark “da Vinci” when it appears as the first word in a sentence. *See*, IS15-16 and IS19-20. Applicant’s mark, whether stylized or not, has a capital “D” in “DaVinci.” DR1-2, DR4-7, DR9-10, DR12.

### **3. Connotation.**

#### **a. Connotation of Applicant’s Mark.**

Applicant’s mark and design connote medical diagnostic imaging services reborn and on a level of genius.

##### **i. DaVinci**

The text “DAVINCI” connotes the famous Renaissance genius and, by extension, the Renaissance (rebirth) itself. As Opposer points out at page 32 of its trial brief, Applicant’s Licensee has reinforced the connotation of Renaissance or rebirth by its reference to “A Renaissance in Care” in its brochures.

##### **ii. Diagnostic**

While Applicant has disclaimed the text “DIAGNOSTIC”, this disclaimer does not remove the word from consideration in the likelihood of confusion analysis. *In re Shell Oil Co.*, 26 USPQ2d 1687, 1688-89 (Fed. Cir. 1993) (“Shell argues that the words are common dictionary words, and that since Shell filed a disclaimer of the words ‘Right-A-Way’, the only issue of

registration relates to the script and the arrow design. The Board correctly held that the filing of a disclaimer with the Patent and Trademark Opposition No. 91167709 Office does not remove the disclaimed matter from the purview of determination of likelihood of confusion”); *see also, In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749,751 (Fed. Cir. 1985) (“The technicality of a disclaimer in National’s application to register its mark has no legal effect on the issue of likelihood of confusion”).

Here, the text “DIAGNOSTIC” is an adjective connoting the noun diagnosis, the art or act of identifying a disease from its signs and symptoms.<sup>2</sup> In fact, citing the Application, Opposer admits at page 30 of its brief that “‘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...”

### **iii. Imaging.**

The text “IMAGING” connotes the imaging services which Applicant’s Licensee provides: Production of diagnostic images, interpretation of those diagnostic images by medical doctors called radiologists, and production of transcribed reports detailing the radiologists’ diagnostic findings. Boyle Tr. at 34:6-21. Opposer admits this connotation at page 30 of its brief.

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<sup>2</sup> The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). In this regard, Applicant asks the Board to take judicial notice of the following definitions:  
diagnostic (adj.) 1. of, relating to, or used in diagnosis;  
diagnosis (noun) 1.a. the art or act of identifying a disease from its signs and symptoms.  
Webster’s Ninth New Collegiate Dictionary (1983)

**iv. The Design.**



The stylized and colorful, graphic design reinforces the Renaissance and DaVinci connotations of the text. The simplicity of the overlapping geometrical shapes, along with them elegantly forming the “D” in “DaVinci” and the “i” in “imaging,” echo and convey the spirit of the Renaissance of beginning again, looking back to ancient Greece and Rome for the primacy of reason, science, simplicity and elegance. The Vitruvian man speaks of DaVinci, underscoring the diagnostic/medical nature of the imaging at DaVinci Diagnostic Imaging.

Viewed in its entirety, Applicant’s Mark connotes a Renaissance or rebirth in diagnostic imaging where Applicant’s Licensee creates medical images with which its radiologists diagnose disease on a level worthy of Leonardo Da Vinci scientifically, rationally, creatively, and otherwise.

**b. Connotation of Opposer’s Mark**

Opposer admits that the only term of its mark DAVINCI “is arbitrary as applied to Computerized Surgical Systems as it does not describe or suggest a function, component or purpose of those Systems...” *See*, Opposer’s brief at page 31. In other words, the text DAVINCI does not connote its goods. Rather, Opposer states that its mark connotes the Renaissance, Leonardo Da Vinci and his almost universal genius.<sup>3</sup> *See*, pages 31 and 32 of Opposer’s trial brief.

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<sup>3</sup> However, Opposer misreads the evidence and history by asserting Leonardo da Vinci “designed ... the first robotics.” *See*, page 6 and 31 of Opposer’s brief. Opposer’s witness, Mr. Annen, asserted this in his testimony, but there is no such credit given to Leonardo da Vinci in Opposer’s encyclopedic evidence. *See*, ISNR1-11.

Opposer's Mark connotes the man and the Renaissance. Applicant's Mark connotes medical diagnostic imaging services reborn on a level of genius. Therefore, the parties' marks have dissimilar connotations.

#### **4. Overall Commercial Impression.**



Applicant's analysis of 's connotation is the same for its overall commercial impression. Applicant's Mark gives an overall commercial impression of a renewal or rebirth on a level of genius in medical diagnostic imaging services.

Opposer's Mark gives no commercial impression. Therefore, the parties' marks are dissimilar in overall commercial impression.

Because the parties' marks differ in appearance, sound when pronounced, connotation and overall commercial impression, they are dissimilar in their entireties. Not only are the marks distinguishable when subjected to a side-by-side comparison, but Opposer's Mark has no commercial impression. Since Applicant's Mark has a commercial impression and Opposer's Mark does not, overall commercial impressions are different such that confusion as to the source of goods or services under the respective marks is logically impossible. *H.D. Lee Co. v. Maidenform Inc., supra*. The *du Pont* factor regarding the similarity of the marks weighs heavily in favor of finding no likelihood of confusion.

#### **B. Dissimilar and Unrelated Goods and Services.**

Here, the Board must make its findings based on the goods as they are recited in the Application and the Registration.

It is well established that the question of likelihood of confusion must be determined on the basis of the goods as identified in the involved application and the cited registration, rather than on what any evidence may show those goods to be. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed.Cir. 1992); *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods”); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (punctuation in original), quoting, *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987) (“Likelihood of confusion must be determined based on an analysis of the mark applied to the ... [goods or] services recited in applicant’s application vis-à-vis the ... [goods or] services recited in [a] ... registration, rather than what the evidence shows the ... services to be”); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed”).

The Registration is for surgical goods in International Class No. 10. ISNR1-1 at p.2. In short, the Registration describes with particularity goods which include a three piece surgery system and several surgical instruments.

The Application is for medical diagnostic imaging services in International Class No. 44. Applicant Licensee provides the following medical diagnostic imaging services: The capture and radiologist interpretation of images generated with modalities such as MRI, CT, PET/CT,

and Digital Mammography. Boyle Tr. at 16:9–17:1, 34:6-21. However, the description of services in the application would also include the capture and interpretation of, among others, plain film x-rays. ISNR1-9 at Admission No. 4.

The services of Applicant’s Licensee and Opposer’s goods plainly are not identical.

They are not competitive.

However, 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. v. Landesman*, 82 U.S.P.Q.2d 1283,1286 (TTAB 2007).

In its trial brief, Opposer tries to connect its goods with diagnostic imaging services in just one way: As part of Opposer’s surgical system, the surgeon’s surgical display has picture-in-picture capability like a TV such that the surgeon can view his surgery and two other visual media. See, Opposer’s trial brief at page 37. He does this by connecting an electronic device, such as a laptop computer, with his visual media on it, to the surgeon console’s DVI or s-video ports. Annen Tr. at 30:12-31:13; Scott Tr. at 16:23-17:14 & 17:22-18:15. The visual media can be anything, including movies, sports, television on HULU, or diagnostic images and radiology reports, including those emanating from Applicant’s Licensee. Annen Tr. at 43:23-44:7.

The surgeon puts his head inside the video console, and with a “quick click with [his] left foot on a pedal, and then [he] could see these auxiliary images at the same time as the surgical field.” Scott Tr. at 14:2-13 (brackets added). The surgeon can view his patient’s surgery on the

upper two-thirds of the display while watching a football game or Home Shopping Network (or presumably both on the double picture-in-picture) on the lower third of the console. Scott Tr. at 42:4-15 & 44:2-7.

Opposer argues that the surgeon could click his left foot on the console's pedal, pipe in diagnostic images and radiology report(s) from his computer with Applicant's Mark on them, and confuse himself about whether the surgical system, images and report emanate from Opposer or Applicant's Licensee. *See*, Opposer's Brief at 37.

There are many problems with Opposer's reasoning. First, the hypothetical confusion occurs after Opposer sells the surgical system to a hospital administrator. As argued below in section V.C.1., only "purchaser" confusion is relevant. The surgeon in this fanciful scenario is not a purchaser. Second, the Registration does not describe this double picture-in-picture feature, and it is impossible to construe the Registration to include it. *Canadian Imperial Bank, supra*. Third, the special feature is only offered on the upgraded da Vinci S system, not the da Vinci system of the Registration, which is not part of this proceeding. Annen Tr. at 13:1-14:19.

Fourth, even assuming, *arguendo*, that (i) the picture-in-picture feature could be construed as part of the Registration's description, and (ii) post-purchase confusion is relevant, there are many reasons why the surgeon -- the only one to place his head inside the "immersive

display console," click a pedal with his left foot, and see a



report -- is

unlikely to confuse the origin of the diagnostic images, the radiology report, and the surgical system. For one, the parties' marks are different in appearance, sound, meaning and overall commercial impression. *See*, section V.B., above. Further, the surgeon is intimately familiar

with Opposer and its surgery system through extensive training on it. Simmonds Tr. at 55:15-56:18 & 57:4-21; IS-15; IS-16. He knows Opposer made it, and he knows that Opposer does not practice medicine like Applicant's Licensee. Therefore, the surgeon will not think that a radiology report or diagnostic images from Applicant's Licensee emanate from Opposer.

In summary, the description of goods in the Registration differs from the description of services in the Application; therefore, Opposer's goods are dissimilar to the services of Applicant's Licensee. Second, Opposer's goods do not compete against Applicant's Licensee's services. Third, the goods and services are unrelated. Therefore, purchasers will not confuse the source of Opposer's goods and Applicant's Licensee's services. The *du Pont* factor regarding the similarity or relatedness of the parties' services and goods weighs heavily in favor of finding no likelihood of confusion.

### **C. Dissimilar Purchasers and Trade Channels.**

With respect to classes of purchasers and trade channels, as with the similarity or dissimilarity and nature of the goods, the question of likelihood of confusion must be determined based on an analysis of the goods recited in applicant's application vis-à-vis the goods identified in opposer's pleaded registration. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1992).

Where the goods in the application at issue and/or in the pleaded registration are broadly identified as to their nature and type, such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that the identification of goods encompasses not only all the goods of the nature and type described therein, but that the identified goods are offered in all channels of trade which would be normal

for such products, and that they would be purchased by all potential buyers thereof. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

**1. No Purchaser Overlap or Confusion.**

Originally, the statute at issue here, 15 U.S.C. §1052(d), “expressly limited consideration of possible confusion to purchasers.” *Electronic Design & Sales v. Electronic Data Systems*, 954 F.2d 713, 21 USPQ2d 1388, 1390 (Fed. Cir. 1992). “The legislative history states that the word “purchasers” was deleted because “the provision actually relates to potential purchasers as well as to actual purchasers.” *Id.* (Internal citations omitted).

In determining likelihood of confusion, “at least in the case of goods and services that are sold, the inquiry generally will turn on whether actual or potential ‘purchasers’ are confused...If likelihood of confusion exists, it must be based on the confusion of some relevant person; i.e., a customer or purchaser.” *Id.* (Internal citations omitted). The Court “broadly construe[d] purchasers and potential purchasers to include those persons, such as some users, who might influence future purchasers. For commercially sold items, only those users who might influence future purchasers can be considered ‘relevant persons.’” *Id.*

In *Electronic Design & Sales v. Electronic Data Systems*, *supra*, the Court reversed the Board’s decision denying applicant’s application for registration of the block letter trademark “E.D.S.” enclosed in a stylized box. The Board concluded that purchasers and users of opposer’s computer services sold under the service mark “EDS” who saw applicant’s power supplies or battery chargers with the stylized E.D.S. would likely be confused and believe that applicant’s equipment goods was produced or endorsed by opposer.

In reversing the Board, the Court stated:

“[W]here both applicant’s goods and opposer’s services are marketed and sold in the medical and certain other fields, it is error to deny registration simply because ‘applicant

sells some of its goods in some of the same fields in which opposer provides its services,' without determining who are the 'relevant persons' within each corporate customer. This is especially true where, as here, the Board acknowledged that 'applicant's goods are specifically different and noncompetitive.'" [Internal citations omitted]. Thus, although the two parties conduct business not only in the same fields but also with some of the same companies, the mere purchase of the goods and services by both parties by the same institution does not, by itself, establish similarity of trade channels, or overlap of customers. The likelihood of confusion must be shown to exist not in a purchasing *institution*, but in 'a customer or purchaser.'" [Internal citations omitted] (Emphasis in the original).

*Electronic Design & Sales v. Electronic Data Systems, supra*, 21 USPQ2d at 1391.

Here, only hospital administrators are Opposer's purchasers within the hospital "purchasing institutions." Annen Tr. at 58:1-10, 18:19-24, 26:24-27:8, 27:16-28:6, 30:21-25, 32:16-18, 39:23-25, & 57:14-16; Simmonds Tr. at 16:8-14 & 112:2-5. Only medical patients purchase medical diagnostic imaging services from Applicant's Licensee. ISNR1-9 at Admission No. 3; ISNR1-8 at Response 16; Boyle Tr. at 32:15-33:10. Therefore, a conclusion of likelihood of confusion is unwarranted because the parties' purchasers do not overlap.

*Electronic Design & Sales v. Electronic Data Systems, supra*.

Opposer may argue purchaser overlap in three ways: 1. Hospital administrators might be disloyal to their hospital and purchase diagnostic imaging services from Applicant's Licensee instead from the hospital; 2. Surgeon Champions may purchase diagnostic imaging services for themselves from Applicant's Licensee; and 3. Surgeon Champions might influence a medical patient to purchase diagnostic imaging services from Applicant's Licensee.

As the Court of Customs and Patent Appeals stated in *Witco Chem. Co. v. Whitfield Chem. Co.*, 418 F.2d 1403, 1405, 164 U.S.P.Q. 43, 44-45 (CCPA 1969), *affirming*, 153 U.S.P.Q. 412 (TTAB):

We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal.

Hospital administrators and Surgeon Champions purchasing both Opposer's goods and Applicant's Licensee's services is a mere theoretical possibility or a *de minimis* situation. *Witco Chem. Co. v. Whitfield Chem. Co. supra.*

So are Surgeon Champion referrals to Applicant's Licensee. Applicant's Licensee is comprised solely of non-surgeon physicians who refer in excess of eight-five percent (85%) of the referrals to Applicant's Licensee. Boyle Tr. at 50:7-19 & 51:3-13. Physicians outside of Applicant's Licensee, surgeons and non-surgeons, account for less than fifteen percent (<15%) of the referrals to Applicant's Licensee. *Id.* Opposer presents no evidence of the amount of referrals within this 15% attributable to Surgeon Champions.

In summary, Opposer's purchasers are hospital administrators. Applicant's Licensee's purchasers are medical patients. There is no purchaser overlap. Further, as discussed in section V.D. below, any small, theoretical, overlap of purchasers is comprised of sophisticated users who will not be confused.

The *du Pont* factor regarding the similarity of purchasers weighs heavily in favor of finding no likelihood of confusion.

## **2. Trade Channels Differ.**

Opposer presents its surgical system to hospital administrators and surgeons at trade shows, medical congresses and symposia. Simmonds Tr. at 14:16-16:9 & 18:6-19:2; Annen Tr. at 46:8-22 & 50:8-19. There, it hands out copies of the Marketing Tools, such as sales brochures, procedural guides, and videos of the surgeries on DVD to surgeons and hospital administrators. Simmonds Tr. at 21:12-24. 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 & 36:19.

Opposer also uses [www.intuitivesurgical.com](http://www.intuitivesurgical.com) to market its goods to surgeons and hospital administrators. Simmonds Tr. at 96:9-16.

Applicant and Applicant's Licensee have used Applicant's Mark on business cards, brochures, physician office visits, and the internet to market its medical diagnostic imaging services to medical patients and physicians. Boyle Tr. at 15:6-23; ISNR1-8 at Supplemental Response Nos. 5 & 11.

Therefore, the trade channels of the parties do not overlap except for the internet. It is fair to say that virtually every service and good imaginable is advertised on the internet. Thus, the fact that both Opposer and Applicant advertise goods and services, respectively, on the internet, especially with dissimilar marks for dissimilar goods and services, and for different purchasers, can hardly be considered a common link between Opposer's goods and Applicant's Licensee's services.

Accordingly, the *du Pont* factor of the similarity of channels weighs heavily in favor of finding no likelihood of confusion.

Opposer erroneously relies on its post-purchase, advertising assistance to hospitals and "da Vinci trained surgeons" to argue likelihood of confusion in the parties' trade channels among the general public and physicians. *See*, Opposer trial brief at sections IV.A.2.b.-e and V.D. Post-purchase, Opposer's clinical sales group assists hospitals and surgeons with, *inter alia*, billboards, advertisements, commercials, brochures, websites, film, invitation letters, referral letters, and patient seminars. Simmonds Tr. at 16:3-17:19; Annen Tr. at 28:7-30:2 & 35:22-36:14. Even the mobile events are post-purchase attempts to create business for trained surgeons. Annen Tr. at 30:6-20.<sup>4</sup>

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<sup>4</sup> There is no evidence that Opposer's post-purchase, radio, TV, and billboard templates for hospital and surgeons use Opposer's Mark. Annen Tr. at 59:4-25 & 61:9-18.

Opposer's argument is misguided. First, the Registration does not include, nor can it be construed to include, post-purchase marketing *services* to hospitals and surgeons. *Canadian Imperial Bank v. Wells Fargo Bank, supra*. Opposer has no trademark for DA VINCI in International Class No. 35 for post-purchase marketing assistance to hospitals and surgeons. It abandoned its service mark applications for DA VINCI in International Class Nos. 41 and 42. *See*, DR-4; ISNR2-1.

Second, the statute at issue here, 15 U.S.C. §1052(d), limits consideration of possible confusion to potential and actual purchasers. *Electronic Design & Sales v. Electronic, supra*, 21 USPQ2d at 1390. Even assuming, *arguendo*, that the Registration could be construed to include Opposer's post-purchase, marketing assistance, hospital administrators presumably purchase the services. Again, hospital administrators are not purchasers of Applicant's Licensee so they will not confuse Opposer's marketing services with the diagnostic imaging services of Applicant's Licensee. *Electronic Design & Sales, supra*.

**D. Sophistication of Purchasers and Conditions Under Which the Purchase is Made.**

Where the purchasers are the same, their sophistication is important and often dispositive because “[s]ophisticated consumers may be expected to exercise greater care.” *Electronic Design & Sales v. Electronic Data Systems*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992), *citing*, *Dynamics Research Corp. v. Langenau Mfg. Co.*, 704 F.2d 1575, 217 USPQ 649 (Fed. Cir. 1983), *quoting*, *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 489, 21 USPQ 246, 252 (1<sup>st</sup> Cir. 1981). “[T]here is always less likelihood of confusion where goods are expensive and purchased after careful consideration.” *Electronic Design & Sales, supra, quoting and citing, Astra Pharmaceuticals Prods. v. Beckman Instruments*, 718 F.2d 1201, 1206, 220 U.S.P.Q. 786, 790 (1<sup>st</sup> Cir. 1983).

Here the purchasers are not the same.

Opposer's purchasers are hospital administrators. Setting aside that "there is always less likelihood of confusion where goods are expensive and purchased after careful consideration," hospital administrators are not Applicant's Licensee's purchasers so a "conclusion of likelihood of confusion is unwarranted... because there is no evidence of overlap with purchasers" of Applicant's Licensee. *Electronic Design & Sales v. Electronic Data Systems, supra.*

Applicant's purchasers are medical patients. Setting aside that purchasing diagnostic imaging services is never an impulse decision and has less likelihood of confusion, medical patients are not Opposer's purchasers. Therefore, a "conclusion of likelihood of confusion is unwarranted... because there is no evidence of overlap with purchasers" of Opposer's goods. *Electronic Design & Sales v. Electronic Data Systems, supra.*

Even assuming, *arguendo*, that disloyal hospital administrators and Surgeon Champions count for more than a *de minimis* overlap of purchasers, the conditions under which a hospital administrator would purchase, or a Surgeon Champion would recommend the purchase of, a surgical system are completely unrelated to a hospital administrator or Surgeon Champion going to Applicant's Licensee for diagnostic imaging services and to a Surgeon Champion referring a medical patient to Applicant's Licensee. Purchasing the surgical system is a career-changing and career-expanding decision for the Surgeon Champion, and a very expensive matter that he and the hospital administrator must discuss carefully and wisely together. Getting an MRI at Applicant's Licensee is not an impulse decision likely to confuse the disloyal hospital administrator or Surgeon Champion with purchasing Opposer's surgical system. The Surgeon Champion's patient referral to Applicant's Licensee is an important, non-financial decision for the surgeon to diagnose his patient's disease. Therefore, purchasing a very

expensive system, going for an MRI, or referring a patient for an MRI are all carefully calculated decisions.

Moreover, hospital administrators and Surgeon Champions are sophisticated purchasers. As in *Electronic Design & Sales, supra*, just reading the Registration, one would expect that Opposer's purchasers would be highly sophisticated. Nothing in the record is to the contrary. Indeed, the record confirms that Opposer's goods are expensive and are purchased only by experienced hospital administrators and promoted by discerning surgeons after significant study and contractual negotiation. Simmonds Tr. at 111:1-5. Thus, it is evident that Opposer's goods are purchased after careful consideration by persons who are highly knowledgeable about Opposer's goods and their source.

For these reasons, the *du Pont* factors of the sophistication of the purchaser and the circumstances under which purchases are made weighs heavily in favor of finding no likelihood of confusion.

**E. The Number and Nature of Similar Marks In Use on Similar Goods and Services  
Comprised of or Including the Text DAVINCI or DA VINCI.**

In a crowded field of similar marks the rights associated with one of the marks in that field are weak and thus narrowly construed. *See, McCarthy on Trademarks*, § 11.87 and § 11.88; *Tektronix, Inc. v. Daktronics, Inc.* 534 F. 2d 915, 189 U.S.P.Q. 693(C.C.P.A. 1976); *General Mills, Inc. v. Kellogg Co.*, 824 F. 2d 622, 3 U.S.P.Q. 2d 1442 (8th Cir. 1987) (Evidence of third party usage of similar marks on similar goods is admissible and relevant to show that the mark is relatively weak and entitled to a narrow scope of protection.). Further, third party registrations are probative to determine a common, weak significance of a part of a composite mark. *See,*

*McCarthy on Trademarks*, § 11.90, and footnotes 2 and 3 and citations therein, and *Sams*, "Third Party Registrations in T.T.A.B. Proceedings," *Trademark Rep.* 197 (1982).

In the immediate matter, there are 93 issued registrations containing the text DA VINCI or DAVINCI. DR-1; DR-2. Moreover, several of the marks are used for goods and services similar to the parties here. Many of them have a design as part of the registration, and Opposer admits, as opposed to Applicant's Mark, that they "are wholly dissimilar in appearance, sound and meaning from Opposer's Marks." See, Opposer trial brief at page 46.

There are other registered trademarks with term DA VINCI or DAVINCI in the health care field, namely for 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. They could easily be classified under the same International Class No. 10 as the Registration.

There are other registered DA VINCI trademarks for goods with robotic features such as automated laboratory instruments and machines to make paper. See, DR2 at pp. 27 and 37.

The evidence of third party use of marks comprised of or including DAVINCI or DA VINCI is probative of the factual issue of whether Opposer's Mark and Applicant's Mark could be confused in a world full of DA VINCI and DAVINCI marks.

**F. Actual Instances of, and Potential for, Purchaser Confusion is Non-Existent or *De Minimis*.**

There have been no actual instances of confusion. ISNR1-8 at Response Nos. 17 & 18; DR-6 at Response Nos. 17 & 18; Boyle Tr. at 93:10-15. The potential for confusion is, at best, *de minimis*. These *du Pont* factors of concurrent use without actual confusion and the lack of potential for confusion favor Applicant and do not support a finding of likelihood of confusion.

## VI. CONCLUSION

For the foregoing reasons, Applicant DaVinci Radiology Associates, P.L. respectfully requests that this Board dismiss this opposition proceeding and approve Applicant's Mark for registration on the Principal Register.

Respectfully submitted,



Matthew T. Vanden Bosch  
Attorney for DaVinci Radiology Associates, P.L.  
301 Clematis Avenue  
Suite 3000  
West Palm Beach, FL 33401  
(561) 736-4696

Dated: September 8, 2009

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**CERTIFICATE OF SERVICE**

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

On September 8, 2009, I hereby certify that I served a copy of Applicant DaVinci Radiology Associates, P.L.'s Trial Brief by first-class mail (with a copy via e-mail), postage prepaid to Michelle J. Hirth, Esq., Embarcadero Four, 17th Floor, San Francisco, California 94111.

Executed on September 8, 2009, at Boynton Beach, Florida.

  
Matthew T. Vanden Bosch