

ESTTA Tracking number: **ESTTA307971**

Filing date: **09/24/2009**

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	Rebuttal Brief
Filer's Name	Matt Vanden Bosch
Filer's e-mail	mvbosch@comcast.net
Signature	/Matt Vanden Bosch/
Date	09/24/2009
Attachments	Document (1).pdf ( 3 pages )(25506 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

---

**APPLICANT'S BRIEF IN REPLY TO  
OPPOSER INTUITIVE SURGICAL, INC.'S  
RESPONSE TO APPLICANT'S EVIDENTIARY OBJECTIONS**

Applicant filed its evidentiary objections in its Trial Brief. Opposer filed a Response to Applicant's Evidentiary Objections ("Opposer's Evidentiary Response Brief") outside of its very lengthy Reply Trial Brief. Applicant is filing this brief in reply to Opposer's Evidentiary Response Brief.

1. File Wrappers Submitted as Exhibits ISNR1-2 through ISNR1-7 are Irrelevant.

ISNR1-2 through ISNR-7 are irrelevant because Opposer failed to plead the marks in its Notice of Opposition and/or Applicant's Mark has priority.

In Opposer's Notice of Opposition, filed January 22, 2007, Opposer claims rights only in DA VINCI, Registration No. 2,628,871 ("DA VINCI"), and DA VINCI S HD SURGICAL SYSTEM (Stylized), Serial No. 77/665,748, filed on September 8, 2006<sup>1</sup> ("DA VINCI S HD SURGICAL SYSTEM"). *See*, Notice of Opposition at ¶3 and 4.

Applicant's Mark was first used on August 1, 2005. DA VINCI was first used on July 7, 2000. *See*, ISNR1-1. DA VINCI S HD SURGICAL SYSTEM, the only other mark pleaded in the Notice of Opposition, was in use "at least as early as January 2007." *See*, Opposer's Evidentiary Response Brief at page 3. Applicant's Mark has priority over all Opposer's marks except DA VINCI. *Id.*

---

<sup>1</sup> Opposer mistakenly states that it was filed on September 8, 2008. *See*, Opposer's Evidentiary Response Brief at page 3.

The only relevant comparison in this matter is between DA VINCI and Applicant's Mark. Therefore, ISNR1-2 through ISNR1-7 should be stricken and given no consideration.

2. Benjamin Gong's deposition and Exhibit IS-27 thereto are Irrelevant.

Opposer states that the relevance of the deposition is to show that Opposer "feels" that photometric analyzers are different from its computerized surgical system. See, Opposer's Evidentiary Response Brief at page 5 and 8-9.

Here is the deposition testimony to the extent that Opposer finds it relevant:

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

A: We **felt** that those goods are different than the goods that Intuitive sells.

Gong Tr. at 17:17-20. (Emphasis added).

In other words, Opposer finds it relevant for the Board to consider that it brought an opposition proceeding against a company using da Vinci to sell goods which Opposer felt were unrelated to its goods in order to limit that company's use of da Vinci to sell just those unrelated goods. The argument is preposterous. Further, it is self-serving. Opposer's feeling, as related by Mr. Gong, does not prove one way or another whether photometric analyzers are different from or similar to Opposer's computerized surgical goods. The deposition was a waste of time and money and should be given no consideration.

Respectfully submitted,



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

Dated: September 24, 2009

**CERTIFICATE OF SERVICE**

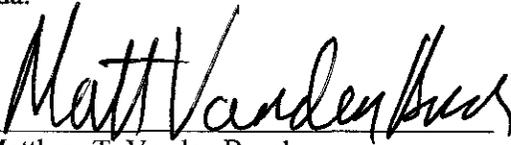
*Intuitive Surgical, Inc. v. DaVinci Radiology Associates, P.L.*  
Opposition No. 91175319

On September 24, 2009, I hereby certify that I served a copy of APPLICANT'S BRIEF IN REPLY TO OPPOSER INTUITIVE SURGICAL, INC.'S RESPONSE TO APPLICANT'S EVIDENTIARY OBJECTIONS

By U.S. Mail to:

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

Executed on September 24, 2009, at Boynton Beach, Florida.

  
Matthew T. Vanden Bosch