

ESTTA Tracking number: **ESTTA140002**

Filing date: **05/10/2007**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Cardinal Health 303, Inc.
Granted to Date of previous extension	05/23/2007
Address	10221 Wateridge Circle San Diego, CA 92121 UNITED STATES

Attorney information	Jessie K. Reider, Esq. Fulwider Patton LLP 6060 Center Drive, Tenth Floor Los Angeles, CA 90045 UNITED STATES doctetla@fulpat.com, reider@fulpat.com Phone:310-824-5555
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**Applicant Information**

Application No	78744914	Publication date	01/23/2007
Opposition Filing Date	05/10/2007	Opposition Period Ends	05/23/2007
Applicant	Alaris Group, Inc., The P.O. Box 24855 Edina, MN 55424 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 044. First Use: 2003/04/01 First Use In Commerce: 2004/04/15 All goods and services in the class are opposed, namely: Medical consulting services in the field of medical and vocational rehabilitation primarily responding to the needs of the workers compensation industry
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**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

**Mark Cited by Opposer as Basis for Opposition**

U.S. Registration No.	2279724	Application Date	01/31/1997
Registration Date	09/21/1999	Foreign Priority Date	NONE

Word Mark	ALARIS
Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 010. First use: First Use: 1997/07/24 First Use In Commerce: 1997/07/24  medical instruments and equipment, namely, infusion pumps and controllers, including volumetric infusion pumps, syringe pumps, programmable infusion pumps, programmable syringe pumps and the resident control programs; clinical vital signs measurement instruments, namely, thermometers for medical use, disposable thermometer covers, blood pressure measurement instruments, pulse rate measurement instruments, blood pressure cuffs, pulse oximetry instruments, namely, sensors and monitors, respiration measurement instruments, and ECG instruments; medical fluid administration sets for the delivery of medical fluids, namely, drug delivery tubing, clamps, flow control devices, drug infusion connectors, adapters, injection sites, needleless connectors, needleless ports, needleless injection sites, and medical valves; medical devices for the delivery of medical fluids, namely, drug delivery tubing, clamps, flow control devices, drug infusion connectors, adapters, injection sites, needleless connectors, needleless ports, needleless injection sites, and medical valves; intravenous fluid containers, monitors, alarms, rate meters; sphygmomanometers; enteric infusion pumps and bags therefor; medical instrument and intravenous fluid container stands and hanger devices; gastrointestinal feeding tubes; needle catheter jejunostomy kits, namely, tubing and needles; multiple specimen holders for medical use; cold and hot packs for chemically producing and absorbing heat for use in medical treatment and therapy</p> <p>Class 037. First use: First Use: 1997/07/24 First Use In Commerce: 1997/07/24  service and repair of medical instruments, equipment and accessories</p> <p>Class 042. First use: First Use: 1997/07/24 First Use In Commerce: 1997/07/24  leasing and rental of medical instruments, equipment, and accessories</p>

Attachments	75234438#TMSN.gif ( 1 page )( bytes ) IVACL76524 Notice of Opposition.pdf ( 7 pages )(238456 bytes )
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Signature	/jkr/
Name	Jessie K. Reider, Esq.
Date	05/10/2007

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

In the Matter of Application Serial No. 78/744,914  
For The Service Mark ALARIS SELECT  
Published in the Official Gazette on January 23, 2007

CARDINAL HEALTH 303, INC.,	)	
	)	
Opposer	)	
	)	
v.	)	Opposition No. _____
	)	
THE ALARIS GROUP, INC.,	)	
	)	
Applicant.	)	
_____	)	

NOTICE OF OPPOSITION

Cardinal Health 303, Inc., (hereinafter "Opposer"), a corporation organized under the laws of Delaware, located at and doing business at 10221 Wateridge Circle, San Diego, California 92121, will be damaged by registration of the above identified service mark application (hereinafter "Application"), in the name of The Alaris Group, Inc. (hereinafter "Applicant"), with a last known address of P.O. Box 24855 Edina, Minnesota 55424, and hereby opposes registration of the same.

The grounds for opposition are as follows:

**COUNT ONE**

1. For almost a decade, long prior to the Applicant's filing of the Application, Opposer has been engaged in the development, manufacture, advertising, distribution and sale in interstate commerce of a wide variety of goods and services, including but not limited to medical instruments and equipment, the service and repair of medical instruments, equipment and

accessories, and the leasing and rental of medical instruments, equipment and accessories bearing the mark ALARIS, alone and in connection with its other marks.

2. As a result of Opposer's widespread use and expenditure of resources to promote the goods and services offered under its ALARIS mark, as well as Opposer's dedication to high quality goods and services, Opposer has acquired significant goodwill in and to the mark. Opposer's ALARIS mark has come to represent the highest quality goods, as well as excellent service, as used in connection with those goods, and consumers have come to count on Opposer's ALARIS mark to represent superior medical instruments and equipment, and superior servicing and leasing of medical instruments, equipment and accessories.

3. Opposer is the owner of U.S. Trade/ Service Mark Registration No. 2,279,724, registered on the Principal Register on September 21, 1999, directed to the mark ALARIS for use in connection with:

medical instruments and equipment, namely, infusion pumps and controllers, including volumetric infusion pumps, syringe pumps, programmable infusion pumps, programmable syringe pumps and the resident control programs; clinical vital signs measurement instruments, namely, thermometers for medical use, disposable thermometer covers, blood pressure measurement instruments, pulse rate measurement instruments, blood pressure cuffs, pulse oximetry instruments, namely, sensors and monitors, respiration measurement instruments, and ECG instruments; medical fluid administration sets for the delivery of medical fluids, namely, drug delivery tubing, clamps, flow control devices, drug infusion connectors, adapters, injection sites, needleless connectors, needleless ports, needleless injection sites, and medical valves; medical devices for the delivery of medical fluids, namely, drug delivery tubing, clamps, flow control devices, drug infusion connectors, adapters, injection sites, needleless connectors, needleless ports, needleless injection sites, and medical valves; intravenous fluid containers, monitors, alarms, rate meters; sphygmomanometers; enteric infusion pumps and bags therefor; medical instrument and intravenous fluid container stands and hanger devices; gastrointestinal feeding tubes; needle catheter jejunostomy kits, namely, tubing and needles; multiple specimen

Service and repair of medical instruments, equipment and accessories in Class 037;

and

Leasing and rental of medical instruments, equipment, and accessories in Class 042.

The registration is in all respects valid and subsisting, and has enjoyed incontestable status since February 5, 2005. A copy of the certificate of Registration is attached as Opposer's Exhibit A.

4. The Application, Serial No. 78/744,914, for the word mark ALARIS SELECT, was filed on November 1, 2005, and is based on the Applicant's contended use of the mark in commerce as early as April 15, 2004, for use in connection with:

Medical consulting services in the field of medical and vocational rehabilitation primarily responding to the needs of the workers compensation industry in Class 044.

5. The mark in the Application so resembles Opposer's ALARIS mark, used in the United States prior to the filing date of the Application, as to be likely to cause confusion, mistake or deception.

6. The mark in the Application is confusingly similar to Opposer's ALARIS mark in sound, sight and overall commercial impression.

7. Applicant's services are related to the goods and services sold and provided in connection with Opposer's ALARIS mark, and/or represent a natural zone of expansion for Opposer, and such goods and services would travel and/or be promoted through the same channels of trade for sale to, and use by, the same class of purchasers.

8. Applicant's use of the mark in the subject Application in connection with its services is likely to cause confusion, mistake, or deception as to the source of the origin of Applicant's goods and services in that the public, the trade and others are likely to believe that

Applicant's goods and services are the goods and services of Opposer or are in some way provided, sponsored, approved, licensed by or affiliated with or in some way legitimately connected to Opposer, all to Opposer's irreparable damage and injury.

## **COUNT TWO**

9. Opposer repeats and realleges the allegations set forth in Paragraphs 1 through 8 as though set forth herein.

10. Opposer's ALARIS mark is distinctive and famous and became famous long prior to the date Applicant filed the Application.

11. Use of the mark in the subject Application by Applicant causes dilution of the distinctive quality of Opposer's famous ALARIS mark.

12. Opposer will be damaged by the registration sought by Applicant because such registration would support and assist Applicant in use of the subject mark and thereby dilute Opposer's rights in its distinctive and famous ALARIS mark.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and Applicant's Application to register the subject mark be denied in all respects.

Please recognize as attorneys for Opposer in this proceeding Thomas A. Runk and Jessie K. Reider, both of whom are members of the State Bar of California, and whose address is Fulwider Patton LLP, 6060 Center Drive, Tenth Floor, Los Angeles, California 90045, and whose telephone number is 310-824-5555.

Respectfully submitted,

Cardinal Health 303, Inc.

Dated: May 10, 2007

By: Jessie K. Reider

Thomas A. Runk, Esq.  
Jessie K. Reider, Esq.  
Fulwider Patton LLP  
6060 Center Drive, Tenth Floor  
Los Angeles, California 90045  
Attorneys for Opposer  
Cardinal Health 303, Inc.

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

In the Matter of Application Serial No. 78/744,914  
For The Service Mark ALARIS SELECT  
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THE ALARIS GROUP, INC.,            )  
  )  
          Applicant.                        )  
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Opposition No. \_\_\_\_\_

Opposer's Exhibit A

**Int. Cls.: 10, 37, and 42**

**Prior U.S. Cls.: 26, 39, 44, 100, 101, 103, and 106**

**Reg. No. 2,279,724**

**United States Patent and Trademark Office**

**Registered Sep. 21, 1999**

**TRADEMARK  
SERVICE MARK  
PRINCIPAL REGISTER**

**ALARIS**

ALARIS MEDICAL SYSTEMS, INC. (DELAWARE CORPORATION)  
10221 WATERIDGE CIRCLE  
SAN DIEGO, CA 92121

FOR: MEDICAL INSTRUMENTS AND EQUIPMENT, NAMELY, INFUSION PUMPS AND CONTROLLERS, INCLUDING VOLUMETRIC INFUSION PUMPS, SYRINGE PUMPS, PROGRAMMABLE INFUSION PUMPS, PROGRAMMABLE SYRINGE PUMPS AND THE RESIDENT CONTROL PROGRAMS; CLINICAL VITAL SIGNS MEASUREMENT INSTRUMENTS, NAMELY, THERMOMETERS FOR MEDICAL USE, DISPOSABLE THERMOMETER COVERS, BLOOD PRESSURE MEASUREMENT INSTRUMENTS, PULSE RATE MEASUREMENT INSTRUMENTS, BLOOD PRESSURE CUFFS, PULSE OXIMETRY INSTRUMENTS, NAMELY, SENSORS AND MONITORS, RESPIRATION MEASUREMENT INSTRUMENTS, AND ECG INSTRUMENTS; MEDICAL FLUID ADMINISTRATION SETS FOR THE DELIVERY OF MEDICAL FLUIDS, NAMELY, DRUG DELIVERY TUBING, CLAMPS, FLOW CONTROL DEVICES, DRUG INFUSION CONNECTORS, ADAPTERS, INJECTION SITES, NEEDLELESS CONNECTORS, NEEDLELESS PORTS, NEEDLELESS INJECTION SITES, AND MEDICAL VALVES; MEDICAL DEVICES FOR THE DELIVERY OF MEDICAL FLUIDS, NAMELY, DRUG DELIVERY TUBING, CLAMPS, FLOW CONTROL DEVICES, DRUG INFUSION CONNECTORS, ADAPTERS, INJEC-

TION SITES, NEEDLELESS CONNECTORS, NEEDLELESS PORTS, NEEDLELESS INJECTION SITES, AND MEDICAL VALVES; INTRAVENOUS FLUID CONTAINERS, MONITORS, ALARMS, RATE METERS; SPHYGMOMANOMETERS; ENTERIC INFUSION PUMPS AND BAGS THEREFOR; MEDICAL INSTRUMENT AND INTRAVENOUS FLUID CONTAINER STANDS AND HANGER DEVICES; GASTROINTESTINAL FEEDING TUBES; NEEDLE CATHETER JEJUNOSTOMY KITS, NAMELY, TUBING AND NEEDLES; MULTIPLE SPECIMEN HOLDERS FOR MEDICAL USE; COLD AND HOT PACKS FOR CHEMICALLY PRODUCING AND ABSORBING HEAT FOR USE IN MEDICAL TREATMENT AND THERAPY, IN CLASS 10 (U.S. CLS. 26, 39 AND 44).

FIRST USE 7-24-1997; IN COMMERCE 7-24-1997.

FOR: SERVICE AND REPAIR OF MEDICAL INSTRUMENTS, EQUIPMENT AND ACCESSORIES, IN CLASS 37 (U.S. CLS. 100, 103 AND 106).

FIRST USE 7-24-1997; IN COMMERCE 7-24-1997.

FOR: LEASING AND RENTAL OF MEDICAL INSTRUMENTS, EQUIPMENT, AND ACCESSORIES, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 7-24-1997; IN COMMERCE 7-24-1997.

SN 75-234,438, FILED 1-31-1997.

JOAN LESLIE BISHOP, EXAMINING ATTORNEY