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

Proceeding	91200436
Party	Defendant Medinol Ltd.
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Submission	Motion to Amend/Amended Answer or Counterclaim
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD

CARDIOMEMS, INC.,

Opposer,

v.

MEDINOL LTD.,

Applicant.

In re Serial No. 85/082098

Mark: CHAMPIONIR

Opposition No. 91200436

**APPLICANT'S MOTION FOR LEAVE TO FILE AN AMENDED ANSWER AND
SUPPORTING MEMORANDUM OF LAW**

Applicant Medinol Ltd. ("Applicant") hereby moves pursuant to 37 CFR §§ 2.106(b)(2)(i) and 2.107(a) and Fed. R. Civ. P. 15(a) for an Order granting leave to amend its Answer to the Amended Notice of Opposition to assert a counterclaim for cancellation of U.S. Registration No. 4029193, the CHAMPION mark ("Opposer's Mark"). A copy of Medinol's proposed amended pleading with cancellation counterclaim is attached.

Based on recently discovered evidence as set forth below, Medinol respectfully submits that it is appropriate for the Board to grant the Motion. Opposer's registration should be cancelled because the specimens submitted by the Opposer do not support a claim that Opposer's Mark was properly used in commerce as a matter of law to identify the source of either of the goods or services set forth in the underlying application. Thus, for example, because the U.S. Food and Drug Administration (FDA) has not given its approval for Opposer to offer such goods lawfully in commerce, and because reliance upon use of a mark for services in clinical trials conducted for one's own benefit is prohibited, such uses cannot form the basis for trademark registration by the USPTO.

BACKGROUND

On June 29, 2011, Opposer CardioMEMS, Inc. (“Opposer”) filed its Opposition against the registration of the CHAMPIONIR mark underlying Application Serial No. 85/082,098 (“Opposed Mark”), on the ground that there is, allegedly, a likelihood of confusion between Applicant’s CHAMPIONIR mark and Opposer’s Mark. Shortly after filing its Opposition, Opposer sought Leave to Amend its Notice of Opposition, which was granted by the Board on August 5, 2011. The stated rationale for Opposer’s Motion to Amend was “to clarify the basis upon which Opposer claims priority.” Motion at p. 2. In actuality, Opposer changed the basis for its alleged use by removing a reference to “high quality products and services offered by Opposer” (Notice, ¶11) and substituting instead a reference to “clinical trials” conducted for its own benefit alleging use with Opposer’s Mark (Amended Notice, ¶10). Consequently, the only alleged use of the CHAMPION mark in relation to this Opposition is “in connection with a now-completed clinical trial involving the Class 10 goods recited in Application Serial No. 77/693458” (hereinafter, “Opposer’s Allegedly Use-Supporting Clinical Trials” or “Clinical Trials”). Amended Notice, ¶4.

On the same day that Opposer moved to amend, Opposer also submitted a Statement of Use to the United States Patent and Trademark Office (USPTO) claiming a date of First Use In Commerce of August 5, 2011 for the following goods in Class 10 recited in the underlying application:

International Class 010: Medical diagnostic sensors for measuring properties of the body, namely, pressure, corresponding catheter-based delivery apparatus to deliver sensors to locations within the body; telemetry devices for medical application and software to interrogate, receive, process and display pressure data or derived quantities for viewing and printing sold as a unit.

See Exhibit A (Statement of Use filed by Opposer with the U.S. Trademark Office on August 5, 2011). In addition, Opposer alleged a date of First Use In Commerce of December 2, 2008, for the Class 42 services recited in the underlying application as follows: “International Class 042: Providing a web site that enables users to upload and access health and medical data.” Id.

In connection with the Statement of Use, Opposer submitted a specimen consisting of (1) an image described by Opposer as a “Shipment of Applicant’s goods for testing showing use of the mark” and having a label stamped “SAMPLE NOT FOR HUMAN USE”, and (2) a “Screen shot from website” evidently also used in connection with Opposer’s Allegedly Use-Supporting Clinical Trials. See Exhibit A; Exhibit B (specimen). Thus, the only specimen to support Opposer’s alleged use in commerce in connection with International Classes 10 and 42 were items from Opposer’s own Clinical Trials that were conducted on its own behalf in the hopes of securing FDA approval for its medical devices.

Medinol timely answered the original Notice of Opposition on August 8, 2011, and answered the Amended Notice of Opposition on August 19, 2011. Therein, Medinol pled as an Affirmative Defense that Opposer “has not continuously used [the Opposer’s Mark] since its alleged date(s) of first use on all of those products or services alleged in its Notice of Opposition.” Answer to Amended Notice, ¶19. Specifically, Medinol noted that the date of first use claimed by Opposer – i.e. August 5, 2011 - “is well after the July 11, 2010 filing date of Applicant’s application for its CHAMPIONIR mark.” Id.

Since the initial exchange of pleadings, the parties have exchanged initial disclosures but have extended discovery deadlines to provide time to engage in settlement discussions. On April 10, 2012, the Board granted a second Motion for an Extension of Expert Disclosures, Discovery,

and Trial Deadlines with Consent, pursuant to which the discovery period is extended to June 3, 2012.

Meanwhile, in or about March 2012, it came to Medinol's attention that Opposer's Allegedly Use-Supporting Clinical Trials resulted in a negative assessment by an advisory panel of the FDA (hereinafter, "the FDA advisory panel"), and that this alleged use was not proper support for a valid registration with the USPTO. See David Morgan, FDA panel votes against CardioMEMS device, Reuters, Dec. 8, 2011, <http://www.reuters.com/article/2011/12/09/us-cardiomems-fda-idUSTRE7B801020111209> (retrieved April 16, 2012). Indeed, as of January 1, 2012, the USPTO had amended the U.S. Acceptable Identification of Goods and Services Manual (ID Manual) to confirm that "conducting one's own clinical trials" does not constitute a recognized "service" for purposes of supporting assertions of use in commerce. See U.S. Acceptable Identification of Goods and Services Manual - Notes, USPTO, <http://tess2.uspto.gov/netahtml/notes.html> (retrieved April 16, 2012) (hereinafter Notes to the ID Manual). Thus, conducting clinical trials for one's own goods in connection with a mark is not a good or service that can support registration of either a trademark or a service mark at the USPTO.

In light of these recent events, Medinol respectfully seeks leave to amend its Answer to the Amended Notice of Opposition to plead the counterclaim for cancellation of Opposer's Mark based on one or both of the following: (a) the failure to use the mark in commerce pursuant to 15 U.S.C. § 1051(d)(1) in connection with the goods or services identified by Opposer under International Classes 10 or 42, respectively, in the Application Serial No. 77/693,458; and/or (b) the making of fraudulent and/or false representations to the USPTO that were material and resulted and caused Opposer's CHAMPION registration to issue and remain in effect.

LEGAL STANDARD

“The Board liberally grants leave to amend pleadings at any stage of the proceeding when justice requires, unless entry of the proposed amendment would violated settled law or be prejudicial to the rights of the adverse party.” Zenella Ltd. v. Nordstrom, Inc., 90 U.S.P.Q.2d 1758, Opp. No. 91177858 (TTAB 2009) (internal citation omitted); see also TBMP § 507.02.

Under 37 CFR § 2.107(a), pleadings in an opposition “may be amended in the same manner and to the same extent as in a civil action in a United States district court.” Under Fed. R. Civ. P. 15(a), “a party may amend its pleading” at any time before trial with “the court’s leave,” and “[t]he court should freely give leave when justice so requires.” See also 3-15 MOORE’S FEDERAL PRACTICE § 15.02[1] (3d Ed. 2012) (Fed. R. Civ. P. 15(a) “allows for liberal amendment in the interests of resolving cases on the merits.”). Specifically with regard to an “attack[on] the validity of any one or more of the registrations pleaded in the opposition,” 37 CFR § 2.106(b)(2)(i) provides that, where “grounds for a counterclaim are learned during the course of opposition proceedings, the counterclaim shall be pleaded promptly after the grounds therefor are learned.” See, also, TBMP § 313.04. In such a instance where compulsory counterclaims are involved, “the reasons for allowing [their] introduction by amendment become even more persuasive” in furtherance of justice and judicial economy. 6 Fed. Prac. & Proc. Civ. § 1430 (3d ed.); see also Rimkus Consulting Group, Inc. v. Cammarata, 257 F.R.D. 127, 134 (S.D. Tex. 2009) (compulsory counterclaim would not delay suit or prejudice the opposing party because it involved the same transaction or occurrence as the opposing party’s claim); Cabana v. Forcier, 200 F.R.D. 9, 13 (D. Mass. 2001).

ARGUMENT

I. APPLICANT'S MOTION FOR LEAVE TO AMEND IS TIMELY FILED

Medinol's motion for leave to amend is timely because the relevant facts were only discovered within the past month, and they both occurred and were discovered well after the pleadings deadline. Thus, Medinol could not have included this counterclaim "at the time when the answer [was] filed" and leave to amend the answer accordingly is proper. 37 C.F.R. § 2.106(b)(2)(i).

In cases before the Board, if the case "is still in the pre-trial stage (i.e., in discovery, or prior to any testimony having been taken by the plaintiff in its testimony period), leave to amend, if otherwise appropriate, will be allowed." Beth A. Chapman, TIPS FROM THE TTAB: Amended Pleadings: The Right Stuff, 81 TRADEMARK REP. 302, 305 (1991); see also Focus 21 Int'l Inc. v. Pola Kasei Kogyo Kabushiki Kaisha, 22 U.S.P.Q.2d 1316, 1318 (TTAB 1992) (motion for leave to amend filed before opening of testimony period granted); Cool-Ray Inc. v. Eye Care, Inc., 183 U.S.P.Q. 618, 621 (TTAB 1974) (motion for leave to amend filed before the testimony period).

Here, the case remains well within the discovery period; no testimony or other document discovery has been taken by either side. This proceeding is still in the discovery stage and Medinol has not delayed in bringing the instant Motion to Amend after learning of facts that Opposer's Mark was improperly registered. See, e.g., Zanella Ltd. V. Nordstrom, Inc., 90 U.S.P.Q.2d 1758, 1759 (TTAB 2008) (The Board found no prejudice to opposer in allowing applicant to amend its answer to add a counterclaim where three and a half months remained with respect to the discovery period.); Commodore Electronics Ltd. v. CBM Kabushiki Kaisha,

26 U.S.P.Q.2d 1503, 1505-6 (TTAB 1993); United States Olympic Committee v. O-M Bread Inc., 26 U.S.P.Q.2d 1221, 1223 (TTAB 1993).

In case the Board believes it would be appropriate, Medinol hereby consents to a reasonable extension of the discovery period, if necessary, to provide sufficient time for all relevant discovery on the issues presented in Medinol's proposed cancellation counterclaim. To the extent that Opposer needs to take any discovery to defend against Applicant's counterclaim, Opposer will have ample opportunity to do so.

II. ENTRY OF APPLICANT'S PROPOSED AMENDMENTS WILL NOT PREJUDICE THE OPPOSER

Entry of the proposed amendment to Medinol's pleading will not be prejudicial to the rights of the adverse party. The question of whether Opposer will be prejudiced by leave to amend Medinol's pleadings is largely determined by "[t]he timing of a motion for leave to amend." See Novo Nordisk A/S v. Insulet Corp., 2007 WL 2010785 at *2, Opp. No. 91155763 (TTAB 2007). Opposer is not prejudiced where – as here – Medinol has moved for leave to amend shortly after it learned of the grounds for cancellation. *Id.* In Novo Nordisk A/S, for example, the applicant moved for leave to amend on November 16, 2006, upon reviewing the opposer's registration while preparing a response to the opposer's motion for summary judgment. *Id.* Noting that "the [USPTO] did not approve opposer's Section 8 declaration until August 9, 2006", the Board held that the movant applicant "timely filed" the counterclaim for cancellation based on non-use of the mark, several months after the facts that formed the basis of the motion were first made publicly available. *Id.*

Here, Medinol could not have learned of the FDA advisory panel's decision until the release of the report declining to endorse the implantable heart device during the Champion Trial

on December 8, 2011¹. Rather, in or about March 2012, Medinol become aware that Opposer's Allegedly Use-Supporting Clinical Trials resulted in a negative assessment by an advisory panel of the FDA (hereinafter, "the FDA advisory panel"), and that this alleged use was not proper support for a valid registration with the USPTO. There upon, Medinol's counsel promptly contacted Opposer to suggest a further extension of the discovery period in order to consider settlement discussions in light of the FDA advisory panel's negative assessment. Opposer therefore cannot claim surprise or prejudice.

III. APPLICANT'S COUNTERCLAIMS ARE CONSISTENT WITH SETTLED LAW

As set forth above, there are substantial questions as to Opposer's purported rights in the CHAMPION mark, in connection with the goods identified in Class 10 and the services identified in Class 42, as asserted in Opposer's Amended Notice of Opposition. The aforementioned vote of the FDA advisory panel – while not binding on the agency – highlights the fact that CardioMEMS has not received FDA approval to market the medical devices tested in connection with Opposer's Mark and therefore could not have made a lawful commercial use of the mark on goods and services such as those identified in the underlying application to register Opposer's Mark.

As evident both from the Statement of Use submitted by Opposer and the Amended Notice of Opposition, Opposer relies entirely on the Clinical Trials as evidence of use of Opposer's Mark in commerce. However, the Clinical Trials are merely a preliminary step towards the possibility of lawful commercial use of the underlying goods. As recently clarified by the USPTO, "conducting one's own clinical trials does not constitute a service" for which a

¹ See FDA EXECUTIVE SUMMARY – ADDENDUM, Dec. 8, 2011, <http://www.fda.gov/downloads/AdvisoryCommittees/CommitteesMeetingMaterials/MedicalDevices/MedicalDevicesAdvisoryCommittee/CirculatorySystemDevicesPanel/UCM282272.pdf>.

mark may be registered. Rather, “for use-based applications the specimen must show that this activity is being done for the benefit of others.” Notes to the ID Manual. Thus, insofar as Opposer bases its use of the CHAMPION mark on “conducting [its] own clinical trials”, such use does not constitute “use in commerce” under 5 U.S.C. § 1051(d)(1). As such, the USPTO must cancel the registration of the Opposer’s Mark. Mountain Top Beverage Group, Inc. v. Wildlife Brewing N.B., Inc., 338 F. Supp. 2d 827, 835 (S.D. Ohio 2003), judgment aff’d, 432 F.3d 651, 80 U.S.P.Q.2d 1064, 2005 FED App. 0482P (6th Cir. 2005) (registration cancelled upon showing that specimen submitted by applicant consisted of a label for an alcoholic beverage that lacked the necessary government approval from the Bureau of Alcohol, Tobacco and Firearms and Explosives for lawful distribution).

In view of the Statement of Use submitted by Opposer as well as Opposer’s admissions contained in its Amended Notice of Opposition, the fact that the FDA has not approved such devices for use leads to one of two conclusions. Either Opposer must acknowledge that it has not used the mark in commerce in accordance with the applicable legal requirements – in which case the Opposer’s Mark was registered in error – or Opposer misrepresented its alleged “use in commerce” in connection with goods that constituted unapproved products at the time, which cannot be the basis for the acquisition of bona fide trademark rights. In either event, Opposer’s registration based on such alleged use is invalid and should be canceled. See 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMP., § 19:124 (4th ed. 2012); see also, 3 RUDOLPH CALLMANN, UNFAIR COMP., TRADEMARKS & MONOPOLIES, § 20:15 (4th ed. 2012); In re Stellar International, Inc., 159 U.S.P.Q. 48, 51 (TTAB 1968) (shipment of goods with labels non-compliant with the Federal Food, Drug, and Cosmetic Act was “unlawful shipment” from

which no right of registration could arise). Accordingly, the counterclaims proposed by Applicant are consistent with settled law.

IV. GRANT OF APPLICANT'S MOTION WILL SERVE THE INTERESTS OF JUSTICE

As explained above, the underlying basis for Opposer's registration is improper and contrary to the established principles of Trademark Law. Accordingly, it will serve the interests of justice to permit Medinol to plead and prove that Opposer's mark was registered on the basis of an improper assertion of use and thereby eliminate this erroneously registered mark from the Principal Register.

CONCLUSION

Because the proposed amendments have been made in good faith and without undue delay, and will not prejudice Opposer, and since denying Medinol the right to amend its pleading would be contrary to the interests of the Board in resolving this case on the merits, Medinol should be afforded the right to amend the Answer to the Amended Notice of Opposition.

Dated: April 26, 2012



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In re Serial No. 85/082098

Mark: CHAMPIONIR

Opposition No. 91200436

CERTIFICATE OF SERVICE

I hereby certify that on this date I served the attached document via e-mail to mbaratta@kilpatricktownsend.com, as agreed by the parties, to Opposer's counsel of record:

Olivia Maria Baratta, Esq.
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Dated: April 26, 2012


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In re Serial No. 85/082098

Mark: CHAMPIONIR

Opposition No. 91200436

**APPLICANT'S AMENDED ANSWER AND COUNTERCLAIM FOR CANCELLATION
TO OPPOSER'S AMENDED NOTICE OF OPPOSITION**

Applicant Medinol Ltd. ("Applicant"), by its undersigned attorney, hereby submits its Amended Answer and Counterclaim for Cancellation in response to the Amended Notice of Opposition filed by CardioMems, Inc. ("Opposer") as follows:

1. Applicant is without sufficient knowledge or information upon which to form a belief as to the truth of the allegations in Paragraph No. 1 and therefore denies same.
2. Applicant denies the allegations contained in Paragraph No. 2.
3. Applicant denies the allegations contained in Paragraph No. 3.
4. Applicant denies the allegations contained in Paragraph No. 4.
5. Applicant is without sufficient knowledge or information upon which to form a belief as to the truth of the allegations in Paragraph No. 5 and therefore denies same.
6. Applicant is without sufficient knowledge or information upon which to form a belief as to the truth of the allegations in Paragraph No. 6 and therefore denies same.

7. Applicant is without sufficient knowledge or information upon which to form a belief as to the truth of the allegations in Paragraph No. 7 and therefore denies same.
8. Applicant admits that Applicant applied to register its CHAMPIONIR mark for “stents” on the Principal Register with the U.S. Trademark Office on July 11, 2010 and the application was assigned Application Serial No. 85/082098 by the U.S. Trademark Office. Applicant denies all other allegations contained in Paragraph No. 8.
9. Applicant denies the allegations contained in Paragraph No. 9.
10. Applicant denies the allegations contained in Paragraph No. 10.
11. Applicant denies the allegations contained in Paragraph No. 11.
12. Applicant denies the allegations contained in Paragraph No. 12.
13. Applicant denies the allegations contained in Paragraph No. 13.
14. Applicant denies the allegations contained in Paragraph No. 14.
15. Applicant is without sufficient knowledge or information upon which to form a belief as to the truth of the allegations in Paragraph No. 15 and therefore denies same.
16. Applicant denies allegations contained in Paragraph No. 16.

AFFIRMATIVE DEFENSES

17. There is no likelihood of confusion, mistake, or deception because Applicant’s mark CHAMPIONIR is not confusingly similar to Opposer’s mark Champion alleged in the

Notice of Opposition, and/or as used on those goods and services alleged in the Notice of Opposition.

18. There is no dilution, tarnishment, degradation, or any other lessening or adverse or undesirable effect, or likelihood of any of the foregoing, because Applicant's mark, CHAMPIONIR, does not dilute, tarnish, degrade, or otherwise adversely affect or lessen the capacity of Opposer's mark Champion (and there is no likelihood of any of the foregoing) alleged in the Notice of Opposition.
19. On information and belief, Opposer has not continuously used its mark Champion since its alleged date(s) of first use on all of those products or services alleged in its Notice of Opposition, and has not used its mark(s) on all of those alleged products or services continuously since a date earlier than Applicant's date of filing of its application. Attached as Exhibit A is Opposer's Statement of Use filed by Opposer with the U.S. Trademark Office on August 8, 2011 which claims August 5, 2011 as the date of first use of Opposer's mark Champion in commerce for all goods in International Class 10 currently identified in Opposer's Application No. 77/693458, which date of first use in commerce is well after the July 11, 2010 filing date of Applicant's application for its CHAMPIONIR mark.

COUNTERCLAIM

Applicant counterclaims for cancellation of Opposer's U.S. Trademark Registration No. 4029193 for the mark CHAMPION in International Classes 10 and 42. The grounds for cancellation are as follows:

1. On or about March 18, 2009, Opposer filed an application in the United States Patent and Trademark Office (“USPTO”) for registration, on an intent-to-use basis, of the CHAMPION mark in International Classes 9, 10, and 42.¹ This application was assigned Serial No. 77/693468.
2. Following Opposer’s filing of multiple extension requests to show evidence of use of the mark, Opposer filed a Statement of Use with the USPTO on August 5, 2011. The Statement of Use included specimens attached as Exhibit B, including (i) an image described by Opposer as a “Shipment of Applicant’s goods for testing showing use of the mark” and having a label stamped SAMPLE NOT FOR HUMAN USE; and (ii) a “Screen shot from website”. The USPTO registered Opposer’s CHAMPION mark on September 20, 2011 under U.S. Trademark Registration No. 4029193. The USPTO issued the CHAMPION registration for: “Medical diagnostic sensors for measuring properties of the body, namely, pressure, corresponding catheter-based delivery apparatus to deliver sensors to locations within the body; telemetry devices for medical application and software to interrogate, receive, process and display pressure data or derived quantities for viewing and printing sold as a unit” in International Class 10; and “Providing a web site that enables users to upload and access health and medical data” in International Class 42.
3. The USPTO registered Opposer’s mark based on and in reliance upon Opposer’s Statement of Use and dates of use in commerce claimed therein. In the declaration that accompanied the Statement of Use, Opposer swore, under the penalties of 18 USC §1001,

¹ Opposer subsequently deleted International Class 9 from its application.

that, inter alia, the mark has been in use in commerce on all goods in International Class 10 and in connection with all services in International Class 42 since the dates claimed in the Statement of Use and the mark is currently in use in such commerce on all such goods and services. Upon information and belief and based on the following, these statements are untrue. Specifically, Opposer's statement of use was based on improper grounds including, inter alia, use in clinical trials conducted solely for Opposer's benefit in contravention of statutory and regulatory requirements.

4. In its Amended Notice of Opposition, Opposer claims that it has used the CHAMPION mark "in commerce in connection with a now-completed clinical trial involving the Class 10 goods recited in Application Serial No. 77/693458." See Opposer's Amended Notice of Opposition, ¶4. Furthermore, upon information and belief and based on Opposer's announcement on its own web site, attached herewith as Exhibit C (CardioMems Completes CHAMPION Clinical Trial Study, CardioMems, June 1, 2010, <http://www.cardiomems.com/content.asp?display=news&view=17> (retrieved April 20, 2012)), Opposer's clinical trial of the goods identified in International Class 10 and services identified in International Class 42 of its application and allegedly provided under the CHAMPION mark ended before June 1, 2010.
5. Despite the alleged 2007 date of use in commerce of the CHAMPION mark in the Amended Notice of Opposition and end of the clinical trial in 2010, Opposer filed three extensions of time to submit a Statement of Use, and filed the Statement of Use with the USPTO only on the same date as the Amended Notice of Opposition and over a month after instituting the current opposition with the Board. Furthermore, in its Statement of Use, Opposer stated that the dates of first use of its CHAMPION mark in commerce were

(i) August 5, 2011 for goods identified in International Class 10 in its application, and (ii) December 2, 2008 for services identified in International Class 42 in its application.

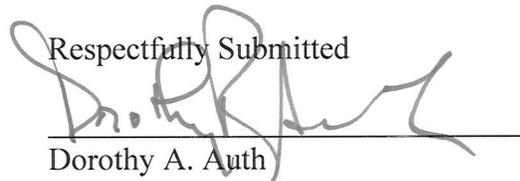
6. Upon information and belief, the alleged uses were actually based only on clinical trials sponsored by and done for the benefit of Opposer. Moreover, the alleged use of the CHAMPION mark have resulted to date in a negative assessment by the United States Food and Drug Administration. It is evident therefore that Opposer could not have lawfully used the product(s) being tested in the clinical trials in interstate commerce to date. Upon information and belief, it is evident that Opposer misrepresented use of its CHAMPION mark in commerce in violation of 15 USC §1064(3), and Opposer knowingly made false, material misrepresentations of fact in procuring the registration with the intent to defraud the USPTO. Specifically, upon information and belief, Opposer knew that its CHAMPION mark was not in use in connection with the goods and services referenced in the Statement of Use at the time that the Statement of Use was filed and made such false, material misrepresentations of fact with the intent to defraud the USPTO. Additionally, further evidence in support of Applicant's claim of fraud by Opposer is likely to be discovered during the discovery period of the opposition.
7. Opposer's CHAMPION registration must be cancelled for failure to use the CHAMPION mark and fraud and/or false representations to the USPTO that were material and resulted and caused Opposer's CHAMPION mark to issue and remain in effect.
8. Applicant is harmed by Opposer's trademark registration of the CHAMPION because, inter alia, it is being asserted by Opposer against Applicant's Application Serial No.

85/082098 (filed on July 11, 2010 for “Stents” in International Class 10) in this proceeding and delaying registration of Applicant’s mark.

9. The Director is authorized to debit Deposit Account No. 50-4387 in the amount of \$600.00 for this Amended Answer and Counterclaim for Cancellation, and for any other fees that may be incurred by this filing.

WHEREFORE, Applicant prays that the Opposer’s Notice of Opposition be dismissed in its entirety, Opposer’s Registration No. 4029193 be cancelled in its entirety, and for such further relief as the Trademark Trial and Appeal Board deems appropriate and necessary, including but not limited to the resetting of all upcoming deadlines in this opposition.

Respectfully Submitted



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Trademark/Service Mark Statement of Use (15 U.S.C. Section 1051(d))

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77693458
LAW OFFICE ASSIGNED	LAW OFFICE 102
EXTENSION OF USE	NO
MARK SECTION	
MARK	CHAMPION
OWNER SECTION (no change)	
GOODS AND/OR SERVICES SECTION	
INTERNATIONAL CLASS	010
CURRENT IDENTIFICATION	Medical diagnostic sensors for measuring properties of the body, namely, pressure, corresponding catheter-based delivery apparatus to deliver sensors to locations within the body; telemetry devices for medical application and software to interrogate, receive, process and display pressure data or derived quantities for viewing and printing sold as a unit
GOODS OR SERVICES	KEEP ALL LISTED
FIRST USE ANYWHERE DATE	09/13/2007
FIRST USE IN COMMERCE DATE	08/05/2011
SPECIMEN FILE NAME(S)	\\TICRS\EXPORT1\IMAGEOUT 11\776\934\77693458\xml7\SOU0002.JPG
SPECIMEN DESCRIPTION	Shipment of Applicant's goods for testing showing use of the mark.
INTERNATIONAL CLASS	042
CURRENT IDENTIFICATION	Providing a web site that enables users to upload and access health and medical data
GOODS OR SERVICES	KEEP ALL LISTED

FIRST USE ANYWHERE DATE	09/13/2007
FIRST USE IN COMMERCE DATE	12/02/2008
SPECIMEN FILE NAME(S)	
ORIGINAL PDF FILE	SPN1-12141226-153746592 . CHAMPION Class 42 second screen.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT1\IMAGEOUT1\1\776\934\77693458 \xml7\SOU0003.JPG
SPECIMEN DESCRIPTION	Screen shot from website.
REQUEST TO DIVIDE	NO
PAYMENT SECTION	
NUMBER OF CLASSES IN USE	2
SUBTOTAL AMOUNT [ALLEGATION OF USE FEE]	200
TOTAL AMOUNT	200
SIGNATURE SECTION	
DECLARATION SIGNATURE	/David Stern/
SIGNATORY'S NAME	David Stern
SIGNATORY'S POSITION	Senior Vice President
DATE SIGNED	08/05/2011
FILING INFORMATION	
SUBMIT DATE	Fri Aug 05 16:06:39 EDT 2011
TEAS STAMP	USPTO/SOU-12.1.41.226-201 10805160639587199-7769345 8-48055bc9d3ca43c83135784 494f6c93a5d-CC-2379-20110 805153746592032

**Trademark/Service Mark Statement of Use
(15 U.S.C. Section 1051(d))**

To the Commissioner for Trademarks:

MARK: CHAMPION
SERIAL NUMBER: 77693458

The applicant, CardioMEMS, Inc., having an address of
387 Technology Circle, N.W., Suite 500
Atlanta, Georgia 30313
United States

is submitting the following allegation of use information:

For International Class 010:

Current identification: Medical diagnostic sensors for measuring properties of the body, namely, pressure, corresponding catheter-based delivery apparatus to deliver sensors to locations within the body; telemetry devices for medical application and software to interrogate, receive, process and display pressure data or derived quantities for viewing and printing sold as a unit

The mark is in use in commerce on or in connection with all goods or services listed in the application or Notice of Allowance or as subsequently modified for this specific class

The mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as 09/13/2007, and first used in commerce at least as early as 08/05/2011, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) Shipment of Applicant's goods for testing showing use of the mark..

Specimen File1

For International Class 042:

Current identification: Providing a web site that enables users to upload and access health and medical data

The mark is in use in commerce on or in connection with all goods or services listed in the application or Notice of Allowance or as subsequently modified for this specific class

The mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as 09/13/2007, and first used in commerce at least as early as 12/02/2008, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) Screen shot from website..

Original PDF file:

SPN1-12141226-153746592 . CHAMPION Class 42 second screen.pdf

Converted PDF file(s) (1 page)

Specimen File1

The applicant is not filing a Request to Divide with this Allegation of Use form.

A fee payment in the amount of \$200 will be submitted with the form, representing payment for the allegation of use for 2 classes.

Declaration

Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). Applicant is the owner of the mark sought to be registered, and is using the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the form or any resulting registration, declares that he/she is properly authorized to execute this form on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /David Stern/ Date Signed: 08/05/2011

Signatory's Name: David Stern

Signatory's Position: Senior Vice President

RAM Sale Number: 2379

RAM Accounting Date: 08/08/2011

Serial Number: 77693458

Internet Transmission Date: Fri Aug 05 16:06:39 EDT 2011

TEAS Stamp: USPTO/SOU-12.1.41.226-201108051606395871

99-77693458-48055bc9d3ca43c83135784494f6

c93a5d-CC-2379-20110805153746592032

Search:

Opposition

Number: 91200436

Filing Date: 06/29/2011

Status: Pending

Status Date: 06/29/2011

Interlocutory Attorney: ROBERT COGGINS

Defendant

Name: Medinol Ltd.

Correspondence: ANNA ERENBURG
 CADWALADER, WICKERSHAM & TAFT LLP
 1 WORLD FINANCIAL CTR 19TH FL
 NEW YORK, NY 10281
 UNITED STATES
 docketing@cw.com

Serial #: 85082098

Application File

Application Status: Opposition Pending

Mark: CHAMPIONIR

Plaintiff

Name: CardioMEMS, Inc.

Correspondence: Olivia Maria Baratta
 Kilpatrick Townsend & Stockton LLP
 1100 Peachtree St. NE., Suite 2800
 Atlanta, GA 30309
 UNITED STATES
 tadmin@kilpatricktownsend.com, mbaratta@kilpatricktownsend.com,
 vnorthcutt@kilpatricktownsend.com

Serial #: 77693458

Application File

Application Status: SU - Registration Review Complete

Mark: CHAMPION

Prosecution History

#	Date	History Text	Due Date
6	08/19/2011	<u>ANSWER</u>	
5	08/08/2011	<u>ANSWER</u>	
4	08/05/2011	<u>P'S MOTION TO AMEND PLEADING/AMENDED PLEADING</u>	
3	06/29/2011	PENDING, INSTITUTED	
2	06/29/2011	<u>NOTICE AND TRIAL DATES SENT; ANSWER DUE:</u>	08/08/2011
1	06/29/2011	<u>FILED AND FEE</u>	

Search:

EXHIBIT B

CHAMPION
HF Monitoring System

Manufacturer:
Cardinal Health, Inc.
211 South Tower Corporate
Avenue, St. Louis, MO 63103
www.cardinalhealth.com

Cardinal Health
One HF Pressure Sensor Module with Drive-In System
One HF Pressure Sensor Module with Drive-In System



REF
Lot
SN

CAL
Use by

STERILE

Single Use Only
Do Not Reuse for...
Not for use on...
Not for use on...

Do not use if package is opened or damaged.
For use on...
For use on...

For Support Visit
Our Support Center
At: www.cardinalhealth.com

REF
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CAL
Use by

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CAL
Use by

Cardinal Health
One HF Pressure Sensor
Part No. 80-010-004-01
Lot No. 0010101
Serial No. 0000000000
Cal. Code: 3770-163500-0000-1430
Exp. Date: 05/2013

CE 0197

REF
Lot
SN

REF
Lot
SN

CAL
Use by

CHAMPION HF



Patients

Medical Conditions

Drugs

Global Thresholds

Global Settings

Users

Logout

Logged in as:
admin@cardiomems.com

[Thumbdrive Import](#)

	Name	DOB	Physician	Last Reading	Last PA Mean	
VIEW				29 Sep 15:37	10.97 mmHg	
VIEW				23 Nov 21:38	0.70 mmHg	
VIEW				28 Nov 12:21	0.90 mmHg	
VIEW				29 Nov 11:05	58.90 mmHg	
VIEW				30 Sep 11:56	15.64 mmHg	
VIEW				30 Sep 15:21	26.86 mmHg	
VIEW				30 Sep 16:05	26.73 mmHg	
VIEW				30 Sep 16:52	17.59 mmHg	
VIEW				05 Aug 09:40	30.14 mmHg	
VIEW				05 Aug 13:24	-2.62 mmHg	
VIEW				05 Aug 07:24	33.79 mmHg	
VIEW				05 Aug 08:16	31.62 mmHg	
VIEW				16 Jun 09:26	56.55 mmHg	
VIEW				05 Aug 10:01	38.69 mmHg	
VIEW				25 Jul 06:55	56.63 mmHg	
VIEW				05 Aug 12:06	50.13 mmHg	
VIEW				27 Jan 19:37	31.60 mmHg	
VIEW				25 Jul 15:31	25.44 mmHg	
VIEW				26 Jul 17:01	12.89 mmHg	
VIEW				19 Oct 11:50	40.10 mmHg	

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Need Help?

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EXHIBIT C



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CardioMEMS Completes CHAMPION Clinical Trial Study

Study results indicate that the CardioMEMS implantable hemodynamic monitoring system significantly reduces the leading cause of hospitalizations in the U.S.

Atlanta – June 1, 2010. The CHAMPION (CardioMEMS Heart Sensor Allows Monitoring of Pressure to Improve Outcomes in NYHA Class III Patients) trial met its primary efficacy endpoint with a 30% reduction in heart failure hospitalization rates at 6 months ($p < 0.001$) in heart failure patients whose treatment was guided by pulmonary artery pressures obtained through a miniature, permanent wireless implant.

The results were presented this week at the European Society of Cardiology Heart Failure Congress 2010 in Berlin, Germany, by the principal investigators of the trial: William Abraham, M.D., Director of the Division of Cardiovascular Medicine at The Ohio State University Medical Center, and Philip Adamson, M.D., Director of the Heart Failure Institute at the Oklahoma Heart Hospital. The study was sponsored by CardioMEMS, Inc., a medical technology company that has developed a novel wireless sensing and communication technology for the human body.

The CHAMPION trial evaluated the safety and effectiveness of CardioMEMS' heart failure (HF) pressure measurement system in New York Heart Association Class III (NYHA Class III) heart failure patients; these patients experience symptoms of heart failure with only mild exertion. NYHA Class III represents roughly 1.5 million of the six million heart failure patients in the U.S., and historically accounts for nearly half of all heart failure hospitalizations.

The CHAMPION Trial enrolled 550 patients, who had been hospitalized for heart failure in the previous year, at 64 leading heart centers in the U.S. All subjects received the heart failure sensor as a permanent pulmonary artery implant and were then randomized to the treatment or control group before discharge. Prior to enrollment in the CHAMPION study, these patients were being treated by heart failure specialists at leading centers and were receiving optimal drug, device and disease management therapy.

The reduction in the risk of a heart failure related hospitalization at 6 months was 30% and the impact on hospitalizations continued to increase over time, reaching 38% per year over the full duration of the trial. The average patient follow-up was 15 months. The safety profile of the device was positive: none of the implanted sensors needed to be removed or replaced and all were functioning throughout the course of the trial.

"Pulmonary artery pressure monitoring using the CardioMEMS Champion™ Heart Failure Pressure Management System represents our first meaningful improvement for the management of heart failure in nearly a decade," said Dr. Abraham. "We were pleased to see that the patient benefit was robust and durable and actually increased beyond the primary endpoint of 6 months; this is a key point for patients, doctors and the healthcare system."

Dr. Adamson added, "The CHAMPION trial illustrates how monitoring of patients with chronic heart failure can reduce the need for costly hospitalizations while improving quality of life. These trial results hold great promise for patients suffering from chronic symptomatic heart failure."

The wireless heart failure sensor is an innovative miniature device that is implanted into the patient's pulmonary artery using a simple, catheter-based technique. Following the procedure, patients perform wireless measurements of their pulmonary artery pressure from home. The pressure data is immediately transmitted to a secure database and is available for review by the patient's physician or nurse on the CardioMEMS Champion website.

"Frequent and unpredictable hospitalizations are very traumatic for heart failure patients and their families and we are gratified to be able to reduce their occurrence," said Jay Yadav, M.D., Co-Founder and CEO of CardioMEMS and cardiologist at the Piedmont Heart Institute. "Using the Champion Heart Failure Management System, doctors can obtain critical information that previously required a cardiac catheterization. Patients can perform these readings from their homes and with this vital information, doctors and nurses can more effectively take care of their patients and keep them out of the hospital."

Caution – Investigational Device. Limited by federal law to investigational use.

About CardioMEMS, Inc.

CardioMEMS is a medical device company that has developed and is commercializing proprietary wireless sensing and communication technology for the human body. Its technology platform is designed to improve the management of severe chronic cardiovascular diseases such as aneurysms, heart failure and hypertension. CardioMEMS miniature wireless sensors can be implanted using minimally-invasive techniques and transmit cardiac output, blood pressure and heart rate data which are critical to the management of patients. The sensors can be permanently implanted into the heart and blood vessels due to their small size, durability and lack of wires and batteries. Using radiofrequency (RF) energy, the sensors transmit real-time data to external electronic readers, which then communicate this information to the patient's

physician. More information about CardioMEMS is located at www.cardiomems.com.

Statements made in this press release that look forward in time or that express beliefs, expectations or hopes regarding future occurrences or anticipated outcomes are forward-looking statements. A number of risks and uncertainties such as risks associated with product development and commercialization efforts, expected timing or results of any clinical trials, ultimate clinical outcome and perceived or actual advantages of the Company's products, market and physician acceptance of the products, intellectual property protection, and competitive offerings could cause actual events to adversely differ from the expectations indicated in these forward looking statements.

CardioMEMS is a registered trademark of CardioMEMS, Inc. Champion and the CardioMEMS logo are trademarks of CardioMEMS, Inc.