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

Proceeding	91205774
Party	Defendant Extremity Medical, LLC
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Submission	Answer
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Date	08/06/2012
Attachments	2012-08-06 IO FIX PLUS Intra Fix Design Answer to Notice of Opposition.pdf ( 10 pages )(2011019 bytes )

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

BAXANO, INC.,  Opposer  v.  EXTREMITY MEDICAL, LLC  Applicant.	Trademark Application Opposed  Mark:  Serial No.:                   85/462,826 Filed:                         11/2/2011 Published:                  June 26, 2012 Opposition No.:           91205774
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**ANSWER AND AFFIRMATIVE DEFENSES TO NOTICE OF OPPOSITION**

Extremity Medical, LLC (hereinafter “Applicant”) hereby answers the Notice of Opposition of Baxano, Inc. (hereinafter collectively “Opposer”). Paragraph numbers 1 – 19 correspond to the numbered paragraphs in the Notice of Opposition. Applicant reserves the right to amend or supplement this Answer as appropriate.

1. Denied.
2. Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in this paragraph, and therefore denies same.
3. Applicant admits that what purports to be copies of Opposer’s registration certificates and corresponding TARR status reports of the IOFLEX Marks is attached as Exhibit A to the Notice of Opposition. Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations contained in this paragraph, and therefore denies same.
4. Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegation that Opposer’s IOFLEX Marks have been used in connection with its goods and services since October 7, 2009 and is currently being used in commerce in association with such goods and services, and therefore denies same. Applicant denies the remaining allegations contained in this paragraph.
5. Denied.

6. Denied.
7. Admitted.
8. Admitted.
9. Admitted that the side-by-side comparison of Opposer's Mark and Applicant's Mark contains an accurate depiction of both marks. Admitted that Applicant's Mark contains a stylized "X," which is in the form of an "X-Man" represented by the abstract design of a person with a solid circle for a head and two curved lines of increasing thickness running from left hand to right foot and right hand to left foot as well as an arc over the man's head. Applicant denies the remaining allegations of this paragraph.<sup>1</sup>
10. Denied.
11. Denied.
12. Denied.
13. Applicant admits that its Trademark Application Serial No. 85/462,826 was filed on an intent-to-use basis on November 2, 2011. Applicant denies the remaining allegations contained in this paragraph.
14. Denied.
15. Admitted, except denied to the extent this paragraph of Opposer's Opposition implies that Applicant would need Opposer's consent or authorization to use or register Applicant's Mark.
16. Denied.
17. Denied.
18. Denied.
19. Denied.

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<sup>1</sup> Applicant owns U.S. Trademark Reg. No. 3,684,368 for its "X-Man" (attached as Ex. A) registered on September 15, 2009, more than one year prior to any of Opposer's IOFLEX Marks.

**AFFIRMATIVE DEFENSES**

Applicant sets forth below its affirmative defenses. By setting forth these affirmative defenses, Applicant does not assume the burden of proving any fact, issues, or element of a cause of action where such burden properly belongs to Opposer. Moreover, nothing stated herein is intended or shall be construed as an acknowledgement that any particular issue or subject matter is relevant to Opposer’s allegations.

1. Opposer’s action is barred because Opposer fails to state a claim upon which relief may be granted.
2. Opposer’s action is barred by the *Morehouse* (prior registration) Defense. Applicant is the exclusive owner of U.S. Trademark Registration Nos. 4,057,095 and 4,057,096 (attached as Ex. B). The Registered Marks are substantially identical to Applicant’s Mark, for identical goods. To illustrate, below is a side-by-side comparison of the Registered Marks and the contested Applicant’s Mark:

<u>Registered Mark</u> Reg. No. 4,057,095	<u>Registered Mark</u> Reg. No. 4,057,096	<u>Applicant’s Mark</u> (contested by Opposer)
		

Opposer will not be damaged by the issuance of Applicant’s Mark because Applicant already owns registrations for substantially the same mark for the same goods.

3. Applicant asserts that there is no likelihood of confusion because Opposer’s Marks are dissimilar in their overall appearance, meaning and commercial impression.
4. Applicant asserts that there is no likelihood of confusion because there is no evidence of any actual confusion by consumers between the goods offered by the Applicant and the goods and/or services offered by the Opposer.
5. Applicant asserts that there is no likelihood of confusion because the consumers of Applicant’s goods are sufficiently sophisticated to know that Opposer’s goods and/or services are unrelated to those of Applicant.
6. Applicant asserts that there is no likelihood of dilution, either by blurring or tarnishment, between Opposer’s Marks and Applicant’s Marks.

7. Applicant hereby gives notice that it intends to rely on any additional affirmative defenses that become available or apparent during discovery and thus reserves the right to amend its answer to assert such additional affirmative defenses.

Wherefore, Applicant respectfully requests that the Board dismiss the above-captioned Notice of Opposition for lack of merit, allow U.S. Trademark Application Serial No. 85/462,826 to register, and to grant any other relief the Board deems appropriate.

Dated: August 6, 2012

Respectfully submitted,

/s/ Michael J. Zinna  
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*Attorneys for Applicant*

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing was served via Federal Express on the 6<sup>th</sup> of August 2012 to the following address:

GREENBERG TRAURIG, LLP

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By: /s/ Michael J. Zinna  
Michael J. Zinna  
Attorney of Record

# EXHIBIT A

# United States of America

United States Patent and Trademark Office



**Reg. No. 3,684,368** EXTREMITY MEDICAL LLC (NEW JERSEY LIMITED LIABILITY COMPANY)  
Registered Sep. 15, 2009 SUITE 410

300 INTERPACE PARKWAY  
PARSIPPANY, NJ 07054

**Int. Cl.: 10**

FOR: MEDICAL DEVICES, NAMELY, ORTHOPEDIC IMPLANTS AND ORTHOPEDIC  
SURGICAL INSTRUMENTS, IN CLASS 10 (U.S. CLS. 26, 39 AND 44).

**TRADEMARK**

**PRINCIPAL REGISTER**

FIRST USE 1-15-2009; IN COMMERCE 1-15-2009.

THE MARK CONSISTS OF THE LETTER "X" WHERE THE "X" IS REPRESENTED AS A  
STYLIZED PERSON WITH A SEMI-CIRCLE ABOVE THE STYLIZED PERSON.

SN 77-611,737, FILED 11-11-2008.

PAUL MORENO, EXAMINING ATTORNEY



*David J. Kyjars*

Director of the United States Patent and Trademark Office

# EXHIBIT B

# United States of America

United States Patent and Trademark Office

# IO Fix

**Reg. No. 4,057,095**

**Registered Nov. 15, 2011**

**Int. Cl.: 10**

**TRADEMARK**

**PRINCIPAL REGISTER**

EXTREMITY MEDICAL, LLC (NEW JERSEY LIMITED LIABILITY COMPANY)  
SUITE 410  
300 INTERPACE PARKWAY  
PARSIPPANY, NJ 07054

FOR: MEDICAL DEVICES, NAMELY, INTRAMEDULLARY FUSION DEVICES, IN CLASS  
10 (U.S. CLS. 26, 39 AND 44).

FIRST USE 5-0-2011; IN COMMERCE 5-0-2011.

OWNER OF U.S. REG. NOS. 3,652,074, 3,756,648, AND OTHERS.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "IO FIX", APART FROM THE  
MARK AS SHOWN.

THE MARK CONSISTS OF THE TERMS, "IO FIX", WITH THE "X" REPRESENTED BY THE  
DESIGN OF A PERSON WITH A SOLID CIRCLE FOR A HEAD AND A THIN LINE CURVED  
DOWNWARD AND RUNNING FROM THE LEFT HAND TO THE RIGHT HAND OF THE  
PERSON.

SN 85-012,995, FILED 4-13-2010.

BARBARA A. GOLD, EXAMINING ATTORNEY



*David J. Kyffers*

Director of the United States Patent and Trademark Office

# United States of America

United States Patent and Trademark Office



**Reg. No. 4,057,096**

**Registered Nov. 15, 2011**

**Int. Cl.: 10**

**TRADEMARK**

**PRINCIPAL REGISTER**

EXTREMITY MEDICAL, LLC (NEW JERSEY LIMITED LIABILITY COMPANY)  
SUITE 410  
300 INTERPACE PARKWAY  
PARSIPPANY, NJ 07054

FOR: MEDICAL DEVICES, NAMELY, INTRAMEDULLARY FUSION DEVICES, IN CLASS 10 (U.S. CLS. 26, 39 AND 44).

FIRST USE 5-0-2011; IN COMMERCE 5-0-2011.

OWNER OF U.S. REG. NOS. 3,652,074, 3,756,648, AND OTHERS.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "IO FIX INTRA OSSEOUS FIXATION", APART FROM THE MARK AS SHOWN.

THE MARK CONSISTS OF THE TERMS, "IO FIX", WITH THE "X" REPRESENTED BY THE DESIGN OF A PERSON WITH A SOLID CIRCLE FOR A HEAD AND A THIN LINE CURVED DOWNWARD AND RUNNING FROM THE LEFT HAND TO THE RIGHT HAND OF THE PERSON, ABOVE THE WORDS, "INTRA OSSEOUS FIXATION", WITHIN A SOLID RECTANGLE DESIGN.

SN 85-013,050, FILED 4-13-2010.

BARBARA A. GOLD, EXAMINING ATTORNEY



*David J. Kyffers*

Director of the United States Patent and Trademark Office