

ESTTA Tracking number: **ESTTA510596**

Filing date: **12/12/2012**

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	Masimo Corporation
Granted to Date of previous extension	12/12/2012
Address	40 Parker Irvine, CA 92618 UNITED STATES

Attorney information	Deborah S. Shepherd Knobbe Martens Olson & Bear, LLP 2040 Main Street, 14th Floor Irvine, CA 92614 UNITED STATES efiling@kmob.com Phone:949-760-0404
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**Applicant Information**

Application No	85580018	Publication date	08/14/2012
Opposition Filing Date	12/12/2012	Opposition Period Ends	12/12/2012
Applicant	Tandem Diabetes Care, Inc. 11045 Roselle Street, Suite 200 San Diego, CA 92121 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 010. All goods and services in the class are opposed, namely: Infusion sets
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**Grounds for Opposition**

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.	1941315	Application Date	02/21/1995
Registration Date	12/12/1995	Foreign Priority Date	NONE
Word Mark	SET		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1994/11/17 First Use In Commerce: 1994/11/17 electronic sensors and monitors for extracting signals from data containing noise Class 010. First use: First Use: 1994/11/17 First Use In Commerce: 1994/11/17 in vivo patient monitors and sensors for detecting a physiological condition

Attachments	MASIMOT.518M-OPP.pdf ( 6 pages )(206039 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Deborah S. Shepherd/
Name	Deborah S. Shepherd
Date	12/12/2012

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

MASIMO CORPORATION,

Opposer,

v.

TANDEM DIABETES CARE, INC.,

Applicant.

Serial No. 85/580,018

Opposition No. \_\_\_\_\_

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, on

December 12, 2012
Date

Deborah S. Shepherd
Deborah S. Shepherd

NOTICE OF OPPOSITION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir or Madam:

Masimo Corporation, a Delaware corporation, located and doing business at 40 Parker, Irvine, California 92618 (hereinafter referred to as "Opposer") believes that it will be damaged by the registration of U.S. Trademark Application Serial No. 85/580,018 for the mark T:SET in International Classes 10 ("Applicant's Application"), filed by Tandem Diabetes Care, Inc., a Delaware corporation, located and doing business at 11045 Roselle Street Suite 200, San Diego, California 92121 (hereinafter referred to as "Applicant") and therefore opposes the same.

A description of Applicant's Application is as follows:

Mark : T:SET
Serial No. : 85/580,018

Filed : March 26, 2012  
Published : August 14, 2012  
Int'l. Class : 10  
Alleged Date  
of First Use : ITU Application  
Goods : Infusion sets

As grounds for opposition, it is alleged:

1. Founded in 1989, Opposer is a leading medical technology company. Opposer develops, licenses and markets medical signal processing technologies and products for the noninvasive monitoring of patient vital signs under the mark SET (the "SET Mark"). Since at least as early as November 17, 1994 and long prior to the acts of Applicant, Opposer has used the SET Mark.

2. On March 26, 2012, Applicant filed Application Serial No. 58/580,018 for the mark T:SET covering goods in International Class 10.

3. Since at least before the filing date of Applicant's Application, Opposer has continuously used and promoted the SET Mark in interstate commerce in connection with its goods. By virtue of Opposer's continuous and substantial use, the SET Mark has become an identifier of Opposer and its goods, and distinguishes Opposer's goods from the goods of others. As a result, Opposer has built up, at great expense and effort, valuable goodwill in the SET Mark. Therefore, Opposer has strong common law rights associated with the SET Mark.

4. Opposer is the owner of and relies upon United States Trademark Registration No. 1,941,315 for the mark SET for "electronic sensors and monitors for extracting signals from data containing noise" in International Class 9 and "in vivo patient monitors and sensors for detecting physiological condition" in International Class 10 (the "'315 Registration"), which was registered on the Principal Register on December 12, 1995. This registration is incontestable

pursuant to § 33(b) of the Lanham Act, 15 U.S.C. § 1115(b). The '315 Registration is based on an application filed in the U.S. Patent and Trademark Office ("PTO") on February 21, 1995, and claims a date of first use in commerce at least as early as November 17, 1994. Thus, the date of first use, application date and registration date of the mark shown in the '315 Registration are all prior to the filing date of Applicant's Application.

5. Opposer's '315 Registration is valid, subsisting, unrevoked and uncancelled, as such it constitutes *prima facie* evidence of the validity of the registered mark and of registration thereof, and of Opposer's ownership of the mark shown therein and of Opposer's exclusive right to use the mark in commerce in connection with the goods named therein, without condition or limitation. Opposer's '315 Registration also constitutes notice to Applicant of Opposer's claim of ownership of the mark shown therein, as provided in Section 7(b), 22 and 33(a) of the Trademark Act of 1946, as amended.

6. Opposer has used the SET Mark in connection with "electronic sensors and monitors for extracting signals from data containing noise" and "in vivo patient monitors and sensors for detecting a physiological condition" since at least as early as November 17, 1994. Opposer's use of its SET Mark covered by the '315 Registration has been valid and continuous since prior to the actual filing date of Applicant's Application.

7. In addition to the protection afforded Opposer by its '315 Registration, Opposer has extensive, non-registered, statutory and common-law rights in the SET Mark for its goods throughout the United States. Opposer's common law rights in the SET Mark predate the filing date of Applicant's Application.

8. Opposer's date of first use and filing date for Opposer's '315 Registration precede the filing date of the Applicant's Application. The mark shown in Applicant's Application so

resembles the SET Mark in Opposer's '315 Registration, previously filed in the PTO and previously used in the United States by the Opposer and not abandoned, as to be likely, when used in connection with the goods of Applicant, to cause confusion, or to cause mistake, or to deceive. Moreover, the goods identified in Applicant's Application are related or similar to the goods offered by Opposer and listed in Opposer's '315 Registration. The respective goods by Opposer and Applicant are marketed or will be marketed to the same consumers and potential consumers in similar channels of trade. Registration of Applicant's Application should therefore be refused pursuant to 15 U.S.C. § 1052(d) in light of Opposer's priority of use and prior statutory and common law rights.

9. The mark shown in Applicant's Application so resembles the SET Mark in Opposer's '315 Registration, previously filed in the PTO and previously used in the United States by the Opposer and not abandoned, as to be likely, when used or in connection with the goods of Applicant, to cause confusion, or to cause mistake, or to deceive, and therefore, Applicant is not entitled to register the T:SET mark pursuant to Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

10. Through extensive use and advertising, the SET Mark has become famous for Opposer's goods since a date prior to the filing of Applicant's Application.

11. Applicant's use and registration of the T:SET mark shown in Applicant's Application will cause or is likely to cause dilution of the distinctive quality of Opposer's SET Mark within the meaning of Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), and will lessen the ability of Opposer's SET Mark to distinguish the goods of Opposer, regardless of the category of goods in connection with which Applicant uses the T:SET mark.

12. Applicant has no license, consent or permission from Opposer to use or register

the T:SET mark.

13. By reason of all the foregoing, Opposer believes it will be damaged by the registration of U.S. Trademark Application Serial No. 85/580,018.

WHEREFORE, Opposer prays that U.S. Trademark Application Serial No. 85/580,018 be rejected and stricken, that no registration be issued thereon Applicant, and this opposition be sustained in favor of Opposer.

Please charge Deposit Account No. 11-1410 for any fees which may be required.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: December 12, 2012

By: Deborah Shepherd

Deborah S. Shepherd  
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Fourteenth Floor  
Irvine, CA 92614  
(949) 760-0404  
efiling@kmob.com  
Attorney for Opposer,  
Masimo Corporation

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing Notice of Opposition upon Applicant's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid, on December 12, 2012, addressed as follows:

Carrie A. Shufflebarger  
THOMPSON HINE  
312 Walnut Street  
14th Floor  
Cincinnati, OH 45202

  
Theresa C. Bishop

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