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

Proceeding	91209134
Party	Defendant Stryker Corporation
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

	:	Opposition No. 91209134
	:	
JOHNSON & JOHNSON,	:	Mark: MICROFX
	:	
Opposer,	:	Serial Number: 85/571,434
	:	
v.	:	Filing Date: March 16, 2012
	:	
STRYKER CORPORATION,	:	
	:	
Applicant.	:	
	:	
	:	x

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

**DEFENDANT'S MOTION TO AMEND ITS
IDENTIFICATION OF GOODS AND MEMORANDUM IN SUPPORT**

Pursuant to 37 C.F.R. § 2.133, Applicant Stryker Corporation ("Applicant"), by and through counsel, respectfully requests that the Trademark Trial and Appeal Board ("the Board") amend the identification of goods in International Class 10 of its U.S. Application Ser. No. 85/571,434, as follows:

Current (International Class 10): Surgical instruments.

Proposed (International Class 10): Surgical instruments, namely osteochondral drills, drill guides, and curettes used to create microfracture holes.

37 C.F.R. § 2.133(a) provides, in pertinent part, "[a]n application subject to an opposition may not be amended in substance nor may a registration subject to a cancellation be amended or disclaimed in part, except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board, or upon motion granted by the Board." (Emphasis added.) Applicant hereby seeks leave, by way of the foregoing motion, to amend its application as set forth above.

I. APPLICANT HAS OBTAINED CONSENT FROM MICROFLEX CORP. AS TO ITS PROPOSED AMENDMENT

Applicant is engaged in a concurrent opposition proceeding filed by MicroFlex Corp., Opposition No. 91209129, in relation to its MICROFLEX mark. The MicroFlex opposition is presently suspended pending the outcome of this opposition proceeding. Indeed, MicroFlex consented to entry of Applicant's proposed amendment above (reflected in the record of Opposition No. 91209129). Entry of this amendment would completely resolve the MicroFlex opposition proceeding and result in the withdrawal of that opposition. The amendment cannot be entered in the MicroFlex proceeding, however, because the present Opposer has not, to date, consented to entry as well. Thus, Applicant is unable to resolve the above-noted proceedings, causing Applicant and MicroFlex to suspend proceedings pending the outcome of this opposition.

Given the foregoing, Applicant respectfully submits that MicroFlex's consent is no impediment to allowing Applicant's request to amend since consent has been procured, as described above.¹

II. ALTHOUGH OPPOSER HAS NOT CONSENTED TO THE AMENDMENT, APPLICANT IS ENTITLED TO REGISTRATION AT LEAST ON THE BASIS OF THE AMENDED GOODS

Applicant respectfully submits that it is entitled to registration of the MICROFX mark, as allowed by the Examining Attorney during prosecution at the USPTO. Nonetheless, Applicant submits the within request to amend its identification of goods to "surgical instruments, namely osteochondral drills, drill guides, and curettes used to create microfracture holes," in International Class 10 because Applicant believes it is also entitled to registration on at least that basis. *See e.g.*, TBMP §§ 514 *et seq.*²

As noted in the precedential opinion *Drive Trademark Holdings LP v. Inofin*, 83 U.S.P.Q.2d 1433 (T.T.A.B. 2007), "in practice, an acceptable amendment to the identification of goods or recitation of services often may be permitted, even where an opposer objects, if the proposed amendment serves to limit the identification of goods or recitation of services and if the applicant consents to the entry of judgment on the question of likelihood of confusion between opposer's and applicant's marks with respect to the broader identification of goods or recitation of services." *Id.* at 1435 (internal citations omitted; emphasis added). In addition, "[t]he goods that

¹ *See, e.g.*, TBMP § 514.02 (stating, "if the application or registration [for which an amendment pursuant to § 2.133 is requested] is the subject of other *inter partes* proceedings, the consent of the other parties in each of those other proceedings must be of record before the amendment may be approved").

² If a defendant, whose application or registration is the subject of a Board *inter partes* proceeding, wishes to defend by asserting that it is at least entitled to a registration with a particular restriction, the defense should be raised either in the defendant's answer to the complaint, or by way of a timely motion to amend the application or registration to include the restriction. TBMP § 514.03.

would remain in the identification of goods after an amendment were entered must be supportable by the specimens of record, and evidence must be introduced by applicant during its testimony period to prove use of its mark on those goods" *Int'l Harvester Co. v. Int'l Tel. & Tel. Corp.*, 208 U.S.P.Q. 940, 941 (T.T.A.B. 1980); *Drive Trademark*, 83 U.S.P.Q.2d at 1435 (stating that "the applicant must introduce evidence during its testimony period to prove use of its mark on those remaining goods or services prior to the relevant date as determined by the basis of the application. In the case of a use-based application, the relevant date is the filing date of such application"). Lastly, the movant must set forth adequate reasons for the amendment, particularly it must be established, *prima facie*, "that the amendment serves to change the nature and character of the goods or to restrict their trade channels and customers in such a manner that a substantially different issue has been introduced from the issue presented by the opposition against the application based upon the original identification of goods." *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 U.S.P.Q. 955, 964 (T.T.A.B. 1986) (citing *Int'l Harvester*, 208 U.S.P.Q. at 941).

Applicant respectfully submits that the requested amendment to its identification of goods complies with the above requirements. As an initial matter, the amendment narrows Applicant's previous identification in that it restricts the surgical instruments covered by the MICROFX mark to a particular subset of instruments having a specific surgical application(s). The proposed identification of goods is also fully supportable by Applicant's use or intended use of the MICROFX mark. Indeed, Applicant confirms that a Statement of Use can and will be filed for MICROFX, which supports the goods listed in Applicant's proposed recitation.

Lastly, the proposed amendment serves to change the nature and character of the goods or to restrict their trade channels and customers so that a substantially different issue is introduced between the parties from that presented by the opposition based on the original identification. *See, e.g., Giant Food*, 229 U.S.P.Q. at 956. Indeed, Applicant's initial recitation "surgical instruments" and its proposed recitation "surgical instruments, namely osteochondral drills, drill guides, and curettes used to create microfracture holes" would present distinct issues between the parties as the latter is changed in nature and character from the former. Further, the trade channels through which Applicant's proposed goods would be offered, and the customers purchasing those goods, would be restricted (as compared to the initial recitation) in the manner discussed in at least *Giant Food*. What is more, Opposer's goods, suture anchors, are fundamentally distinct and are offered through different trade channels and to different consumers than Applicant's "surgical instruments, namely osteochondral drills, drill guides, and curettes used to create microfracture holes," as proposed. Thus, Applicants respectfully submit that confusion is unlikely.³

Applicant further notes that it is willing to consent to entry of judgment on the basis of its broader recitation, provided that registration is granted as to the proposed narrower recitation.⁴ Indeed, Opposer (to Applicant's knowledge) is not using its MICROFIX mark on any of the proposed goods, and such a restriction would further avoid a likelihood of confusion between

³ TBMP § 514.03 (noting that: "[a] request by a defendant to restrict its identification of goods or services. . . may be made by way of a motion under 37 C.F.R. § 2.133. . . by alleging that the restriction will avoid a likelihood of confusion, and alleging that plaintiff is not using the mark on the products or services being excluded from the registration"). (internal citations omitted).

⁴ Applicant reserves the right to accept registration based on the initial recitation, however, depending on the Board's ruling. TBMP § 514.03 (stating, "[i]f. . . the Board ultimately finds that the defendant is entitled to registration even

Applicant's and Opposer's respective marks, although such confusion would not be present in the first instance.

For at least the foregoing reasons, Applicant respectfully requests that the Board grant Applicant's motion and amend its application for MICROFX accordingly.

Respectfully Submitted,
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Dated: June 13, 2013

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without the proposed restriction, defendant will be allowed time to indicate whether it still wishes to have the restriction entered").

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the within DEFENDANT'S MOTION TO AMEND ITS IDENTIFICATION OF GOODS AND MEMORANDUM IN SUPPORT was served upon the following counsel of record this 13th day of June, 2013, as follows:

VIA E-MAIL

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Opposition No. 91209134