

ESTTA Tracking number: **ESTTA658234**

Filing date: **02/26/2015**

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	03/01/2015
Address	40 Parker Irvine, CA 92618 UNITED STATES

Attorney information	Jessica C. Sganga Knobbe, Martens, Olson & Bear, LLP 2040 Main Street, 14th Floor Irvine, CA 92614 UNITED STATES efiling@knobbe.com Phone:949-760-0404
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Applicant Information

Application No	86273929	Publication date	09/02/2014
Opposition Filing Date	02/26/2015	Opposition Period Ends	03/01/2015
Applicant	Covidien LP 15 Hampshire Street Mansfield, MA 02048 UNITED STATES		

Goods/Services Affected by Opposition

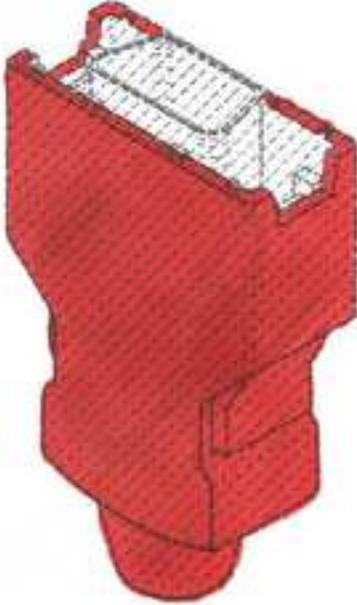
Class 010. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: disposable medical devices and supplies, namely, connectors and lead wires for use with patient monitoring devices

Grounds for Opposition

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

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3976092	Application Date	03/07/2007
Registration Date	06/07/2011	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	The mark consists of the color red covers the entirety of the mark, specifically the shape of a connector plug. The dotted outline of the goods is intended to show the position of the mark, and is not a part of the mark
Goods/Services	Class 010. First use: First Use: 2005/03/00 First Use In Commerce: 2005/03/00 Medical devices, namely, patient monitoring sensors and cables

Attachments	77124981#TMSN.png(bytes) Notice of Opposition MASIMOT 624M.pdf(395565 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	/jessica c sganga/
Name	Jessica C. Sganga
Date	02/26/2015

MASIMOT.624M

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

Masimo Corporation,

 Opposer,

 v.

Covidien LP,

 Applicant.

Serial No. 86/273,929
Opposition No. _____

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 (“Opposer”), believes that it will be damaged by the registration of U.S.

Trademark Application Serial No. 86/273,929 for the mark  in International Class 10, filed by Covidien LP, a Delaware limited partnership, located and doing business at 15 Hampshire Street, Mansfield, Massachusetts 02048 (“Applicant”), and therefore opposes the same.

A description of Applicant’s application (“Applicant’s Application”) is as follows:

Mark : 
Serial No. : 86/273,929

Filed : May 07, 2014
Published : September 02, 2014
Int'l. Class : 10
Alleged Date
of First Use : Application filed on the Intent to Use basis.
Goods : Disposable medical devices and supplies, namely, connectors
and lead wires for use with patient monitoring devices.

As grounds for opposition, it is alleged:

1. Founded in 1989, Opposer is a leading medical technology company. Opposer develops, manufactures, licenses, markets, and sells medical products for patient monitoring

under its  mark. Since at least as early as March 31, 2005, and long prior to the acts of

Applicant, Opposer has used the  mark.

2. On May 7, 2014, Applicant filed Application Serial No. 86/273,929 for the

 mark 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  mark in interstate commerce in connection with its

goods. By virtue of Opposer's continuous and substantial use, the  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 

mark. Therefore, Opposer has strong common law rights associated with the  mark.

4. Opposer is the owner of and relies upon United States Trademark Registration No. 3,976,092 for the mark  for “Medical devices, namely, patient monitoring sensors and cables” in International Class 10 (the ’092 Registration), which was registered on the Principal Register on June 7, 2011. The ’092 Registration is based on an application filed in the U.S. Patent and Trademark Office (“PTO”) on March 7, 2007, and claims a date of first use in commerce at least as early as March 31, 2005. Thus, the first use date, application date, and registration date of the mark shown in the ’092 Registration are all prior to the filing date of Applicant’s Application. True and correct copies of the specifics of the ’092 Registration obtained from the PTO’s TESS and Assignment databases are attached hereto as Exhibit A and made of record.

5. Opposer’s ’092 Registration is valid, subsisting, unrevoked, and uncancelled. As such, it constitutes *prima facie* evidence of the validity of the registered mark and of the registration thereof, 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 ’092 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. In addition to the protection afforded to Opposer by its ’092 Registration, Opposer has extensive common law rights in the  mark for its goods throughout the United States. Opposer’s common law rights in the  mark were established long before and predate the

filing date of Applicant's Application. Opposer's rights in the  mark are prior to and superior to Applicant's Application.

7. The mark shown in Applicant's Application is highly similar to the mark shown in Opposer's '092 Registration. Additionally, the goods identified in Applicant's Application are related or similar to the goods offered by Opposer and listed in Opposer's '092 Registration. As such, when the mark shown in Applicant's Application is used in connection with the goods identified in Applicant's Application, it is likely to cause confusion, or to cause mistake, or to deceive the trade and purchasing public into believing that Applicant's goods originate with Opposer or are otherwise authorized, licensed, or sponsored by Opposer, within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). In view of Opposer's prior statutory and common law trademark rights, Applicant is not entitled to registration of the Application pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

8. The mark shown in Applicant's Application so resembles the mark shown in Opposer's '092 Registration, previously filed in the PTO and previously used in the United States by 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, and therefore, Applicant is not entitled to registration of the Application pursuant to Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

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

10. Applicant's use and registration of the mark shown in Applicant's Application

will cause or is likely to cause dilution of the distinctive quality of Opposer's  mark within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), and will lessen the ability

of Opposer's  mark to distinguish the goods of Opposer.

11. Applicant has no license, consent, or permission from Opposer to use or register the mark shown in Applicant's Application.

12. By reason of all the foregoing, Opposer believes it will be damaged by the registration of U.S. Trademark Application Serial No. 86/273,929.

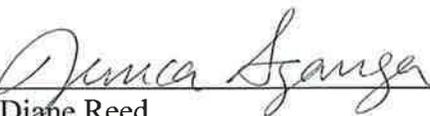
WHEREFORE, Opposer prays that U.S. Trademark Application Serial No. 86/273,929 be rejected and stricken, that no registration be issued thereon to Applicant, and this opposition be sustained in favor of Opposer.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 2/26/15

By: 
Diane Reed
Deborah S. Shepherd
Jessica C. Sganga
2040 Main Street
Fourteenth Floor
Irvine, CA 92614
(949) 760-0404
Attorneys for Opposer, Masimo Corporation

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served on Applicant's by mailing said copy on February 26, 2015, via First Class Mail, postage prepaid to:

John L. Welch
LANDO & ANASTASI, LLP
1 Main St. Ste 11
Cambridge, Massachusetts 02142-1517


Cheryl Brunet

TTAB Opposition No. _____
Serial No. 86/273,929
Masimo Corporation. v. Covidien LP.

EXHIBIT A

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Thu Feb 26 03:20:54 EST 2015

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Logout Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

[TSDR](#) | [ASSIGN Status](#) | [TTAB Status](#) (Use the "Back" button of the Internet Browser to return to TESS)



Goods and Services IC 010. US 026 039 044. G & S: Medical devices, namely, patient monitoring sensors and cables. FIRST USE: 20050300. FIRST USE IN COMMERCE: 20050300

Mark Drawing Code (2) DESIGN ONLY

Design Search Code 10.07.25 - Bed pans; Blood pressure apparatus; Braces (neck, back, teeth, leg, etc.); Caps, surgical; Clamps, medical; Eye droppers; Face Masks, surgical; Gloves, surgical; Hearing aids; Heating pads; Hot water bottles; Inhalers (medical); Intravenous devices; Masks, surgical; Mirrors, dental; Pans, bed; Scrubs (surgical); Surgical caps; Surgical gowns; X-ray apparatus
 14.01.03 - Cables, electrical, With electric plugs; Cords, electrical (with plugs); Electrical wire/cables, With plug; Plugs, electrical
 14.03.04 - Clamps, hardware; Connectors (clamps, collars); Rings, hardware
 29.02.01 - Red or pink (single color used for the entire goods/services)

Serial Number 77124981

Filing Date March 7, 2007

Current Basis 1A

Original Filing Basis 1A

Registration Number 3976092

Registration Date June 7, 2011

Owner (REGISTRANT) Masimo Corporation CORPORATION DELAWARE 40 Parker Irvine CALIFORNIA 92618

Attorney of Record Diane M. Reed

Description of Mark The color(s) red is/are claimed as a feature of the mark. The mark consists of the color red covers the entirety of the mark, specifically the shape of a connector plug. The dotted outline of the goods is intended to show the position of the mark,

and is not a part of the mark

Type of Mark TRADEMARK
Register SUPPLEMENTAL
Live/Dead Indicator LIVE

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[HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)

**Assignments on the Web > Trademark Query****Trademark Assignment Abstract of Title****Total Assignments: 1**Serial #: [77124981](#)

Filing Dt: 03/07/2007

Reg #: [3976092](#)

Reg. Dt: 06/07/2011

Registrant: Masimo Corporation

Mark:

Assignment: 1Reel/Frame: [5275/0896](#)

Recorded: 04/30/2014

Pages: 16

Conveyance: SECURITY INTEREST

Assignors: [MASIMO CORPORATION](#)

Exec Dt: 04/23/2014

Entity Type: CORPORATION

Citizenship: DELAWARE

Exec Dt: 04/23/2014

Entity Type: CORPORATION

Citizenship: DELAWARE

Entity Type: NATIONAL ASSOCIATION

Citizenship: UNITED STATES

[MASIMO AMERICAS, INC.](#)Assignee: [JPMORGAN CHASE BANK, NATIONAL ASSOCIATION, ATTN. AWRI MCKEE](#)

10 S. DEARBORN ST., FLOOR 07

CHICAGO, ILLINOIS 60603

Correspondent: PATRICK TIERNEY

PO BOX 2828

CHICAGO, IL 60690-2828

Search Results as of: 02/26/2015 02:37 PM

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.5
Web interface last modified: July 25, 2014 v.2.5