

ESTTA Tracking number: **ESTTA714417**

Filing date: **12/14/2015**

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	Bracco Diagnostics Inc.
Granted to Date of previous extension	12/13/2015
Address	259 Prospect Plains Road, Bldg. H Monroe Twp., NJ 08831 UNITED STATES
Attorney information	Erica D. Klein Kramer Levin Naftalis & Frankel LLP 1177 Avenue of the Americas New York, NY 10036 UNITED STATES KLTrademark@kramerlevin.com, eklein@kramerlevin.com, fsilverman@kramerlevin.com, tramos@kramerlevin.com

Applicant Information

Application No	79157578	Publication date	06/16/2015
Opposition Filing Date	12/14/2015	Opposition Period Ends	12/13/2015
International Registration No.	1229153	International Registration Date	08/27/2014
Applicant	Schwarzer Cardiotek GmbH Im Zukunftspark 3 GERMANY		

Goods/Services Affected by Opposition

<p>Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Software for use with medical apparatus and instruments, in particular for the processing of images and the indication of medical-diagnostic data and information; software for use with cardiovascular apparatus used for medical and surgical purposes, for the function of stimulating and processing of cardiac signals, processing of images, display, monitoring and storage of medical diagnostic data and information; electrical circuits and integrated circuits for medical and surgical apparatus and instruments; recorders and recording machines for use with medical apparatus and instruments, namely, electronic data recorders and electronic recorders for storing and archiving information related to medical-diagnostic data</p>
<p>Class 010. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Medical apparatus and instruments, namely, Medical instruments to measure blood pressure, cardiac output and other physiological and cardiovascular parameters, electrocardiographs; electromedical apparatus for use in cardiovascular surgery and procedures, electromedical diagnostic instruments for cardiovascular diagnosis, electromedical monitoring apparatus for use in cardiovascular surgery and diagnosis; ultrasonic medical</p>

diagnostic apparatus; ultrasonic medical diagnostic apparatus for cardiovascular diagnosis, screening and cardiovascular patient follow-up; medical cardiovascular instruments for cardiovascular diagnostics and for treating cardiovascular diseases; ultrasonic measuring instruments for measuring blood flow; medical apparatus and instruments for haemodynamic and electrophysiologic measurement; electrodes and hemodynamic sensors for use with medical apparatus and instruments; medical electrodes and diagnostic catheters for electrophysiology and for haemodynamic measurements; structural and replacement parts for the aforementioned medical apparatus and instruments

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1279584	Application Date	09/27/1982
Registration Date	05/29/1984	Foreign Priority Date	NONE
Word Mark	CARDIOTEC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1982/08/06 First Use In Commerce: 1982/08/06 a Pharmaceutical Preparation-Namely, a Cardiac Imaging Agent		

U.S. Application No.	86458322	Application Date	11/19/2014
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CARDIOTEC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 0 First Use In Commerce: 0 Pharmaceutical preparations, namely, a cardiac imaging agent		

Attachments	86458322#TMSN.png(bytes) Notice of Opposition - SCHWARZER CARDIOTEK.pdf(445996 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	/Erica D. Klein/
Name	Erica D. Klein
Date	12/14/2015

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

In re Application Serial No. : 79/157,578
Mark : SCHWARZER CARDIOTEK
International Classes : 9, 10, 37
Applicant : Schwarzer Cardiotek GmbH
Filed : August 27, 2014
Published : June 16, 2015

-----X
: Bracco Diagnostics Inc., :
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: :
: Opposer, :
: :
: v. : Opposition No.
: :
: Schwarzer Cardiotek GmbH, :
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: Applicant. :
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NOTICE OF OPPOSITION

Bracco Diagnostics Inc. (“Opposer”) believes that it would be damaged by a grant of registration to Schwarzer Cardiotek GmbH (“Applicant”), Applicant for Application Serial No. 79/157,578 (the “SCHWARZER CARDIOTEK Application”) for the mark SCHWARZER CARDIOTEK (the “SCHWARZER CARDIOTEK Mark”) filed in International Classes 9, 10 and 37 on August 27, 2014 and published for opposition on June 16, 2015, and hereby opposes said application. Requests for extensions of time to oppose the SCHWARZER CARDIOTEK Application were filed by Opposer and granted by the Board, providing Opposer until December 13, 2015 (or the next business day thereafter, December 14, 2015) to file an opposition.

The grounds for opposition are:

I. PARTIES

1. Opposer is a Delaware corporation located at 259 Prospect Plains Road, Building H, Monroe Township, New Jersey 08831, U.S.A.

2. Upon information and belief, Applicant is a German corporation located at Im Zukunftspark 3, 74076 Heilbronn, Germany.

II. OPPOSER'S MARKS AND SERVICES

3. Opposer is the owner of: (A) U.S. Reg. No. 1,279,584 (the "CARDIOTEC Registration") for the mark CARDIOTEC (the "CARDIOTEC Mark") covering *pharmaceutical preparation, namely, a cardiac imaging agent* in International Class 5 (the "CARDIOTEC Goods"), which was issued on May 29, 1984 and cancelled on March 17, 2015, and claimed a date of first use in commerce of August 6, 1982; and (B) U.S. App. Ser. No. 86/458,322 (the "CARDIOTEC Application") for the CARDIOTEC Mark covering the CARDIOTEC Goods, which was filed on November 19, 2014. A true copy of the TESS record for the CARDIOTEC Registration is attached hereto as Exhibit A, and a true copy of the TESS record for the CARDIOTEC Application is attached hereto as Exhibit B.

4. Opposer is also the owner of extensive common law rights in the CARDIOTEC Mark, due to use of the CARDIOTEC Mark since at least as early as August 1982, and the attainment of significant industry recognition therefrom, through which the CARDIOTEC Mark has acquired considerable value and goodwill.

III. APPLICANT'S APPLICATION FOR THE SCHWARZER CARDIOTEK MARK

5. On August 27, 2014, Applicant filed the SCHWARZER CARDIOTEK Application for a number of goods and services, including related to electronic software, hardware and medical apparatus in the field of cardiovascular care in International Classes 9 and 10, and installation of medical apparatus in International Class 37. A true copy of the TESS

record for the SCHWARZER CARDIOTEK Application, showing the full identifications of goods and services (collectively, the “SCHWARZER CARDIOTEK Goods”), is attached hereto as Exhibit C.

6. The SCHWARZER CARDIOTEK Application is based on International Registration No. 1229153 pursuant to Section 66(a) of the Trademark Act, and has a priority date of August 5, 2014.

IV. GROUNDS FOR OPPOSITION: LIKELIHOOD OF CONFUSION

7. The dominant portion of the SCHWARZER CARDIOTEK Mark – CARDIOTEK – is nearly identical to the CARDIOTEC Mark.

8. The addition of SCHWARZER, Applicant’s house mark, to the SCHWARZER CARDIOTEK Mark does not materially distinguish it over the CARDIOTEC Mark, as the addition of a house mark does not alleviate a likelihood of confusion when the dominant portion of both marks are the same.

9. The SCHWARZER CARDIOTEK Goods are closely related to the CARDIOTEC Goods. Both comprise products that relate to the medical diagnosis and treatment of cardiovascular conditions.

10. On information and belief, the consumers of the SCHWARZER CARDIOTEK Goods overlap with the consumers of the CARDIOTEC Goods, in that both comprise medical personnel providing, and patients seeking, cardiovascular care.

11. Opposer’s substantial rights in the CARDIOTEC Mark are considerably prior in time to any purported rights claimed by Applicant in the SCHWARZER CARDIOTEK Mark.

12. Opposer has not consented to the use and/or registration by Applicant of the SCHWARZER CARDIOTEK Mark.

13. In light of the foregoing, there is a strong likelihood that consumers viewing the SCHWARZER CARDIOTEK Mark in respect of the goods and services for which registration is sought are likely to believe that such goods and services derive from the same source as the goods provided under the CARDIOTEK Mark, or are affiliated, connected, associated, sponsored, approved, or authorized by Opposer, in violation of Section 2(d) of the Trademark Act. Accordingly, issuance of a registration to Applicant for the SCHWARZER CARDIOTEK Mark would seriously damage Opposer in that it would be likely to cause confusion, deception or mistake among consumers, and dilute the distinctiveness of the CARDIOTEK Mark.

14. Moreover, Opposer would be damaged by the issuance of a registration for the SCHWARZER CARDIOTEK Mark, as it would be an obstacle to the registration of the CARDIOTEK Application.

WHEREFORE, Opposer prays that this opposition be sustained and that the opposed Application be refused registration.

This Notice is being filed electronically with the Board, and is being served on Applicant, through its attorney of record, at the correspondence address of record with the PTO. Proof of Service is attached hereto.

Respectfully submitted,

Dated: New York, NY
December 14, 2015

KRAMER LEVIN NAFTALIS & FRANKEL LLP
Attorneys for Opposer



By: Erica D. Klein
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New York, New York 10036
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(212) 715-8000 (fax)
KLtrademark@kramerlevin.com

CERTIFICATE OF SERVICE

I hereby certify that on December 14, 2015, I caused one true and correct copy of the foregoing Notice of Opposition against U.S. Application No. 79/157,578 for SCHWARZER CARDIOTEK, and accompanying exhibits, to be served by first class mail upon Schwarzer Cardiotek GmbH, by causing a true and correct copy thereof to be deposited in the United States mail, postage prepaid, addressed to Applicant's attorney of record, at the correspondence address of record with the PTO as follows:

Norman P. Soloway
Hayes Soloway, P.C.
4640 E Skyline Drive
Tucson, Arizona 85718



Erica D. Klein

Opposition filed against Application No. 79/157,578
Bracco Diagnostics Inc. v. Schwarzer Cardiotek GmbH
Exhibit Filed by Bracco Diagnostics Inc.

EXHIBIT A



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Typed Drawing

Word Mark CARDIOTEC
Goods and Services (CANCELLED) IC 005. US 018. G & S: a Pharmaceutical Preparation-Namely, a Cardiac Imaging Agent. FIRST USE: 19820806. FIRST USE IN COMMERCE: 19820806
Mark Drawing Code (1) TYPED DRAWING
Serial Number 73389066
Filing Date September 27, 1982
Current Basis 1A
Original Filing Basis 1A
Published for Opposition March 6, 1984
Registration Number 1279584
Registration Date May 29, 1984
Owner (REGISTRANT) E. R. Squibb & Sons, Inc. CORPORATION DELAWARE Lawrenceville-Princeton Rd. Princeton NEW JERSEY 08540
 (LAST LISTED OWNER) BRACCO DIAGNOSTICS INC. CORPORATION DELAWARE 107 COLLEGE ROAD EAST PRINCETON NEW JERSEY 08540
Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record Mary B. Aversano
Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20040711.
Renewal 1ST RENEWAL 20040711
Live/Dead Indicator DEAD
Cancellation Date March 17, 2015

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Exhibit Filed by Bracco Diagnostics Inc.

EXHIBIT B



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CARDIOTEC

Word Mark	CARDIOTEC
Goods and Services	IC 005. US 006 018 044 046 051 052. G & S: Pharmaceutical preparations, namely, a cardiac imaging agent
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	86458322
Filing Date	November 19, 2014
Current Basis	1B
Original Filing Basis	1B
Owner	(APPLICANT) Bracco Diagnostics Inc. CORPORATION DELAWARE 259 Prospect Plains Road, Bldg. H Monroe Twp. NEW JERSEY 08831
Attorney of Record	Erica D. Klein
Prior Registrations	1279584
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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Bracco Diagnostics Inc. v. Schwarzer Cardiotek GmbH
Exhibit Filed by Bracco Diagnostics Inc.

EXHIBIT C



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Schwarzer Cardiotek

Word Mark SCHWARZER CARDIOTEK

Goods and Services IC 009. US 021 023 026 036 038. G & S: Software for use with medical apparatus and instruments, in particular for the processing of images and the indication of medical-diagnostic data and information; software for use with cardiovascular apparatus used for medical and surgical purposes, for the function of stimulating and processing of cardiac signals, processing of images, display, monitoring and storage of medical diagnostic data and information; electrical circuits and integrated circuits for medical and surgical apparatus and instruments; recorders and recording machines for use with medical apparatus and instruments, namely, electronic data recorders and electronic recorders for storing and archiving information related to medical-diagnostic data

IC 010. US 026 039 044. G & S: Medical apparatus and instruments, namely, Medical instruments to measure blood pressure, cardiac output and other physiological and cardiovascular parameters, electrocardiographs; electromedical apparatus for use in cardiovascular surgery and procedures, electromedical diagnostic instruments for cardiovascular diagnosis, electromedical monitoring apparatus for use in cardiovascular surgery and diagnosis; ultrasonic medical diagnostic apparatus; ultrasonic medical diagnostic apparatus for cardiovascular diagnosis, screening and cardiovascular patient follow-up; medical cardiovascular instruments for cardiovascular diagnostics and for treating cardiovascular diseases; ultrasonic measuring instruments for measuring blood flow; medical apparatus and instruments for haemodynamic and electrophysiologic measurement; electrodes and hemodynamic sensors for use with medical apparatus and instruments; medical electrodes and diagnostic catheters for electrophysiology and for haemodynamic measurements; structural and replacement parts for the aforementioned medical apparatus and instruments

IC 037. US 100 103 106. G & S: Installation, maintenance and repair of medical apparatus and instruments, in particular of electromedical apparatus and accessories thereof

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 79157578

Filing Date August 27, 2014

Current Basis 66A

Original Filing Basis 66A

Published for Opposition June 16, 2015

International Registration Number 1229153

Owner (APPLICANT) Schwarzer Cardiotek GmbH LIMITED LIABILITY COMPANY FED REP GERMANY Im Zukunftspark 3 74076 Heilbronn FED REP GERMANY

Attorney of Record Norman P. Soloway

Priority Date August 5, 2014

Type of Mark TRADEMARK. SERVICE MARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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