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

Proceeding	91229064
Party	Plaintiff Intuitive Surgical, Inc.
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Date	10/03/2016
Attachments	Compact Intuitive - Counterclaim Answer.pdf(329525 bytes)

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

INTUITIVE SURGICAL, INC.,)	
)	Opposition No. 91229064
Opposer,)	
)	Serial No.: 79/133,618
v.)	
)	Filed: June 10, 2013
)	
ABBOTT MEDICAL OPTICS INC.)	Published: May 24, 2016
)	
Applicant.)	
)	Trademark: 

TO: Commissioner For Trademarks
ATTN: Trademark Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

**OPPOSER INTUITIVE SURGICAL, INC'S ANSWER TO COUNTERCLAIM FOR
CANCELLATION OF U.S. TRADEMARK REGISTRATION NO. 2,381,704**

In response to the Counterclaim for Cancellation of U.S. Trademark Registration No. 2,381,704 for "INTUITIVE" filed by Applicant Abbott Medical Optics Inc. ("Applicant" or "Abbott") on August 29, 2016 ("Counterclaim"), Opposer Intuitive Surgical, Inc. ("Opposer" or "Intuitive Surgical") admits, denies, and avers as follows:

1. Opposer has insufficient knowledge or information to form a belief as to the truth of the allegations of paragraph 1 of the Counterclaim and on that basis denies them.
2. Opposer admits the allegations of paragraph 2 of the Counterclaim.
3. Opposer admits that it has alleged Opposer's U.S. Registration No. 2,381,704 against Applicant in Opposer's Notice of Opposition. Opposer has insufficient knowledge or information to form a belief as to the truth of the remaining allegations of paragraph 3 of the Counterclaim and on that basis denies them.

4. Opposer admits that it filed an application to register the mark INTUITIVE on April 4, 1997 on an intent-to-use basis and that it filed a Statement of Use with a date of deposit of December 16, 1999, alleging a first use date and first use in commerce date of at least as early as April 30, 1998 of the mark INTUITIVE in connection with goods in International Class 10. Opposer has insufficient knowledge or information to form a belief as to the truth of the remaining allegations of paragraph 4 of the Counterclaim and on that basis denies them.

5. Opposer admits that it filed correspondence dated August 18, 2006 including a Combined Declaration of Use and Incontestability for the mark INTUITIVE in International Class 10, together with a specimen showing the mark INTUITIVE as used. Opposer denies the remaining allegations of paragraph 5 of the Counterclaim.

6. Opposer admits that in a filing dated February 23, 2006, Opposer filed a Specimen of Use, alleging a first use date and first use in commerce date of at least as early as February 26, 1997 for the mark INTUITIVE SURGICAL (U.S. Registration No. 2,364,862) in connection with goods in International Class 10. Opposer has insufficient knowledge or information to form a belief as to the truth of the remaining allegations of paragraph 6 of the Counterclaim and on that basis denies them.

7. Opposer admits that on July 29, 2010, it filed a Combined Declaration of Use and Application for Renewal of Registration under Sections 8 and 9 for the mark INTUITIVE in International Class 10, together with a specimen showing the mark INTUITIVE as used. Opposer has insufficient knowledge or information to form a belief as to the truth of the remaining allegations of paragraph 7 of the Counterclaim and on that basis denies them.

8. Opposer admits that on June 18, 2010, it filed a Combined Declaration of Use and Application for Renewal of Registration under Sections 8 and 9 for the mark INTUITIVE

SURGICAL in International Class 10, together with a specimen showing the mark INTUITIVE SURGICAL as used. Opposer has insufficient knowledge or information to form a belief as to the truth of the remaining allegations of paragraph 8 of the Counterclaim and on that basis denies them.

9. Opposer has insufficient knowledge or information to form a belief as to the truth of the allegation that “Opposer filed the identical specimens that were used for its INTUITIVE SURGICAL mark to show use for the INTUITIVE mark” and on that basis denies that allegation. Opposer denies the remaining allegations of paragraph 9 of the Counterclaim.

10. Opposer denies the allegations of paragraph 10 of the Counterclaim.

11. Opposer denies the allegations of paragraph 11 of the Counterclaim.

12. Opposer denies the allegations of paragraph 12 of the Counterclaim.

13. Opposer denies the allegations of paragraph 13 of the Counterclaim.

OPPOSER’S AFFIRMATIVE DEFENSES

First Affirmative Defense

(Morehouse Prior Registration Defense and Lack of Standing)

14. Opposer owns a previously-issued and subsisting U.S. trademark registration, U.S. Registration No. 2,364,862, for a substantially similar mark covering substantially similar goods as covered by U.S. Registration No. 2,381,704, which Applicant seeks to cancel. Applicant therefore cannot be damaged and lacks standing to challenge Opposer’s U.S. Registration No. 2,381,704 on that basis.

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CERTIFICATE OF SERVICE

I hereby certify that **OPPOSER INTUITIVE SURGICAL, INC'S ANSWER TO COUNTERCLAIM FOR CANCELLATION OF U.S. TRADEMARK REGISTRATION NO. 2,381,704** is being deposited with the United States Postal Service, postage prepaid, first class mail, in an envelope addressed to:

Sarkis Khachatryan
Richard Zaitlen
Pillsbury Winthrop Shaw Pittman LLP
725 S. Figueroa Street, Suite 2800
Los Angeles, CA 90017-5406

on this 3 day of October, 2016.

A handwritten signature in blue ink, appearing to read "Patricia Marquez", enclosed within a blue oval-shaped stamp or seal.

Patricia Marquez