

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

In the Matter of Trademark Registration No. 2,515,322

For the mark INTEGRITY AFX

Registered December 4, 2001

11-19-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #30

AFX, INC.

Petitioner,

v.

Cancellation Proceeding No. _____

PACESETTER, INC.

Registrant

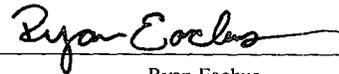
CERTIFICATE OF EXPRESS MAILING

I hereby certify that this paper and the documents and/or fees referred to as attached therein are being deposited with the United States Postal Service on November 19, 2002 in an envelope as "Express Mail Post Office to Addressee" service under 37 CFR §1.10, Mailing Label Number EV201229625US addressed to the Commissioner for Trademarks, Box TTAB-Fee, 2900 Crystal Drive, Arlington, VA, 22202-3513.

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Ryan Eachus

**PETITION FOR CANCELLATION
UNDER 37 CFR §2.111 and §2.112**

Trademark Trial and Appeal Board
Box TTAB Fee
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Registrant hereby petitions for the cancellation of U.S. Registration No. 2,515,322 for the mark INTEGRITY AFX, Registered December 4, 2001, under 37 CFR §2.111.

Petitioner, AFx, inc., a Delaware corporation located and doing business at 47929 Fremont Boulevard, Fremont, California 94538, believes that it is damaged by Registrant's mark INTEGRITY AFX for "cardiac pacing apparatus and pulse generators for generating heart stimulating pulses" in International Class 10.

GROUND FOR PETITION FOR CANCELLATION

As grounds for cancellation, Petitioner alleges as follows:

1. Common Law Trade Name and Trademark Rights. Petitioner has common law rights in its trade name and trademark AFX. Petitioner's use of the trade name and trademark AFX, has been valid and continuous since well before May 1, 2001, the filing date of Registrant's application, and well before May, 2000, the date of first use of the Registrant's mark, and has not been abandoned.
2. U.S. Trademark Registration. Petitioner is the owner of U.S. Registration No. 2,548,340, filed May 3, 2000 and registered March 12, 2002, for the mark AFX in connection with Surgical Instruments, namely, tissue ablation devices in International Class 10. This registration is in full force and effect. Petitioner's date of first use as a trade name is at least as early as November 1999, and date of first use in commerce for the goods associated with said mark is at least as early as January 7, 2000.
3. Priority of use. Petitioner has been using the trade name AFX since at least as early as November, 1999, in connection with tissue ablation devices, and more particularly, microwave ablation instruments designed to ablate tissues of the heart specifically for the treatment of arrhythmia's. Moreover, since at least as early as January, 2000, Petitioner has been

using the mark AFX in connection with the same. Since the primary component of Registrant's mark is virtually identical to the mark and trade name which Petitioner has used for nearly three years, Registrant should not have been entitled to register its mark.

PETITIONER IS DAMAGED BY THE REGISTRATION

4. Likelihood of Confusion. The primary component "AFX" of Registrant's mark INTEGRITY AFX is identical in sight and sound to Petitioner's mark and trade name AFX. Therefore, consumers are highly likely to be confused that the Registrant's mark is related to Petitioner's.

Registrant is presently engaged in the business of designing, manufacturing, distributing and selling cardiac stimulation devices and, cardiac monitoring devices for the heart to treat arrhythmia's. Accordingly, the Registrant's products are applied to treat the same heart disease (i.e., arrhythmia's) as that which the Petitioner's products are primarily directed. Even sophisticated consumers that encounter Registrant's nearly identical mark are likely to believe or assume that the same identifies goods that are associated with or sponsored by Petitioner. Thus, since confusion, mistake and deception in the trade and in the minds of purchasers as to the source or origin of the respective goods are highly likely to result, the Petitioner will be damaged.

5. Equity. Petitioner has been using the trade name AFX for three years, and has been using the trademark AFX since at least as early as January, 2000. Petitioner has invested substantial amounts of money in the development of goodwill in this trade name and trademark, and in its protection as a United States trademark. At the time that Registrant filed their application, Petitioner's pending application was readily publicly available in the U.S. trademark

office's files that are made available for public searching, and it is believed that since the marks are nearly identical, any reasonable clearance search would have uncovered Petitioner's pending application. Therefore, had Registrant conducted a reasonable clearance search before seeking registration of the mark, they would have had the opportunity to choose an alternative mark. Moreover, the Petitioner's trade name and trademark AFX alone is well known by its peers and competitors for researching and developing ablation instruments to treat arrhythmia's. Therefore, Registrant should choose a new mark, one which is not confusingly similar to Petitioner's mark.

6. Dilution. During its near three years of use, Petitioner's trade name and trademark AFX have become well known and have acquired extensive goodwill in connection with its tissue ablation devices and especially with respect to its cardiac ablation devices specifically designed to treat cardiac conditions (e.g. arrhythmia's). The Petitioner stands to have the value of its well-respected trade name and trademark diluted by Registrant's use of a confusingly similar trademark. Thus, Registrant should not have been entitled to registration of its mark.

NAME AND ADDRESS OF CURRENT OWNER

7. To the best of the Petitioner's knowledge, the current owner of the aforementioned registration is Pacesetter, Inc., a Delaware Corporation, 15900 Valley View Court Sylmar, CA 91342, which is a subsidiary of St Judes Medical.

RELATED APPLICATIONS

8. The Petitioner would also like to acknowledge U.S. Trademark Application Serial Nos. 76/288,521, filed July 19, 2001, for the mark INTEGRITY μ AFX, and 76/288,522, filed July 19, 2001, for the mark INTEGRITY MICRO AFX, both of which the Petitioner plans to Petition for Cancellation, and Petition to Join in this matter once those application pass to registration. Further, the Petitioner would like to acknowledge U.S. Trademark Application Serial Nos. 76/250,374, filed May 1, 2001, and 76/290,657, filed July 25, 2001, both for the mark AFX, and both of which the Petitioner is currently opposing.

WHEREFORE, Petitioner prays that the subject mark be cancelled.

Respectfully submitted,

AFx, inc.

By Michael L. Louie

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ATTORNEYS FOR PETITIONER

Dated: November 19, 2002