

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Butler

Mailed: March 15, 2007

Cancellation No. 92046058

Masimo Corporation

v.

Medtronic, Inc.

**Before Hohein, Grendel and Zervas, Administrative Trademark
Judges.**

By the Board:

Petitioner seeks to cancel respondent's registration for the mark MAXIMO for a "medical device, namely, implantable cardioverter defibrillator, parts and fittings therefor."¹ As grounds for the cancellation, petitioner alleges that respondent's mark, when used on the identified goods, so resembles petitioner's previously used and registered mark MASIMO for "in vivo patient monitors for detecting a physiological condition"² and for "electronic in vivo monitors, namely, blood

¹ Registration No. 2916730, issued January 4, 2005, claiming a date of first use anywhere and a date of first use in commerce of November 14, 2003.

² Registration No. 1906425, which petitioner claims issued July 18, 1995, and further claims use since at least as early as November 17, 1994.

monitors"³ as to be likely to cause confusion, mistake or to deceive. Petitioner also alleges likelihood of confusion with its previously used MASIMO mark for "various medical-related goods." Petitioner further alleges that respondent's use and registration of the MAXIMO mark will dilute the distinctive quality of petitioner's MASIMO marks, which petitioner claims became famous for its goods well prior to the filing date of respondent's underlying application which matured into the subject registration.

In addition, petitioner alleges that respondent, prior to its adoption of the MAXIMO mark, was a licensee of petitioner's MASIMO SET patented technology and MASIMO trademark; that respondent has used petitioner's MASIMO mark on its website to promote respondent's LifePak 20 defibrillator/monitor; and that, thus, respondent had actual knowledge of petitioner's MASIMO trademark and rights therein. Petitioner also relies on its registered mark ACCURATE MONITORING WHEN YOU NEED IT MOST,⁴ alleging that respondent has adopted the slogan CONFIDENCE WHERE IT IS NEEDED MOST, that respondent uses such slogan in connection with its MAXIMO mark, and that such use further exacerbates the likelihood of confusion between the parties' respective marks.

³ Registration No. 1951663, which petitioner claims issued January 23, 1996, and further claims use since at least as early as November 17, 1994.

⁴ Registration No. 2834864, issued April 20, 2004.

In its answer, respondent admits that its website has included news releases containing limited information about Medtronic Emergency Response Systems, Inc.'s licensed use of petitioner's products; that it has adopted and is using the slogan "confidence where it's needed most"; and that it has "no license, consent or permission to use or register the MAXIMO mark," stating that it does not need a license, consent or permission to do so. Respondent otherwise denies the essential allegations of the petition to cancel. Respondent, as part of its answer, has filed a counterclaim to cancel petitioner's pleaded Registration No. 2834864 for the mark ACCURATE MONITORING WHEN YOU NEED IT MOST on the grounds that the term is merely descriptive and has not acquired secondary meaning.

Petitioner, in its answer to the counterclaim, denies the salient allegations thereof.

In accordance with the institution order dated July 19, 2006, discovery was set to close on February 4, 2007. This case now comes up on respondent's motion, filed September 26, 2006, for summary judgment in its favor only on petitioner's likelihood of confusion and dilution claims.

In support of its motion with respect to petitioner's likelihood of confusion claim,⁵ respondent argues that, based

⁵ Respondent's argument that the Examining Attorney did not cite any of petitioner's marks as a bar to registration of respondent's MAXIMO mark during the prosecution of the underlying application carries no probative weight and will be given no further consideration. See *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir.

solely on the first two duPont factors,⁶ there is no likelihood of confusion between the parties' respective marks because the marks are dissimilar and the involved goods are non-competitive and unrelated. More particularly, respondent argues that the parties' respective marks are dissimilar in sight, sound, meaning, and commercial impression. Respondent contends that its mark, MAXIMO, suggests the well-known term "maximum," which provides guidance for pronunciation of the first syllable in respondent's mark, such pronunciation being "max". Respondent argues that, in contrast, petitioner's mark, MASIMO, does not suggest any other known English language term and could be perceived as a foreign term, a technical term or a surname, all of which often have unconventional pronunciations. Acknowledging both terms have three syllables, respondent emphasizes that the middle letter in its mark, "x," is a hard consonant while the middle letter in petitioner's mark, "s," is a soft consonant, further providing guidance to consumers in the pronunciation of the terms.

Respondent argues that the mere fact the parties' goods are broadly described as "medical devices" does not make them related goods. Instead, according to respondent, the parties' goods are different, non-competitive and unrelated because petitioner's

2001); and *TransAmerica Relocation Services, Inc. v. Century 21 Real Estate Corp.*, 221 USPQ 901 (TTAB 1983).

⁶ See *In re E. I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 463 (CCPA 1973).

blood monitors are non-invasive (not requiring surgery and usually attached to the skin), while respondent's defibrillators are surgically implanted devices for addressing irregular heart rhythm disorders.

Respondent contends that it is not a licensee of petitioner's products. According to respondent, petitioner entered into an agreement with Medtronic Physio-Control Corporation (hereinafter "Physio-Control") in 2000 to incorporate petitioner's MASIMO pulse oximetry technology into Physio-Control's LIFEPAK 20 defibrillator/monitor; Physio-Control, in 2004, changed its name to Medtronic Emergency Response Systems, Inc. (hereinafter "MERS"); MERS develops, manufactures and sells quality medical devices, including LIFEPAK defibrillator/monitors but does not sell or manufacture surgically-implantable medical devices.

In support of its motion with respect to petitioner's dilution claim, respondent argues that its mark, MAXIMO, is not identical to, essentially the same as or substantially similar to petitioner's MASIMO mark. Respondent contends that, because the marks are dissimilar for the reasons discussed earlier, consumers would not be confused and, further, there is no evidence that consumers would link the two marks in their minds. Respondent also argues that petitioner cannot prove that its mark is famous in the sense that it is "truly prominent and renowned."

Respondent contends that, because the parties operate in different fields, even if petitioner is able to show some recognition in its "niche" market, such recognition does not translate into fame in respondent's market; and that, in any event, petitioner cannot show its MASIMO mark acquired fame prior to 2003 when respondent filed its application for registration of its MAXIMO mark.

Respondent's motion is supported by the declaration of its attorney and numerous exhibits.

In response, petitioner argues that the parties' marks are similar, the parties' goods are related, the channels of trade involved are the same or overlapping, respondent was aware of petitioner's mark when it adopted its own mark and has attempted to create an association with petitioner's mark, and petitioner's mark is famous. With respect to the similarities of the marks, petitioner contends that the terms are similar in sight, differing only by one letter; that the marks are similar in sound because respondent's middle letter "x" is also pronounced as is the combination of the letters "ks," which is audially similar to petitioner's middle letter "s"; that respondent has admitted petitioner's mark is arbitrary; and that, by changing only one letter, respondent has essentially adopted petitioner's mark in its entirety. Petitioner argues that the goods are related, noting that both parties acknowledge MERS is a licensee of petitioner and further arguing that there is a relationship

between respondent and MERS. Petitioner argues that respondent's goods and MERS' LIFEPAK goods, the latter including technology licensed from petitioner, are both types of defibrillators. According to petitioner, due to the relationship between respondent and MERS (which petitioner characterizes as "ambiguous") and the references on respondent's website to petitioner's technology and products, genuine issues of material fact exist with respect to the relatedness of the parties' goods, the involved channels of trade, the market interface between and consumers for the parties' goods, and respondent's intent in adopting its mark.

Petitioner contends that genuine issues of material fact also exist with respect to its dilution claim, noting that its registrations for the mark MASIMO predate the filing date of the underlying application to respondent's registration for the mark MAXIMO; that there is no dispute that petitioner has used its MASIMO mark for at least twelve years; that the parties' marks are very similar, differing only by one letter; that respondent has admitted petitioner's mark is a coined term and, thus, inherently distinctive; and that there is no showing that third parties use any similar term for the same type of goods.

Petitioner's response is accompanied by the declaration of its patent attorney concerning petitioner's monitoring technologies, the declaration of its attorney of record, and numerous exhibits.

In reply, respondent argues petitioner's goods are not incorporated into or sold in connection with respondent's implantable goods; that respondent announced on December 4, 2006 it was spinning-off its MERS subsidiary so respondent can focus its resources aimed at technologies for chronic disease management and MERS can continue its core mission of developing technologies in emergency response external defibrillators; and the parties' involved goods are very dissimilar. Respondent contends that the parties' marks are not similar and clarifies that it did not state that petitioner's mark was arbitrary or coined but that "it was not presently aware of any meaning in the English language." Respondent argues that, because the marks are dissimilar, they are not "identical, essentially the same or substantially similar," and, thus, there can be no dilution. Respondent also argues that petitioner's mark was in use only nine years prior to the filing date of respondent's underlying application; and that there is no evidence petitioner's mark has acquired the requisite degree of fame necessary to establish dilution.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issues of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). A genuine issue with respect to material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the

non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any factual issues are genuinely in dispute must be resolved against the moving party and all inferences must be viewed in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

With respect to petitioner's likelihood of confusion claim, we find that genuine issues of material fact exist as to the similarities of the marks and the relatedness of the involved goods and their channels of trade. Although the marks are not identical, genuine issues of material fact exist as to the similarities of the marks MASIMO and MAXIMO in sight, sound, meaning, and commercial impression. Again, although the goods are not identical, genuine issues of material fact exist as to whether the goods are related in some manner that the circumstances surrounding their use may be such that they would be likely to be encountered by the same persons in situations that would give rise to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods.⁷

⁷ The fact that we have identified and discussed only a few genuine issues of material fact as sufficient bases for denying the motion for summary judgment should not be construed as a finding that these are necessarily the only issues which remain for trial.

As to petitioner's dilution claim, we find that respondent has not carried its burden of demonstrating the absence of genuine issues of material fact and that it is entitled to judgment as a matter of law. Genuine issues of material fact exist with respect to whether the parties' marks are substantially similar and whether petitioner's mark is famous for purposes of ascertaining dilution.⁸

Accordingly respondent's motion for summary judgment is denied.⁹

Discovery and trial dates are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	August 1, 2007
30-day testimony period for party	October 30, 2007
30-day testimony period for party in position of defendant to close:	December 29, 2007
15-day rebuttal testimony period to close:	February 12, 2008

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on

⁸ In coming to this conclusion, the Board recognizes that petitioner's response consists mainly of denials and conclusory assertions. However, the burden of raising a genuine issue of fact does not shift to petitioner unless respondent first carries its burden on summary judgment, which respondent has not done.

⁹ The parties should note that the evidence submitted in connection with their motions for summary judgment is of record only for consideration of those motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial periods. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); and *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.
