

ESTTA Tracking number: **ESTTA101004**

Filing date: **09/26/2006**

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

Proceeding	92046058
Party	Defendant Medtronic, Inc. Medtronic, Inc. 710 Medtronic Parkway Minneapolis, MN 554325604
Correspondence Address	Dean R. Karau Fredrikson & Byron, P.A. 200 South Sixth Street Suite 4000 Minneapolis, MN 554021425 UNITED STATES ip@fredlaw.com, dkarau@fredlaw.com
Submission	Motion for Summary Judgment
Filer's Name	Dean R. Karau
Filer's e-mail	dkarau@fredlaw.com, ip@fredlaw.com
Signature	/Dean R. Karau/
Date	09/26/2006
Attachments	MAXIMO Motion Memorandum & Affidavit.pdf ( 58 pages )(5772935 bytes )

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

---

Masimo Corporation,	)	
	)	Cancellation No. 92,046,058
Petitioner,	)	Registration No. 2,916,730
v.	)	Mark: MAXIMO
	)	
Medtronic, Inc.,	)	
	)	
Registrant,	)	
	)	
and	)	
	)	
Medtronic, Inc.	)	
	)	
Counterclaim Petitioner,	)	
v.	)	
	)	
Masimo Corporation,	)	
	)	
Counterclaim Registrant.	)	

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

---

**REGISTRANT’S MOTION FOR SUMMARY JUDGMENT  
DISMISSING PETITION TO CANCEL AND  
MEMORANDUM OF LAW IN SUPPORT THEREOF**

---

**MOTION**

Registrant, Medtronic, Inc., hereby moves the Trademark Trial and Appeal Board, pursuant to Rule 56 of the Federal Rules of Civil Procedure, for summary judgment dismissing Petitioner, Masimo Corporation’s Petition to Cancel the registration of Medtronic, Inc.’s MAXIMO mark.

The first ground for dismissing the Petition to Cancel is that, pursuant to the Lanham Act, 15 U.S.C. § 1052(d), and based on the first two *DuPont* factors alone, Medtronic, Inc.'s MAXIMO trademark and Masimo's MASIMO trademarks are dissimilar marks, and the parties respective goods are dissimilar, non-competitive and unrelated, such that there is no likelihood the MAXIMO mark, when used on or in connection with the goods of Medtronic, Inc., will cause confusion, or will cause mistake, or will deceive. Therefore, Medtronic, Inc. is entitled to summary judgment on Masimo's Section 2(d) claim.

The second ground for dismissing the Petition to Cancel is that MASIMO and MAXIMO are not identical, essentially the same or substantially similar, and Masimo cannot prove that its mark is famous, as required under 15 U.S.C. § 1125(c) of the Lanham Act. Therefore, Medtronic, Inc. is entitled to summary judgment on Masimo's dilution claim.

Medtronic, Inc. also requests that, pursuant to Trademark Rule 2.127(d), 37 C.F.R. § 2.127(d), the Board suspend this proceeding, pending determination of this motion, as of the date of the submission of this motion. In the event that the Board denies Medtronic, Inc.'s motion for summary judgment, it hereby requests that the discovery, testimony and briefing periods be reset in this proceeding.

Medtronic, Inc.'s motion is based upon the following facts and legal analysis; the accompanying Affidavit of Dean R. Karau in Support of Registrant's Motion for Summary Judgment Dismissing the Petition to Cancel ("Karau Aff.") and exhibits submitted therewith; the Registration for the mark MAXIMO, Registration No. 2,916,730; and the pleadings in this proceeding.

Dated: September 26, 2006



---

Dean R. Karau  
FREDRIKSON & BYRON, P.A.  
Suite 4000  
200 Sixth Street South  
Minneapolis, MN 55402-1425  
(612) 492-7178  
(612) 492-7077 (Fax)  
IP@fredlaw.com

**Attorneys for Registrant  
Medtronic, Inc.**

## TABLE OF CONTENTS

I.	INTRODUCTION .....	1
II.	STATEMENT OF FACTS .....	2
	A. General Background Facts.....	2
	1. Masimo markets medical signal processing technology for noninvasive patient monitoring.....	2
	2. Masimo entered into an agreement with Medtronic Physio-Control, not Medtronic, Inc.....	3
	3. Medtronic, Inc. makes implantable defibrillators. ....	4
	B. Facts Relevant to this Motion .....	5
III.	ARGUMENT .....	5
	A. The Summary Judgment Legal Standard.....	6
	B. Medtronic, Inc. Is Entitled To Summary Judgment On Masimo’s Likelihood of Confusion Claim. ....	7
	1. On the basis of the first two <i>DuPont</i> factors alone, Masimo’s registered MASIMO marks for the goods recited in its registrations are not confusingly similar to Medtronic, Inc.’s MAXIMO mark for the goods identified in its registration. ....	8
	a. MASIMO and MAXIMO are dissimilar marks.....	9
	b. The goods in the registrations for MASIMO and the goods in the registration for MAXIMO are dissimilar. ....	12
	B. Medtronic, Inc. is Entitled to Summary Judgment on Masimo’s Dilution Claim Because MAXIMO and MASIMO are Not Identical, Essentially the Same or Substantially Similar and the MASIMO Marks are Not Famous.....	16
	1. Masimo’s dilution claim must fail because the marks are not identical, essentially the same or substantially similar. ....	16
	2. Masimo cannot prove that its mark is famous. ....	17
III.	CONCLUSION.....	20

## TABLE OF CASES

### FEDERAL CASES

<u>AMF Inc. v. Sleekcraft Boats</u> , 599 F.2d 341 (9th Cir. 1979) .....	13
<u>Advantage Rent-A-Car Inc. v. Enterprise Rent-A-Car Co.</u> , 238 F.3d 378, 57 U.S.P.Q. 2d 1561 (5th Cir. 2001) .....	16, 17
<u>Anderson v. Liberty Lobby, Inc.</u> , 477 U.S. 242 (1986) .....	6, 7
<u>Application of E. I. DuPont DeNemours &amp; Co.</u> , 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973) .....	9
<u>Avery Dennison Corp. v. Sumpton</u> , 189 F.3d 868 (9th Cir. 1999).....	17
<u>Blansett Pharmacal Co. v. Carmrick Laboratories, Inc.</u> , 25 U.S.P.Q. 2d 1473 (T.T.A.B. 1992) .....	7
<u>In re British Bulldog, Ltd.</u> , 224 U.S.P.Q. 854 (TTAB 1984) .....	14
<u>Celotex Corp. v. Catrett</u> , 477 U.S. 317 (1986) .....	6, 7
<u>Champagne Louis Roederer, S.A. v. Delicato Vineyards</u> , 148 F.3d 1373, 47 U.S.P.Q. 2d 1459 (Fed. Cir. 1998) .....	11
<u>Copelands' Enterprises, Inc. v. CNV, Inc.</u> , 945 F.2d 1563, 20 U.S.P.Q. 2d 1295 (Fed. Cir. 1991) .....	6, 7
<u>Cunningham v. Laser Golf Corp.</u> , 222 F.3d 943, 55 U.S.P.Q. 2d 1842 (Fed. Cir. 2000) .....	7
<u>Electronic Data Systems Corp. v. EDSA Micro Corp.</u> , 23 U.S.P.Q. 2d 1460 (T.T.A.B. 1992) .....	14
<u>Federated Foods, Inc. v. Fort Howard Paper Co.</u> , 544 F.2d 1098, 192 U.S.P.Q. 24 (C.C.P.A. 1976).....	9
<u>Flatley v. Trump</u> , 11 U.S.P.Q. 2d 1284 (T.T.A.B. 1989) .....	6
<u>Flow Technology, Inc. v. Picciano</u> , 18 U.S.P.Q. 2d 1970 (T.T.A.B. 1991).....	13
<u>In re General Electric Co.</u> , 49 CCPA 1186, 304 F.2d 688, 134 U.S.P.Q. 190 (1962).....	12
<u>General Mills, Inc. v. Kellogg Co.</u> , 824 F.2d 622 (8th Cir. 1987).....	10

<u>Giant Food, Inc. v. Nation's Foodservice, Inc.,</u> 710 F.2d 1565, 218 U.S.P.Q. 390 (Fed. Cir. 1983) .....	9
<u>Hi-Country Foods Corp. v. Hi Country Beef Jerky,</u> 4 U.S.P.Q. 2d 1169 (TTAB 1987) .....	14
<u>Information Resources Inc. v. XPress Information Services,</u> 6 U.S.P.Q. 2d 1034 (TTAB 1988) .....	14
<u>Jacobs v. International Multifoods Corp.,</u> 668 F.2d 1234, 212 U.S.P.Q. 641 (CCPA 1982.).....	11
<u>Kellogg Co. v. Pack'Em Enterprises Inc.,</u> 14 U.S.P.Q. 2d 1545 (T.T.A.B. 1990).....	6, 9
<u>Libman Co. v. Vining Industrial, Inc.,</u> 69 F.3d 1360 (7th Cir. 1995).....	15
<u>Lloyd's Food Products Inc. v. Eli's Inc.,</u> 987 F.2d 766, 25 U.S.P.Q. 2d 2027 (Fed. Cir. 1993) .....	7
<u>Munters Corp. v. Matsui America, Inc.,</u> 730 F. Supp. 790 (N.D. Ill. 1989).....	14
<u>Murray v. Cable National Broadcasting Co.,</u> 86 F.3d 858 (9th Cir. 1996).....	13, 14
<u>Opryland USA Inc. v. Great American Music Show, Inc.,</u> 970 F.2d 847, 23 U.S.P.Q. 2d 1471 (Fed. Cir. 1992) .....	7
<u>Pack'Em Enterprises Inc.,</u> 951 F.2d 330, 21 U.S.P.Q. 2d 1142 .....	7
<u>Prince Dog &amp; Cat Food Co. v. Central Nebraska Packing Co.,</u> 305 F.2d 904, 134 U.S.P.Q. 366 (C.C.P.A. 1962) .....	8
<u>Pure Gold, Inc. v. Syntex (U.S.A.) Inc.,</u> 221 U.S.P.Q. 151 (T.T.A.B. 1983).....	13, 14
<u>Pure Gold, Inc. v. Syntex (U.S.A.), Inc.,</u> 739 F.2d 624, 222 U.S.P.Q. 741 (Fed. Cir. 1984) .....	6
<u>In re Quadram Corp.,</u> 228 U.S.P.Q. 863 (TTAB 1985).....	14
<u>In Re Shell Oil Co.,</u> 992 F.2d 1204 (Fed. Cir. 1993).....	9
<u>Sweats Fashions, Inc. v. Pannill Knitting Co.,</u> 833 F.2d 1560, 4 U.S.P.Q. 2d 1793 (Fed. Cir. 1987) .....	6
<u>TCPIP Holding Co., Inc. v. Haar Communications, Inc.,</u> 244 F.3d 88 (2d Cir. 2001) .....	18
<u>The Toro Company v. Torohead, Inc.,</u> 61 U.S.P.Q. 2d 1164 (TTAB 2001) .....	16

<u>Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C.</u> , 212 F.3d 157 (3d Cir. 2000), <i>cert denied</i> , 531 U.S. 1071 (2001).....	18, 19
<u>WCVB-TV v. Boston Athletic Association</u> , 926 F.2d 42 (1st Cir. 1991).....	15
<u>W. D. Byron &amp; Sons, Inc. v. Stein Brothers Manufacturing Co.</u> , 377 F.2d 1001, 153 U.S.P.Q. 749 (C.C.P.A. 1967).....	7
<u>W.W.W. Pharm. Co. v. Gillette Co.</u> , 984 F.2d 567 (2d Cir. 1993) .....	14

**FEDERAL STATUTES**

15 U.S.C. § 1125(c) .....	6, 18
Fed. R. Civ. P. 56(e) .....	7
Lanham Act, 15 U.S.C. § 1052(d) .....	ii
Trademark Rule 2.127(d), 37 C.F.R. § 2.127(d).....	2, ii

## MEMORANDUM OF LAW

### I. INTRODUCTION

Masimo Corporation's Petition alleges "facts" which are simply either wrong or are red herrings sowing confusion and obscuring the real issues – MASIMO and MAXIMO are not identical, essentially the same or substantially similar, MASIMO is not a famous mark, and there is no likelihood of confusion as the result of the simultaneous use by Medtronic, Inc. of its MAXIMO mark.

For instance, Masimo alleges that Medtronic, Inc., uses Masimo's MASIMO products in LIFE-PAK products, which allegedly establishes that Medtronic, Inc. adopted its MAXIMO mark in bad faith. Masimo is wrong, however, *and it knows it is wrong*.

Medtronic Emergency Response Systems, Inc., ("MERS"), a Washington corporation located in Redmond, Washington, not Medtronic, Inc., owns the LIFE-PAK trademarks. MERS, not Medtronic, Inc., uses the LIFE-PAK marks in connection with the goods sold under those marks. MERS, not Medtronic, Inc., is the party with whom Masimo entered into a contract in 2002 for the use of its products in MERS' LIFE-PAK products. MERS, not Medtronic, Inc., is the party with whom Masimo is currently negotiating a new agreement to continue the relationship between Masimo and MERS which began in 2002.

Masimo also alleges that Medtronic, Inc.'s use of the slogan, "Confidence where it is needed most," is somehow wrongful but does not explain why, a vagary distracting from the real issues.

Simply put, the false allegations and red herrings are a smoke screen attempting to hide the fact that Masimo's likelihood of confusion and dilution claims are doomed to fail.

MASIMO and MAXIMO are dissimilar marks, and the parties' respective goods are not similar, competitive or related. Based on the first two *DuPont* factors alone, Medtronic is entitled to summary judgment as a matter of law on Masimo's 2(d) claim.

In addition, Masimo cannot carry its burden to show that MASIMO is identical, essentially the same or substantially similar to MAXIMO, let alone carry its burden to show that MASIMO is a "famous" mark. As a result, Medtronic, Inc. is also entitled to judgment as a matter of law on Masimo's dilution claim.

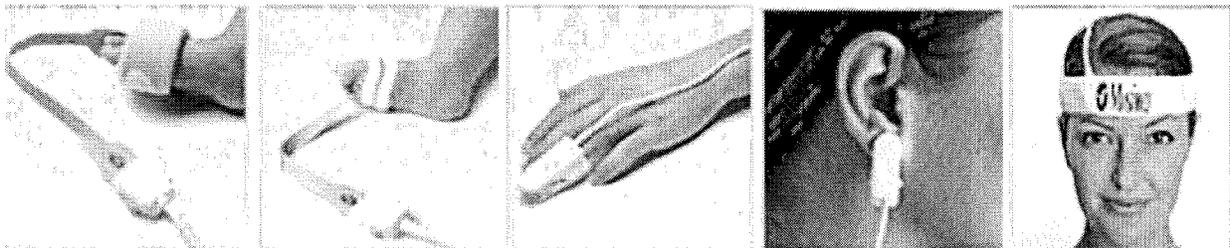
## II. STATEMENT OF FACTS

### A. General Background Facts.

#### 1. Masimo markets medical signal processing technology for noninvasive patient monitoring.

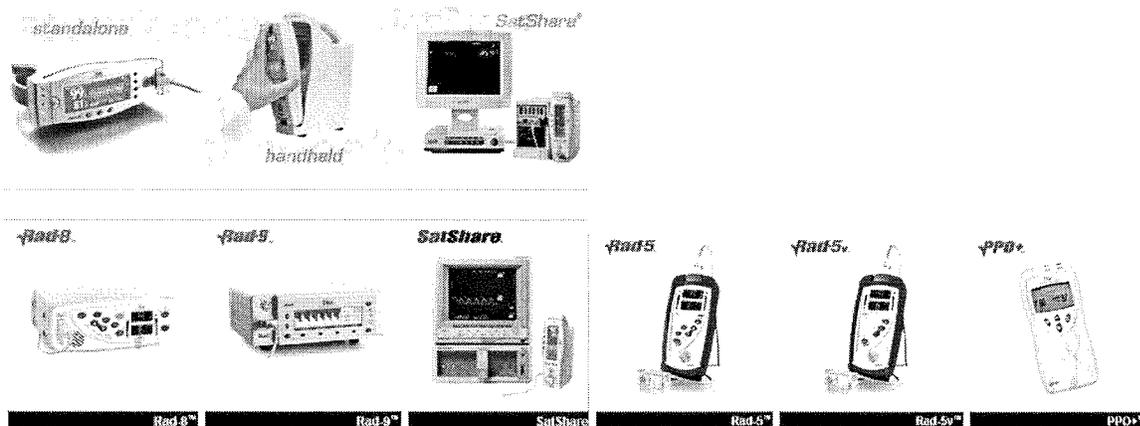
Masimo is a medical technology company that develops, licenses and markets medical signal processing technologies and products for the *noninvasive* monitoring of patient vital signs. Petition to Cancel, ¶ 1; see also, Karau Aff., Exhs. A and B (printouts from the Masimo website, located at [www.masimo.com](http://www.masimo.com)). Masimo's technology relates to a method of acquiring, processing and reporting arterial oxygen saturation and pulse rate. *Id.*

By way of example, Masimo sensors are attached externally on skin, typically on the hand, foot or head, as shown in the following images from Masimo's website:



Karau Aff., Exhs. C and D. Masimo's sensors are then attached to monitors, as also shown in the following images from Masimo's website:

**Radical.** 3-in-one oximeter



Karau Aff., Exh. E. Specifically, Masimo's pulse oximetry technology continuously tracks pulse rate and oxygen saturation in the blood to determine trends and warn of dangerous saturation levels. Karau Aff., Exhs. A and B.

**2. Masimo entered into an agreement with Medtronic Physio-Control, not Medtronic, Inc.**

Contrary to the allegations in Masimo's Petition to Cancel, Medtronic, Inc. is not a licensee of Masimo's products. Rather, Masimo's website unequivocally states that it entered into an agreement with Medtronic Physio-Control Corporation ("Physio-Control") in 2002 to incorporate Masimo's pulse oximetry technology into Physio-Control's LIFEPAK<sup>®</sup> 20 defibrillator/monitor. Karau Aff., Exh. F. Medtronic Physio-Control was a Washington corporation located in Redmond, Washington, and in 2004, changed its name to Medtronic Emergency Response Systems, Inc. ("MERS") while maintaining its Washington state corporate status. Karau Aff., Exh. G. (MERS' LIFEPAK<sup>®</sup> 12 also incorporates Masimo's pulse oximetry technology. Karau Aff., Exh. F.)

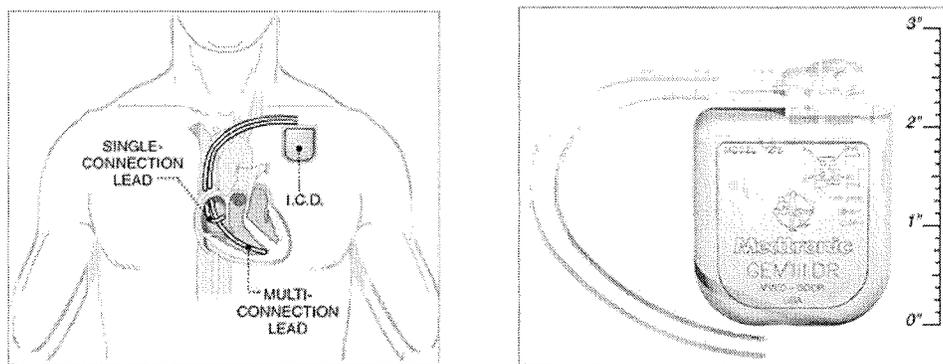
By way of background, according to its website MERS develops, manufactures, sells and services the LIFEPAK<sup>®</sup> defibrillator/monitors and automated external defibrillators (AEDs). Karau Aff., Exh. H. MERS focus has been on development of quality medical devices for

prediction or urgent treatment of cardiac and respiratory emergencies. *Id.* MERS offers a full range of services and complementary products that form an emergency cardiac care system. *Id.* As can be seen from its website, MERS neither manufactures nor sells surgically-implantable medical devices.

### 3. Medtronic, Inc. makes implantable defibrillators..

Medtronic, Inc. is the world leader in medical technology providing lifelong solutions for people with chronic disease, offering products, therapies and services that enhance or extend the lives of millions of people. One of the significant products it provides treats heart rhythm disorders.

Ventricular tachycardia (“VT”) is an abnormally fast heart rate in the lower heart chambers (ventricles) when a person is at rest. Karau Aff., Exh. I. This rapid heart rate can cause a person to become dizzy, feel light-headed, and faint. *Id.* A specific treatment for VT is an implantable defibrillator which can detect when VT occurs and resets the heart to a normal rhythm. *Id.* Most often, defibrillators are implanted in a surgical procedure, with an incision made in the upper part of the chest. Karau Aff., Exh. J.



Karau Aff., Exhs. K and L.

**B. Facts Relevant to this Motion.**

Medtronic, Inc. owns the registration at issue in this proceeding, Registration No. 2,916,730, for the mark MAXIMO, used in connection with *medical device, namely, implantable cardioverter defibrillator, parts and fittings therefor*, registered on January 4, 2005, based on an application filed on April 17, 2003, claiming a date of first use of November 14, 2003.

Masimo relies on two of its registrations for its MASIMO mark. Registration No. 1,906,425 is used in connection with *in vivo patient monitors for detecting a physiological condition*, registered on July 18, 1995, based on an application filed on September 30, 1993, claiming a date of first use in commerce of November 17, 1994. Registration No. 1,951,663 used in connection with *electronic in vivo monitors; namely, blood monitors*, registered on January 23, 1996, based on an application filed on October 16, 1992, claiming a date of first use of November 17, 1994.

**III. ARGUMENT**

Medtronic, Inc. is entitled to summary judgment on Masimo's Section 2(d) claim on the basis of the first two *DuPont* factors alone. As a matter of law, the parties' respective marks are dissimilar, and the parties' respective goods are dissimilar, non-competitive and unrelated and, therefore, Masimo simply cannot meet its burden needed to cancel the registration Medtronic, Inc.'s registration for its MAXIMO mark.<sup>1</sup>

Medtronic, Inc. is also entitled to summary judgment on Masimo's dilution claim. MASIMO and MAXIMO are not identical, essentially the same or substantially similar, a

---

<sup>1</sup> Medtronic, Inc. reserves the right to submit evidence at a later date, if necessary, that the other *DuPont* factors also weigh in its favor.

prerequisite for a dilution claim. Moreover, Masimo cannot prove that its mark is famous, as required under 15 U.S.C. § 1125(c) of the Lanham Act.

Therefore, as a matter of law, Medtronic, Inc. is entitled to summary judgment, dismissing Masimo's Petition to Cancel.

**A. The Summary Judgment Legal Standard.**

Summary judgment is a pretrial device to dispose of cases in which “the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law.” *See* F.R.Civ.P. 56(c); *see also Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 U.S.P.Q.2d 1793 (Fed. Cir. 1987). The purpose of the motion is judicial economy – to avoid an unnecessary trial where there is no genuine issue of material fact and additional evidence could not reasonably be expected to change the result. *See Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 U.S.P.Q. 741 (Fed. Cir. 1984). Summary judgment is “a salutary method of disposition,” and the Board should not hesitate to dispose of cases on summary judgment when appropriate. *See Sweats Fashions, Inc.*, 833 F.2d at 1562, 4 U.S.P.Q.2d at 1795.

A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. *See, e.g., Copelands' Enterprises, Inc. v. CNV, Inc.*, 945 F.2d 1563, 20 U.S.P.Q.2d 1295 (Fed. Cir. 1991); *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 U.S.P.Q.2d 1545 (T.T.A.B. 1990), *aff'd*, 951 F.2d 330, 21 U.S.P.Q.2d 1142 (Fed. Cir. 1991); *Flatley v. Trump*, 11 U.S.P.Q.2d 1284 (T.T.A.B. 1989). The burden of the moving party may be met by showing (that is, pointing out) “that there is an absence of evidence to support the nonmoving party's case.” *See Celotex*, 477 U.S. 317;

*Liberty Lobby, Inc.*, 477 U.S. 242; see also *Pack'Em Enterprises Inc.*, 951 F.2d 330, 21 U.S.P.Q.2d 1142.

When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by affidavit or as otherwise provided in Rule 56 of the Federal Rules of Civil Procedure, showing that there is a genuine factual dispute for trial. See Fed. R. Civ. P. 56(e); *Copelands' Enterprises*, 945 F.2d 1563, 20 U.S.P.Q.2d 1295; *Blansett Pharmacal Co. v. Carmrick Laboratories, Inc.*, 25 U.S.P.Q.2d 1473 (T.T.A.B. 1992). A factual dispute is genuine only if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the nonmoving party. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 U.S.P.Q.2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 U.S.P.Q.2d 1471 (Fed. Cir. 1992).

**B. Medtronic, Inc. Is Entitled To Summary Judgment On Masimo's Likelihood of Confusion Claim..**

Because Masimo is relying on Section 2(d), it has the burden of pleading and proving two basic elements: (1) that it has standing to petition to cancel in that it is likely to be damaged by the registration, and (2) that there are valid grounds why the registration should not continue to be registered. See J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 20:41 (4th ed. 2006), citing *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 U.S.P.Q.2d 1842 (Fed. Cir. 2000). Petitioner, as the party in the position of a plaintiff, bears the burden of proof. *Id.*, citing *W. D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 377 F.2d 1001, 153 U.S.P.Q. 749 (C.C.P.A. 1967); *Prince Dog & Cat Food Co. v. Central Nebraska Packing Co.*, 305 F.2d 904, 134 U.S.P.Q. 366 (C.C.P.A. 1962).

For the purpose of this motion only, Medtronic, Inc. is relying only upon the first two *DuPont* factors. As discussed below, Masimo cannot establish that its MASIMO marks are confusingly similar to Medtronic, Inc.'s MAXIMO mark. Therefore, the Board should grant Medtronic, Inc. summary judgment on Masimo's Section 2(d) claim.

1. **On the basis of the first two *DuPont* factors alone, Masimo's registered MASIMO marks for the goods recited in its registrations are not confusingly similar to Medtronic, Inc.'s MAXIMO mark for the goods identified in its registration..**

When examining Medtronic, Inc.'s application to register MAXIMO, the U.S.P.T.O. did not even issue an office action, let alone refuse registration because of either of Masimo's registrations. Karau Aff., Exh. M. When the MAXIMO application was published for opposition in November 2003, Masimo neither requested an extension of time to oppose the application nor filed a notice of opposition. Karau Aff., Exh. N. The first time Medtronic, Inc. learned of Masimo's concerns was in June of 2005. Karau Aff., Exh. O. After Medtronic, Inc. responded to Masimo's concerns in September 2005, Medtronic, Inc. did not hear from Masimo prior to its commencement of this proceeding. Karau Aff., Exh. P.

There are excellent reasons why the examining attorney found no confusion between MASIMO and MAXIMO, excellent reasons why Masimo never opposed the registration of MAXIMO and excellent reasons why, until now, Masimo refrained from commencing any proceeding. Simply put, the marks are dissimilar and are used in connection with distinctly dissimilar, non-competitive and unrelated goods, and thus there is no likelihood of consumer confusion.

In *Application of E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973), the court set out thirteen factors that may be considered when determining whether a challenged trademark is likely to cause confusion with another prior mark. The

*DuPont* factors, however, will vary from case to case, and not all of the factors need be present to determine the issue. *Id.* at 1361-62. Each factor may play a more or less weighty role in any particular determination. *In Re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993). A single factor can substantially outweigh any other relevant factor and be dispositive of the issue. *See, e.g., Kellogg Co. v. Pack'Em Enterprises, Inc.*, 14 U.S.P.Q.2d 1545 (T.T.A.B. 1990), *aff'd*, 951 F.2d 330 (Fed. Cir. 1991).

Two key factors are the similarities between the marks and the similarities between the goods and services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 U.S.P.Q. 24, 29 (C.C.P.A. 1976).

**a. MASIMO and MAXIMO are dissimilar marks..**

In this case, the first *DuPont* factor alone, the dissimilarity of the marks themselves, is dispositive of the issue. *Kellogg Co. v. Pack'Em Enterprises, Inc.*, 14 U.S.P.Q.2d 1545 (T.T.A.B. 1990), *aff'd*, 951 F.2d 330 (Fed. Cir. 1991). Medtronic, Inc.'s MAXIMO mark and Masimo's MASIMO marks are dissimilar as to appearance, sound, connotation and commercial impression.

Marks must be considered in their entirety, and not simply to determine what points they have in common. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983). Moreover, the fact that two marks share a similar term is not itself an indication that the marks are similar, let alone create a likelihood of confusion. "The use of identical, even dominant, words in common does not automatically mean that the two marks are similar." *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987).

In the instant matter, the marks are different visually:

**MASIMO      MAXIMO**

MAXIMO contains the letter “X,” which, under any frequency analysis measure, is one of the rarest letters used in the English language, while the letter “S” is one of the most commonly-used letters. Thus the use of the letter “X” in MAXIMO serves to distinguish that term from the term MASIMO, creating a significant visual difference.

There are distinct aural differences as well between MAXIMO and MASIMO. The term MASIMO has no apparent meaning in the English language, and there is nothing about the term which suggests similarity to another, known term. From a consumer’s perspective, MASIMO could be a coined term, a foreign term, a technical term or a surname, types of terms which often have unconventional pronunciations. Thus, the term itself does not readily give consumers guidance on how to pronounce it, on which syllable to place emphasis and so forth. In contrast, while not a word in the English language, MAXIMO provides clear pronunciation guidance to consumers, based on its strong similarity to the well-known term “maximum” and its variations and derivatives. Even if a consumer believed that MAXIMO was a coined term, a foreign term, a technical term or a surname, he or she would nevertheless have a strong bias in the pronunciation of the term based on its similarity to a known term. While MAXIMO and MASIMO both consist of three syllables, the first and dominant syllable in MAXIMO is clearly pronounced “max,” as in “maximum,” with the “X” pronounced as a hard consonant -- mak-s. The first syllable in MASIMO *may be* pronounced “mas,” as in “master,” with the “S” a soft consonant, assuming the consumer selects that pronunciation instead of trying another based on the term’s unfamiliarity. The similarity of MAXIMO to the familiar term “maximum” also gives guidance to the consumer as to how to pronounce the second syllable in MAXIMO, while MASIMO offers no such guidance. Further, the similarity of MAXIMO to the familiar term

“maximum” also suggests to the consumer how to emphasize each syllable in MAXIMO, while MASIMO again offers no such guidance. Thus, the marks are very different as to sound.

In terms of meaning, the first syllable in MAXIMO, “max,” *could* suggest “maximum” and its equivalent meanings. In contrast, MASIMO suggests nothing about the goods because it has no known meaning. Thus, the marks are also very different in meaning.

The MASIMO and MAXIMO marks convey different commercial impressions. If marks create a different commercial impression, then confusion is unlikely regardless of identical or highly related goods, identical trade channels, and the same consumers. *See Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1375, 47 U.S.P.Q.2d 1459 (Fed. Cir. 1998) (CRYSTAL CREEK for wine did not create a likelihood of confusion with CRISTAL and CRISTAL CHAMPAGNE despite being in the same class of goods and trade channels and being purchased by the same consumers).

MAXIMO may suggest “maximum” or a similar-meaning variation, creating a commercial impression distinct from MASIMO which, because it is not a word in the English language, leaves no impression, let alone a similar impression. Thus, the obvious differences will not cause confusion among consumers.

Moreover, the consumer will have little difficulty in differentiating between the two marks because, when comparing a commonly known term and an uncommon term, “the familiar is readily distinguishable from the unfamiliar.” *See Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 U.S.P.Q. 641 (CCPA 1982.) (BOSTON TEA PARTY was a commonly known term, whereas BOSTON SEA PARTY was not, making confusion unlikely.) “The human mind has little difficulty in differentiating between the familiar and unfamiliar.” *In re General Electric Co.*, 49 CCPA 1186, 304 F.2d 688, 134 USPQ 190 (1962) (VULKENE is an

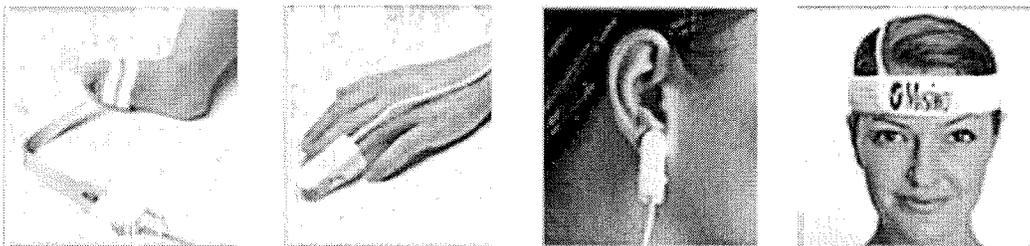
uncommon term and VULCAN is a common term. “Anyone confronted with it . . . would recognize it as something already known - it would not impress itself on his consciousness as anything new or strange, but rather as something familiar.” Thus, no confusion was likely because VULKENE was not a common term, but a coined one.) Because MAXIMO may suggest maximum, it gives it a degree of familiarity to the consumer which MASIMO, because it is not a word in the English language, does not.

Consequently, the mere fact that MAXIMO and MASIMO may share some syllables and letters does not mean that the marks are sufficiently similar in meaning, or project a similar commercial impression. Simply put, confusion is unlikely to result from contemporaneous use of MAXIMO and MASIMO, even if the marks are used on identical goods marketed in the same trade channels to the same class of purchasers, which they are not. Thus, the dissimilarity of the marks simply outweighs the other relevant *DuPont* factors.

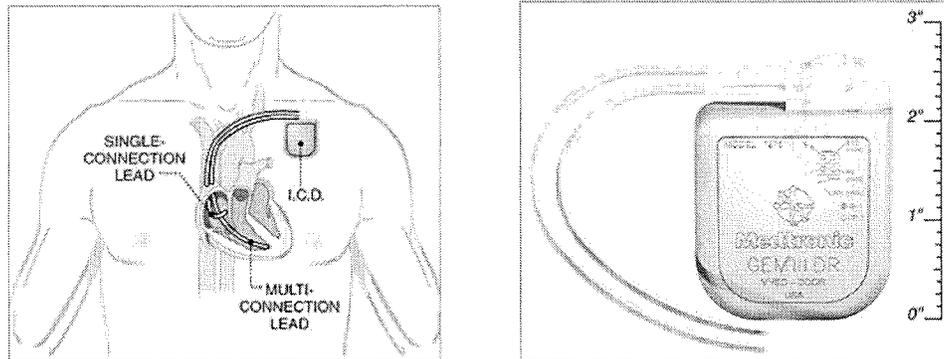
Simply put, MASIMO and MAXIMO are different in sight, sound, meaning and commercial impression. Based on this *DuPont* factor alone, there is no likelihood of confusion.

**b. The goods in the registrations for MASIMO and the goods in the registration for MAXIMO are dissimilar..**

The goods in the parties’ respective registrations are very different, non-competitive and unrelated. Masimo’s MASIMO in vivo blood monitoring devices are non-invasive, meaning they do not involve surgery. Rather, Masimo’s products are for blood monitoring and are used externally on the body – clipped on, attached with adhesives or otherwise attached to the body:



In contrast, Medtronic's MAXIMO medical device is surgically implanted:



The parties' respective products do not compete nor serve the same purpose, although they may both be generally defined as medical devices.

Where the parties' goods are unrelated, there is no likelihood of consumer confusion as a matter of law. *See, e.g., Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 U.S.P.Q. 151 (T.T.A.B. 1983), *aff'd*, 739 F.2d 624, 222 U.S.P.Q. 741 (Fed. Cir. 1984); *Murray v. Cable Nat'l Broadcasting Co.*, 86 F.3d 858, 861 (9th Cir. 1996). Related goods are those products which would be reasonably thought by the buying public to come from the same source if sold under the same mark. *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 n.10 (9th Cir. 1979). In other words, the relationship between the goods must be such that they are likely to be encountered by the same persons under circumstances which would, because of the marks used thereon, give rise to a presumption that they originate from or are in some way associated with the same producer. *Flow Technology, Inc. v. Picciano*, 18 U.S.P.Q.2d 1970 (T.T.A.B. 1991); *Murray*, 86 F.3d at 861. Where the parties' goods are so unrelated, there is no likelihood of consumer confusion as a matter of law. *See, e.g., Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 U.S.P.Q. 151 (T.T.A.B. 1983), *aff'd*, 739 F.2d 624, 222 U.S.P.Q. 741 (Fed. Cir. 1984); *Murray v. Cable Nat'l Broadcasting Co.*, 86 F.3d 858, 861 (9th Cir. 1996).

Goods are not related for the purposes of a likelihood of confusion analysis simply by fitting within a broad umbrella term such as “medical devices.” A long history of case law prohibits the reliance on any such generalizations in analyzing the likelihood of confusion between any products in any industry. “[T]he issue of whether or not two products are related does not revolve around the question of whether a term can be used that describes them both, or whether both can be classified under the same general category.” *See Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 U.S.P.Q.2d 1460, 1463 (T.T.A.B. 1992); *-W.W.W. Pharm. Co. v. Gillette Co.*, 984 F.2d 567, 573 (2d Cir. 1993) (“These products *do not compete nor serve the same purpose*, although they may both be generally defined as personal care products”- SPORTSTICK for lip balm not confusing with SPORT STICK for deodorant) (emphasis supplied); *Munters Corp. v. Matsui Am., Inc.*, 730 F. Supp. 790, 798 (N.D. Ill. 1989) (“In some, *albeit non-meaningful*, sense, all products are related” (emphasis supplied)).

There can be no rule that certain goods are per se related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto. *See, e.g., Information Resources Inc. v. X\*Press Information Services*, 6 USPQ2d 1034, 1038 (TTAB 1988) (regarding computer hardware and software); *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169, 1171 (TTAB 1987) (regarding food products); *In re Quadram Corp.*, 228 USPQ 863, 865 (TTAB 1985) (regarding computer hardware and software); *In re British Bulldog, Ltd.*, 224 USPQ 854, 855-56 (TTAB 1984) and cases cited therein (regarding clothing).

In this case, Medtronic, Inc.’s goods are surgically-implanted devices. Masimo’s goods are noninvasive blood monitors. Masimo cannot establish as a matter of law that blood monitors sold in connection with its MASIMO mark are meaningfully, and legally, related to the implantable devices sold in connection with the MAXIMO mark. The relevant buying public

would not reasonably think that Medtronic, Inc.'s surgically-implanted devices addressing irregular heart rhythm disorders under its MAXIMO mark come from Masimo.

Masimo's belief, that because its goods and the goods sold in connection with the MAXIMO marks are "medical products" and could be used together, does not make the respective goods related as a matter of law. Such a determination would dictate that almost all medical products are necessarily related for likelihood of confusion purposes. Such an outcome is not supported by the case law and public policy.

Trademark rights extend only as far as necessary to prevent consumer confusion. *See et al., Libman Co. v. Vining Indus., Inc.*, 69 F.3d 1360 (7th Cir. 1995); *WCVB-TV v. Boston Athletic Ass'n*, 926 F.2d 42, 45 (1st Cir. 1991)("The trademark statute does not give the appellants any 'property right' in their mark *except* 'the right to prevent confusion'").

An actual comparison of these goods provides clear and substantial evidence that Medtronic, Inc.'s implanted defibrillators and Masimo's blood monitors are not related in a manner that would lead to source confusion.

To the extent that Masimo is relying on any common law rights in its MASIMO mark for all medical devices, Masimo's devices as depicted on its website are related to pulse oximetry technology, not surgically-implanted devices and, therefore, are also dissimilar, non-competitive and unrelated to Medtronic, Inc.'s MAXIMO products. For the same reasons discussed above, there simply is no likelihood of confusion.

Therefore, on the basis of the first two *DuPont* factors alone, the dissimilarity of the marks and the dissimilarity in the parties' respective services and goods, the Board should find that Medtronic, Inc.'s MAXIMO mark is not confusingly similar to Masimo's MASIMO marks as a matter of law.

**B. Medtronic, Inc. is Entitled to Summary Judgment on Masimo’s Dilution Claim Because MAXIMO and MASIMO are Not Identical , Essentially the Same or Substantially Similar and the MASIMO Marks are Not Famous.**

Masimo cannot carry its burden to show that its marks are identical, essentially the same or substantially similar to Medtronic, Inc.’s mark, and that its marks are “famous,” both of which are required to cancel Medtronic, Inc.’s registration under a dilution theory. Consequently, Medtronic, Inc. is entitled to summary judgment on Masimo’s dilution claim.

**1. Masimo’s dilution claim must fail because the marks are not identical, essentially the same or substantially similar..**

Courts and the Board have held that dilution is an “extraordinary remedy.” *See, e.g., Advantage Rent-A-Car Inc. v. Enterprise Rent-A-Car Co.*, 238 F.3d 378, 57 USPQ2d 1561, 1563 (5th Cir. 2001); *The Toro Company v. Torohead, Inc.*, 61 USPQ2d 1164, 1173 (TTAB 2001). Unlike in likelihood of confusion cases, the Board does not resolve doubts in favor of the party claiming dilution. *The Toro Co. v. Torohead, Inc.*, at 1174.

For dilution purposes, a party must prove more than confusing similarity; it must show that the marks are “identical or very or substantially similar.” *The Toro Co. v. Torohead, Inc.*, at 1183. In the *Toro* case, the Board found that the marks TORO and ToroMR & design, although similar, were not “substantially similar” for dilution purposes. *Id.* (“Although the same word ‘toro’ appears in both marks, we do not see the marks as being ‘essentially the same.’”)

Masimo’s dilution claim can be easily dismissed because the marks MASIMO and MAXIMO are not identical, essentially the same or even very or substantially similar. As discussed above, the differences between the marks MASIMO and MAXIMO make them so dissimilar that consumers would not be confused. As noted in *Toro*, “there must be some evidence that the potential purchasers link the two marks in their minds even if it is simply to speculate as to why the other party should be able to use the famous mark of another.” *Id.* at

1184. In this case, Masimo can present no evidence that consumers link the two marks in their minds.

Masimo cannot scale the steep incline of evidentiary persuasion needed to prevail. On this basis alone, Masimo's dilution claim must fail.

**2. Masimo cannot prove that its mark is famous.**

Moreover, Masimo cannot demonstrate that its mark is famous, as also required to prevail on its dilution theory.

Dilution is a claim "invented and reserved for a select class of marks – those marks with such powerful consumer associations that even non-competing uses can impinge on their value." *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 875 (9th Cir. 1999). To prevail on a trademark dilution claim, Masimo must show: (1) Masimo's trademark MASIMO is famous and distinctive; (2) Medtronic, Inc. adopted its MAXIMO mark, after Masimo's mark had become famous; and (3) Medtronic, Inc.'s use of the MAXIMO mark would dilute Masimo's mark. *Advantage Rent-A-Car, Inc. v. Enterprise Rent-A-Car, Co.*, 238 F.3d 378, 380 (5th Cir. 2001).

To qualify as "famous," a mark must be "truly prominent and renowned." *Avery*, 189 F.3d at 875. Congress envisioned that a mark would qualify as famous under the Lanham Act only if the mark carried a "substantial degree" of fame. *TCPIP Holding Co., Inc. v. Haar Communications, Inc.*, 244 F.3d 88, 99 (2d Cir. 2001).

In analyzing a claim for dilution, the Board may consider the following factors:

- The degree of inherent or acquired distinctiveness of the mark;
- The duration and extent of use of the mark in connection with the goods or services with which the mark is used;
- The duration and extent of advertising and publicity of the mark;

- The geographical extent of the trading area in which the mark is used;
- The channels of trade for the goods or services with which the mark is used;
- The degree of recognition of the mark in the trading areas and channels of trade used by the mark's owner and the person against whom relief is sought;
- The nature and extent of use of the same or similar marks by third parties; and
- Whether the mark is registered.

15 U.S.C. § 1125(c)(1). All factors need not be considered in deciding whether a mark is sufficiently famous to warrant protection. See *Times Mirror Magazines, Inc. v. Las Vegas Sports News, L.L.C.*, 212 F.3d 157, 166 (3d Cir. 2000) (holding that courts are not required to apply every factor in the statute based on permissive language in statute), *cert denied*, 531 U.S. 1071 (2001).

Even assuming that Masimo could demonstrate that its mark has achieved some level of distinctiveness in the pulse oximetry field within which it operates, Masimo can present no evidence that its mark is famous. Although Masimo carries the burden of proof on its claim, Masimo can present no evidence that its mark has become truly prominent and renowned. There are several reasons why Masimo cannot demonstrate that its mark has acquired fame.

First, as noted above, Masimo has only used its mark within the non-invasive pulse oximetry field. While Masimo might be able to present evidence that its mark is recognized by customers in that field, it can present no evidence that the mark is recognized by purchasers of implantable devices. Indeed, Masimo and Medtronic, Inc. have co-existed without any incident of confusion since Medtronic, Inc. first started using its MAXIMO mark.

Masimo's limited use of its mark in the noninvasive pulse oximetry field is inadequate to create a mark of the kind of fame protected against dilution under the Lanham Act -- especially

when Medtronic, Inc. uses the mark sought to be registered in an entirely different field. As the Third Circuit noted in *Times Mirror Magazines*, a mark that is not famous to the public is entitled to protection only where both parties are operating in the same or related markets and the mark sought to be protected possesses a high degree of fame in its niche market. *Time Mirror Magazines*, 212 F.3d at 164. The Third Circuit's ruling is consistent with the Restatement (Third) of Unfair Competition which protects a mark used in a niche market only if the mark sought to be restrained is directed at the same market. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 25 cmt e (1995 Main Vol.).

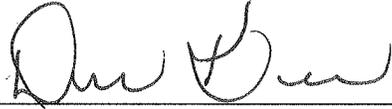
Medtronic, Inc. and Masimo operate in different fields and use their trademarks for entirely different goods. Masimo has no evidence that its marks are famous even in its niche market. Even assuming Masimo's marks had achieved fame within its niche market, however, Medtronic, Inc. uses its mark in a different market. Fame in one market does not translate into fame in another market.

Further, Medtronic, Inc. filed its application to register its MAXIMO mark in 2003. To prevail on its dilution claim, Masimo must show that its marks acquired fame *before* Medtronic, Inc.'s filing date. Masimo cannot, however, present evidence of fame whatsoever, let alone that its mark acquired fame prior to 2003. Simply put, Masimo cannot establish that its MASIMO marks are famous. Although Masimo's marks may have developed some distinctiveness in the pulse oximetry field, it has not reached the level of distinctiveness necessary to achieve fame. Because Masimo has not and cannot demonstrate that its marks have acquired the fame necessary for anti-dilution protection, Medtronic, Inc. is entitled to summary judgment on the dilution claim.

### III. CONCLUSION

For the foregoing reasons, Medtronic, Inc. requests the Board grant its motion for summary judgment, dismissing the Petition to Cancel.

Dated: September 26, 2006



---

Dean R. Karau  
FREDRIKSON & BYRON, P.A.  
Suite 4000  
200 Sixth Street South  
Minneapolis, MN 55402-1425  
(612) 492-7178  
(612) 492-7077 (Fax)  
IP@fredlaw.com  
**Attorneys for Registrant  
Medtronic, Inc.**

**CERTIFICATE OF SERVICE**

I hereby certify that true copies of the REGISTRANT'S MOTION FOR SUMMARY JUDGMENT DISMISSING THE PETITION TO CANCEL AND MEMORANDUM OF LAW IN SUPPORT THEREOF and AFFIDAVIT OF DEAN R. KARAU IN SUPPORT OF REGISTRANT'S MOTION FOR SUMMARY JUDGMENT DISMISSING THE PETITION TO CANCEL were served by United States mail on the attorney of record for Masimo in this action, Deborah S. Shepherd, Knobbe, Martens, Olson & Bear, LLP, 2040 Main Street, 14th Floor, Irvine, CA 92614, by mailing it to her address of record by first class mail, postage prepaid, this 26 day of September, 2006.

  
\_\_\_\_\_  
Dean R. Karau



4. Attached as Exhibit C is a true and correct copy of a printout from the Masimo Corporation webpage located at: <http://www.masimo.com/sensors/LNOP-reusable.htm>.

5. Attached as Exhibit D is a true and correct copy of a printout from the Masimo Corporation webpage located at: <http://www.masimo.com/sensors/SofTouch.htm>.

6. Attached as Exhibit E is a true and correct copy of a printout from the Masimo Corporation webpage located at: <http://www.masimo.com/pulseOximeter/index.htm>.

7. Attached as Exhibit F is a true and correct copy of a printout from the Masimo Corporation webpage located at: <http://www.masimo.com/partners/Medtronic.htm>.

8. Attached as Exhibit G is a true and correct copy of a printout from the United States Patent and Trademark Office Assignments on the Web webpage, located at:

<http://assignments.uspto.gov/assignments/q?db=tm&qt=sno&reel=&frame=&sno=7239029>

9.

9. Attached as Exhibit H is a true and correct copy of a printout from the Medtronic Emergency Response Systems, Inc. webpage located at: <http://www.medtronic-ers.com/company/>.

10. Attached as Exhibit I is a true and correct copy of a printout from the Medtronic, Inc. webpage located at:

[http://www.medtronic.com/servlet/ContentServer?pagename=Medtronic/Website/StageArticle&ConditionName=Heart+ Failure&Stage= Treatment&Article= hf\\_art\\_device&c= qlinks&n= insync%20cardiac%20resynchronization&r= mdtcom&t= internal](http://www.medtronic.com/servlet/ContentServer?pagename=Medtronic/Website/StageArticle&ConditionName=Heart+Failure&Stage=Treatment&Article=hf_art_device&c=qlinks&n=insync%20cardiac%20resynchronization&r=mdtcom&t=internal).

11. Attached as Exhibit J is a true and correct copy of a printout from the Medtronic, Inc. webpage located at:

[http://www.medtronic.com/servlet/ContentServer?pagename= Medtronic/Website/StageArticle &ConditionName= Heart+ Failure&Stage= Treatment&Article= hf\\_art\\_deviceplus](http://www.medtronic.com/servlet/ContentServer?pagename= Medtronic/Website/StageArticle &ConditionName= Heart+ Failure&Stage= Treatment&Article= hf_art_deviceplus).

12. Attached as Exhibit K is a true and correct copy of a printout from the Medtronic, Inc. webpage located at:

[http://www.medtronic.com/servlet/ContentServer?pagename= Medtronic/Website/StageArticle &ConditionName= Heart+ Failure&Stage= Treatment&Article= hf\\_art\\_surgery](http://www.medtronic.com/servlet/ContentServer?pagename= Medtronic/Website/StageArticle &ConditionName= Heart+ Failure&Stage= Treatment&Article= hf_art_surgery).

13. Attached as Exhibit L is a true and correct copy of a printout from the Medtronic, Inc. webpage located at:

[http://www.medtronic.com/physician/hf/insync\\_maximo.html](http://www.medtronic.com/physician/hf/insync_maximo.html).

14. Attached as Exhibit M is a true and correct copy of the July 12, 2004, Office Action for the application to register INSYNC MAXIMO.

15. Attached as Exhibit N is a true and correct copy of the TTABVUE webpage for the INSYNC MAXIMO cancellation proceeding.

16. Attached as Exhibit O is a true and correct copy of a June 1, 2005, letter from Deborah S. Shepherd, an attorney representing Masimo Corporation.

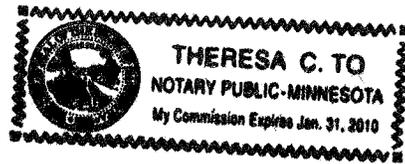
Dated this 26 day of September, 2006

  
\_\_\_\_\_  
Dean R. Karau

Subscribed and sworn to before me  
this 26<sup>th</sup> day of September, 2006.

Theresa C. To  
\_\_\_\_\_  
Notary Public

4088006\_1.DOC





Accurate Monitoring When You Need It Most.®

home

about masimo

awards

news

technology

why choose masimo

SET® oximeter sensors

SET® oximeters

Rainbow SET® oximeters

general floor monitoring

additional products

publications

oem solutions

contact us

\$500,000 challenge



日本語

guiding principles | evolution | key personnel | code of conduct | directions to masimo | careers

## about masimo

Founded in 1989, Masimo Corporation, the innovator of motion and low perfusion tolerant pulse oximetry, is a privately held medical technology company that develops, licenses and markets advanced medical signal processing technologies and products for the noninvasive monitoring of patient vital signs.

Masimo Signal Extraction Technology pulse oximetry, Masimo SET®, represents a fundamental departure from conventional pulse oximetry technologies. Over 60 independent published studies have demonstrated that Masimo SET substantially overcomes the limitations of conventional pulse oximeters in accurately measuring arterial blood oxygen saturation levels and pulse rates in the presence of patient movement and low perfusion. To date, Masimo has licensed its Signal Extraction pulse oximetry technology to over 35 international patient monitoring systems providers, which make up over 60% of the world's pulse oximeter shipments. We invite you to learn more about the products, people, and services that have brought us to where we are today.

© 2006 Masimo Corporation. All Rights Reserved.

patents

legal

home


Accurate Monitoring When You Need It Most.®

home	about masimo	awards	news	technology
------	--------------	--------	------	------------

why choose masimo?	what's the difference?	reduce the cost of care
improve patient care	improve patient safety	

**why choose masimo?**

Masimo pioneered motion and low perfusion tolerant technology. Masimo SET is the technology proven clinically in over 100 studies since 1994. Masimo Signal Extraction Technology (SET) is a breakthrough technology that represents a new and fundamentally distinct method of acquiring, processing and reporting arterial oxygen saturation and pulse rate. Masimo SET greatly enhances the accuracy of SpO<sub>2</sub> monitoring, particularly in the most difficult patient conditions such as motion and low peripheral perfusion.

Numerous clinical studies have demonstrated that the use of Masimo SET, in conjunction with Masimo's sensors, significantly:

1. Reduce the cost of care
2. Improve patient care
3. Improve patient safety

**Clinically Proven:**

Over 70 independent and objective studies have shown that Masimo SET is the gold standard for pulse oximetry. In addition, two ECRI publications have focused on Masimo SET.

**Maximum Accuracy, Lowest Cost, Guaranteed:**

Only Masimo SET has the ability to give you accurate pulse oximetry when you need it most with a written guarantee to reduce your annual pulse oximetry costs.

**The First and the Best Read-Through-Motion & Low Perfusion Pulse Oximeter:**

1. Unprecedented specificity and sensitivity. Essentially eliminates false alarms and detects virtually all true alarms.
2. Accurate during most patient movement, including shivering, combativeness, neonatal movement, and seizures.
3. Effective during helicopter and ambulance transport.
4. Accurate during low perfusion.
5. Accurate during intense ambient light and resists electrocautery interference.
6. Reduces cost of care through reliable monitoring and durable adhesive sensors. Studies have shown that Masimo SET adhesive sensors are replaced less than half as often as other leading brands.
7. Helps reduce neonatal eye damage. In 2003, a ground breaking study has shown that Masimo SET was instrumental in the protocol that dramatically reduced Retinopathy of Prematurity.<sup>1</sup>
8. Reduce medical errors. In 2002, a ground breaking study showed that Masimo SET helped reduce unnecessary ABG and excessive or precipitous oxygen use. In addition, it stated that Masimo reduces latent conditions, which have been linked to medical errors.<sup>2</sup>
9. Brigham & Women's, Hospital for Sick Kids, Johns Hopkins, Mass General Hospital, National Children's Hospital, UCLA, UC Davis, and UMC Arizona are among the many prestigious hospitals that have already converted hospital-wide to Masimo SET.
10. Only Masimo can offer seamless hospital-wide standardization on next-generation pulse oximetry technology, with over 35 OEM partnerships including Atom, Datascope, Drager, GE, InvivoMDE, Medtronic, Philips, Spacelabs, Welch Allyn and Zoll.
11. Masimo SET is considered the gold standard and has won over a dozen awards; these include

**\$500,000 Challenge**

*senate hearing update*



日本語

Society for Technology in Anesthesia Outstanding Technology Award, the Society for Critical Care Medicine Technology Excellence Award, the Medical Device Manufacturing Design Award, the American Electronic Association Breakthrough Technology Award, the Frost & Sullivan New Standard of Care Award, and the Audie Lewis Award for the best technology and service amongst pulse oximetry vendors.

**\$250,000 Guarantee:**

Masimo is the only medical technology company offering a \$250,000 guarantee to hospitals seeking an upgrade to next-generation pulse oximetry. If Masimo does not outperform Nellcor in an objective clinical trial, Masimo will pay that hospital \$250,000 towards the purchase of Nellcor oximetry. Certain restrictions apply. Contact Masimo for more details.

1. Chow LC, Wright KW, Sola A, and the CSMC Oxygen Administration Study Group. Pediatrics 2003; 111(2): 339-345
2. Durbin CG, Rostow SK. Crit Care Med 2002; 30(8):1735-1740

\*Call for a Masimo demonstration or clinical evaluation. 1-877-4Masimo [www.masimo.com](http://www.masimo.com)

**Signal Extraction Technology**

Masimo SET technology enables the power of adaptive filters to be applied to real-time physiologic monitoring by utilizing proprietary techniques to accurately establish a "noise reference" in the detected physiologic signal, thus enabling direct calculation of arterial saturation and pulse rate. While other pulse oximetry technologies employ one, or sometimes two algorithms to attempt to measure a patient's arterial oxygen saturation, Masimo SET's unique patented approach employs five algorithms, working in parallel, to ensure continuous, accurate SpO<sub>2</sub> measurement, even under the most challenging conditions.

MASIMO *Accurate Monitoring When You Need It Most.®*

home	about masimo	awards	news	technology
------	--------------	--------	------	------------

why choose masimo

SET® oximeter sensors

SET® oximeters

Rainbow SET® oximeters

general floor monitoring

additional products

publications

oem solutions

contact us

---

**\$500,000 challenge**

*senate hearing update*

**MASIMO**

日本語

LNOP® sensors			LNCS® sensors		SofTouch™ sensors	specialty sensors	patient cables
adhesive	reusable	multisite	adhesive	reusable			

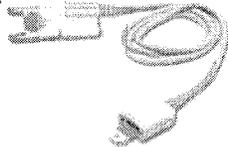
## LNOP® reusable sensors

technology overview

Rad-57™

Radical-7™

sensors & cables

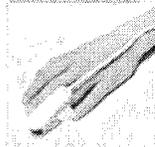


LNOP DCI



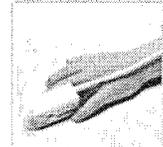


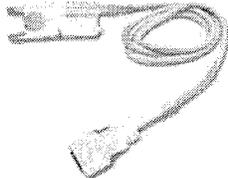
LNOP DC-195





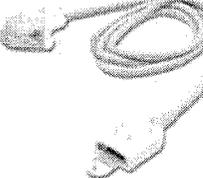
LNOP DCIP





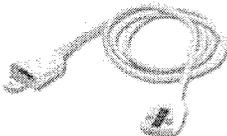
LNOP DCSC





LNOP TC-I





LNOP Transreflectance TF-I



### masimo reusable sensors

Masimo reusable sensors are designed for performance and durability where ever they are used.

Only Masimo sensors can deliver Masimo SET performance, recognized around the world as the leading pulse oximeter technology.

	<b>Pediatric</b>	<b>Adult</b>
		LNOP® DCI
		LNOP® DCSC

LNOP Reusable Sensors	LNOP® DCIP	LNOP® DC-195
		LNOP® TC-I
		LNOP® TF-I

© 2006 Masimo Corporation. All Rights Reserved.

[patents](#)

[legal](#)

[home](#)

MASIMO *Accurate Monitoring When You Need It Most.®*

home
about masimo
awards
news
technology

	LNOP® sensors	LNCS® sensors	SofTouch™ sensors	specialty sensors	patient cables
	adhesive    reusable    multisite	adhesive    reusable			

why choose masimo

SET® oximeter sensors

SET® oximeters

Rainbow SET® oximeters

general floor monitoring

additional products

publications

oem solutions

contact us

---

**\$500,000 challenge**

*senate hearing update*

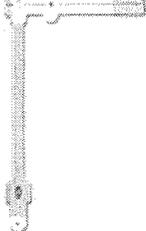
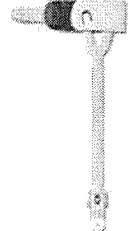
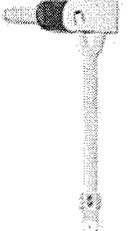
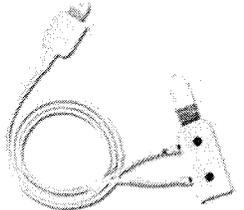
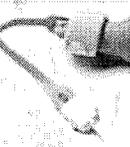
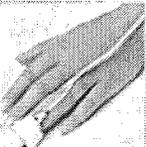
**MASIMO**

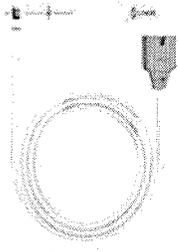
日本語

# LNOP®

## SofTouch™

SofTouch sensors

			
LNOP SofTouch NeoPt-L	LNOP SofTouch NeoPt	LNOP SofTouch NeoPt Bridge	LNOP YI w/ Foam Wrap
			



LNCS NeoPt

	Neonatal	Pediatric	Adult
SofTouch Sensors	LNOP® NeoPt-L	LNOP® YI Multisite	LNOP® YI Multisite
	LNOP® NeoPt		
	LNOP® SofTouch NeoPt Bridge		
	LNOP® YI Multisite		

© 2006 Masimo Corporation. All Rights Reserved.
patents
legal
home


Accurate Monitoring When You Need It Most.®

[home](#)    [about masimo](#)    [awards](#)    [news](#)    [technology](#)

## masimo SET pulse oximeters

why choose masimo

SET® oximeter sensors

SET® oximeters

Rainbow SET® oximeters

general floor monitoring

additional products

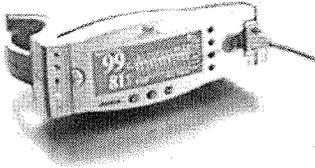
publications

oem solutions

contact us

### Radical. 3-in-one oximeter

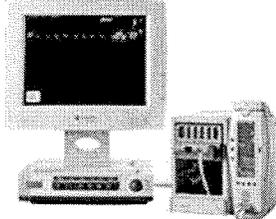
technology overview  
Rad-57™  
Radical-7™  
sensors & cables



standalone



handheld



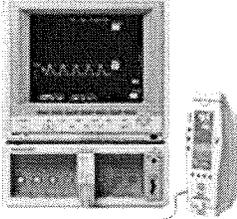
SatShare®



Rad-8™



Rad-9™



SatShare®



Rad-5™



Rad-5v™



PPO+™

Masimo and its technology partner companies offer a wide range of products that are designed to fit everyone's patient monitoring and pulse oximetry needs. Whether you require standalone monitors, transport monitors, integrated multi-parameter monitors, apnea monitors, infant incubators, infant warmers, telemetry units or defibrillators, there are now a variety of ways to add Masimo SET pulse oximetry to your department, hospital, hospital-type facility, transport or home environment.

Products containing Masimo SET pulse oximetry are available for all patient populations, from pre-term neonate

<http://www.masimo.com/pulseOximeter/index.htm>

EXHIBIT E

9/25/2006

to pediatric and adult. Products containing Masimo SET pulse oximetry are widely being used for all types of applications: operating room, intensive care, recovery room, emergency department, delivery room, NICU, PICU, step-down units, general floor, ambulance and helicopter transport, physical therapy, oncology, sleep lab and home.

© 2006 Masimo Corporation. All Rights Reserved.

[patents](#)

[legal](#)

[home](#)


*Accurate Monitoring When You Need It Most.®*

home
about masimo
awards
news
technology

why choose masimo

SET® oximeter sensors

SET® oximeters

Rainbow SET® oximeters

general floor monitoring

additional products

publications

oem solutions

contact us

---

**\$500,000 challenge**



senate hearing update



MASIMO

日本語



## Medtronic

what's the difference?

reduce cost of care

improve patient safety

**Medtronic Physio-Control**

11811 Willows Road NE

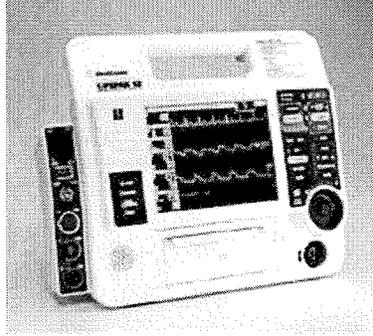
Redmond, WA 98073-9706

(425) 867-4000

(425) 867-4121 FAX

[www.medtronic.com](http://www.medtronic.com)

**Released Products with Masimo SET technology:**  
(Move mouse over instrument names to see pictures.)



- Lifepak 12
- Lifepak 20

Medtronic Physio-Control's Newest Cardiac Defibrillator/Monitor Incorporates Masimo Corporation Signal Extraction Technology For Pulse Oximetry REDMOND, Wash., Sept. 16, 2002 - Medtronic Physio-Control announced its agreement with Masimo Corporation to incorporate Masimo's Signal Extraction Technology (Masimo SET®) for pulse oximetry into its recently introduced LIFEPAK® 20 defibrillator/monitor. Pulse oximetry continuously tracks pulse rate and oxygen saturation in the blood to determine trends and warn of dangerous saturation levels. The LIFEPAK 20 defibrillator/monitor offers both manual and AED (automated external defibrillator) functionality for hospital and clinic settings.

According to Jon Tremmel, president of Medtronic Physio-Control, the company chose Masimo's SET technology for the LIFEPAK 20 defibrillator/monitor because it provides accurate readings and fewer false alarms of dangerous saturation levels, particularly when patients are moving, or when there is little blood flow.

"Medtronic Physio-Control is a world-class supplier of lifesaving equipment for critically ill patients, and we're very honored that they have selected Masimo SET as its pulse oximetry technology for the LIFEPAK 20," stated Kevin Mosher, president of Masimo Americas. "Masimo SET pulse oximetry has been clinically proven superior under the most challenging patient conditions, for which Medtronic Physio-Control products are designed."

**About Medtronic**  
Medtronic Physio-Control pioneered defibrillation technology nearly 50 years ago. Today, more than 350,000 LIFEPAK devices have been distributed worldwide, making the company the leading provider of defibrillation technology for saving the lives of people suffering sudden cardiac arrest. Four out of five emergency services use LIFEPAK defibrillators, and LIFEPAK defibrillator/monitors are used throughout the hospital from emergency rooms to intensive care, cardiac care and EP labs. For more information on LIFEPAK defibrillator/monitors, visit [www.physiocontrol.com](http://www.physiocontrol.com). Medtronic, Inc. (NYSE:MDT), headquartered in Minneapolis, is the world's leading medical technology company, providing lifelong solutions for people with chronic disease. Its Internet address is [www.medtronic.com](http://www.medtronic.com).

Any statements made about the company's anticipated financial results and regulatory approvals are forward-looking statements subject to risks and uncertainties such as those described in Medtronic's Annual Report on Form 10-K for the year ended April 26, 2002. Actual results may differ materially from anticipated results.

© 2006 Masimo Corporation. All Rights Reserved.
patents
legal
home



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)


## Assignments on the Web &gt; Trademark Query

## Trademark Assignment Abstract of Title

**Total Assignments: 5****Serial #:** [72390299](#)**Filing Dt:** 04/26/1971**Reg #:** [935766](#)**Reg. Dt:** 06/13/1972**Registrant:** PHYSIO-CONTROL CORPORATION**Mark:** LIFEPAK**Assignment: 1****Reel/Frame:** [1198/0296](#)**Received:****Recorded:** 08/11/1994**Pages:** 11**Conveyance:** CONDITIONAL ASSIGNMENT**Assignor:** [PHYSIO-CONTROL CORPORATION](#)**Exec Dt:** 07/29/1994**Entity Type:** CORPORATION**Citizenship:** DELAWARE**Entity Type:** CORPORATION**Citizenship:** DELAWARE**Assignee:** [CREDITANSTALT BANKVEREIN](#)

245 PARK AVENUE NEW YORK, NY 10167

**Correspondent:** PERRY A. PAPPASO'SULLIVAN GRAEV & KARABELL  
30 ROCKEFELLER PLAZA, 41ST FL.  
NEW YORK, NY 10112**Assignment: 2****Reel/Frame:** [1459/0242](#)**Received:** 05/14/1996**Recorded:** 05/10/1996**Pages:** 3**Conveyance:** REVOCATION AND POWER OF ATTORNEY**Assignor:** [PHYSIO-CONTROL CORPORATION](#)**Exec Dt:** 04/20/1996**Entity Type:** CORPORATION**Citizenship:** NONE**Entity Type:** CORPORATION**Citizenship:** DELAWARE**Assignee:** [PHYSIO-CONTROL CORPORATION](#)11811 WILLOWS ROAD N.E.  
REDMOND, WASHINGTON 98052-1013**Correspondent:** CHRISTENSEN O'CONNOR JOHNSON & KINDNESSKISONG KIM LANG-CADITZ, ESQ.  
1420 FIFTH AVENUE  
SUITE 2800  
SEATTLE, WASHINGTON 98101-2347**Assignment: 3****Reel/Frame:** [1650/0301](#)**Received:** 11/05/1997**Recorded:** 10/30/1997**Pages:** 8**Conveyance:** MERGER**Assignor:** [PHYSIO-CONTROL CORPORATION](#)**Exec Dt:** 06/10/1997**Entity Type:** CORPORATION**Citizenship:** DELAWARE**Entity Type:** CORPORATION**Citizenship:** WASHINGTON**Assignee:** [PHYSIO-CONTROL CORPORATION](#)1811 WILLOWS ROAD N.E.  
REDMOND, WASHINGTON 98052-1013**Correspondent:** CHRISTENSEN O'CONNOR JOHNSON & KINDNESSKISONG KIM LANG-CADITZ, ESQ.  
1420 FIFTH AVENUE  
SUITE 2800  
SEATTLE, WA 98101-2347**Assignment: 4**

EXHIBIT G

**Reel/Frame:** 1937/0103      **Received:** 08/18/1999  
**Conveyance:** CHANGE OF NAME  
**Assignor:** PHYSIO-CONTROL CORPORATION

**Recorded:** 08/10/1999      **Pages:** 7

**Assignee:** MEDTRONIC PHYSIO-CONTROL CORP.  
11811 WILLOWS ROAD NE  
REDMOND, WASHINGTON 98052

**Exec Dt:** 01/26/1999  
**Entity Type:** CORPORATION  
**Citizenship:** WASHINGTON  
**Entity Type:** CORPORATION  
**Citizenship:** WASHINGTON

**Correspondent:** JOHNSON & KINDNESS PLLC  
KISONG KIM LANG-CADITZ, ESQ.  
1420 FIFTH AVENUE  
SUITE 2800  
SEATTLE, WA 98101-2347

**Assignment: 5**

**Reel/Frame:** 2854/0368      **Received:** 05/19/2004  
**Conveyance:** CHANGE OF NAME  
**Assignor:** MEDTRONIC PHYSIO-CONTROL CORP.

**Recorded:** 05/19/2004      **Pages:** 3

**Assignee:** MEDTRONIC EMERGENCY RESPONSE SYSTEMS, INC.  
11811 WILLOWS ROAD NE  
REDMOND, WASHINGTON 98052

**Exec Dt:** 05/01/2004  
**Entity Type:** CORPORATION  
**Citizenship:** WASHINGTON  
**Entity Type:** CORPORATION  
**Citizenship:** WASHINGTON

**Correspondent:** MEDTRONIC, INC.  
710 MEDTRONIC PARKWAY  
LC 340  
MINNEAPOLIS, MN 55432-5604

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350.  
Web interface last modified: July 26, 2006 v.1.10

Search Results as of: 09/25/2006 11:03 AM

[| .HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)



[AEDHELP.COM](#)  
[BIPHASIC.COM](#)  
[Contact Us](#)

[PRODUCTS](#)   [SUPPORT](#)   [EMPLOYMENT](#)   [COMPANY](#)

▶ [Company Information](#)

- [Who Are We?](#)
- [Quality Credentials](#)
- [Investor Information](#)
- [Worldwide](#)
- [Community Support](#)
- [Contact Us](#)
- [Medtronic](#)



## *Who Is Medtronic Emergency Response Systems?*

**Our mission is to make lifesaving tools for lifesaving teams.** We develop, manufacture, sell and service the renowned LIFEPAK® defibrillator/monitors and automated external defibrillators (AEDs). But our tool set is much more extensive than devices. We also offer medical assistance, data management software, leasing programs, training assistance, round-the-clock technical service, and liability insurance - to help you build a "heart safe community". Our solutions are used by [our customers](#) to save thousands of lives every year.

## *Our Pioneering Spirit Drives Us*

Nearly 40 years ago, we introduced a medical device that launched an industry - the first commercial DC defibrillator. From that day forward, our product focus has been on development of the highest quality medical devices for prediction or urgent treatment of cardiac and respiratory emergencies. [Our history](#) includes a long legacy of "firsts", groundbreaking tools created for lifesaving teams. All done with one focus: saving minutes.....saving lives.

## *Our Philosophy*

We believe that customers need a total solution, not just a device. From involving customers early in the development process to shadowing them in their work environment, we design solutions for the first responder through the advanced life support provider. We concentrate on making products and services more intuitive, more complete and less costly to own and operate, so that lives can be saved in more places more often.

## *Improving Lives Around the World*

We are based near Seattle, Washington, but our lifesaving products are sold, serviced and preferred throughout the world - a responsibility we don't take lightly. In the toughest emergencies - anywhere in the world - you'll find our equipment on the scene.

[HOME](#) | [PRODUCTS](#) | [SUPPORT](#) | [COMPANY](#) | [EMPLOYMENT](#) | [MEDTRONIC](#) | [PRIVACY](#) | [TERMS OF USE](#)

[Contact Us](#)  
© 2006 Medtronic, inc.



Search

Home » Health Information » Contact Us

Heart Failure

Diagnosis

Treatment

Management

Treating Heart Failure

Treatment Options for Heart Failure

What is Ventricular Dysynchrony?

What is Cardiac Resynchronization Therapy (CRT)?

What is CRT plus ICD Therapy?

Am I a Candidate for CRT?

What Does the Implant Procedure Involve?

Prepare for Your Physician Visit

More Information about Heart Failure

Frequently Asked Questions

Patient Stories

Related Conditions

> Coronary Artery Disease

> Heart Valves

> Sudden Cardiac Arrest

> Ventricular Fibrillation

Stages of Your Condition

Diagnosing Heart Failure

Treating Heart Failure

Managing Heart Failure

Important Safety Information

Email This Page to Friend or Family

Print This Page

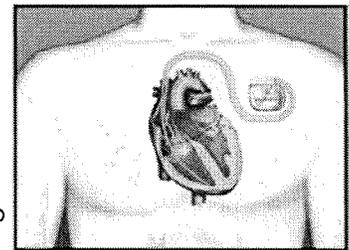
Contact Medtronic

What is Cardiac Resynchronization Therapy (CRT)?

Heart failure is the result of a damaged heart muscle. A heart with damaged muscle is a less effective pump resulting in a reduced ability to supply oxygen to meet the needs of the body and brain.

Selected patients with moderate to severe heart failure may benefit from Cardiac Resynchronization Therapy (CRT). CRT, in combination with stable optimal medical therapy, may help the lower chambers of the heart beat together and improve the heart's ability to supply blood and oxygen to the body. CRT is designed to help the two lower heart chambers, the right and left ventricles, beat at the same time in a normal sequence treating ventricular dysynchrony.

CRT is similar to a pacemaker. It is placed (implanted) under the skin of the upper chest. CRT is delivered as tiny electrical pulses to the right and left ventricles through three or four leads (soft insulated wires) that are inserted through the veins to the heart. These tiny impulses are small and not normally detected by the individual. Note the diagram to the right.



enlarge

Could CRT help me? More information

CRT may be prescribed for someone suffering from heart failure, but it is not a replacement for drug therapy. It is recommended that anyone choosing to receive CRT continue taking medications as prescribed by their physician.



Meet Bob and see how CRT has improved his quality of life.

"I'm back into life's circle. The light literally has turned green. Cardiac resynchronization therapy has given me a whole new chance to live my life..."

In some patients, cardiac resynchronization therapy has been shown to:

- Improve the ability to exercise and perform other physical activities
• Improve quality of life
• Improve the NYHA functional class (Class III, IV -- the heart failure classification system developed by the New York Heart Association widely used in the diagnosis of heart failure)

EXHIBIT I

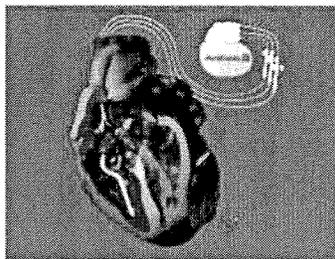
The world's first CRT system, the Medtronic InSync®, was introduced in 2001. Since then, more than 40,000 patients with heart failure have been treated with the Medtronic Cardiac Resynchronization Therapy.

Now, the next generation CRT system, the Medtronic InSync III, is available and offers expanded diagnostic and programming features to support your physician in treating your heart failure. [Click here](#) to see what the InSync III looks like.

Some heart failure patients are also at high risk of dangerously fast and life threatening heart rhythms ([Ventricular Tachycardia](#) and [Ventricular Fibrillation](#)). For those patients, Medtronic offers cardiac resynchronization therapy (CRT) combined with [implantable cardioverter defibrillator](#) (ICD) therapy.

[Click here](#) to learn more about CRT plus ICD therapies.

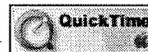
### Cardiac Resynchronization Therapy with the InSync Family



[ play video ]

This video shows how cardiac resynchronization therapy (the device and three or four leads or soft insulated wires) works. The system delivers tiny electrical pulses to the two sides of the heart, stimulating them to beat in a normal rhythm. In combination with optimal medical therapy, CRT improves the quality of life for thousands of patients by reducing their symptoms, increasing their exercise capacity and allowing them to resume many of their daily activities.

Need help viewing video?



*Information on this website should not be a substitute for consulting with your physician.*



- [Could I Have Heart Failure?](#)
- [Could CRT Help Me?](#)
- [MIRACLE Trial: Heart Failure Therapy Confirmed](#)
- [Request for Information - Heart Failure](#)
- [Find a Doctor Who Treats Heart Failure](#)
- [Prepare for Your Physician Visit](#)



Search

Home • Health Information • Contact Us

Heart Failure

Diagnosis

Treatment

Management

Treating Heart Failure

[Treatment Options for Heart Failure](#)

[What is Ventricular Dysynchrony?](#)

[What is Cardiac Resynchronization Therapy \(CRT\)?](#)

[What is CRT plus ICD Therapy?](#)

[Am I a Candidate for CRT?](#)

[What Does the Implant Procedure Involve?](#)

[Prepare for Your Physician Visit](#)

More information about Heart Failure

[Frequently Asked Questions](#)

[Patient Stories](#)

[Related Conditions](#)

[Coronary Artery Disease](#)

[Heart Valves](#)

[Sudden Cardiac Arrest](#)

[Ventricular Fibrillation](#)

Stages of Your Condition

[Diagnosing Heart Failure](#)

[Treating Heart Failure](#)

[Managing Heart Failure](#)

Important Safety Information

[Email This Page to Friend or Family](#)

[Print This Page](#)

[Contact Medtronic](#)

### What is Cardiac Resynchronization Therapy (CRT) plus ICD Therapy?

Heart failure is the result of damaged heart muscle. A heart with damaged muscle is a less effective pump resulting in reduced ability to supply oxygen to meet the needs of the body and brain.

Some individuals with a damaged heart muscle are also at high risk for dangerously fast and life threatening heart rhythms, [Ventricular Tachycardia \(VT\)](#) and [Ventricular Fibrillation \(VF\)](#). Patients with heart failure who are also at high risk for VT and VF may require a [CRT system](#) that includes implantable cardioverter defibrillator (ICD) therapy. The CRT plus ICD system is designed to help the two lower heart chambers, the right and left ventricles, beat at the same time in a normal sequence treating [ventricular dysynchrony](#). Additionally, should an individual experience an episode of VT or VF, the system will detect the life-threatening arrhythmia and automatically correct the heart's rhythm.



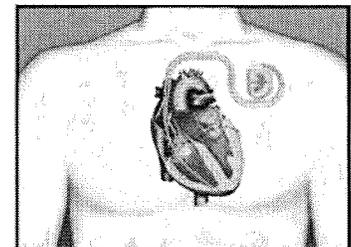
Meet Josephine and see how CRT plus ICD has improved her quality of life.

—"You know what a million dollar person feels like? That's what I feel like every day I get up."

See graphic at right for how the CRT system works.

### Medtronic CRT plus ICD systems

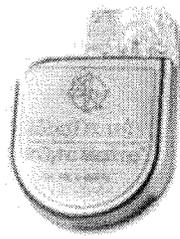
Medtronic has a number of devices that combine Cardiac Resynchronization Therapy (CRT) and Implantable Cardioverter Defibrillator (ICD) therapies to treat both ventricular dysynchrony and ventricular arrhythmias. These systems also offer extensive diagnostic and programming features to help your physician monitor and treat your condition.



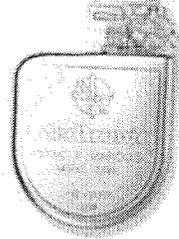
[enlarge](#)

Medtronic currently offers these CRT plus ICD systems:

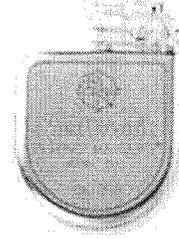
EXHIBIT J



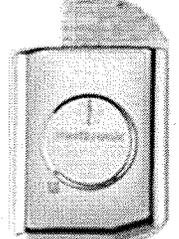
InSync Maximo™



InSync II  
Marquis™



InSync Marquis™  
CRT-ICD



InSync ICD®  
CRT-ICD

*Information on this website should not be a substitute for consulting with your physician.*



- [Could I Have Heart Failure?](#)
- [Could CRT Help Me?](#)
- [MIRACLE Trial: Heart Failure Therapy Confirmed](#)
- [Request for Information - Heart Failure](#)
- [Find a Doctor Who Treats Heart Failure](#)
- [Prepare for Your Physician Visit](#)



Search



Home • Health Information • Contact Us

Heart Failure

Diagnosis

Treatment

Management

Treating Heart Failure

[Treatment Options for Heart Failure](#)

[What is Ventricular Dysynchrony?](#)

[What is Cardiac Resynchronization Therapy \(CRT\)?](#)

[What is CRT plus ICD Therapy?](#)

[Am I a Candidate for CRT?](#)

[What Does the Implant Procedure Involve?](#)

[Prepare for Your Physician Visit](#)

More Information about Heart Failure

[Frequently Asked Questions](#)

[Patient Stories](#)

[Related Conditions](#)

› [Coronary Artery Disease](#)

› [Heart Valves](#)

› [Sudden Cardiac Arrest](#)

› [Ventricular Fibrillation](#)

Stages of Your Condition

[Diagnosing Heart Failure](#)

[Treating Heart Failure](#)

[Managing Heart Failure](#)

Important Safety Information

[Email This Page to Friend or Family](#)

[Print This Page](#)

[Contact Medtronic](#)

What Does the Implant Procedure Involve?

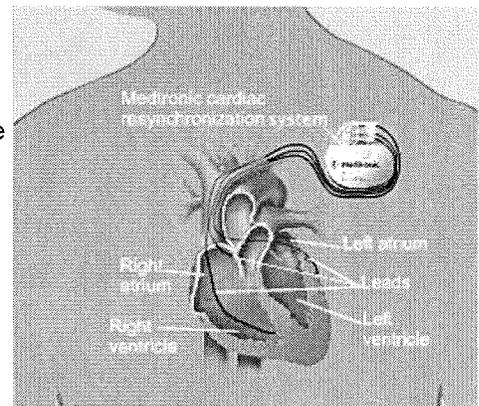
Implanting any of Medtronic InSync® Systems (Cardiac Resynchronization or Cardiac Resynchronization plus ICD) is a medical procedure. The system is placed under the skin of the chest and connected to three of four leads (soft insulated wires) that are inserted through veins into the heart.

During the procedure, you are given medication to make you sleepy and comfortable. After the implant, you will look the same as before. You may see a slight bulge under your skin where the device is located. The leads are quite thin and not visible. You will usually stay in the hospital overnight.

During your hospital stay, the doctor or nurse will use a specialized computer (programmer) to determine how your system is working.

After the procedure, you will receive instructions on how to care for the incision while it heals. When you are recovering at home there are some restrictions as to arm movement for a short period of time after surgery.

*Information on this website should not be a substitute for consulting with your physician.*



Take CHARGE

- [Could I Have Heart Failure?](#)
- [Could CRT Help Me?](#)
- [MIRACLE Trial: Heart Failure Therapy Confirmed](#)
- [Request for Information - Heart Failure](#)
- [Find a Doctor Who Treats Heart Failure](#)
- [Prepare for Your Physician Visit](#)



Medtronic.com | Physician | Cardiology

## Heart Failure InSync Maximo™ CRT-D Device

**Cardiac Resynchronization Therapy**

**CRT Devices**

**Left-Heart Leads**

**Delivery Systems**

**Programmings**

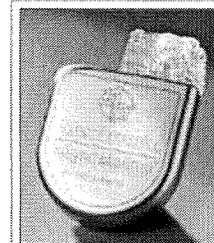
**Remote Monitoring**

**Clinical Studies & Guidelines**

**Reimbursement**

Indications, contraindications, warnings, precautions and adverse events

The Medtronic InSync Maximo™ incorporates proven cardiac resynchronization therapy, high defibrillation safety margin, enhanced longevity, and sophisticated diagnostics to meet each patient's individual needs.



[+] Click to enlarge

### Key Features

#### Advanced Cardiac

#### Resynchronization + ICD Therapies

- 35 Joules, high energy output in 9 seconds or less throughout the life of the device<sup>1</sup>.
- 6 years of longevity<sup>2</sup> (14% increase in longevity over InSync II Marquis).
- Separately programmable ventricular outputs for adapting pacing outputs to unique patient needs
- Special pacing functions to help manage heart failure patients who also experience atrial fibrillation.
- Painless antitachycardia pacing (ATP) therapy to terminate 3 out of 4 episodes of fast ventricular tachycardia (VT).<sup>3</sup>
- Enhanced PR Logic dual-chamber detection to maintain high sensitivity for ventricular tachyarrhythmias while improving discrimination for supraventricular tachycardias. Offers 95.2% accuracy (Positive Predictive Value) in delivered therapies.<sup>4</sup>
- Programmable with the [Medtronic CareLink® Programmer](#)

### Powerful Heart Failure Management and Advanced Patient Alert Capabilities

- [Heart Failure Management Report](#) showing 14-month trends of key heart failure patient monitoring categories such as AT/AF Burden, ventricular rate during AF, heart rate variability, patient activity and night/day heart rates.
- Observation messages highlighting heart failure related parameters outside of typical ranges.
- [Cardiac Compass® Report](#) with additional information about ventricular arrhythmia detection and therapies.
- [Rate Histogram Report](#) provides information about % pacing during episodes of AF, sinus rate profiles and ventricular rate profile during AF.
- Advanced patient alert capabilities, including lead integrity, battery condition change, and ICD therapy issues.
- Remote device follow-up with the [Medtronic CareLink Network](#) can dramatically reduce the time and resources required for routine device checks. Patients can use the Medtronic CareLink Service to transmit comprehensive device data using a standard phone line while at home, work or while traveling. Within minutes, clinics can view patient device data from any Internet-enabled PC using the secure clinician website. [Learn more.](#)

### Additional Information

➔ [Download "Cardiac Resynchronization Overview" \(PowerPoint\)](#)



➔ Visit [Medtronic Connect](#) for the latest in online presentation tools and in-depth information



➔ [Contact Medtronic Heart Failure Physician Services](#)

🖨️ [Print this page](#)

✉️ [Email this page to a colleague](#)

**Mechanical Specifications**

Volume	40 cc
Size: H x W x D	73 x 51 x 15 mm
Mass	78 g
Pace/sense ports	Three IS-1 bipolar (A, RV, LV)
Defibrillation ports	Two DF-1 (RV coil [HVB], SVC [HVX])
External shield	Titanium
Radiopaque ID	PRL
Battery	Lithium silver vanadium oxide; 3.2 V nominal

**Medtronic CareLink® Network**

Remote device follow-up with the [Medtronic CareLink Network](#) can dramatically reduce the time and resources required for routine device checks. Patients can use the Medtronic CareLink Service to transmit comprehensive device data using a standard phone line while at home, work or while traveling. Within minutes, clinics can view patient device data from any Internet-enabled PC using the secure clinician website. [Learn more.](#)

**References**

1. Full formed capacitors.
2. 100% DDD, atrial tracking, biventricular pacing, 70 min-1 average rate, 2.5 V/0.4 (A and RV), 3 V/0.4 (LV), 700 ohms equivalent pacing loads, 2 full energy charges per year.
3. Wathen MS, Sweeney MO, DeGroot PJ, et al. Shock reduction using antitachycardia pacing for spontaneous rapid ventricular tachycardia in patients with coronary artery disease. *Circulation*. August 14, 2001;104:796-801.2.
4. Accuracy based on Positive Predictive Value (PPV). Wilkoff B, Gillberg J, DeSouza C. The Enhanced PR Logic dual chamber tachyarrhythmia detection algorithm: retrospective analysis of supraventricular tachycardia with long PR intervals. *JACC Abstract* #873-4, Feb. 2001.

Document Description: **Off Action Outgoing**Mail / Create Date: **12-Jul-2004****UNITED STATES PATENT AND TRADEMARK OFFICE****SERIAL NO:** 78/341539**APPLICANT:** Medtronic, Inc.**\*78341539\*****CORRESPONDENT ADDRESS:**

Trademark Dept.  
 Medtronic, Inc.  
 LC 340  
 710 Medtronic Parkway  
 Minneapolis, MN 55432-5604

**RETURN ADDRESS:**

Commissioner for Trademarks  
 2900 Crystal Drive  
 Arlington, VA 22202-3514

**MARK:** INSYNC MAXIMO**CORRESPONDENT'S REFERENCE/DOCKET NO:** T1499 US

Please provide in all correspondence:

**CORRESPONDENT EMAIL ADDRESS:**

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**OFFICE ACTION**

**TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.**

Serial Number 78/341539

The assigned examining attorney has reviewed the referenced application and determined the following.

**Search Results**

The Office records have been searched and no similar registered or pending mark has been found that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

**Identification of Goods**

However, the wording "including" in the identification of goods needs clarification because it suggests the identification lists some, but not all goods, with which the mark will be used. The identification of goods must be specific and all-inclusive. Applicant should amend the identification to replace this wording with "namely." Please note that applicant may amend the identification to list only those items that are within the scope of the goods set forth in the application. 37 C.F.R. §2.71(a); TMEP §§1402.01 and 1402.03(a).

EXHIBIT M

The applicant may adopt the following identification of goods, if accurate:

medical devices, *namely*, implantable pulse generators and cardioverter defibrillators, component parts and fittings therefore.

For additional guidance, the applicant is strongly encouraged to consult the Acceptable Identification of Goods and Services Manual for the United States Trademark Office which may be found at [http://www.uspto.gov/web/offices/tac/doc/gsmannual/](http://www.uspto.gov/web/offices/tac/doc/gsmmanual/). The Manual is searchable using Ctrl+F.

The applicant is also advised that, while an application may be amended to clarify or limit the identification, *additions* to the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, the applicant may not amend to include any goods/services that are not within the scope of the goods/services set forth in the present identification.

#### **Electronic Response Encouraged**

To expedite prosecution of this application, applicant is encouraged to file its response to this Office action through the Trademark Electronic Application System (TEAS), available at <http://eteas.uspto.gov/V2.0/oa211>.

/kbp/  
Kimberly Boulware Perry  
Attorney, US Patent & Trademark Office  
phone: 703-308-9112 x251  
fax: 703-746-8112  
email: kimberly.perry@uspto.gov

#### **How to respond to this Office Action:**

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.**

This document may be displayed as a PDF file containing images without text. You may view online or save the entire document using the file download icon to the upper right. [required PDF viewer] [FAQ: Are you seeing only the first page of this PDF document?](#)

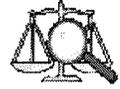
*If you need help:*

- *Call the Trademark Assistance Center at 571.272.9250 for help on trademark matters.*
- *Send questions about USPTO programs to the [USPTO Contact Center \(UCC\)](#).*
- *If you have technical difficulties or problems with this application, please e-mail them to [Electronic Business Support Electronic Applications](#) or call 1 800-786-9199.*



United States Patent and Trademark Office

Home | Site Index | Search | Guides | Contacts | eBusiness | eBiz alerts | News | Help



TTABVUE. Trademark Trial and Appeal Board Inquiry System

**Cancellation**

**Number:** 92046064

**Filing Date:** 07/18/2006

**Status:** Pending

**Status Date:** 07/20/2006

**Interlocutory Attorney:** ELIZABETH A DUNN

**Defendant**

**Name:** Medtronic, Inc.

**Correspondence:** Dean R. Karau  
Fredrikson & Byron, P.A.  
200 South Sixth Street Suite 4000  
Minneapolis, MN 554021425  
ip@fredlaw.com, dkarau@fredlaw.com

**Serial #:** 78341539

**Registration #:** 2968680

**Application Status:** Cancellation Pending

**Mark:** INSYNC MAXIMO

**Plaintiff**

**Name:** Masimo Corporation Masimo Corporation

**Correspondence:** Deborah S. Shepherd  
Knobbe, Martens, Olson & Bear, LLP  
2040 Main Street, 14th Floor  
Irvine, CA 92614  
efiling@kmob.com

**Prosecution History**

#	Date	History Text	Due Date
5	08/28/2006	ANSWER	
4	07/28/2006	CHANGE OF CORRESPONDENCE ADDRESS	
3	07/20/2006	PENDING, INSTITUTED	
2	07/20/2006	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	08/29/2006
1	07/18/2006	FILED AND FEE	

Results as of 09/25/2006 12:43 PM

**Search:**

| [HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)

EXHIBIT N

**Knobbe Martens Olson & Bear LLP***Intellectual Property Law*

2040 Main Street  
Fourteenth Floor  
Irvine, CA 92614  
Tel 949-760-0404  
Fax 949-760-9502  
www.kmob.com

June 1, 2005

**VIA FACSIMILE****ATTORNEY-CLIENT, COMMONALITY OF INTEREST AND/OR WORK PRODUCT PRIVILEGED COMMUNICATION**

This communication is protected by the attorney-client, commonality of interest and/or the work product privilege and should be treated in a confidential manner. Any disclosure to other than key management personnel on a need-to-know basis may jeopardize the privilege and require disclosure to adverse parties in litigation.

Dean R. Karau, Esq.  
FREDRIKSON & BYRON, P.A.  
200 South Sixth Street  
Suite 4000  
Minneapolis, MN 55402-1425

Re: MASIMO Corporation  
Medtronic's Use and Registration of the MAXIMO Trademark  
Our Reference No.: MASIMOT.068TIS

Dear Mr. Karau:

This is further to our telephone conversation regarding Medtronic's use and registration of the mark MAXIMO. It was a pleasure speaking with you.

As you know, we represent MASIMO Corporation ("MASIMO") in connection with its intellectual property matters. MASIMO is a leading medical technology company founded in 1989 that develops, licenses, and markets advanced medical signal processing technologies and products for non-invasive patient monitoring. Indeed, your client, Medtronic, Inc., has a long-standing relationship with MASIMO, and it has been a licensee of MASIMO and its MASIMO SET technology for several years now. Some of Medtronic's products, such as the LifePak 20 defibrillator/monitor, incorporate MASIMO SET technology and are marketed and sold as containing MASIMO SET technology.

Since at least as early as 1994, MASIMO Corporation has used the MASIMO trademark in connection with medical devices and technology. In order to protect its substantial investment, MASIMO has obtained two incontestable registrations, U.S. Registration No. 1,906,425 and U.S. Registration No. 1,951,663, for the mark MASIMO®. A copy of these registrations is enclosed. Issuance of these federal registrations constitutes constructive notice of MASIMO's claim of ownership of the MASIMO® trademark. See 15 U.S.C. § 1072.

San Diego  
619-235-8550

San Francisco  
415-954-4114

Los Angeles  
310-551-3450

Riverside  
951-781-9231

San Luis Obispo  
805-547-5580

**Knobbe Martens Olson & Bear LLP**

Dean R. Karau, Esq.  
June 1, 2005  
Page -2-

MASIMO is also the owner of registrations for the MASIMO mark throughout the world, including registrations in Argentina, Australia, Brazil, Canada, Chile, China the European Community, Hong Kong, Iran, Saudi Arabia, and Japan. MASIMO has expended substantial resources to promote its MASIMO trademark domestically and internationally for over a decade now and has developed a significant amount of goodwill in this trademark. As we are sure that you can appreciate, the MASIMO mark is an extremely valuable asset of the company and MASIMO will take all measures necessary to protect the strength and integrity of its trademark.

For many years, Medtronic, as a licensee, has been marketing certain of its products as containing MASIMO SET technology. For your information, enclosed is a printout of a press release dated September 16, 2002 in which Medtronic announced its agreement with MASIMO to incorporate MASIMO SET in its LifePak 20 defibrillator/monitor. Also, enclosed are printouts of products sheets which include use of the MASIMO SET trademark. MASIMO values its relationship with Medtronic and is appreciative of the efforts that Medtronic has made to incorporate MASIMO SET in its products and to promote and market such products and the MASIMO name.

MASIMO has also appreciated the efforts that Medtronic has made to market and sell MASIMO product accessories. For example, on Medtronic's website, under "Products" and "Product Accessories," several types of MASIMO sensors and patient cables are listed. Once a customer clicks on any of these products, a photograph of the MASIMO product appears along with information and a catalog number. A printout of several relevant pages from Medtronic's website are enclosed for your reference.

It has recently come to MASIMO's attention that Medtronic is now using the mark MAXIMO in connection with pulse generators, defibrillators, and other cardiac devices. This mark was adopted long after Medtronic began marketing its products as containing MASIMO SET technology and after Medtronic became a licensee of MASIMO.

The MAXIMO mark is virtually identical to the MASIMO mark. Moreover, the MAXIMO mark is used in connection with goods similar to and/or related to the MASIMO goods. The MAXIMO and MASIMO products may often be used on the same patient in the same hospitals by the same doctors or the same medical professionals. A doctor or medical professional using a MAXIMO device on a patient may likely use a MASIMO sensor on that same patient.

There is a strong likelihood of consumer confusion given the use of virtually identical marks in connection with similar goods used on the same patients in the same hospitals. Further exacerbating the likelihood of confusion is the fact that the MAXIMO mark is used on the same type of products that Medtronic sells as incorporating MASIMO SET® technology. Even on the Medtronic website, you can find a Masimo Corporation MASIMO sensor, a Medtronic MAXIMO device, or a Medtronic device containing MASIMO SET technology.

**Knobbe Martens Olson & Bear LLP**

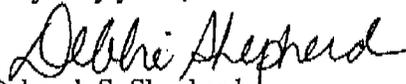
Dean R. Karau, Esq.  
June 1, 2005  
Page -3-

We are sure that you can appreciate the seriousness and gravity of these circumstances. Not only has MASIMO learned that a licensee of its MASIMO SET technology is using a mark that is virtually identical to the mark it has used for over a decade and one that is one of its most valuable assets, but it has also learned that your client has been seeking to register this mark in such countries as the U.S., Canada, Japan, the European Union. The use and registration of the MAXIMO mark constitutes trademark infringement, dilution and unfair competition.

Because MASIMO values its relationship with Medtronic, MASIMO is hopeful that this matter can be resolved amicably. We are confident that Medtronic will agree that both companies have an interest in identifying their goods separate and apart from each other. Accordingly, we request that Medtronic agree to cease all use of the MAXIMO mark and abandon all applications and registrations for this mark. MASIMO is willing to work with Medtronic in negotiating a reasonable phase-out period.

We look forward to your prompt response and thank you in advance for your cooperation.

Very truly yours,

  
Deborah S. Shepherd

Enclosures

cc: Chris Kilpatrick, Esq.  
Stephen C. Jensen, Esq.  
Diane M. Reed, Esq.

1735768  
060105