

TTAB

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

76467293

Mailed: September 10, 2008

Cancellation No. 92049753

Zimmer, Inc.

v.

ENCORE MEDICAL ASSET
CORPORATION

Karl Kochersperger, Paralegal

The notice instituting this proceeding and a copy of the petition to cancel were forwarded to registrant but were returned by the Postal Service as undeliverable.

It appears that the institution letter was mailed to a former address for registrant. This Office has obtained a more current address for registrant:

Encore Medical Asset Corporation
701 NORTH GREEN VALLEY PKWY
SUITE 209
HENDERSON, NEVADA 89074

Accordingly, the above notice, with enclosure, is remailed as indicated above.

Registrant is allowed until **FORTY DAYS** from the mailing date of this order in which to inform this Office of its correct address in order that all records may be amended.



09-29-2008

Compliance with Trademark Rule 2.193(b) and Trademark 2.119(a) is required.

If there has been any transfer of interest in the involved registration, registrant must so advise the Board and registrant must submit copies of the appropriate documents. See Section 10 of the Trademark Act and Patent and Trademark Rules 3.71 and 3.73.

In view of the circumstances, the time for filing an answer to the petition to cancel is extended to **FORTY DAYS** from the mailing date of this order. Notice is hereby given that unless the registrant listed herein, its assigns or legal representatives, shall enter an appearance, answer or other response to the petition within the time frame allowed, the cancellation may proceed as in the case of default.

In accordance with the Trademark Rules of Practice, conferencing, disclosure, discovery and testimony dates are set below. In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Time to Answer	10/20/08
Deadline for Discovery Conference	11/19/08
Discovery Opens	11/19/08
Initial Disclosures Due	12/19/08
Expert Disclosures Due	4/18/09
Discovery Closes	5/18/09
Plaintiff's Pretrial Disclosures	7/2/09
Plaintiff's 30-day Trial Period Ends	8/16/09
Defendant's Pretrial Disclosures	8/31/09
Defendant's 30-day Trial Period Ends	10/15/09
Plaintiff's Rebuttal Disclosures	10/30/09
Plaintiff's 15-day Rebuttal Period Ends	11/29/09

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

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

NEWS FROM THE TTAB:

For faster handling of all papers, the TTAB strongly encourages electronic filing whenever possible. TTAB forms for electronic filings are available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABvue at <http://ttabvue.uspto.gov>.

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while

most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>

ESTTA Case Number: ESTTA228344
 Filing Date: 08/05/2008

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Zimmer, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	345 Main Street Warsaw, IN 46580 UNITED STATES		

Attorney information	Christina L. Brown McDonnell Boehnen Hulbert & Berghoff LLP 300 South Wacker Drive Suite 3100 Chicago, IL 60606 UNITED STATES brownc@mbhb.com, gutwaks@mbhb.com, PSGDocket@mbhb.com Phone:312/913-0001
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Registrations Subject to Cancellation

Registration No	2750144	Registration date	08/12/2003
Registrant	ENCORE MEDICAL ASSET CORPORATION P.O. Box 530759 Henderson, NV 89053 UNITED STATES		

Goods/Services Subject to Cancellation

Class 010. First Use: 2002/06/05 First Use In Commerce: 2002/06/05 All goods and services in the class are cancelled, namely: Orthopedic prostheses, namely, joint implants
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Grounds for Cancellation

Genericness	Trademark Act section 23		
The mark is merely descriptive	Trademark Act section 2(e)(1)		
Registration No	2859530	Registration date	07/06/2004
Registrant	ENCORE MEDICAL ASSET CORPORATION P.O. Box 530759 Henderson, NV 89053 UNITED STATES		

Goods/Services Subject to Cancellation

Class 010. First Use: 2002/06/05 First Use In Commerce: 2002/06/05 All goods and services in the class are cancelled, namely: Orthopedic prostheses, namely, joint implants
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Grounds for Cancellation

Genericness	Trademark Act section 23
The mark is merely descriptive	Trademark Act section 2(e)(1)

Attachments	Petition to Cancel.pdf (5 pages)(154154 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/Christina L. Brown/
Name	Christina L. Brown
Date	08/05/2008

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

Zimmer, Inc.,

Petitioner,

v.

Encore Medical Asset Corporation,

Registrant

PETITION FOR CANCELLATION

Cancellation No. _____

Registration Nos. 2,750,144 and
2,859,530

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

PETITION FOR CANCELLATION PURSUANT TO 37 C.F.R. § 2.111

Petitioner, Zimmer, Inc., a Delaware corporation having its principal place of business at 345 Main Street, Warsaw, Indiana 46580, believes that it is being or will be damaged by Registration No. 2,750,144 for the mark REVERSE and Registration No. 2,859,530 for the mark *Reverse* ("Reverse" stylized), and, by its attorneys, hereby petitions to cancel same pursuant to 37 C.F.R. § 2.111, 15 U.S.C. § 1052, 15 U.S.C. § 1064 and 15 U.S.C. § 1127, for the reasons set forth herein.

Upon information and belief, the name and address of the current owner of the registrations is Encore Medical Asset Corporation, having an address at P.O. Box 530759, Henderson, NV 89053.

On information and belief, Encore Medical Asset Corporation's current correspondence address is as follows:

Harry L. Zimmerman
Encore Medical Asset Corporation
9800 Metric Boulevard
Austin, TX 78758

I. Background

As grounds for this Petition, Zimmer, Inc. ("Zimmer") alleges that:

1. On information and belief, Registration Nos. 2,750,144 and 2,859,530 are owned by Encore Medical Asset Corporation ("Encore Medical"), a Nevada corporation.
2. Registrant's application for Registration No. 2,750,144 was filed on November 15, 2002 and issued on August 12, 2003, for "orthopedic prostheses, namely, joint implants" in International Class 010.
3. Registrant's application for Registration No. 2,859,530 for the mark **Reverse** was filed on January 9, 2003 and issued on July 6, 2004, for "orthopedic prostheses, namely, joint implants" in International Class 010.

II. Standing

4. Zimmer has been actively engaged in research, development, and marketing activities using the word "reverse" in connection with prosthetic shoulder devices.
5. Zimmer has been using the name "Reverse" in connection with its Anatomical ShoulderTM Inverse/Reverse System prosthetic devices, in which the socket and ball of the joint are reversed.

6. Because of Zimmer's use of and need for the word "reverse" to refer to such prosthetic devices, Zimmer believes it will be damaged by Registration Nos. 2,750,144 and 2,859,530.

III. Counts

7. On information and belief, the term "reverse" when used in conjunction with prosthetic devices was not originated by Encore Medical.
8. On information and belief, a reverse/inverse shoulder was conceived by C.S. Neer in the early 1970's and the appellation of such devices (or procedures therefore) as "reverse" shoulders has been in use for decades.
9. The term "reverse" is at best merely descriptive of the type of prosthetic device with which the Registrant's marks are used. The device involves a prosthetic joint in which the ball and socket of the prosthesis are *reversed*. In the healthy patient, the shoulder is made up of a ball and socket joint and a rotator cuff. The ball connects to the arm; the socket connects to the shoulder blade. The rotator cuff is muscle that surrounds the joint and helps lift and rotate the arm. In patients suffering from a torn rotator cuff or arthritis, however, this protection is gone, and bone painfully scrapes against bone. Patients who receive a reverse shoulder prosthesis have the ball on the shoulder side, and the socket on the arm side – the sides of the two components of the shoulder are *reversed*.
10. Because of the descriptiveness of the marks (they directly describe without conjecture or speculation a quality of the Registrant's goods), they are inherently incapable of identifying a single source of goods.
11. Indeed, the term "reverse" is or has become generic when used to refer to the type of prosthetic device with which the marks are used. The term "reverse" is used to describe

such shoulder prostheses, and surgeries therefore, in journal articles and on the internet, without referring to Encore Medical's products.

12. The website [shouldersurgeon.com](http://www.shouldersurgeon.com) provides a list of definitions common to shoulder vocabulary. It defines "reverse shoulder prosthesis" as "an artificial shoulder joint made from metal and plastic that is used to replace a natural shoulder joint that is worn out, painful, and/or no longer functions properly. With a reverse shoulder prosthesis, the ball (humeral head) and socket (glenoid cup) are switched or "reversed." There may be advantages to using a reverse shoulder prosthesis in patients with an irreparable, massive rotator cuff tear or significant glenoid bone loss. Compare to *standard shoulder prosthesis*."

[http://www.shouldersurgeon.com/shoulder_terminology_vocabulary/index.htm]

IV. Prayer For Relief

13. The term "reverse" is a term that Zimmer and, on information and belief, other companies need to use in order to describe the products that they manufacture.
14. Without being able to use the word "reverse" when referring to their shoulder prostheses, Zimmer would be left with no way to accurately describe the type of prosthetic shoulder device it sells. Using the phrase "shoulder prosthesis" or the like is not sufficient to describe Petitioner's particular goods.
15. Zimmer believes that it is being or will be damaged by the continued registration of the marks REVERSE and Reverse.

WHEREFORE, Zimmer prays that Registration Nos. 2,750,144 and 2,859,530 be cancelled in their entireties, as they are generic and/or at best merely descriptive, and that this Petition for Cancellation be sustained in favor of Zimmer.

Respectfully submitted,

Dated: August 5, 2008

/Christina L. Brown
Christina Brown
James M. McCarthy
Marcia Ireland Rosenfeld

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Attorneys for the Petitioner,
Zimmer, Inc.

United States Patent and Trademark Office
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA. 22313-1451
If Undeliverable Return in Ten Days

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PENALTY FOR PRIVATE USE. \$300

AN EQUAL OPPORTUNITY EMPLOYER

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