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

Proceeding	92054196
Party	Plaintiff Medtronic, Inc.
Correspondence Address	DEAN R KARAU FREDRIKSON & BYRON PA 200 SOUTH SIXTH STREET, SUITE 4001 MINNEAPOLIS, MN 55402-1425 UNITED STATES ip@fredlaw.com, dkarau@fredlaw.com, cmoyer@fredlaw.com
Submission	Motion to Strike
Filer's Name	Dean R. Karau
Filer's e-mail	ip@fredlaw.com, dkarau@fredlaw.com
Signature	/Dean R. Karau/
Date	08/23/2011
Attachments	Medtronic Motion to Strike (92054196).pdf (6 pages)(24294 bytes) Medtronic Motion to Strike Exhibit 1.pdf (6 pages)(1169162 bytes)

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

Medtronic, Inc.,

Petitioner,

v.

Snow/Wood LLC,

Registrant.

Cancellation No. 92054196

**OPPOSER’S MOTION TO STRIKE REGISTRANT’S SECOND DEFENSE AND
MEMORANDUM IN SUPPORT THEREOF**

MOTION

Pursuant to Rule 12(f) of the Federal Rules of Civil Procedure and Sections 506.01 and 506.02 of the Trademark Trial and Appeal Board Manual of Procedure, Petitioner Medtronic, Inc., respectfully requests the Board to enter an order striking Registrant Snow/Wood LLC’s second defense in Registrant’s Answer and Defenses.

Despite the fact that Registrant sent Petitioner a cease and desist letter demanding that Petitioner stop using the term “patient ambassador,” Registrant’s defense asserts that Petitioner has not been and will not be damaged and, therefore, Petitioner lacks standing.

Petitioner has, in fact, been damaged, and, more importantly for purposes of this motion, has sufficiently plead its damage and its standing. Accordingly, Petitioner respectfully requests that Registrant’s second defense be stricken. Registrant should not be permitted to first threaten Petitioner and then claim that its threat was not intended to adversely affect Petitioner.

Petitioner’s motion is based upon the following facts and legal analysis, and the files and the pleadings related to this matter.

MEMORANDUM OF LAW

To have standing, the Board has stated that “[a]ll that is necessary . . . is that the ‘person’ bringing the opposition establish conditions and circumstances from which damage to it from the opposed mark can be assumed.” *FBI v. Societe: “M. Bril & Co.”*, 172 U.S.P.Q. 310 (T.T.A.B. 1971). The CCPA, the Board and the Federal Circuit have consistently de-emphasized “standing” or “damage” in inter partes oppositions and cancellations. Lanham Act §13 gives standing to oppose to “any person who believes that he would be damaged.” 15 U.S.C.A. § 1063. The courts have interpreted that statutory preamble to merely require that the opposer or petitioner demonstrate a real interest in the proceeding. *Federated Foods, Inc. v. Ft. Howard Paper Co.*, 544 F.2d 1098, 192 U.S.P.Q. 24 (C.C.P.A. 1976).

The only purpose of a standing requirement is to weed out “intermeddlers” from those with “a personal interest in the outcome beyond that of the general public.” *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 U.S.P.Q. 185 (C.C.P.A. 1982); *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 U.S.P.Q.2d 2021 (Fed. Cir. 1987) (opposer had standing because it was “more than a meddlesome party”). The focus has shifted to whether there is a reasonable basis for the opposer’s “belief” in damage. *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 U.S.P.Q. 641 (Fed. Cir. 1983) (dictum); *Rosso & Mastracco, Inc. v. Giant Food, Inc.*, 720 F.2d 1263, 219 U.S.P.Q. 1050 (Fed. Cir. 1983) (dictum). In 1991 the Board summarized the state of the law on standing to oppose:

The standing question is an initial and basic inquiry made by the Board in every inter partes case: that is to say, standing is a threshold inquiry. . . . [T]here is a low threshold for a plaintiff to go from being a mere intermeddler to one with an interest in the proceeding. The Court [of Appeals for the Federal Circuit] has stated that an opposer need only show “a personal interest in the outcome of the case beyond that of the general public.” . . . Once this threshold has been crossed, the opposer may rely on any ground that negates applicant's right to the registration sought.

Estate of Biro v. Bic Corp., 18 U.S.P.Q.2d 1382 (T.T.A.B. 1991).

Thus, the Board has concluded that there is no requirement that any type of actual damage be pleaded and proved in order to establish standing or to prevail in an opposition or cancellation proceeding. *Harjo v. Pro Football*, 30 U.S.P.Q.2d 1828 (T.T.A.B. 1994) (Petitioners, representing native Americans, sought to cancel registration of REDSKINS for a football team on grounds of disparagement and scandalousness; standing found: “[A] party may establish its standing to oppose or to petition to cancel by showing that it has a real interest in the case, that is, a personal interest beyond that of the general public.”).

Petitioner has sufficiently alleged facts that would, if proved, establish that it has standing to maintain the proceeding. Petitioner has also sufficiently alleged facts that would, if proved, establish that it has a valid ground for cancelling the registration of the mark.

In paragraph 6 of the Petition to Cancel, Petitioner alleged

Petitioner has also used the term “patient ambassador” for a number of years in connection with various programs designed to connect persons diagnosed with a disease or medical condition with other persons with the same disease or condition who have first-hand experience in the treatment of the disease or condition.

In paragraph 7 of the Petition to Cancel, Petitioner alleged:

Petitioner owns U.S. Registration No. 3,554,655 for the mark REAL DIABETES CONTROL, used in connection with, among other services, services described as “medical consultation services, namely, *patient ambassador* program to communicate medical information with people with diabetes.” (Emphasis added.)

In paragraph 8 of the Petition to Cancel, Petitioner alleged:

In a June 14, 2011, letter, Registrant demanded that Medtronic cease and desist any further use of the term “patient ambassador.”

In paragraph 9 of the Petition to Cancel, Petitioner alleged:

Continued registration of the term “patient ambassador” is causing and/or will cause damage to Medtronic by, among other things, interfering with Medtronic’s right to use the term or variations of the term in connection with various programs designed

to connect persons diagnosed with a disease or medical condition with other persons with the same disease or condition who have first-hand experience in the treatment of the disease or condition, including, but not limited to, use of the term in connection with its mark REAL DIABETES CONTROL.

Despite those very clear and precise pleadings, and despite Registrant admitting in its Answer and Defenses that it sent its cease and desist letter, Registrant's second defense states that "Petitioner has not been and will not be damaged by the continued registration of Registrant's mark and, therefore, lacks standing to cancel the Registration."

A cease and desist letter alone is sufficient to create standing. For instance, in *Ipco Corp. v. Blessings Corp.*, 5 USPQ2d 1974 (TTAB 1988), the Board found the opposer had standing as the result of the applicant's cease and desist letters it sent to the opposer. Similarly, in *Southern Snow Manufacturing, Inc. v. Snowizard Holdings, Inc.*, 2009 TTAB LEXIS 692, Cancellation No. 92044522 (TTAB Dec. 10, 2009), the Board found that petitioner's standing was established by the cease and desist letter that the respondent sent to the petitioner. These are not isolated cases.

Simply put, Registrant sent a cease and desist letter to Petitioner threatening consequences for Petitioner's continued use of the term "patient ambassador," and Petitioner sufficiently alleged those facts that would, if proved, establish that it would be damaged and that it has standing to maintain the proceeding. Registrant has a real interest in the outcome of the proceedings, that is, a personal interest. Simply put, Petitioner has standing.¹

¹ In its letter, Registrant wrote that, because Medtronic's use of the term "patient ambassador" "is a direct infringement of [Registrant's] rights, we demand that Medtronic cease and desist from any further use" of the term. Registrant demanded that Medtronic

1. remove all infringing content from the website www.medtronic.com and any other marketing materials;
2. immediately cease the use and distribution of any materials; and
3. deliver-up for destruction all unused or undistributed copies of the materials.

While motions to strike are not favored and a defense will not be stricken if the insufficiency of the defense is not clearly apparent, in this case, there is no doubt that Petitioner properly and unequivocally established its standing and, therefore, the insufficiency of Registrant's defense is clearly apparent. Registrant should not be permitted to first threaten Petitioner and then claim that its threat neither intended nor caused damage to Petitioner.

Accordingly, Registrant respectfully requests that the Board to strike Registrant's second defense, and grant such other and further relief as the Board deems appropriate.

Respectfully submitted,

Dated: August 23, 2011



Dean R. Karau
Cynthia A. Moyer
FREDRIKSON & BYRON, P.A.
Suite 4000
200 South Sixth Street
Minneapolis, Minnesota 55402
Tel.: (612) 492-7178/7167
Fax: (612) 492-7077
E-mail: ip@fredlaw.com; dkarau@fredlaw.com;
cmoyer@fredlaw.com

Attorneys for Petitioner

See Exhibit 1 attached hereto. Registrant then reserved all rights to further legal action, threatening that it "is prepared and intends to take whatever action is necessary to protect its Marks. . . [and] hope[s] that this issue can be resolved promptly so that further legal action may be avoided." Id.

CERTIFICATE OF SERVICE

I hereby certify that a true copy of Opposer's Motion To Strike Registrant's Second defense And Memorandum In Support Thereof was served on Registrant counsel of record, Christina L Demory, by mailing it to the correspondent address of record, PO Box 16216, Wilmington, NC 28408, by first-class mail, postage prepaid, this 23rd day of August, 2011.



Dean R. Karau

4977756_2.DOC



**Service of Process
Transmittal**

06/17/2011
CT Log Number 518693576

TO: Vicki Tersteeg
Medtronic, Inc.
MS: LC300, 710 Medtronic Parkway
Minneapolis, MN 55432-5604

RE: Process Served in Minnesota

FOR: MEDTRONIC USA, Inc. (Domestic State: MN)

ENCLOSED ARE COPIES OF LEGAL PROCESS RECEIVED BY THE STATUTORY AGENT OF THE ABOVE COMPANY AS FOLLOWS:

TITLE OF ACTION: RE: Unauthorized Use of Patient Ambassador // To: Medtronic USA, Inc.

DOCUMENT(S) SERVED: Letter, Attachment

COURT/AGENCY: None Specified
Case # None Specified

NATURE OF ACTION: Letter of Intent - Service Mark Infringement - Cease and Desist Use of Marks

ON WHOM PROCESS WAS SERVED: C T Corporation System Inc., Minneapolis, MN

DATE AND HOUR OF SERVICE: By Certified Mail on 06/17/2011 postmarked on 06/14/2011

JURISDICTION SERVED : Minnesota

APPEARANCE OR ANSWER DUE: Within 15 days of June 14, 2011 - Respond

ATTORNEY(S) / SENDER(S): Brenda Snow
Snow Companies
219 Bulifants Blvd.
Williamsburg, VA 23188

ACTION ITEMS: CT has retained the current log, Retain Date: 06/17/2011, Expected Purge Date:
06/22/2011
Image SOP
Email Notification, Vicki Tersteeg VICKI.ANN.TERSTEEG@MEDTRONIC.COM
Email Notification, Jackie Hiltner jackie.hiltner@medtronic.com

SIGNED: C T Corporation System Inc.
PER: Deborah Van Ness
ADDRESS: 100 South Fifth Street
Suite 1075
Minneapolis, MN 55402
TELEPHONE: 612-333-4315

June 14, 2011

Via U.S. Certified Mail
Return Receipt Requested

Mr. William A. Hawkins
Chief Executive Officer
Medtronic, Inc.
710 Medtronic Parkway
Minneapolis, MN 55432-5604

CT Corporation System, Inc.
Registered Agent for Medtronic USA, Inc.
100 S. 5th St. # 1075
Minneapolis, MN 55402

Re: Unauthorized use of Patient Ambassador™

Dear Mr. Hawkins:

It has come to our attention that Medtronic, Inc. and Medtronic USA, Inc. (collectively "Medtronic") have been and are using federally-registered service marks belonging to Snow Companies without authorization. Because such unauthorized use is likely to cause confusion in the marketplace, dilutes the good will that Snow has developed in these marks, and is a direct infringement of Snow's rights, we demand that Medtronic cease and desist from any further use of these service marks.

Snow first used Patient Ambassador in commerce as a service mark in 2001. Subsequently, Snow/Wood LLC obtained two service mark registrations for Patient Ambassador™ from the U.S. Patent and Trademark Office: U.S. Reg. No. 3346658 and U.S. Reg. No. 3346659 ("the Marks")(copies enclosed). Snow/Wood LLC has granted to Snow Companies ("Snow") the exclusive license to use the Marks, together with the right to protect them. By virtue of these registrations, Snow has the exclusive right to use the Marks for the recruitment of persons diagnosed with a certain disease or medical condition for the purpose of conducting educational symposia and for the promotion and marketing of educational symposia using persons diagnosed with a certain disease or medical condition. It is important that Snow exercise its rights to protect the Marks, as they serve as important and distinctive representations of the origin of Snow's services as well as Snow's goodwill within the medical marketing community.

We have learned that Medtronic has used the Marks in the marketing of its products and services through both the Internet and other advertising means. This unauthorized use creates confusion among our customers. Moreover, this unauthorized use is likely to lessen the Marks effectiveness in establishing a distinct association among the Marks, Snow's services,

Mr. William A. Hawkins
June 14, 2011
Page 2

and Snow's good will, which has caused, and may continue to cause, substantial harm to the Marks themselves and to Snow.

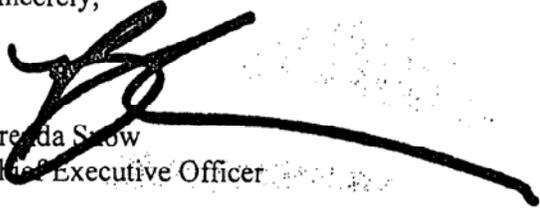
Due to these concerns, and because unauthorized use of the Marks is an infringement of Snow's rights under the Lanham Act and at common law and may cause irreparable harm to Snow, we respectfully request that Medtronic cease and desist from any further use of Patient Ambassador™ in association with the marketing, sale, distribution, or identification of its products and services. Specifically, we demand that Medtronic immediately:

1. remove all infringing content from the website www.medtronic.com and any other marketing materials and notify us in writing that Medtronic has done so;
2. immediately cease the use and distribution of any materials, whether in printed or electronic form, containing the Marks;
3. deliver-up for destruction all unused or undistributed copies of materials containing the Marks;
4. undertake in writing to desist from any future use of the Marks without prior written authorization from Snow.

Please respond in writing within fifteen (15) days of the date of this letter and indicate Medtronic's intention to cease and desist using the Marks, or any confusingly similar mark. This request is made without prejudice to any other rights Snow may have under the Lanham Act or at common law, all of which are hereby expressly reserved.

Snow is prepared and intends to take whatever action is necessary to protect its Marks. We hope that this issue can be resolved promptly so that further legal action may be avoided. We thank you in advance for your attention to this important matter.

Sincerely,



Brenda Snow
Chief Executive Officer

Enclosures

cc: Ms. Christina L. Demory, Esq.

Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 3,346,658

United States Patent and Trademark Office

Registered Dec. 4, 2007

**SERVICE MARK
PRINCIPAL REGISTER**

PATIENT AMBASSADOR

SNOW/WOOD LLC (VIRGINIA LTD LIAB CO)
4300 EASTER CIRCLE
WILLIAMSBURG, VA 23185

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

FOR: EMPLOYMENT RECRUITING ON BEHALF
OF OTHERS OF ONE OR MORE PERSONS DIAG-
NOSED WITH A DISEASE OR MEDICAL CONDI-
TION FOR THE PURPOSE OF HAVING THE
RECRUITED PERSON OR PERSONS CONDUCT
SYMPOSIUMS RELATED TO THE DISEASE OR
MEDICAL CONDITION, IN CLASS 35 (U.S. CLS.
100, 101 AND 102).

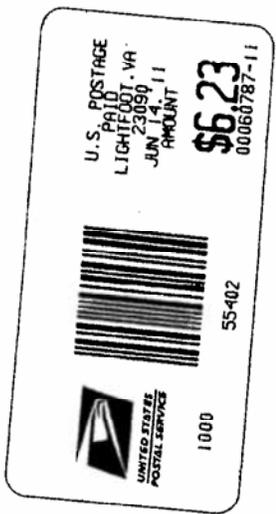
NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "PATIENT", APART FROM THE
MARK AS SHOWN.

SER. NO. 76-671,817, FILED 1-25-2007.

FIRST USE 11-30-2001; IN COMMERCE 11-30-2001.

GEOFFREY FOSDICK, EXAMINING ATTORNEY

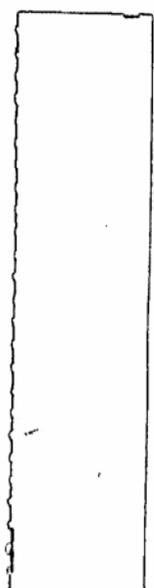
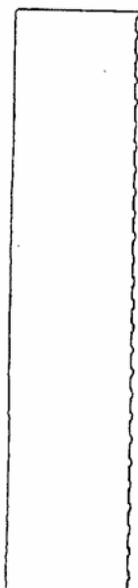
Snow Com
219 Bolif
Williamson



7/14/89

RETURN RECEIPT
REQUESTED

CT Corporation Systems Inc.
Registered Agent for Medtronic USA, Inc.
100 S. 5th Street, # 1075
Minneapolis, MN 55402



802-564-7937