

ESTTA Tracking number: **ESTTA614749**

Filing date: **07/09/2014**

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	Resonance Innovations, LLC		
Entity	Limited Liability Company	Citizenship	Nebraska
Address	9840 S. 140th Street, Suite 8 Omaha, NE 68138 UNITED STATES		

Attorney information	Mark C. Young Stinson Leonard Street LLP 1201 Walnut Street, Suite 2900 Kansas City, MO 64106-2150 UNITED STATES TRADE- MARK@STINSONLEONARD.COM, MARK.YOUNG@STINSONLEONARD.COM M Phone: 816.842.8600
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Registration Subject to Cancellation

Registration No	4493468	Registration date	03/11/2014
Registrant	SCANMED QR, LLC 2716 NW 158TH STREET EDMOND, OK 73013 UNITED STATES		

Goods/Services Subject to Cancellation

Class 016. First Use: 2012/04/04 First Use In Commerce: 2012/04/04 All goods and services in the class are cancelled, namely: Medical identification cards, not magnetically encoded; Medical identification cards, not magnetically encoded, having a code that permits access to a database containing medical information and records for medical alert purposes
Class 044. First Use: 2012/04/04 First Use In Commerce: 2012/04/04 All goods and services in the class are cancelled, namely: Medical assistance services in the nature of medical information and records provided to medical professionals and first responders from remote locations via the Internet and global computer network through the use of a data storage and retrieval system

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Violation of Duty of Candor

Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration	3185228	Application Date	12/27/2004
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No.			
Registration Date	12/19/2006	Foreign Priority Date	NONE
Word Mark	SCANMED		
Design Mark	SCANMED		
Description of Mark	NONE		
Goods/Services	Class 010. First use: First Use: 2004/06/30 First Use In Commerce: 2004/06/30 Biomedical instrumentation, namely, magnetic resonance imaging machines, and magnetic resonance spectroscopy coils for medical use		

Attachments	76625887#TMSN.gif(bytes) PetitionForCancellation4493468.pdf(216656 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	/Mark C. Young/
Name	Mark C. Young
Date	07/09/2014

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

In re Registration No. 4,493,468
Mark: SCANMED QR
Date Registered: March 11, 2014

RESONANCE INNOVATIONS LLC,)
)
 Petitioner,)
)
 v.) Cancellation No.
)
SCANMED QR, LLC,)
)
 Registrant.)

PETITION FOR CANCELLATION

Resonance Innovations, LLC ("Petitioner"), a limited liability company organized and existing under the laws of the State of Nebraska, believes that it is, and will continue to be, damaged by Registration No. 4,493,468 and hereby petitions to cancel the same under the provisions of 15 U.S.C. § 1064(3). As grounds for cancellation, Petitioner asserts:

1. Petitioner is a leading designer and manufacturer of Magnetic Resonance Imaging (MRI) coils and other biomedical instrumentation, including MRI related products and accessories.
2. Upon information and belief, Scanned QR, LLC ("Registrant") is an Oklahoma Limited Liability Company with its principal place of business at 2716 NW 158th Street, Edmond, OK 73013.
3. Petitioner is the owner of U.S. Registration No. 3,185,228 for the mark SCANMED for use with biomedical instrumentation, namely, MRI machines, and magnetic resonance spectroscopy coils for medical use in International Class 10. The SCANMED mark

was registered on December 19, 2006 and Petitioner adopted and has used this mark in interstate commerce in connection with the listed goods at least as early as June 30, 2004.

4. Registration No. 4,493,468, sought to be cancelled herein, is for the mark SCANMED QR, registered for use in connection with medical identification cards, not magnetically encoded; medical identification cards, not magnetically encoded, having a code that permits access to a database containing medical information and records for medical alert purposes in International Class 16, and for medical assistance services in the nature of medical information and records provided to medical professionals and first responders from remote locations via the Internet and global computer networks through the use of a data storage and retrieval system in International Class 44.

5. Petitioner has, since long before the date of first use alleged in Registration No. 4,493,468, been in the business of designing and manufacturing biomedical instrumentation, including biomedical instrumentation and MRI-related products and accessories used in hospitals, clinics, and doctors' offices throughout the United States, and Petitioner is currently in such business.

6. Petitioner has, since long before the date of first use alleged in Registration No. 4,493,468, adopted and began using the name "SCANMED" in conjunction with biomedical instrumentation products, and the SCANMED mark appears prominently on Petitioner's product packaging, sent to hospitals, clinics and doctors' offices throughout the United States and on Petitioner's products, which are located in hospitals, clinics and doctors' offices throughout the United States.

7. Petitioner has invested substantial time, money and effort in promoting, advertising and popularizing its SCANMED mark and has developed substantial and exclusive

goodwill and a good reputation in connection with its use of SCANMED in connection with biomedical instrumentation products.

First Basis for Cancellation - Likelihood of Confusion

8. Registrant's mark SCANMED QR so closely resembles Petitioner's mark "SCANMED" that the registration and continued use of SCANMED QR by Registrant will falsely suggest a connection with Petitioner in violation of Section 2(a) of the Trademark Act of 1946 (15 U.S.C. § 1052[a]) and will result in irreparable damage and injury to Petitioner.

9. Registrant's mark SCANMED QR so closely resembles Petitioner's mark "SCANMED" that the registration and continued use of SCANMED QR by Registrant is likely to cause confusion, mistake and deception within the meaning of section 2(d) of the Trademark Act of 1946 (15 U.S.C. § 1052[d]) and will result in irreparable damage and injury to Petitioner.

10. Registrant's mark SCANMED QR when used in connection with Registrant's goods and services as identified above is confusingly similar to Petitioner's SCANMED mark identified herein, as applied to Petitioner's goods.

11. Registrant's goods and services identified in the subject registration are or will be offered through the same channels of trade as Petitioner's related goods, including those goods offered under Petitioner's mark SCANMED.

12. If the Registrant is permitted to retain the registration sought to be cancelled, and, thereby, the *prima facie* right to use in commerce its mark on medical goods similar to those offered by Petitioner, confusion in trade is likely to result from any concurrent use of Petitioner's marks and that of the Registrant all to the great detriment of Petitioner, who has expended considerable sums and effort in promoting its mark.

**Second Basis for Cancellation –
Registrant's Violation of its Duty of Candor to the Office**

13. On or about early September, 2013, Petitioner became aware of Registrant's use of "SCANMED QR" in conjunction with medical identification cards.

14. On September 13, 2013, Mark Peterson, then-counsel for Petitioner, contacted Registrant via email regarding its use of SCANMED QR, notifying Registrant that such use infringed Petitioner's trademark rights and demanding that Registrant cease and desist all use of SCANMED QR in conjunction with medical-related goods and services.

15. On or about September 13, 2013, Registrant responded to Mark Peterson via telephone and agreed to cease all use of SCANMED QR and assured Mr. Peterson that Registrant would provide to him a written document memorializing that agreement.

16. On September 16, 2013, three days after agreeing to stop using the SCANMED QR mark, Registrant filed a Response to Office Action with the U.S. Patent and Trademark Office ("the Office"), continuing to pursue registration of SCANMED QR. Based upon information and belief, that response did not include any amendment to Registrant's declaration or any notification to the Office of the infringement claim against Registrant nor of Registrant's agreement to cease all use of SCANMED QR.

17. On November 15, 2013, Registrant communicated with the Office to amend the goods and services description of the application and to continue to pursue registration of SCANMED QR. Based upon information and belief, that communication did not include any amendment to Registrant's declaration or any notification to the Office of the infringement claim against Registrant nor of Registrant's agreement to cease all use of SCANMED QR.

18. The Office relied upon Registrant's declaration in allowing Registration No. 4,493,468, and presumably would not have allowed that registration absent Registrant's intentional withholding of its agreement to cease and desist all use of the SCANMED QR mark.

WHEREFORE, Petitioner prays that Registration No. 4,493,468 be cancelled pursuant to 15 U.S.C. § 1064(3).

Respectfully submitted,

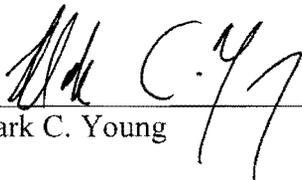
By: 
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Attorney for Petitioner

Dated: July 9, 2014

CERTIFICATE OF SERVICE

Pursuant to C.F.R. 2.111, I hereby certify that a true and correct copy of the foregoing Petition for Cancellation was served, via Federal Express Overnight Delivery, on Registrant SCANMED QR, at the following address:

2716 NW 158th Street
Edmond, OK 73013


Mark C. Young