

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

In the matter of application Serial No. 76/535,842. Filed on July 30, 2003 for the Mark "PACEMAKERPLUS". Published in the Official Gazette (Trademarks) on March 23, 2004.

Pacesetter, Inc. doing business as St. Jude Medical Cardiac
Rhythm Management Division
Opposer,

v.

Cardiac Pacemakers, Inc.
Applicant.

Opposition No. 91161301

Box TTAB No Fee
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

ANSWER TO OPPOSITION

Dear Commissioner:

Applicant Cardiac Pacemakers, Inc., 4100 Hamline Avenue North, Saint Paul, MN 55112-5798, by its undersigned counsel, responds to Opposer's Notice of Opposition by denying each and every allegation of the Opposition unless specifically admitted hereunder below and further responds as follows:

1. Applicant admits the allegations contained in Paragraph 1 of the Notice of Opposition.

2. In response to Paragraph 2 of the Notice of Opposition, Applicant denies that PACEMAKER is the predominant term in Applicant's mark PACEMAKERPLUS and further states that whether PACEMAKER is generic or descriptive does not materially affect the registrations of the PACEMAKERPLUS mark.



3. Opposer admits the allegations of paragraph 3 of the Notice of Opposition and notes that Opposer has not used the mark PACEMAKERPLUS for describing its goods in its trademark registration PACESETTER (LOGO), Registration No. 1,097,321.

4. In response to Paragraph 4 of the Opposition, Applicant denies that PACEMAKER is the predominant term of the PACEMAKERPLUS mark. Applicant admits the work "pacemaker" appears in the documents identified, and notes that Opposer has not used the mark PACEMAKERPLUS for describing its goods in its trademark registrations RHYTHM ID, Registration No. 2,800,770, and CONTAK TR, Registration No. 2,462,195.

5. In response to Paragraph 5 of the Notice of Opposition, Applicant denies that the term "pacemaker" is the predominant term in the PACEMAKERPLUS mar. Applicant admits that the documents attached to the Notice of Opposition as Exhibit A purport to be U.S. Patent Nos. 6,615,089; 6,564,095; 6,522,922; 6,216,035; 6,055,454; 5,941,903; 5,413,593; and 5,284,136. Applicant admits that the documents attached as Exhibit A to the Notice of Opposition use the term "pacemaker" and notes that none of the documents in Exhibit A include the mark PACEMAKERPLUS.

6. In response to Paragraph 6 of the Notice of Opposition, Applicant denies that the term "pacemaker" is the predominant term in the PACEMAKERPLUS mark. Applicant admits that documents attached to the Notice of Opposition as Exhibit B purport to be U.S. Patent Nos. 6,625,491; 6,671,549; 6,067,472; 5,814,083; 5,676,686; and 5,431,695. Applicant admits that term "pacemaker"

is used within these patents, and notes that the mark PACEMAKERPLUS does not appear in any of the patents contained in Exhibit B.

7. In response to Paragraph 7 of the Notice of Opposition Applicant denies that ``pacemakers'' is the predominant term in the PACEMAKERPLUS mark. Applicant admits that Exhibit C to the Notice of Opposition purports to be copies of the following publications:

Title of Publication	Author of Company	Name of Publication	Date Published	Page No.
Pacemaker Diagnostics: A Critical Appraisal of Current Technology	Pollack et al.	PACE	Jan, 2003 Vol. 26	76-98
New Onset of Pacemaker Dependency After Permanent Pacemaker Implantation	Nagatomo et al.	PACE	Apr, 2004 Vol. 27	475-479
Managing Pacemaker Safety Alerts: Experience with Three Successive Models of a Single Manufacturer	Gurevitz et al.	PACE	Dec, 2003 Vol. 26	2283-2288
Physician Management of Pacemaker and Implantable Cardioverter Defibrillator Advisories	Maisel	PACE	Apr, 2004 Vol. 27	437-442
Right Ventricular Outflow Versus Apical Pacing in Pacemaker Patients with Congestive Heart Failure and Atrial Fibrillation	Stambler et al.	J. Cardiovascular Electrophysiology	Nov, 2003 Vol. 14, No. 1	104-106
Sophisticated Architecture is Required for the Sinoatrial Node to Perform Its Normal Pacemaker Function	Boyett et al.	J. Cardiovascular Electrophysiology	Jan, 2003 Vol. 14, No. 1	104-106
Cellular expression and functional characterization of four hyperpolarization-activated pacemaker channels in cardiac neuronal tissues	Moosmang et al.	Eur. J. Biochem	Mar, 2001 Vol. 268, Issue 6	1646-1652

Applicant notes that the mark PACEMAKERPLUS is not used generically in any of the publications.

8. Applicant admits that it is claiming the mark PACEMAKERPLUS for the goods listed in its application for registration, but denies the remaining allegations of Paragraph 8 of the Notice of Opposition.

9. Applicant denies each and every allegation contained in Paragraph 9 of the Notice of Opposition.

10. Applicant admits that registration of the mark PACEMAKERPLUS would grant it a prima facie exclusive right to use the mark PACEMAKERPLUS. Applicant denies that such registration would be a source of damage and injury to the Opposer.

AFFIRMATIVE DEFENSES

11. Opposer's Notice of Opposition fails to state a claim upon which relief can be granted.

12. Opposer has not alleged any legislative grounds for denying applicant registration of the PACEMAKERPLUS mark.

13. Opposer does not alleged that it is the prior user of the mark PACEMAKERPLUS.

14. Opposer does not allege that the PACEMAKERPLUS mark is descriptive.

15. Opposer does not allege that the PACEMAKERPLUS mark is generic.

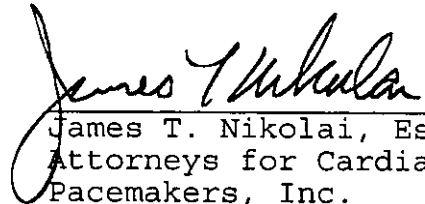
16. Opposer, itself, has registered various marks which include a descriptive term followed by the work PLUS.

See, for example, U.S. Trademark Registration 2,008,955 for the mark AV PLUS and U.S. Trademark Registration 1,955,899

for the mark PASSIVE PLUS. Thus, Opposer understand that this opposition is not well founded in fact or law.

WHEREFORE, Applicant prays that the application Serial No. 76/5351842 be granted.

Respectfully submitted,
Nikolai & Mersereau, P.A.


James T. Nikolai, Esq.
Attorneys for Cardiac
Pacemakers, Inc.
820 International Centre
900 Second Avenue South
Minneapolis, MN 55402
Telephone: (612) 339-7461

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

Pacesetter, Inc., dba St. Jude Medical
Cardiac Rhythm Management Division,

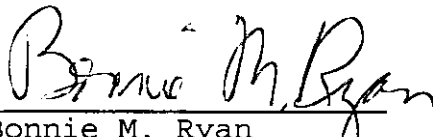
Opposer, Opposition No. 91161301

Cardiac Pacemakers, Inc.

Applicant.

CERTIFICATE OF MAILING

I hereby certify that an original and two copies of the Answer to Notice of Opposition mailed July 19, 2004 in the above-noted opposition are being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Box TTAB, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514, postage prepaid, on Aug. 27, 2004.



Bonnie M. Ryan
On Behalf of James T. Nikolai

TTAB

August 27, 2004

Assistant Commissioner for Trademarks
Box TTAB
2900 Crystal Drive
Arlington, Virginia 22202-3514

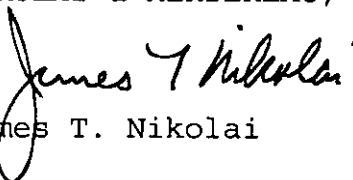
Re: In the matter of application Serial No. 76/535,842
Opposition No. 91161301
Applicant: Cardiac Pacemakers, Inc.
Proposed Mark: PACEMAKERPLUS
Our File No. 20030256

Sir:

We are enclosing with this letter the original and two copies of Applicant's Answer to Opposition, together with a Certificate of Mailing and a copy of the Certificate of Service on counsel for Opposer regarding the above-referenced trademark application.

Yours very truly,

NIKOLAI & MERSEREAU, P.A.


James T. Nikolai

JTN:br
Enclosures
cc: Steven M. Mitchell, Esq.



08-30-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #22