

ESTTA Tracking number: **ESTTA401832**

Filing date: **04/05/2011**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	SYNTHES USA, LLC
Granted to Date of previous extension	04/06/2011
Address	1302 WRIGHTS LANE EAST WEST CHESTER, PA 19380 UNITED STATES

Attorney information	Denise I. Mroz WOODCOCK WASHBURN LLP Cira Centre, 12th Fl., 2929 Arch Street Philadelphia, PA 19104-2891 UNITED STATES trademarks@woodcock.com, dmroz@woodcock.com Phone:215.568.3100
----------------------	--

Applicant Information

Application No	77917879	Publication date	12/07/2010
Opposition Filing Date	04/05/2011	Opposition Period Ends	04/06/2011
Applicant	SYNTHASOME INC. SUITE 308 3030 BUNKER HILL STREET SAN DIEGO, CA 92019 UNITED STATES		

Goods/Services Affected by Opposition

Class 010. First Use: 2004/10/01 First Use In Commerce: 2004/10/01 All goods and services in the class are opposed, namely: medical and surgical devices excluding goods in the orthopedic field, namely, surgical meshes and artificial tissue-engineered implants
--

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	999397	Application Date	05/17/1972
Registration Date	12/10/1974	Foreign Priority Date	NONE
Word Mark	SYNTHES		
Design Mark			

Description of Mark	NONE
Goods/Services	Class U044 (International Class 010). First use: First Use: 1960/12/16 First Use In Commerce: 1964/01/01 INSTRUMENTS AND APPARATUS FOR SURGICAL, MEDICAL, AND VETERINARY PURPOSES SOLELY FOR BONE SURGERY-NAMELY, INSTRUMENTS AND IMPLANTS FOR OSTEOSYNTHESIS, INCLUDING BONE SCREWS, BONE NAILS, BONE PLATES AND SPLINTS; INJECTION NEEDLES, AND GUM PLATES

U.S. Registration No.	2561835	Application Date	09/05/2001
Registration Date	04/16/2002	Foreign Priority Date	NONE
Word Mark	SYNTHESES		
Design Mark	SYNTHESES		
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 2001/03/06 First Use In Commerce: 2001/03/06 WATER BATH HEATERS FOR MEDICAL INSTRUMENTS AND FOR CONTOURING BIOLOGICAL IMPLANTS		

U.S. Registration No.	2788064	Application Date	01/10/2002
Registration Date	12/02/2003	Foreign Priority Date	NONE
Word Mark	SYNTHESES		
Design Mark	SYNTHESES		
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1982/01/04 First Use In Commerce: 1982/01/04 Chemical preparations used in science for, or in connection with bone implants and implantation, namely, bone cements, pastes, putties and ceramics and bone growth factors; unprocessed plastics, namely bioresorbable plastics for use in connection with osteosynthesis, [musculoskeletal] * musculoskeletal, * maxillofacial, and spine surgery; unprocessed polylactates for use in osteosynthesis, musculoskeletal, maxillofacial, and spine surgery Class 010. First use: First Use: 2000/12/06 First Use In Commerce: 2000/12/06		

	<p>Surgical and medical equipment, namely handheld power drills, bone milling cutters, saw, and locking bolts for medical and surgical purposes and electronic motors for use with the aforementioned equipment; surgical, medical, and veterinary instruments for use in [osteosyntbesis,] * osteosynthesis, * musculoskeletal, maxillofacial, and spine surgery, namely, saws and rasps for bones, probes, surgical knives, bone drills, surgical drills, drill guides, aiming guides for directing bone screws and similar devices into bone plates, retractors, chisels, bone forceps, bone clamps, pelvic clamps, internal and external fixators, elevators and impactors; devices for use and insertion [dining] * during * surgery and recovery, namely, intra medullary nails and plugs, bone staples, bone pins, bone clamps, pelvic clamps, angulated plates, compression plates, pedicle screws, pedicle hooks, cerclage wires, disc replacements, spinal rods and plates, artificial bones for surgical implantation, surgical implants comprising artificial non-biodegradable and biodegradable materials, namely, bone cements, bone pastes, and [patties,] * putties, * and ceramics, bone substitutes, allograft implants, chips, strips, hip screws; parts of artificial bones for augmenting natural bones; bone graft extenders and bone growth factors all used for bone void fillers and bone regeneration; sterilizing trays for surgical and medical use, trays and cases for surgical and medical instruments and implants; apparatus for classifying and keeping inventory of scientific documentation and surgical and medical instruments and implants, namely, metal medical storage cabinets for storing surgical and medical instruments and implants, featuring a CPU for keeping inventory of surgical and medical instruments and implants</p>
--	---

Attachments	<p>76309308#TMSN.gif (1 page)(bytes) 76357989#TMSN.gif (1 page)(bytes) SynthasomeComplaint.pdf (14 pages)(235860 bytes)</p>
-------------	--

Certificate of Service

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

Signature	/Denise I. Mroz/
Name	Denise I. Mroz
Date	04/05/2011

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

Synthes USA, LLC		In Re:
	Opposer,	Serial No.: 77917879
	v.	Filed: January 22, 2010
Synthasome Inc.,		Published: December 7, 2010
	Applicant.	Mark: SYNTHASOME
		Opposition No.:

NOTICE OF OPPOSITION

Opposer, Synthes USA, LLC (“Synthes”), a Delaware limited liability company with a principal place of business located at 1302 Wrights Lanes East, West Chester, Pennsylvania 19380, believes it will be damaged by registration of the mark SYNTHASOME, which is the subject of U.S. Trademark Application Serial No. 77917879 filed by Synthasome Inc. (“Applicant”), a California corporation with a place of business at Suite 308, 3030 Bunker Hill Street, San Diego, California 92019, and Synthes hereby opposes the same.

As grounds of opposition, it is alleged that:

1. For more than fifty years, Synthes and its predecessors in interest have been a leading global medical device company. Specifically, Synthes develops produces, and markets instruments, implants and biomaterials for the surgical fixation, correction and regeneration of the human skeleton and its soft tissues.

2. Synthes employs over ten thousand (10,000) people worldwide. Synthes’ annual sales in North America are in the billions of dollars. In 2009, Synthes’ revenues in North America were over \$2 billion and its worldwide revenues were nearly \$3.4 billion, with net earnings of \$824 million.

3. Prior to January 22, 2010, the filing date of the Applicant's intent-to-use application, Synthes commenced and has continuously used its mark SYNTHES® in U.S. commerce for a wide variety of medical and surgical instruments, applications, implants and biomaterials.

4. Synthes owns several U.S. trademark registrations for the mark SYNTHES®. Its U.S. registrations include:

- U.S. Registration No. 999397 for SYNTHES® for "Instruments and apparatus for surgical, medical, and veterinary purposes solely for bone surgery-namely, instruments and implants for osteosynthesis, including bone screws, bone nails, bone plates and splints; injection needles and gum plates." This registration issued in 1974.
- U.S. Registration No. 2561835 for SYNTHES® for "water bath heaters for medical instruments and for contouring biological implants." This registration issued in 2002.
- U.S. Registration No. 2788064 for SYNTHES® for "Chemical preparations used in science for, or in connection with bone implants and implantation, namely, bone cements, pastes, putties and ceramics and bone growth factors; unprocessed plastics, namely bioresorbable plastics for use in connection with osteosynthesis, musculoskeletal, maxillo-facial, and spine surgery; unprocessed polylactates for use in osteosynthesis, musculoskeletal, maxillofacial, and spine surgery", in Class 1, and "Surgical and medical equipment, namely handheld power drills, bone milling cutters, saw, and locking bolts for medical and surgical purposes and electronic motors for use with the aforementioned equipment; surgical, medical, and veterinary instruments for use in osteosynthesis, musculoskeletal, maxillofacial, and spine

surgery, namely, saws and rasps for bones, probes, surgical knives, bone drills, surgical drills, drill guides, aiming guides for directing bone screws and similar devices into bone plates, retractors, chisels, bone forceps, bone clamps, pelvic clamps, internal and external fixators, elevators and impactors; devices for use and insertion during surgery and recovery, namely, intra medullary nails and plugs, bone staples, bone pins, bone clamps, pelvic clamps, angulated plates, compression plates, pedicle screws, pedicle hooks, cerclage wires, disc replacements, spinal rods and plates, artificial bones for surgical implantation, surgical implants comprising artificial non-biodegradable and biodegradable materials, namely, bone cements, bone pastes, and putties, and ceramics, bone substitutes, allograft implants, chips, strips, hip screws; parts of artificial bones for augmenting natural bones; bone graft extenders and bone growth factors all used for bone void fillers and bone regeneration; sterilizing trays for surgical and medical use, trays and cases for surgical and medical instruments and implants. apparatus for classifying and keeping inventory of scientific documentation and surgical and medical instruments and implants, namely, metal medical storage cabinets for storing surgical and medical instruments and implants, featuring a CPU for keeping inventory of surgical and medical instruments and implants,” In Class 10. This registration issued in 2003.

Hereinafter collectively referred to as the “SYNTHESES® Registrations”. The certificates of registration for the SYNTHESES® Registrations are attached hereto as Exhibits A, B and C, respectively.

5. Synthes first used its SYNTHESES® mark in commerce in 1960 and in U.S. interstate commerce in 1964 in connection with instruments and apparatus for instruments and

implants for osteosynthesis, including bone screws, bone nails, bone plates and splints and for injection needles and gum plates.

6. The SYNTHES® mark is famous, inherently distinctive, and represents the exceedingly valuable good will of Synthes. As such, the relevant consumers have come to rely upon and recognize the SYNTHES® mark, and, as such, the mark has substantial goodwill associated with it.

7. On January 22, 2010, over thirty years after Synthes' first use and registration of its SYNTHES® mark, Applicant filed its U.S. trademark application to register SYNTHASOME in International Class 10 for "Medical and surgical devices excluding goods in the orthopedic field, namely, surgical meshes and artificial tissue-engineered implants." This application was assigned Serial No. 77917879 ("the Application").

8. The Application is based on Applicant's use of the mark in commerce. Applicant alleges that it first used the mark SYNTHASOME in U.S. commerce on October 1, 2004, approximately thirty years after Synthes' first use and registration of its SYNTHES® mark in the U.S.

COUNT I

9. The allegations of paragraphs 1-8 above are incorporated herein by reference as though fully set forth herein.

10. Applicant's mark SYNTHASOME and Synthes' mark SYNTHES® are nearly identical, if not identical, in appearance, sound, and meaning.

11. The goods identified in the Application are related, if not identical, to those claimed in the SYNTHES® Registrations.

12. There is no issue of priority. The Application filing date as well as Applicant's claimed date of first use are both subsequent to Synthes' first use and registration of its SYNTHES® mark in the U.S.

13. Applicant's use of SYNTHASOME in connection with products in Class 10 is likely to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). Such confusion, mistake, or deception regarding the origin of Applicant's goods or their affiliation with, endorsement by, or sponsorship by Synthes will cause loss, damage, and/or injury to Synthes and/or the relevant consumers.

14. If Applicant is permitted to register SYNTHASOME and, thereby, obtain the *prima facie* exclusive right to use SYNTHASOME in commerce in connection with goods related, if not identical, to Synthes' products, confusion is likely to result, and Synthes will be damaged thereby.

15. Synthes is likely to be damaged by the registration sought by Applicant because such registration will give Applicant statutory rights in violation and derogation of Synthes' prior and superior rights.

COUNT II

16. The allegations of paragraphs 1-8 above are incorporated herein by reference as though fully set forth herein.

17. Applicant's use of SYNTHASOME in connection with products in Class 10 is likely to cause dilution of the distinctive quality of the SYNTHES® marks, within the meaning of Section 42(c) of the Lanham Act, 15 U.S.C. § 1125(c).

WHEREFORE, Synthes prays that allowance of Serial No. 77917879 be refused and that this Opposition be sustained.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Denise I. Mroz", is positioned above a horizontal line.

Denise I. Mroz
Woodcock Washburn LLP
Cira Centre, 12th Floor, 2929 Arch Street
Philadelphia, PA 19104-2891

Attorneys for Opposer
SYNTHES USA, LLC

Date: April 5, 2011

EXHIBIT A

Int. Cl.: 10

Prior U.S. Cl.: 44

United States Patent Office

Reg. No. 999,397

Registered Dec. 10, 1974

TRADEMARK

Principal Register

SYNTHES

Synthes AG (Swiss corporation)
Steinbockstrasse 2
7000 Chur, Switzerland

For: INSTRUMENTS AND APPARATUS FOR SURGICAL, MEDICAL, AND VETERINARY PURPOSES SOLELY FOR BONE SURGERY—NAMELY, INSTRUMENTS AND IMPLANTS FOR OSTEOSYNTHESIS, INCLUDING BONE SCREWS, BONE NAILS, BONE PLATES AND SPLINTS; INJECTION NEEDLES, AND GUM PLATES—in CLASS 44 (INT. CL. 10).

First use Dec. 16, 1960; in commerce Jan. 1, 1964.

Ser. No. 424,694, filed May 17, 1972.

S. D. LAPOINTE, Examiner

Int. Cl.: 10

Prior U.S. Cl.: 44

United States Patent and Trademark Office
10 Year Renewal

Reg. No. 999,397
Registered Dec. 10, 1974
Renewal Term Begins Dec. 10, 1994

**TRADEMARK
PRINCIPAL REGISTER**

SYNTHES

SYNTHES (U.S.A.) (PARTNERSHIP)
1690 RUSSELL ROAD
PAOLI, PA 193011222, BY ASSIGNMENT
AND ASSIGNMENT FROM SYNTHES
AG (SWITZERLAND CORPORATION)
7000 CHUR, SWITZERLAND

FOR: INSTRUMENTS AND APPARA-
TUS FOR SURGICAL, MEDICAL, AND
VETERINARY PURPOSES SOLELY FOR
BONE SURGERY—NAMELY, INSTRU-

MENTS AND IMPLANTS FOR OSTEO-
SYNTHESIS, INCLUDING BONE
SCREWS, BONE NAILS, BONE PLATES
AND SPLINTS; INJECTION NEEDLES,
AND GUM PLATES, IN CLASS 44 (INT.
CL. 10).

FIRST USE 12-16-1960; IN COMMERCE
1-1-1964.

SER. NO. 72-424,694, FILED 5-17-1972.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on Feb. 14, 1995.*

COMMISSIONER OF PATENTS AND TRADEMARKS

EXHIBIT B

Int. Cl.: 11

Prior U.S. Cls.: 13, 21, 23, 31 and 34

United States Patent and Trademark Office

Reg. No. 2,561,835

Registered Apr. 16, 2002

**TRADEMARK
PRINCIPAL REGISTER**

SYNTHES

SYNTHES (U.S.A.) (PARTNERSHIP)
1690 RUSSELL ROAD
P. O. BOX 1766
PAOLI, PA 19301

GICAL IMPLANTS, IN CLASS 11 (U.S. CLS. 13, 21, 23,
31 AND 34).

FIRST USE 3-6-2001; IN COMMERCE 3-6-2001.

SER. NO. 76-309,308, FILED 9-5-2001.

FOR: WATER BATH HEATERS FOR MEDICAL
INSTRUMENTS AND FOR CONTOURING BIOLO-

DAVID MURRAY, EXAMINING ATTORNEY

EXHIBIT C

Int. Cls.: 1 and 10

Prior U.S. Cls.: 1, 5, 6, 10, 26, 39, 44 and 46

Reg. No. 2,788,064

United States Patent and Trademark Office

Registered Dec. 2, 2003

**TRADEMARK
PRINCIPAL REGISTER**

SYNTHESES

SYNTHESES (U.S.A.) (PENNSYLVANIA GENERAL PARTNERSHIP)
1690 RUSSELL ROAD
P. O. BOX 1766
PAOLI, PA 19301

FOR: CHEMICAL PREPARATIONS USED IN SCIENCE FOR, OR IN CONNECTION WITH BONE IMPLANTS AND IMPLANTATION, NAMELY, BONE CEMENTS, PASTES, PUTTIES AND CERAMICS AND BONE GROWTH FACTORS; UNPROCESSED PLASTICS, NAMELY BIORESORBABLE PLASTICS FOR USE IN CONNECTION WITH OSTEOSYNTHESIS, MUSCULOSKETAL, MAXILLOFACIAL, AND SPINE SURGERY; UNPROCESSED POLYLACTATES FOR USE IN OSTEOSYNTHESIS, MUSCULOSKELETAL, MAXILLOFACIAL, AND SPINE SURGERY, IN CLASS 1 (U.S. CLS. 1, 5, 6, 10, 26 AND 46).

FIRST USE 1-4-1982; IN COMMERCE 1-4-1982.

FOR: SURGICAL AND MEDICAL EQUIPMENT, NAMELY HANDHELD POWER DRILLS, BONE MILLING CUTTERS, SAW, AND LOCKING BOLTS FOR MEDICAL AND SURGICAL PURPOSES AND ELECTRONIC MOTORS FOR USE WITH THE AFOREMENTIONED EQUIPMENT; SURGICAL, MEDICAL, AND VETERINARY INSTRUMENTS FOR USE IN OSTEOSYNTHESIS, MUSCULOSKELETAL, MAXILLOFACIAL, AND SPINE SURGERY, NAMELY, SAWS AND RASPS FOR BONES, PROBES, SURGICAL KNIVES, BONE DRILLS, SURGICAL DRILLS, DRILL GUIDES, AIMING GUIDES FOR DIRECTING BONE SCREWS AND SIMILAR DEVICES INTO BONE PLATES, RETRACTORS, CHISELS, BONE FORCEPS, BONE CLAMPS, PELVIC CLAMPS, INTERNAL AND EXTERNAL FIXATORS, ELEVATORS AND IMPACTORS; DEVICES FOR USE AND INSERTION DURING SURGERY AND

RECOVERY, NAMELY, INTRA MEDULLARY NAILS AND PLUGS, BONE STAPLES, BONE PINS, BONE CLAMPS, PELVIC CLAMPS, ANGULATED PLATES, COMPRESSION PLATES, PEDICLE SCREWS, PEDICLE HOOKS, CERCLAGE WIRES, DISC REPLACEMENTS, SPINAL RODS AND PLATES, ARTIFICIAL BONES FOR SURGICAL IMPLANTATION, SURGICAL IMPLANTS COMPRISING ARTIFICIAL NON-BIODEGRADABLE AND BIODEGRADABLE MATERIALS, NAMELY, BONE CEMENTS, BONE PASTES, AND PATTIES, AND CERAMICS, BONE SUBSTITUTES, ALLOGRAFT IMPLANTS, CHIPS, STRIPS, HIP SCREWS; PARTS OF ARTIFICIAL BONES FOR AUGMENTING NATURAL BONES; BONE GRAFT EXTENDERS AND BONE GROWTH FACTORS ALL USED FOR BONE VOID FILLERS AND BONE REGENERATION; STERILIZING TRAYS FOR SURGICAL AND MEDICAL USE, TRAYS AND CASES FOR SURGICAL AND MEDICAL INSTRUMENTS AND IMPLANTS; APPARATUS FOR CLASSIFYING AND KEEPING INVENTORY OF SCIENTIFIC DOCUMENTATION AND SURGICAL AND MEDICAL INSTRUMENTS AND IMPLANTS, NAMELY, METAL MEDICAL STORAGE CABINETS FOR STORING SURGICAL AND MEDICAL INSTRUMENTS AND IMPLANTS, FEATURING A CPU FOR KEEPING INVENTORY OF SURGICAL AND MEDICAL INSTRUMENTS AND IMPLANTS, IN CLASS 10 (U.S. CLS. 26, 39 AND 44).

FIRST USE 12-6-2000; IN COMMERCE 12-6-2000.

OWNER OF U.S. REG. NO. 999,397.

SER. NO. 76-357,989, FILED 1-10-2002.

THEODORE MCBRIDE, EXAMINING ATTORNEY

CERTIFICATE OF SERVICE

I, Denise I. Mroz, hereby certified that a true and correct copy of the foregoing Notice of Opposition was served on counsel to Applicant:

Thomas M. Rosselli
Carter, DeLuca, Farrell, & Schmidt, LLP
445 Broadhollow Road, Suite 420
Melville, NY 11747-3685

Postage prepaid by first class mail on April 5, 2010.

Executed on April 5, 2010, at Philadelphia, Pennsylvania.

A handwritten signature in cursive script, appearing to read "Denise I. Mroz", is written over a horizontal line.

Denise I. Mroz