

ESTTA Tracking number: **ESTTA811900**

Filing date: **04/06/2017**

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	Abbott Medical Optics Inc.
Granted to Date of previous extension	04/12/2017
Address	1700 E. St. Andrew Pl. Santa Ana, CA 92705 UNITED STATES

Correspondence information	Jeffrey D. Wexler Pillsbury Winthrop Shaw Pittman LLP 725 S. Figueroa St., 28th Floor Los Angeles, CA 90017 UNITED STATES jeffrey.wexler@pillsburylaw.com, carolyn.toto@pillsburylaw.com, irma.magana@pillsburylaw.com, ip_docket@pillsburylaw.com Phone:2134887129
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Applicant Information

Application No	86697932	Publication date	12/13/2016
Opposition Filing Date	04/06/2017	Opposition Period Ends	04/12/2017
International Registration No.	NONE	International Registration Date	NONE
Applicant	Leica Microsystems (Schweiz) AG Max-Schmidheiny-Strasse 201 Heerbrugg, CH9435 SWITZERLAND		


Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Microscopes and parts therefor
Class 010. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Microscopes for surgical operations and parts therefor; operating microscopes for use during surgery and parts therefor; operating microscopes for use during minimally invasive surgery and microsurgery and parts therefor; operating microscopes for ophthalmological use and parts therefor; operating microscopes for medical use in the ENT region and parts therefor; operating microscopes for use in dentistry and parts therefor

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3867798	Application Date	12/08/2006
Registration Date	10/26/2010	Foreign Priority Date	NONE
Word Mark	FUSION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 010. First use: First Use: 2007/04/27 First Use In Commerce: 2007/04/27 [SURGICAL MACHINES FOR USE DURING PHACOEMULSIFICATION SURGERY AND VITRECTOMY, AND PARTS AND SOFTWARE SOLD AS A UNIT; NEEDLES,] ASPIRATION AND IRRIGATION [TIPS AND] TUBING FOR MEDICAL AND SURGICAL USE; FLUIDIC PACKS AND PUMPS * FOR USE WITH PHACOEMULSIFICATION AND VITRECTOMY SURGICAL MACHINES; * DRAINAGE BAGS FOR MEDICAL USE [, HANDPIECES, NAMELY, FOR PHACOEMULSIFICATION SURGERY AND VITRECTOMY]		

Attachments	77059886#TMSN.png(bytes) Notice of Opposition.pdf(38766 bytes)
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Signature	/Jeffrey D. Wexler/
Name	Jeffrey D. Wexler
Date	04/06/2017

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

ABBOTT MEDICAL OPTICS INC.,)	
)	Opposition No. _____
Opposer,)	
)	Mark: FUSION OPTICS
v.)	
)	Serial No. 86/697,932
LEICA MICROSYSTEMS (SCHWEIZ))	
AG,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer Abbott Medical Optics Inc. (“Abbott”), a Delaware corporation having a place of business at 1700 East Saint Andrew Place, Santa Ana, CA 92705-4933, believes that it will be damaged by the registration of Serial No. 86/697,932 (the “’932 Application”), filed on July 20, 2015 for the mark FUSION OPTICS. The ‘932 Application was published for opposition on December 13, 2016. Abbott timely took extensions of time to oppose the ‘932 Application on January 6, 2017 and February 7, 2017, giving Abbott until April 12, 2017 to file a notice of opposition.

Abbott hereby opposes the ‘932 Application on the following grounds.

BACKGROUND FACTS

1. Among other things, Abbott sells surgical systems for ophthalmological procedures, including phacoemulsification, laser cataract surgery, and Lasik.
2. Abbott holds Reg. No. 3,867,798, issued on October 26, 2010, for the mark FUSION. Currently, the mark is used to designate “ASPIRATION AND IRRIGATION TUBING FOR MEDICAL AND SURGICAL USE; FLUIDIC PACKS AND PUMPS * FOR

USE WITH PHACOEMULSIFICATION AND VITRECTOMY SURGICAL MACHINES; *
DRAINAGE BAGS FOR MEDICAL USE” in International Class 10. The application was filed
as an intent-to-use application under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), on
December 8, 2006, and the registration therefore has a priority date of December 8, 2006.

3. On December 19, 2016, the PTO accepted Abbott’s combined Section 8 and 15
Declarations of Use and Incontestability for the FUSION mark. Abbott’s FUSION mark is now
incontestable under Section 15 of the Trademark Act, 15 U.S.C. § 1065.

4. Since at least April 27, 2007, Abbott has continuously used the mark FUSION in
connection with the goods identified in the registration for that mark. Abbott has expended
considerable effort and expense in promoting the FUSION mark, and the goods associated with
that mark, in the United States. Because of its longstanding use and recognition, Abbott’s
FUSION mark has acquired substantial goodwill among the medical community, including
ophthalmological surgeons and surgical facilities. Among such customers, Abbott’s FUSION
mark is instantly recognizable, and associated exclusively with Abbott, in connection with its
goods sold under the FUSION mark.

5. Applicant seeks to register the mark FUSION OPTICS to designate
“[m]icroscopes and parts therefor” in International Class 9 and “[m]icroscopes for surgical
operations and parts therefor; operating microscopes for use during surgery and parts therefor;
operating microscopes for use during minimally invasive surgery and microsurgery and parts
therefor; operating microscopes for ophthalmological use and parts therefor; operating
microscopes for medical use in the ENT region and parts therefor; operating microscopes for use
in dentistry and parts therefor” in International Class 10.” Applicant has disclaimed the
exclusive right to use “OPTICS” apart from the mark as shown. The ‘932 Application,

originally filed pursuant to Section 44(d) of the Trademark Act, 15 U.S.C. § 1126(d), and now based upon Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e), claims a priority date of January 27, 2015.

6. Abbott is not affiliated or connected with Applicant or its goods or services, nor has Abbott endorsed or sponsored Applicant or its goods or services.

FIRST GROUND FOR OPPOSITION

(Likelihood of Confusion)

7. Abbott incorporates paragraphs 1 through 6 above, inclusive, as if fully set forth herein.

8. Abbott filed its intent-to-use application for the FUSION mark on December 8, 2006, and it has continuously used that mark in commerce since at least April 27, 2007. Based upon its filing of its intent-to-use application, which was well prior to the filing date or the claimed priority date of Applicant's '932 Application, Abbott enjoys priority vis-à-vis Applicant.

9. Applicant's FUSION OPTICS mark, and especially the dominant "FUSION" portion of the mark – Applicant has disclaimed "OPTICS" apart from the mark as shown – is nearly identical in sound, appearance, and commercial impression to Abbott's FUSION mark. Applicant's goods – especially operating microscopes for use in surgical procedures and for ophthalmological use – are highly similar to Abbott's goods – tubing for medical and surgical use, equipment for use with phacoemulsification and vitrectomy (*i.e.*, ophthalmological) surgical machines, and drainage bags for surgical use.

10. In view of the strength of Abbott's FUSION mark, Abbott's longstanding use of that mark, the high degree of similarity between Opposer's FUSION OPTICS mark and Abbott's FUSION mark, and the relatedness of Applicant's goods to Abbott's goods, purchasers are likely

to mistakenly believe that Applicant's FUSION OPTICS goods originate from, are sponsored by, or are in some way associated with Abbott, when they are not.

11. Because Applicant's goods and Abbott's goods are offered to the same customers in the medical community, including surgeons and surgical facilities, the channels of trade for the respective parties' goods and services completely overlap.

12. Registration of Applicant's FUSION OPTICS mark will injure Abbott by causing the public to be confused or mistaken into believing that the goods and services provided by Applicant are endorsed by or sponsored by Abbott.

13. Abbott has no control over the nature and quality of the goods offered by Applicant under the highly similar FUSION OPTICS mark, and any defect, objection, or fault found with Applicant's goods marketed under the FUSION OPTICS mark would necessarily reflect upon and injure the reputation that Abbott has established for the goods that it offers in connection with its FUSION mark. As a result, Applicant's registration of its FUSION OPTICS mark would jeopardize Abbott's reputation and goodwill, and the value of its FUSION mark.

14. Accordingly, registration of the FUSION OPTICS mark is likely to cause damage to Abbott because that mark is likely, when used in connection with the goods described in the application, to cause confusion, to cause mistake, or to deceive.

WHEREFORE, Abbott respectfully requests that Application Serial No. 86/697,932 be refused registration.

Please address all correspondence to Carolyn S. Toto, Esq. and Jeffrey D. Wexler, Esq. of Pillsbury Winthrop Shaw Pittman LLP, 725 S. Figueroa Street, Suite 2800, Los Angeles, CA 90017-5406; Telephone No. (213) 488-7100.

Respectfully submitted,

Pillsbury Winthrop Shaw Pittman LLP
Carolyn S. Toto
Jeffrey D. Wexler

Date: April 6, 2017

By: /s/ Jeffrey D. Wexler
Jeffrey D. Wexler
Attorneys for Opposer
Abbott Medical Optics Inc.

CERTIFICATE OF ELECTRONIC TRANSMISSION

DATE OF DEPOSIT

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office Trademark Trial and Appeal Board using the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated above.

/s/ Jeffrey D. Wexler

Jeffrey D. Wexler

CERTIFICATE OF SERVICE

I, Jeffrey D. Wexler, Esq., of Pillsbury Winthrop Shaw Pittman LLP, attorneys for Opposer Abbott Medical Optics Inc., hereby certifies that a true and complete copy of the foregoing Notice of Opposition was served on Applicant Leica Microsystems (Schweiz) AG, via first class mail, postage prepaid, this 6th day of April, 2017, to the following address:

Michael H. Jacobs, Esq.
Crowell & Moring LLP
P.O. Box 14300
Washington, D.C. 20044-4300

/s/ Jeffrey D. Wexler
Jeffrey D. Wexler