

ESTTA Tracking number: **ESTTA623377**

Filing date: **08/25/2014**

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	Kinamed Navigation Systems, LLC		
Entity	Limited Liability Company	Citizenship	Delaware
Address	820 Flynn Road Camarillo, CA 93012 UNITED STATES		

Attorney information	Nicole Townes Knobbe, Martens, Olson & Bear, LLP 2040 Main Street, 14th Floor Irvine, CA 92614 UNITED STATES efiling@knobbe.com Phone:949-760-0404		
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Registration Subject to Cancellation

Registration No	4569095	Registration date	07/15/2014
Registrant	Boston Scientific Scimed, Inc. One Scimed Place Maple Grove, MN 55311 UNITED STATES		

Goods/Services Subject to Cancellation

Class 010. First Use: 2013/04/00 First Use In Commerce: 2013/04/00 All goods and services in the class are cancelled, namely: Medical Guidewires

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2830739	Application Date	12/07/2001
Registration Date	04/06/2004	Foreign Priority Date	NONE
Word Mark	NAVIPRO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2002/11/19 First Use In Commerce: 2002/11/19 Computer software for aiding in orthopedic surgery		

	Class 010. First use: First Use: 2002/11/19 First Use In Commerce: 2002/11/19 Surgical instruments, namely computer navigation devices for orthopedic surgery
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Attachments	2014-08-25 Signed Petition to Cancel - KMED.003N.PDF(353380 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 First Class Mail on this date.

Signature	/Nicole Townes/
Name	Nicole Townes
Date	08/25/2014

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

Kinamed Navigation Systems, LLC,)	Cancellation No: _____
)	
Petitioner,)	
)	Registration No.: 4,569,095
v.)	
)	Mark: NAVIPRO
Boston Scientific Scimed, Inc.,)	
)	
Respondent.)	
)	

PETITION FOR CANCELLATION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir or Madam:

Pursuant to 15 U.S.C. § 1064, 37 C.F.R. § 2.111(b) and TBMP § 309.03(c), Petitioner Kinamed Navigation Systems, LLC, a Delaware Limited Liability Company, having a place of business at 820 Flynn Road, Camarillo, California 93012 (“Petitioner”) believes it has and will be damaged by the continued registration of the mark shown in U.S. Trademark Registration No. 4,569,095 for the mark NAVIPRO, owned by Boston Scientific Scimed, Inc., a Minnesota corporation having a place of business at One Scimed Place, Maple Grove, Minnesota 55311 (“Respondent”), and hereby petitions to cancel said registration. Respondent’s Trademark Registration No. 4,569,095 (“Respondent’s Registration”) is described as follows:

Mark:	NAVIPRO
Goods:	Medical Guidewires
Class:	10
Filed:	December 28, 2012
Alleged First Use:	April, 2013
Registered:	July 15, 2014

As grounds for cancellation, it is alleged that:

1. Petitioner is a company that provides surgical navigation systems under the mark NAVIPRO.

2. Petitioner is the owner of and relies on U.S. Trademark Registration No. 2,830,739 for the mark NAVIPRO for “Computer software for aiding in orthopedic surgery” in International Class 9 and “Surgical instruments, namely computer navigation devices for orthopedic surgery” in International Class 10 (“Petitioner’s Registration”), which registered on the Principal Register on April 6, 2004. Said registration is based on an application filed in the United States Patent and Trademark Office (“PTO”) on December 7, 2001 and claims a date of first use of November 19, 2002. Thus, the dates of registration, first use and application of Petitioner’s NAVIPRO mark are well prior to Respondent’s filing date and alleged first use date set forth in its Registration for the NAVIPRO mark. A Section 8 & 15 declaration has been filed and accepted and, accordingly Petitioner’s Registration is incontestable. A true and correct copy of a printout of the TSDR records for Petitioner’s Registration is attached hereto as Exhibit 1.

3. Petitioner is the owner of and relies upon its Registration. Petitioner’s use of its mark shown in its Registration has been valid and continuous prior to the filing date and alleged first use date of Respondent’s Registration and has not been abandoned. Petitioner’s Registration is valid, subsisting, unrevoked and uncancelled, as such it constitutes *prima facie* evidence of the validity of the registered mark and of registration thereof, and of Petitioner’s ownership of the mark shown therein and of Petitioner’s exclusive right to use the mark in commerce in connection with the goods named therein. It also constitutes notice to Respondent of Petitioner’s claim of ownership of the mark shown therein as provided in Section 7(b), 22 and 33(a) of the Trademark Act of 1946 as amended.

4. Since prior to the filing date and alleged first use date of Respondent's Registration, Petitioner has consistently used the NAVIPRO mark in interstate commerce in connection with its goods. The NAVIPRO mark, by virtue of Petitioner's substantial use, has acquired great value as an identification of Petitioner, and Petitioner's goods, and distinguishes them from the goods of others.

5. Petitioner, through advertising and promotion of its goods under the NAVIPRO mark has built up, at great expense and effort, valuable goodwill symbolized by the NAVIPRO mark and the relevant class of the public has come to associate Petitioner with the NAVIPRO mark.

6. Petitioner has invested substantial amounts of time, effort and money in the NAVIPRO mark throughout the United States. Petitioner has used its NAVIPRO mark throughout the United States and such use has been continuous since at least as early as the filing date and alleged first use date of Respondent's Registration. As such, in addition to the protection afforded Petitioner by its federal trademark registration, Petitioner has extensive, non-registered statutory and common-law rights in the NAVIPRO mark for its goods throughout the United States. Further, Petitioner's common law rights in the NAVIPRO mark predates the filing date and alleged first use date of Respondent's NAVIPRO mark as set forth in its Registration.

7. If Respondent is permitted to maintain its Registration, Respondent's corresponding *prima facie* exclusive right to use the NAVIPRO mark in nationwide commerce will conflict with Petitioner's lawful and *prima facie* and prior exclusive right to use the NAVIPRO mark nationwide.

8. Petitioner's Registration No. 2,830,739 is derived from an application filed in the PTO on a date prior to the filing of Respondent's Registration. Said registration of Petitioner is

valid and subsisting. In view of Respondent's registration of the identical NAVIPRO mark, and the highly related nature of the goods and consumers of the respective parties' goods, it is alleged that Respondent's NAVIPRO mark so resembles Petitioner's registered and common law NAVIPRO mark, previously used in the United States and not abandoned, as to be likely to cause confusion or to cause mistake or deceive.

9. Respondent's NAVIPRO mark is identical to Petitioner's NAVIPRO mark. In addition, Respondent's "medical guidewires" are highly related to Petitioner's goods. Respondent's goods are marketed or will be marketed to the same consumers and potential consumers as Petitioner's goods, through similar channels of trade. As such, when the NAVIPRO mark is used on or in connection with Respondent's goods, it is likely to cause confusion, or to cause mistake or to deceive the purchasing public into believing that Respondent's goods originate with Petitioner or are otherwise authorized, licensed or sponsored by Petitioner within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

10. Petitioner will be damaged by the continued registration of Respondent's Registration for the mark NAVIPRO in that the mark so resembles Petitioner's NAVIPRO mark as to be likely, when used on or in connection with the goods identified in Respondent's Registration, to cause confusion, or to cause mistake, or to deceive within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

11. In view of Petitioner's prior rights in the NAVIPRO mark, Respondent is not entitled to continued registration of the NAVIPRO mark.

12. Respondent has no license, consent or permission from Petitioner to use or register the NAVIPRO mark.

WHEREFORE, Petitioner prays that U.S. Registration No. 4,569,095 be canceled and that this Petition for Cancellation be sustained in favor of Petitioner.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 8/25/14

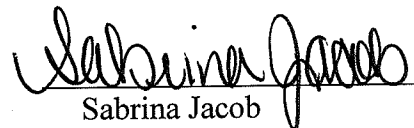
By: *Lynda J. Zadra-Symes*

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Attorneys for Petitioner,
Kinamed Navigation Systems, LLC

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **PETITION FOR CANCELLATION** upon Registrant's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid on August 25, 2014 addressed as follows:

MICHAEL T. HESS
SEAGER, TUFTE & WICKHEM LLC.
1221 NICOLLET AVE STE 800
MINNEAPOLIS, MINNESOTA 55403-2445


Sabrina Jacob

18676791

EXHIBIT 1

Int. Cls.: 9 and 10

Prior U.S. Cls.: 21, 23, 26, 36, 38, 39, and 44

Reg. No. 2,830,739

United States Patent and Trademark Office

Registered Apr. 6, 2004

**TRADEMARK
PRINCIPAL REGISTER**

NAVIPRO

KINAMED NAVIGATION SYSTEMS, LLC (DE-
LAWARE LTD LIAB CO)
820 FLYNN ROAD
CAMARILLO, CA 930128701

FOR: COMPUTER SOFTWARE FOR AIDING IN
ORTHOPEDIC SURGERY, IN CLASS 9 (U.S. CLS. 21,
23, 26, 36 AND 38).

FIRST USE 11-19-2002; IN COMMERCE 11-19-2002.

FOR: SURGICAL INSTRUMENTS, NAMELY
COMPUTER NAVIGATION DEVICES FOR ORTHO-
PEDIC SURGERY, IN CLASS 10 (U.S. CLS. 26, 39
AND 44).

FIRST USE 11-19-2002; IN COMMERCE 11-19-2002.

SN 78-097,324, FILED 12-7-2001.

KIMBERLY PERRY, EXAMINING ATTORNEY



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US Serial No 78097324 Status Documents

Status results found

STATUS DOCUMENTS ? Download Print Preview

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Mark: NAVIPRO No Image exists for this case.

US Serial Number: 78097324 Application Filing Date: Dec. 07, 2001
 US Registration Number: 2830739 Registration Date: Apr. 06, 2004
 Register: Principal
 Mark Type: Trademark
 Status: The registration has been renewed.
 Status Date: Sep. 22, 2013
 Publication Date: Jul. 09, 2002 Notice of Allowance Date: Oct. 01, 2002

Mark Information Collapse All

Mark Literal Elements: NAVIPRO
 Standard Character Claim: No
 Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Goods and Services

Note:
 The following symbols indicate that the registrant/owner has amended the goods/services:
 • Brackets [...] indicate deleted goods/services;
 • Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
 • Asterisks "*" identify additional (new) wording in the goods/services.

For: Computer software for aiding in orthopedic surgery

International Class(es): 009 - Primary Class U.S Class(es): 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 1(a)

First Use: Nov. 19, 2002 Use in Commerce: Nov. 19, 2002

For: Surgical instruments, namely computer navigation devices for orthopedic surgery

International Class(es): 010 - Primary Class U.S Class(es): 026, 039, 044

Class Status: ACTIVE

Basis: 1(a)

First Use: Nov. 19, 2002

Use in Commerce: Nov. 19, 2002

▼ Basis Information (Case Level)

Filed Use:	No	Currently Use:	Yes	Amended Use:	No
Filed ITU:	Yes	Currently ITU:	No	Amended ITU:	No
Filed 44D:	No	Currently 44D:	No	Amended 44D:	No
Filed 44E:	No	Currently 44E:	No	Amended 44E:	No
Filed 66A:	No	Currently 66A:	No		
Filed No Basis:	No	Currently No Basis:	No		

▼ Current Owner(s) Information

Owner Name: KINAMED NAVIGATION SYSTEMS, LLC

Owner Address: 820 FLYNN ROAD
CAMARILLO, CALIFORNIA 930128701
UNITED STATES

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

▼ Attorney/Correspondence Information

Attorney of Record

Attorney Name: Steven C. Patrick

Docket Number: 464-48-038

Attorney Primary Email Address: generalmail@koppelpatent.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Steven C. Patrick

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Correspondent e-mail: generalmail@koppelpatent.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

▼ Prosecution History

Date	Description	Proceeding Number
Sep. 22, 2013	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Sep. 22, 2013	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	68335
Sep. 22, 2013	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	68335
Sep. 18, 2013	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	68335
Sep. 22, 2013	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	68335
Sep. 18, 2013	TEAS SECTION 8 & 9 RECEIVED	
Oct. 12, 2010	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	68973
Oct. 05, 2010	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	68973
Oct. 04, 2010	TEAS SECTION 8 & 15 RECEIVED	
Apr. 06, 2004	REGISTERED-PRINCIPAL REGISTER	
Jan. 24, 2004	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Jan. 20, 2004	CASE FILE IN TICRS	
Jun. 01, 2003	LETTER OF SUSPENSION E-MAILED	
May 27, 2003	ASSIGNED TO EXAMINER	73372
Mar. 26, 2003	STATEMENT OF USE PROCESSING COMPLETE	
Mar. 26, 2003	USE AMENDMENT FILED	
Mar. 26, 2003	PAPER RECEIVED	
Oct. 01, 2002	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Jul. 09, 2002	PUBLISHED FOR OPPOSITION	
Jun. 19, 2002	NOTICE OF PUBLICATION	

Mar. 19, 2002	APPROVED FOR PUB - PRINCIPAL REGISTER	
Mar. 15, 2002	ASSIGNED TO EXAMINER	77868
▼ Maintenance Filings or Post Registration Information		
Affidavit of Continued Use:	Section 8 - Accepted	
Affidavit of Incontestability:	Section 15 - Accepted	
Renewal Date:	Apr. 06, 2014	
▼ TM Staff and Location Information		
TM Staff Information - None		
File Location		
Current Location:	GENERIC WEB UPDATE	Date in Location: Sep. 22, 2013
▼ Assignment Abstract Of Title Information - Click to Load		
▼ Proceedings - Click to Load		

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