

ESTTA Tracking number: **ESTTA686921**

Filing date: **07/31/2015**

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

| | |
|------------------------|---|
| Proceeding | 92059848 |
| Party | Defendant Boston Scientific Scimed, Inc. |
| Correspondence Address | JAMES R STEFFEN FAEGRE BAKER DANIELS LLP 2200 WELLS FARGO CENTER, 90 SOUTH SEVENTH STREET MINNEAPOLIS, MN 55402 UNITED STATES tmindy@faegrebd.com, louis.perry@faegrebd.com, james.steffen@faegrebd.com, trademarkmpls@faegre.com |
| Submission | Other Motions/Papers |
| Filer's Name | Louis T. Perry |
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| Signature | /Louis T. Perry/ |
| Date | 07/31/2015 |
| Attachments | BSC Motion To Amend.pdf(635230 bytes) |

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

In the Matter of U.S. Reg. No. 4,569,095
For the Mark: NAVIPRO
Filed: December 28, 2012
Registered: July 15, 2014

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| KINAMED NAVIGATION |) | |
| SYSTEMS, LLC, |) | Cancellation No. 92059848 |
| |) | |
| Petitioner, |) | |
| |) | |
| v. |) | |
| |) | |
| BOSTON SCIENTIFIC SCIMED, INC. |) | |
| |) | |
| Registrant |) | |
| <hr/> |) | |

MOTION TO AMEND REGISTRANT'S IDENTIFICATION OF GOODS

Registrant Boston Scientific Scimed, Inc. ("Registrant") moves (this "Motion") without the consent¹ of Petitioner Kinamed, Inc. ("Petitioner") that (i) the goods description of U.S. Registration No. 4,569,095 (the "Registration") for the mark NAVIPRO be amended pursuant to 37 C.F.R. § 2.133 and (ii) the Board defer its determination of this unconsented motion until its final determination decision in this proceeding. *See* Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 514.03 (2015).

1. Registrant respectfully requests that the goods description in the Registration be amended from "Medical Guidewires" in International Class 10 to "medical guidewires for use during endoscopic pancreatic-biliary procedures" in International Class 10.

¹ Registrant contacted Petitioner regarding this Motion, but Petitioner refused to consent.

2. Registrant maintains that it is *at least* entitled to the Registration with this proposed amendment. If the Board ultimately finds that Registrant is not entitled to registration in the absence of the amendment, Registrant requests that such amendment be approved.

3. Alternatively, if a further refinement of the amendment is found necessary by the Board (and that refinement is within the scope of the notice provided to Petitioner by this Motion or was tried with the express or implied consent of Kinamed), Registrant requests that it be allowed time in which to file a request that the Registration be amended to conform to the findings of the Board.

4. If the Board ultimately finds that Registrant is entitled to the Registration even without the proposed amendment, Registrant requests that it be allowed time to indicate whether it still wishes to have the amendment entered. Registrant sought Petitioner's consent to this proposed amendment, but Petitioner declined to provide such consent.

5. The requested amendment is supported by the specimens of record.

6. A supporting declaration is attached as Exhibit A in accordance with 37 C.F.R. § 2.173.

7. Should the amendment be entered, the Board is authorized to debit the deposit account of Faegre Baker Daniels LLP for the required fee.

WHEREFORE, Registrant Boston Scientific Scimed, Inc. requests the foregoing relief any other relief the Board deems just and proper.

Date: July 31, 2015

Respectfully submitted,

/Louis T. Perry/

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Attorneys for Registrant

CERTIFICATE OF SERVICE

The undersigned certifies that on July 31, 2015, the foregoing document was served upon Nicole R. Townes and Lynda Zadra-Symes via email pursuant to agreement of the parties.

/Louis T. Perry

EXHIBIT A

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

In the Matter of U.S. Reg. No. 4,569,095
For the Mark: NAVIPRO
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| |) | |
| Petitioner, |) | |
| |) | |
| v. |) | |
| |) | |
| BOSTON SCIENTIFIC SCIMED, INC. |) | |
| |) | |
| Registrant |) | |
| |) | |

**DECLARATION OF MICHAEL LYNN IN SUPPORT OF MOTION TO AMEND
REGISTRANT'S IDENTIFICATION OF GOODS**

MICHAEL LYNN states as follows:


1. I am in-house counsel with Registrant Boston Scientific Scimed, Inc. ("Registrant"), and I submit this declaration in support of Registrant's Motion to Amend Registrant's Identification of Goods.

2. Registrant wishes to amend its goods description for U.S. Registration No. 4,569,095 (the "Registration") for the mark NAVIPRO from "Medical Guidewires" in International Class 10 to "medical guidewires for use during endoscopic pancreatic-biliary procedures" in International Class 10.

3. The goods Registrant uses in connection with the NAVIPRO mark are only used (and only approved for use by the Food & Drug Administration) in connection with endoscopic pancreatic-biliary procedures.

THE UNDERSIGNED BEING WARNED THAT WILLFUL FALSE STATEMENTS AND THE LIKE ARE PUNISHABLE BY FINE OR IMPRISONMENT, OR BOTH, UNDER 18 U.S.C. 1001, AND THAT SUCH WILLFUL FALSE STATEMENTS AND THE LIKE MAY JEOPARDIZE THE VALIDITY OF THE APPLICATION OR DOCUMENT OR ANY REGISTRATION RESULTING THEREFROM, DECLARES THAT ALL STATEMENTS MADE OF HIS/HER OWN KNOWLEDGE ARE TRUE; AND ALL STATEMENTS MADE ON INFORMATION AND BELIEF ARE BELIEVED TO BE TRUE.

Date: July 31, 2015



Michael Lynn, Esq.
Counsel
Boston Scientific Scimed, Inc.
300 Boston Scientific Way
Marlborough, MA 01752