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

Proceeding	92059848
Party	Plaintiff Kinamed Navigation Systems, LLC
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Submission	Opposition/Response to Motion
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Attachments	2015-08-14 Response to Registrant's Motion to Amend Registration - KMED.003N.pdf(27989 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Kinamed Navigation Systems, LLC,)	U.S. Cancellation No.: 92059848
)	
Petitioner,)	Registration No.: 4,569,095
v.)	
)	Trademark: NAVIPRO
Boston Scientific Scimed, Inc.)	
)	
Respondent.)	
)	

PETITIONER’S RESPONSE TO REGISTRANT’S MOTION TO AMEND

REGISTRANT’S IDENTIFICATION OF GOODS

Petitioner Kinamed Navigation Systems, LLC (“Kinamed”) hereby submits this Response to Registrant’s Motion to Amend Registrant’s Identification of Goods. Specifically, Kinamed opposes Registrant’s request that its identification of goods for Registrant’s NAVIPRO mark be amended from “medical guidewires” to “medical guidewires for use during endoscopic pancreatic-biliary procedures.” Registrant’s registration and use of the NAVIPRO mark in connection with “medical guidewires for use during endoscopic pancreatic-biliary procedures” as set forth in Registrant’s proposed amendment is still likely to cause confusion with Kinamed’s NAVIPRO mark as shown in Kinamed’s U.S. Trademark Registration No. 2,830,739 which was registered prior to Registrant’s NAVIPRO mark and is used in connection with “surgical instruments, namely computer navigation devices for orthopedic surgery.” Registrant’s proposed amendment will not resolve the issues in this Cancellation proceeding, and thus Kinamed opposes such an amendment.

Nonetheless, Kinamed agrees with Registrant’s request that the Board defer its determination of whether Registrant may amend its NAVIPRO mark to identify the goods as

“medical guidewires for use during endoscopic pancreatic-biliary procedures” until its final decision in this proceeding. Pursuant to T.B.M.P. § 514.03, “[t]he Board generally will defer determination of a timely filed (i.e. pretrial) unconsented motion to amend in substance until final decision, or until the case is decided upon summary judgment.” See Space Base Inc. v. Stadis Corp., 17 U.S.P.Q.2d 1216 (T.T.A.B. 1990) (motion to amend identification of goods deferred until final decision). Accordingly, Kinamed requests that the Board defer determination of whether Registrant’s identification of goods should be amended as set forth in Registrant’s Motion until the Board’s final decision.

However, Registrant’s alternative request that it be allowed time in which to file a request to amend the registration to conform with the findings of the Board after final determination should the Board determine that its proposed amendment set forth in its Motion is not sufficient to alleviate a likelihood of confusion is improper. T.B.M.P. § 514.03 requires that “[t]he proposed restriction should be described in sufficient detail to give the plaintiff fair notice thereof.” Any amendment to the identification of goods besides the proposed amendment set forth in Registrant’s Motion to Amend will not be described in sufficient detail to provide Kinamed with fair notice thereof. Thus, Registrant’s alternative request should be denied.

Accordingly, Kinamed requests that the Board defer determination of whether Registrant should be permitted to amend its identification of goods for its NAVIPRO mark to “medical guidewires for use during endoscopic pancreatic-biliary procedures” until the Board’s final decision in this proceeding.

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Further, Kinamed requests that the Board deny Registrant's request that it alternatively be permitted time in which to file a request to amend its registration for the NAVIPRO mark to conform with the findings of the Board after final decision.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: August 14, 2015

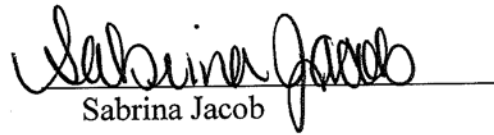
By:  _____

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **PETITIONER'S RESPONSE TO REGISTRANT'S MOTION TO AMEND REGISTRANT'S IDENTIFICATION OF GOODS** has been served on Respondent's counsel on August 14, 2015 by electronic mail and by mailing one copy via the United States Mail, first-class postage prepaid to:

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