

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Trademark Trial and Appeal Board**  
**P.O. Box 1451**  
**Alexandria, VA 22313-1451**  
General Contact Number: 571-272-8500

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Mailed: November 12, 2015

Cancellation No. 92059848

Kinamed Navigation Systems, LLC

v.

Boston Scientific Scimed, Inc.

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of Respondent's July 31, 2015 motion to amend its involved Registration No. 4569095, for the mark NAVIPRO for "medical guidewires" in International Class 10. The motion is fully briefed.

This proceeding involves Petitioner's petition to cancel said registration on the ground of priority and likelihood of confusion pursuant to Trademark Act Section 2(d), wherein it asserts ownership of Registration No. 2830739 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.

By way of its motion to amend, Respondent seeks to amend its identification of goods to "medical guidewires for use during endoscopic pancreatic-biliary procedures," submits a supporting declaration, and

acknowledges that Petitioner did not consent to the amendment. Trademark Rules 2.173(a) and (b). Respondent requests various alternative forms of relief, including that the amendment be approved if the Board “finds that Registrant is not entitled to registration in the absence of the amendment,” that if the Board finds further refinement of the amendment to be necessary, it be allowed to request an amendment to conform to the Board’s findings, and that if the Board finds that it is entitled to the registration without the amendment, that it be allowed to indicate whether it still wishes to have the amendment entered.<sup>1</sup>

Petitioner opposes the proposed amendment, asserting, *inter alia*, that the amendment will not resolve the issue of likelihood of confusion because with the proposed amendment the registered mark is still likely to cause confusion with Petitioner’s mark. It further posits that Respondent should not be granted the alternative relief of being allowed to file a request to amend its registration to conform with the findings of the Board after final hearing in the event that the Board determines that the proposed amendment is not sufficient to alleviate a likelihood of confusion, and that any amendment other than the one proposed in Respondent’s motion will not be described in sufficient detail to provide Petitioner with fair notice thereof.

### Analysis

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<sup>1</sup> 14 TTABVUE 3.

Respondent’s authorization, included in its motion, to charge a deposit account does not include the account number; the better practice is to provide the deposit account number as part of each written authorization.

Pursuant to Trademark Rule 2.133(a), a registration subject to a cancellation may not be amended except with the consent of the other party or parties and the approval of the Board, or upon motion granted by the Board. Trademark Rule 2.133(a). Moreover, a motion to amend an involved registration in substance, made without the consent of the other party, will generally be deferred until final decision, or until the case is decided upon summary judgment. TBMP § 514.03 (2015), and cases cited therein.

Petitioner has made clear that it does not consent to Respondent's proposed amendment to its registration, and both parties acknowledge that the Board generally defers consideration of an unconsented motion to amend a registration.

To the extent that Respondent wishes to defend this action by requesting to restrict its identification of goods pursuant to Trademark Act Section 18, Respondent did not assert the matter by way of an affirmative defense in its answer,<sup>2</sup> and does not, in its motion to amend, set forth all required elements of such a request. TBMP §§ 309.03(b), 311.02(b) and 514.03 (2015). Specifically, Respondent does not allege that the proposed restriction will avoid a likelihood of confusion, and does not allege that Petitioner is not using its mark(s) on the product(s) proposed to be excluded from the registration. *Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1828 (TTAB 2013) (ideally, Section 18 affirmative defense should be made in answer to put plaintiff on notice followed by a motion to amend the application or registration). In any event,

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<sup>2</sup> 5 TTABVUE 4.

given that Petitioner does not consent to the proposed amendment, and clearly is of the position that the entry of it would not obviate or remove a likelihood of confusion, deferral of further consideration of the proposed amendment is appropriate.

With respect to the various forms of relief in the alternative that Respondent sets forth in its motion, it is unnecessary and inappropriate for Respondent to seek at this time the Board's leave to further refine or to otherwise address the proposed amendment set forth in the motion. The Board makes a determination as to the appropriateness of such matters upon final hearing. More specifically, pursuant to established Board practice, if the Board ultimately finds that Respondent is not entitled to registration in the absence of a restriction that was timely proposed, the proposed restriction will be approved and entered, and if the Board finds a further refinement of the proposed restriction to be necessary and is within the scope of the notice given to Petitioner, or was tried with the express or implied consent of Petitioner, Respondent will be allowed time in which to file a request that its registration be amended to conform to the findings of the Board, failing which judgment will be entered against Respondent. If the Board ultimately finds that Respondent is entitled to registration even without the proposed restriction, Respondent will be allowed time to indicate whether it still wishes to have the restriction entered. Trademark Rule 2.133(b); TBMP § 514.03 (2015).

In view of these findings, Respondent's motion to amend its Registration No. 4569095 is deferred until final decision, or until this proceeding is decided upon summary judgment.

Expert Disclosure

The Board notes Petitioner's July 2, 2015 notice that Petitioner timely served on Respondent the expert disclosures of Richard F. Santore. In view thereof, proceedings remain suspended to provide for the taking of any further or necessary discovery of the proposed expert witness. Additionally, Respondent is allowed until thirty (30) days from the mailing date of this order to file notice herein indicating whether it will rely on a rebutting expert witness. TBMP § 401.03, 408.01(b) and 510.03(a) (2015). The parties are expected to fully cooperate in the process of exchanging information about any testifying experts.