

ESTTA Tracking number: **ESTTA1227372**

Filing date: **08/08/2022**

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 has filed a petition to cancel the registration indicated below.

**Petitioner information**

|         |   |             |        |
|---------|---|-------------|--------|
| Name    | Canary Medical Inc.   |             |        |
| Entity  | Corporation   | Citizenship | Canada |
| Address | 1450 CREEKSIDE DR., SUITE 400<br>VANCOUVER, BC V6J5B3<br>CANADA |             |        |

|                      |  |  |  |
|----------------------|--|--|--|
| Attorney information | KEVIN S. COSTANZA<br>SEED IP LAW GROUP LLP<br>701 FIFTH AVENUE, SUITE 5400<br>SEATTLE, WA 98104<br>UNITED STATES<br>Primary email: KevinCo@seedip.com<br>Secondary email(s): LitCal@seedip.com<br>206-622-4900 |  |  |
| Docket no.           | 191166.828   |  |  |

**Registration subject to cancellation**

|                  |   |                   |            |
|------------------|---|-------------------|------------|
| Registration no. | 5262286   | Registration date | 08/08/2017 |
| Register         | Principal   |                   |            |
| Registrant       | Canary Sound Design, LLC<br>112 HILLCREST LOOP<br>MISSOULA, MT 59803<br>UNITED STATES |                   |            |

**Goods/services subject to cancellation**

|  |
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| Class 010. First Use: Aug 1, 2016 First Use In Commerce: Dec 1, 2016<br>All goods and services in the class are subject to cancellation, namely: Patient medical monitors for monitoring oxygen saturation, heart rate, noninvasive blood pressure |
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**Grounds for cancellation**

|                                      |                                       |
|--------------------------------------|---------------------------------------|
| Priority and likelihood of confusion | Trademark Act Sections 14(1) and 2(d) |
|--------------------------------------|---------------------------------------|

**Marks cited by petitioner as basis for cancellation**

|                       |            |                  |            |
|-----------------------|------------|------------------|------------|
| U.S. registration no. | 5541402    | Application date | 12/09/2015 |
| Register              | Principal  |                  |            |
| Registration date     | 08/14/2018 | Foreign priority | NONE       |

|                     |  |      |  |
|---------------------|--|------|--|
|                     |  | date |  |
| Word mark           | CANARY MEDICAL   |      |  |
| Design mark         |  |      |  |
| Description of mark | NONE   |      |  |
| Goods/services      | Class 010. First use: First Use: Jun 7, 2018 First Use In Commerce: Jun 7, 2018<br>Joint prostheses; medical, surgical and orthopaedic implants made of artificial materials |      |  |

|                      |   |                       |            |
|----------------------|---|-----------------------|------------|
| U.S. application no. | 88131718  | Application date      | 09/25/2018 |
| Register             | Principal   |                       |            |
| Registration date    | NONE  | Foreign priority date | NONE       |
| Word mark            | CANARY MEDICAL  |                       |            |
| Design mark          |   |                       |            |
| Description of mark  | NONE  |                       |            |
| Goods/services       | Class 010. First use: First Use: None First Use In Commerce: None<br>Cardiovascular devices, namely, coronary stent grafts; coronary stents; artificial (e.g., mammalian or mechanical) heart valves; angioplasty rings which measure blood flow, blood pressure and / or blood volume; systems for in vivo cardiovascular blood pressure monitoring including one or more sensors and means for communicating or transmitting sensor data; systems for aneurism stent graph monitoring including one or more sensors and means for communicating or transmitting sensor data; systems for hypertension monitoring including one or more sensors and means for communicating or transmitting sensor data; sensors, power sources, and electronics for use in recording and transferring internal patient data to a device external to the body including one or more sensors and means for communicating or transmitting sensor data; systems for monitoring the integrity and function of a medical implant including one or more sensors and means for communicating or transmitting sensor data; joint prostheses; medical, surgical and orthopaedic implants made of artificial materials |                       |            |

|             |   |
|-------------|---|
| Attachments | 88131718#TMSN.png( bytes )<br>Petition to Cancel CANARYBOX.pdf(530534 bytes ) |
|-------------|---|

|           |                     |
|-----------|---------------------|
| Signature | /Kevin S. Costanza/ |
| Name      | Kevin S. Costanza   |
| Date      | 08/08/2022          |

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

Canary Medical Inc.

Petitioner,

v.

Canary Sound Design, LLC

Registrant.

Cancellation No. \_\_\_\_\_

Registration No. 5262286

Attorney Docket No. 191166.828

**PETITION TO CANCEL REGISTRATION**

1. Petitioner, Canary Medical Inc. (“Petitioner”), hereby requests that the Trademark Trial and Appeal Board cancel United States Trademark Registration No. 5262286 issued to Canary Sound Design, LLC (“Registrant”) for CANARYBOX in International Class 10 (“CANARYBOX Registration”).

**I. PARTIES**

2. Petitioner is a corporation organized under the laws of Canada with an address of 1450 Creekside Dr., Suite 400, Vancouver, Canada V6J5B3.

3. On information and belief, Registrant is a limited liability company organized under the laws of the state of Montana with an address of 112 Hillcrest Loop, Missoula, Montana 59803.

## II. PETITIONER'S MARK

4. Petitioner designs and manufactures medical devices that incorporate sensors, embedded software and means for communicating data to physicians and others to monitor and manage the device's and a patient's performance. Practitioner promotes such goods and related services under a family of CANARY brands, including CANARY and CANARY MEDICAL.

5. Petitioner is the owner of U.S. Trademark Registration No. 5541402 ("Petitioner's Registration") for the standard character mark "CANARY MEDICAL" ("Petitioner's Mark") in International Class 10 for, "Joint prostheses; medical, surgical and orthopaedic implants made of artificial materials". The registration issued from an application filed December 9, 2015.

6. Petitioner has also applied to register Petitioner's Mark in International Class 10 for: "Cardiovascular devices, namely, coronary stent grafts; coronary stents; artificial (e.g., mammalian or mechanical) heart valves; angioplasty rings which measure blood flow, blood pressure and/or blood volume; systems for in vivo cardiovascular blood pressure monitoring including one or more sensors and means for communicating or transmitting sensor data; systems for aneurism stent graph monitoring including one or more sensors and means for communicating or transmitting sensor data; systems for hypertension monitoring including one or more sensors and means for communicating or transmitting sensor data; sensors, power sources, and electronics for use in recording and transferring internal patient data to a device external to the body including one or more sensors and means for communicating or transmitting sensor data; systems for monitoring the integrity and function of a medical implant including one or more sensors and means for communicating or transmitting sensor data; joint prostheses; medical, surgical and orthopaedic implants made of artificial materials" ("Petitioner's Goods").

7. Petitioner's application was assigned Application Serial No. 88/131718 ("Petitioner's Application") to register Petitioner's Mark for Petitioner's Goods in International Class 10.

8. Registration No. 5262286 for the mark CANARYBOX for "Patient medical monitors for monitoring oxygen saturation, heart rate, noninvasive blood pressure" in International Class 10 was cited in Petitioner's Application as a bar to registration of Petitioner's Mark in a Non-Final Office Action issued January 14, 2019.

### **III. REGISTRANT'S MARK**

9. According to U.S. Patent and Trademark Office records, Registrant filed Application Serial No. 87045050 on May 20, 2016 for registration of the standard character mark CANARYBOX ("Registrant's Mark") for "Patient medical monitors for monitoring oxygen saturation, heart rate, noninvasive blood pressure" in International Class 10 ("Registrant's Goods"), an application that registered on August 8, 2017 as U.S. Registration No. 5262286, based on an alleged date of first use of Registrant's Mark with Registrant's Goods in interstate commerce of December 1, 2016.

### **IV. CLAIMS**

10. Petitioner's CANARY MEDICAL trademark and Petitioner's Registration have seniority over the cited CANARYBOX mark and registration because, among other things, Petitioner's Registration issued from an application filed December 9, 2015, while the cited registration issued from an application filed May 20, 2016 and alleges a date of first use of August 1, 2016 and a date of first use in commerce of December 1, 2016. Registrant's filing date and both of registrant's first use dates are junior to the filing date for Petitioner's Registration.

11. As reflected in the specimen Petitioner submitted to support registration, the Goods in Petitioner's senior Registration—*i.e.*, joint prostheses; medical, surgical and orthopaedic implants made of artificial materials—incorporate some of the sensors and are part of some of the systems described in Petitioner's Application—*e.g.*, systems for monitoring the integrity and function of a medical implant including one or more sensors and means for communicating or transmitting sensor data.

12. Registrant's goods—Patient medical monitors for monitoring oxygen saturation, heart rate, noninvasive blood pressure—are, on the face of the registration, identical or closely related to the sensors incorporated into the goods in Petitioner's Registration.

13. The U.S. Trademark Office Examining Attorney reviewing Petitioner's Application found that CANARY MEDICAL and CANARYBOX are sufficiently similar to support of a conclusion that the two marks, if used for both Petitioner's Goods and the Registrant's Goods, are confusingly similar and create a likelihood of consumer confusion or mistake.

14. Absent appropriate safeguards, Registrant's Mark is likely to be confused with Petitioner's CANARY MEDICAL mark and is likely to cause confusion in the minds of consumers as to source, sponsorship, or affiliation between Registrant and Petitioner as to their respective goods. In view of the foregoing and Petitioner's priority of use, Registrant's registration should be invalidated and cancelled. See 15 U.S.C. § 1052(d).

## **V. PETITIONER HAS STANDING**

15. Petitioner is likely to be damaged and highly prejudiced by continuance of registration of Registrant's Mark because Petitioner is unable to register Petitioner's Mark for Petitioner's Goods. See *Empresa Cubana del Tabaco v. General Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (finding Petitioner had standing based on an allegation that it filed a trademark application with the USPTO and an Office Action was issued refusing registration in view of Respondent's registrations).

**VI. REQUESTS FOR RELIEF**

WHEREFORE, Petitioner requests that United States Trademark Registration No. 5262286 be canceled.

WHEREFORE, Petitioner requests such other or additional relief as is warranted.

DATED this 8th day of August, 2022.

Respectfully submitted,

/Kevin S. Costanza/  
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