

ESTTA Tracking number: **ESTTA205361**

Filing date: **04/16/2008**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Penumbra, Inc.
Granted to Date of previous extension	04/16/2008
Address	2401 Merced Street, Suite 200 San Leandro, CA 94577 UNITED STATES
Correspondence information	Simone M. Katz Shartsis Friese LLP One Maritime Plaza 18th Floor San Francisco, CA 94111 UNITED STATES skatz@sflaw.com

**Applicant Information**

Application No	79032245	Publication date	12/18/2007
Opposition Filing Date	04/16/2008	Opposition Period Ends	04/16/2008
International Registration No.	0906850	International Registration Date	07/25/2006
Applicant	Paion Deutschland GmbH Martinstr. 10-12 52062 Aachen, GERMANY		

**Goods/Services Affected by Opposition**

<p>Class 005. All goods and services in the class are opposed, namely: Pharmaceutical preparations, namely, pharmaceutical preparations derived from living organism proteins and peptides for treatment and diagnosis of tumors, cancer, dermatological diseases, spinal cord injuries, osteoporosis, cell degeneration, allergies, endocrine diseases, hormonal imbalances, nervous diseases, diseases of the respiration system, kidney and bladder diseases, infectious diseases, gastrointestinal diseases, pain and epilepsy; pharmaceutical anti-inflammatory preparations; pharmaceutical nutraceutical preparations for the treatment of strokes, neuron damage, thrombotic diseases, tumors, cancer, heart disease including heart failure, circulation disorders, dermatological diseases, spinal cord injuries, osteoporosis, cell degeneration, allergies, endocrine diseases, hormonal imbalances, nervous diseases, diseases of the respiration system, kidney and bladder diseases, infectious diseases, gastrointestinal diseases, pain and epilepsy; blood cloning test kits comprised of medical diagnostic reagents; medical and clinical diagnostic reagents for clinical or medical laboratory use; Pharmaceutical preparations, namely, thrombolytic, fibrinolytic anti-coagulative, antithrombotical or neuroprotective substances for the treatment of blood clotting, cell protection and cell regeneration; products from biotechnological methods, namely, proteins for therapeutic and diagnostic use in the</p>
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treatment and diagnosis of blood clotting disorders
Class 010. All goods and services in the class are opposed, namely: Laboratory and analysis apparatus for medical, pharmaceutical and laboratory tests; medical devices, namely, coated catheters, medical stents, surgical implants comprising artificial materials; membranes intended for medical use, namely, filters for dialysis, hemofiltration

## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)

## Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	78679046	Application Date	07/26/2005
Registration Date	04/29/2008	Foreign Priority Date	NONE
Word Mark	PENUMBRA STROKE SYSTEM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 010. First use: First Use: 2005/11/00 First Use In Commerce: 2005/11/00 medical devices for treatment of strokes; namely, devices for removal of thromboembolic material from arteries		

Attachments	78679046#TMSN.jpeg ( 1 page )( bytes ) Notice of Opposition.pdf ( 5 pages )(23719 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 Overnight Courier on this date.

Signature	/Simone M. Katz/
Name	Simone M. Katz
Date	04/16/2008

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

PENUMBRA, INC.,

Opposer,

v.

PAION DEUTSCHLAND GMBH,

Applicant.

Opp. No.:

Ser. No.: 79/032245

Date of Publication:  
December 18, 2007

NOTICE OF OPPOSITION

Opposer, PENUMBRA, INC., a Delaware corporation having its principal place of business at 2401 Merced Street, Suite 200, San Leandro, California 94577 (“Opposer”), believes that it will be damaged by registration of the mark PENUMBRA IS BRAIN shown in Application Serial No. 79/032245 (“Application”) filed by Paion Deutschland GmbH (“Applicant”), and hereby opposes the same pursuant to the provisions of Section 13 of the Lanham Act (15 U.S.C. § 1063). The Application was published in the Official Gazette on December 18, 2007. Opposer was granted an extension of time until April 16, 2008 to oppose the Application.

As grounds for the opposition it is alleged that:

1. Opposer is a medical device company that develops and manufactures products to treat patients suffering from strokes and other neurovascular diseases. Opposer is the owner of common law rights in the trademarks PENUMBRA STROKE SYSTEM, PENUMBRA SYSTEM, and the logo design PENUMBRA.

2. Opposer is also the owner of Application Serial No. 78/679046, filed as an intent-to-use application on July 26, 2005 for the trademark PENUMBRA STROKE SYSTEM for “medical devices for treatment of strokes; namely, devices for removal of thromboembolic material from arteries” in International Class 10, and subsequently claimed a first use in commerce of November 2005.

3. On information and belief, Applicant is a pharmaceutical company based in Germany that develops drugs for the treatment of stroke and other thrombotic diseases.

4. Applicant filed its Application on July 25, 2006, based on Section 66(a) of the Lanham Act (15 U.S.C. §1141f(a)), claiming a priority date of January 31, 2006, for among other goods and services, “medical devices, namely, coated catheters, medical stents, surgical implants comprising artificial materials; membranes intended for medical use, namely, filters for dialysis, hemofiltration” in International Class 10, and “pharmaceutical nutraceutical preparations for the treatment of strokes, neuron damage, thrombotic diseases” in International Class 5.

5. Opposer began to use its PENUMBRA STROKE SYSTEM trademark for its medical devices in the United States prior to the filing and priority dates of the Application.

6. On information and belief, Applicant uses the mark PENUMBRA IS BRAIN, if at all, as a slogan to identify its goods and services.

#### LIKELIHOOD OF CONFUSION (CLAIM 1)

7. The facts alleged in paragraphs 1 through 6 are restated and incorporated herein by reference.

8. Applicant's goods in International Classes 10 and 5 are identical to and/or closely related to Opposer's medical devices sold under the PENUMBRA STROKE SYSTEM trademark.

9. The PENUMBRA IS BRAIN mark is comprised of and begins with the dominant term PENUMBRA that appears in Opposer's PENUMBRA STROKE SYSTEM trademark.

10. The PENUMBRA IS BRAIN mark so resembles Opposer's PENUMBRA STROKE SYSTEM trademark, when applied to medical devices and/or pharmaceuticals that treat strokes, as to be likely to cause confusion, to cause mistake or to deceive the consuming public by creating the false impression that Applicant's goods originate with or come from the same source as Opposer's goods, or are endorsed by, sponsored by or connected in some way with Opposer.

11. On information and belief, Applicant has taken the position that Opposer's logo design PENUMBRA is likely to cause confusion with Applicant's PENUMBRA IS BRAIN mark in the European Community, and has opposed registration of said mark on those grounds.

12. Registration of the Application should be refused under Section 2(d) of the Lanham Act (15 U.S.C. § 1052(d)) for the reason that the PENUMBRA IS BRAIN mark consists of or comprises a mark that so resembles Opposer's previously used and not abandoned PENUMBRA STROKE SYSTEM trademark for medical devices, as to be likely, when applied to Applicant's goods, to cause confusion, mistake and/or to deceive.

THE PENUMBRA IS BRAIN MARK IS MERELY DESCRIPTIVE AND HAS

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