

ESTTA Tracking number: **ESTTA281852**

Filing date: **05/04/2009**

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 | Medinol Ltd. |
| Granted to Date of previous extension | 05/03/2009 |
| Address | P.O. Box 58165 Kiryat Atidim Bldg. 3 Tel Aviv, 61581 ISRAEL |

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| Attorney information | Anna Erenburg Cadwalader, Wickersham & Taft LLP One World Financial Center New York, NY 10281 UNITED STATES anna.erenburg@cwt.com, docketing@cwt.com, dawn.signoretta@cwt.com Phone:212-504-6526 |
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Applicant Information

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|--------------------------------|--|---------------------------------|------------|
| Application No | 79028077 | Publication date | 11/04/2008 |
| Opposition Filing Date | 05/04/2009 | Opposition Period Ends | 05/03/2009 |
| International Registration No. | 0896419 | International Registration Date | 05/11/2006 |
| Applicant | Paion Deutschland GmbH Martinstr. 10-12 52062 Aachen, GERMANY | | |

Goods/Services Affected by Opposition

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| Class 001. All goods and services in the class are opposed, namely: Research reagents; biochemical preparations for scientific purposes |
| 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 clotting 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 and 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 treatment and diagnosis of blood clotting disorders

Class 010.

All goods and services in the class are opposed, namely: Laboratory devices for medical and pharmaceutical investigations, namely, portable medical devices for conducting blood specimen analysis of the human blood clotting system and for conducting medical diagnostic tests in the nature of medical apparatus for diagnosing suspected heart attacks, strokes, thrombosis, circulations and vascular disorders, embolisms, kidney failures, liver damages, infections, viral infections, sepsis, inflammatory and neuronal disorders

Class 041.

All goods and services in the class are opposed, namely: Educational services, namely, providing seminars, educational exhibitions, correspondence courses, colloquiums, conferences, congresses, and workshops in the field of biotechnology, pharmacology, biochemistry, molecular biology, medical procedures, product research and development of medical devices and pharmaceutical preparations, research procedures, protein design diagnostics, molecular diagnostics, proteogenomic profiling, gendiagnosics

Class 042.

All goods and services in the class are opposed, namely: Database development for others; computer programming for others; performing chemical analyses for others; technical consultation in the field of biotechnology; services of a biotechnological laboratory, namely, conducting lab research for others in the field of drug research and development; pharmaceutical consulting, namely, performing pre-clinical studies, quality control; preparation of technical expert opinions in the field of chemical engineering, biology, molecular biology, pharmacology, chemistry, bio-technology, bio-chemistry, product research and development of medical devices and pharmaceutical preparations; and molecular diagnostic services of a bio-chemist, namely, product research and development services for others in the areas the treatment and diagnosis of stroke, neuron damage, thrombotic diseases, heart diseases including heart failure, circulation disorders, gene expression analysis, namely, protogenomic profiling, DNA-sequencing, drug target development and identifying, designing and analyzing therapeutic proteins, diagnostic services in the field of molecular science, comparative genome analysis, DNA-arrays including DNA-microarrays, creation of nucleic acid libraries, screening of nucleic acid libraries; performance of pre-clinical studies, namely, conducting and managing pre-clinical trials and studies of pharmaceutical, bio-technology and health care products; bio-chemical and biotechnological research and development for others, namely, bio-technical research and development regarding medical disease diagnosis and pharmacology, namely, prenatal diagnostic and identification of hereditary factors leading to diseases, identification of genes involved in the formation of cancer, identification of target molecules for cancer treatment, scientific research on and development of medical diagnostic equipment and pharmaceutical preparations and products for the treatment 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; scientific and technical consulting for others in the field of medical science and drug research, namely, identifying, designing, and developing drugs, specifically, therapeutic proteins, gene expression analysis, namely, proteogenomic profiling, DNA-sequencing, drug target development, identification and design; medical science research services for others in the fields of prenatal diagnostics, molecular diagnostics, comparative genome analysis, DNA-arrays including DNA-microarrays, creating and screening of nucleic acid libraries, identifying hereditary factors leading to diseases, identifying genes involved in the formation of cancer, identification of target molecules for cancer treatment

Grounds for Opposition

Priority and likelihood of confusion

Trademark Act section 2(d)


Mark Cited by Opposer as Basis for Opposition

U.S. Application

77233796

Application Date

07/19/2007

| | | | |
|---------------------|--|-----------------------|------|
| No. | | | |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | PIONIR | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 010. First use: Medical devices, namely stents | | |

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| Attachments | 77233796#TMSN.jpeg (1 page)(bytes) Notice of Opposition & Cert of Service.pdf (8 pages)(762160 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 First Class Mail on this date.

| | |
|-----------|-----------------|
| Signature | /Anna Erenburg/ |
| Name | Anna Erenburg |
| Date | 05/04/2009 |

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

MEDINOL LTD.,

Opposer,

v.

PAION DEUTSCHLAND GMBH,

Applicant.

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Serial No. 79/028077
:
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Opposition No.
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NOTICE OF OPPOSITION

In the matter of pending U.S. Trademark Application Serial No. 79/028077 for the trademark “PAIONEERING” published for opposition on November 4, 2008 on the Principal Register for a large variety of goods and services, including medical devices and related services, under Section 66 of the Lanham Act, owned by Paion Deutschland GmbH, a Fed. Rep. Germany GmbH; of Martinstr. 10-12, 52062 Aachen, Fed. Rep. Germany (“Applicant”).

Medinol Ltd., an Israel corporation having a place of business at P.O. Box 58165, Kiryat Atidim Bldg. 3, Tel Aviv 61581, Israel (“Opposer”) believes that it will be damaged if said application Serial No. 79/028077 is registered on the Principal Register, and hence gives notice of its intention to oppose Serial No. 79/028077.

The grounds for the Notice of Opposition are as follows:

1. Opposer is the owner of U.S. Trademark Application No. 77/233796 filed July 19, 2007 for the mark PIONIR for “medical devices, namely stents” in International Class 10. A TARR copy of Application No. 77/233796 is annexed as Exhibit A.
2. In examining Opposer’s PIONIR application, Trademark Examining Attorney Amy Hella issued an advisory opinion concerning Applicant’s PAIONEERING

application, stating that there may be a likelihood of confusion between Opposer's and Applicant's marks under Trademark Act Section 2(d), 15 U.S.C. §1052(d), if Applicant's PAIONEERING mark proceeds to registration.

3. Examining Attorney Hella has currently suspended Opposer's PIONIR application pending final disposition before the U.S. Trademark Office of the PAIONEERING mark.

4. Opposer's PIONIR mark is a fanciful mark and is inherently distinctive in connection with Opposer's goods. Even assuming *arguendo* that Opposer's mark is arbitrary, rather than fanciful, as it neither suggests nor describes any quality or characteristic of Opposer's goods, it is inherently distinctive and does not require any proof of secondary meaning.

5. Applicant's mark, PAIONEERING, is visually and phonetically similar to Opposer's PIONIR mark.

6. The goods and services identified in Applicant's PAIONEERING application are similar to the goods identified in Opposer PIONIR application, i.e., Applicant's goods/services include medical devices/apparatus and related educational and research services that are similar to Opposer's medical stents. Hence, Applicant's goods/services and Opposer's goods are directly competitive, and could be distributed and/or are likely to be distributed through the same or commercially related channels of trade to the same or overlapping classes of consumers.

7. The simultaneous use of Opposer's and Applicant's respective marks for the closely related goods/services will lead to a likelihood of confusion. Thus, upon encountering Applicant's mark on its goods or in connection with its services, customers and potential customers of Opposer's goods would be likely to believe that the goods and services identified in Applicant's application emanate from the Opposer. Such customers would be

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