

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

Lexington Medical, Inc.

Petitioner,

vs.

AEON Scientific AG

Registrant.

In the matter of Registration Nos.  
4,853,082 & 4,848,405

For the marks: AEON PHOCUS &  
AEON SCIENTIFIC & DESIGN

Registered on November 17, 2015 & November  
10, 2015

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

**PETITION TO CANCEL REGISTRATION NOS. 4,853,082 & 4,848,405**

Lexington Medical, Inc. (“Lexington” or “Petitioner”), through its undersigned counsel, hereby petitions the Trademark Trial and Appeal Board (the “Board”) to cancel U.S. Trademark Registration Nos. 4,853,082 and 4,848,405 (the “Registrations”) for the trademarks AEON PHOCUS and AEON SCIENTIFIC & Design (the “Marks”), owned by AEON Scientific AG (“Registrant”), because Registrant: (1) has abandoned the Marks; and (2) lacked a *bona fide* intent to use the Marks for the designated goods at the time of filing the applications leading to the grant of the registrations, i.e., U.S. Trademark Application Serial Nos. 79/147,899 and 79/147,573 (“Registrant’s Applications”). Accordingly, Lexington requests that the Board cancel the Registrations pursuant to 37 CFR § 2.111, TBMP § 309.03 and Lanham Act §§ 8 and 14, 15 U.S.C. §§ 1064, 1141f. In support of its Petition, Lexington states as follows:

## **THE PARTIES**

1. Lexington is a Delaware corporation with its principal place of business at 11 Executive Park Drive, Billerica, MA 01862.

2. Lexington is a healthcare company seeking registrations of the mark AEON for surgical staplers and surgical staples.

3. Registrant is a Switzerland corporation with its principal place of business at Rütistrasse 12, CH-8952 Schlieren-Zurich, Switzerland. The name and address of the correspondent of record for each of the Registrations is:

Lawrence E. Abelman  
Abelman, Frayne & Schwab  
666 3<sup>rd</sup> Ave. FL. 10  
New York, NY 10017-4046

## **BACKGROUND**

4. Lexington filed U.S. Trademark Application Serial No. 87/826,390 on March 8, 2018 seeking registration of the standard character mark AEON for surgical staplers and surgical staples (the “Lexington Application”).

5. On June 20, 2018, the Examining Attorney issued an office action refusing registration under Section 2(d) of the Trademark Act citing the Registrations.

6. On July 17, 2018, Lexington responded to the Examining Attorney’s office action arguing that no likelihood of confusion exists.

7. On August 13, 2018, the Examining Attorney issued a final office action again refusing registration of Lexington’s AEON mark under Section 2(d) and citing the Registrations. No other issues were raised in this August 13, 2018 office action.

8. Lexington has been and continues to be damaged by the Registrations, which were cited against the Lexington Application.

9. The Registrations each cover the following goods:

Surgical and medical apparatus and instruments for use in surgery; robotic instruments, namely, surgical robots and robotic arms for surgical purposes for use in human body; magnetic navigation systems for medical use; medical apparatus, namely, systems for steering medical devices within the human body through the use of magnetic fields and magnetic torque and force featuring robotic arms, electro magnets and magnetic medical devices; catheters; rigid and flexible medical endoscopes; magnets and electric magnets for medical applications; atherectomy apparatus; conducting wires for medical use; apparatus for locating medical apparatus in the body; medical electrodes and catheters with electrodes; medical mapping systems featuring robotic arms, electro magnets and receivers to receive, store and make visible magnetic fields in International Class 10.

10. The original basis listed in Registrant's Applications and the current basis for the Registrations is Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f. That statute provides that a request for extension of protection of an international registration to the United States is only available if the applicant has a *bona fide* intention to use the mark in commerce, i.e., commerce which may lawfully be regulated by Congress. See 15 U.S.C. § 1127. On information and belief, Registrant never had any such *bona fide* intent and in the nearly five years since Registrant's Applications were filed has not taken any of the steps necessary under applicable laws and regulations to market the goods listed in Registrant's Registrations in the United States.

11. The sales of goods of the types listed in the Registrations secured by Registrant require certain approvals from the U.S. Food and Drug Administration ("FDA") prior to the time such goods are offered for sale or sold in the United States. On

information and belief, such belief based upon a search using search tools made available to the public by the FDA, Registrant has never received the necessary FDA approvals to offer for sale or sell in the U.S. any of the goods listed in the Registrations.

12. On information and belief, Registrant has never offered for sale or sold within the United States any of the goods listed in the Registrations and has abandoned the Marks covered by the cited Registrations.

13. On information and belief, Registrant has not ever made any *bona fide* use of the Marks covered by the Registrations in the ordinary course of trade or otherwise in commerce which may be lawfully regulated by Congress.

14. On information and belief, Registrant has never used the Marks covered by the Registrations in the ordinary course of trade in the United States by placing the Marks in any manner on the goods or their containers or displays associated with the goods or on tags or labels affixed thereto or on documents associated with the good or their sale.

15. On information and belief, Registrant has been in financial distress for at least the past several years, filed for bankruptcy protection in Registrant's home country of Switzerland and was recently liquidated. On information and belief, Registrant is no longer in business.

16. To the extent Registrant ever used the Marks covered by the Registrations in commerce regulated by Congress, such use has been discontinued. On information and belief, Registrant intends not to resume use. Such intention may be inferred from the fact that no applications for FDA approval of sales of the goods in the United States have

been filed and not such approvals have been granted. Such intention may also be inferred from other facts, including without limitation, the liquidation of Registrant.

17. For at least the last three consecutive years, Registrant has not made any *bona fide* use of the Marks covered by the Registrations in the ordinary course of trade in the United States. Such nonuse is *prima facie* evidence of abandonment. See 15 U.S.C. § 1127.

**COUNT I: CANCELLATION BASED ON ABANDONMENT  
(15 U.S.C. § 1064)**

18. Lexington fully repeats and incorporates each of the foregoing paragraphs Nos. 1-17.

19. Lexington has standing to petition to cancel the Registrations because Lexington is being damaged and will continue to be damaged by the Registrations.

20. Valid grounds exist for cancellation of the Registrations, namely, that Registrant never made a *bona fide* use of the Marks which are the subject of the Registrations in U.S. commerce for the goods described in the Registrations.

21. Alternatively, if Registrant ever made a *bona fide* use in U.S. commerce of the Marks cover by the Registrations, Registrant has not used the Marks with the identified goods within the last three years, at least, and does not intend to resume use.

22. For at least the last three consecutive years, Registrant has not used the Marks in connection with the goods claimed in the Registrations. This lack of use constitutes *prima facie* evidence of abandonment of the Marks.

23. Given Registrant's lack of use, lack of intent to resume use, and resulting abandonment of the Marks covered by the Registrations, Registrant is not entitled to continued registration of the Marks and the Registrations should be cancelled pursuant to Section 14(3) of the Trademark Act, 15 U.S.C. §1064(3).

**COUNT II: CANCELLATION BASED ON LACK OF A *BONA FIDE* INTENT TO USE AT THE TIME OF FILING OF THE APPLICATION**

24. Lexington fully repeats and incorporates each of the foregoing paragraphs Nos. 1-23.

25. The basis for each of the two Registrations is Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f, based on international registrations.

26. Extension of protection under Section 66(a) of the Trademark Act requires a *bona fide* intention to use a mark in commerce, i.e., commerce which may lawfully be regulated by Congress. See 15 U.S.C. § 1127.

27. If a party files requests for extension of protection under Section 66(a) of the Trademark Act, and that party does not have a *bona fide* intent to use the applied-for-mark in commerce in connection with the goods or services listed in the request and international registration, then that request is void *ab initio*.

28. Lexington has found no evidence that Registrant ever had a *bona fide* intent to use the Marks covered by the Registrations in U.S. commerce in connection with the goods listed therein.

29. Because Registrant in fact had no *bona fide* intent to use the Marks in U.S. commerce in connection with the goods identified in Registrant's applications and the resulting Registrations, the Registrations must be cancelled as void *ab initio*.

**PRAYER FOR RELIEF**

**WHEREFORE**, Lexington prays that the Board grant this Petition to Cancel in favor of Lexington, and that U.S. Trademark Reg. No's 4,853,082 and 4,848,405 each be cancelled and removed from the Principal Register. Lexington submits herewith the requisite filing fee in the amount of \$800.00. Lexington authorizes the Board to charge USPTO Deposit Account 08-1265 for any additional charges or fees related to this filing.

Respectfully submitted,

Dated: February 12, 2019

/s/James T. Nikolai

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