

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF INDIANA,
SOUTH BEND DIVISION



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ZIMMER, INC.,)	
)	
Plaintiff,)	
)	
v.)	Case No.
)	
ZIMMER MEDIZINSYSTEMS, and)	JURY TRIAL DEMANDED
ZIMMER ELEKTROMEDIZIN GMBH)	
)	
Defendants.)	

**COMPLAINT FOR TRADEMARK INFRINGEMENT,
TRADEMARK DILUTION, AND UNFAIR COMPETITION**

Plaintiff Zimmer, Inc. (“Zimmer”) alleges as follows, upon actual knowledge with respect to itself and its own acts, and upon information and belief as to all other matters:

NATURE OF THIS ACTION

1. This is a civil action for trademark infringement, trademark dilution, and unfair competition under federal, state, and common law. Zimmer seeks equitable and monetary relief from Defendants’ violations of Zimmer’s trademark rights in its ZIMMER name and mark and Z mark.

2. Defendants have been offering for sale, selling, and promoting medical devices (including in the fields of podiatry and sports medicine) under the marks ZIMMER, ZIMMER MEDIZINSYSTEMS, ZIMMER MEDIZINSYSTEME, and Z—all in violation of Zimmer’s trademark rights. As a result, consumers have been confused and misled to believe that Defendants’ products and related services are made, approved, and/or licensed by Zimmer.

PARTIES

3. Plaintiff Zimmer, Inc. is a Delaware corporation with a principal place of business at 345 East Main Street Warsaw, Indiana 46580.

4. Defendant Zimmer MedizinSystems is a California company with a principal place of business at 25 Mauchly #300, Irvine, California 92618.

5. Defendant Zimmer Elektromedizin GmbH, doing business as Zimmer MedizinSysteme (“Zimmer MedizinSysteme”), is a company organized under the laws of Germany with an address at Junkersstraße 9, 89231 Neu-Ulm, Germany.

6. On information and belief, Zimmer MedizinSystems and Zimmer MedizinSysteme are related entities. Zimmer MedizinSystems distributes and sells products in the United States for and with Zimmer MedizinSysteme.

JURISDICTION AND VENUE

7. This Court has jurisdiction over the subject matter of this action pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338(a) and (b). Because Zimmer is a citizen of Indiana, Zimmer MedizinSystems is a citizen of California, and Zimmer MedizinSysteme is a citizen of Germany and the matter in controversy exceeds \$75,000 exclusive of interest and costs, the Court also has jurisdiction under 28 U.S.C. § 1332. The Court has supplemental jurisdiction over Zimmer’s state-law claims pursuant to 28 U.S.C. § 1367(a) because they are substantially related to its federal claims and arise out of the same case or controversy.

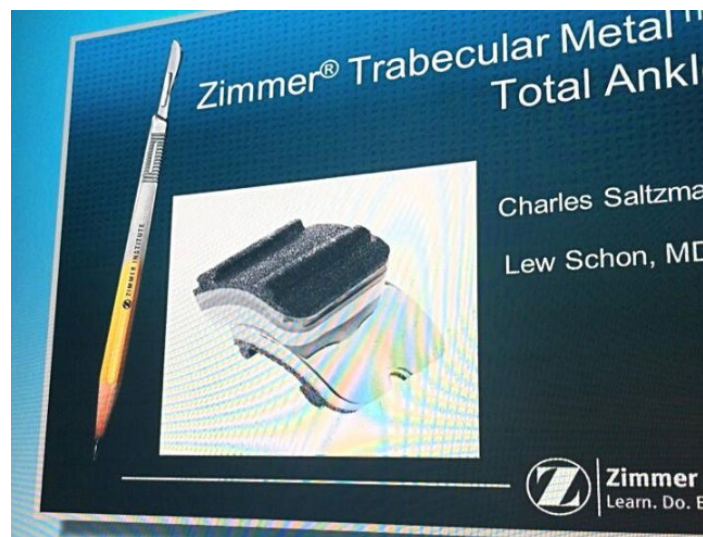
8. This Court has personal jurisdiction over Defendants, and venue is proper in the Northern District of Indiana pursuant to 28 U.S.C. § 1391(b) and (c), because a substantial part of property that is the subject of the action—i.e. Zimmer’s trademarks—is situated in this District, where Zimmer maintains its principal place of business; Defendants are doing business

in this District; and Defendants are using the ZIMMER, ZIMMER MEDIZINSYSTEMS, ZIMMER MEDIZINSYSTEME, and Z marks in this District.

**ZIMMER, ITS MUSCULOSKELETAL PRODUCTS,
AND ITS ZIMMER AND Z TRADEMARKS**

9. Zimmer is a global leader in musculoskeletal care. Zimmer engineers, develops, and manufactures medical technology, surgical instruments, and medical supplies and devices to treat bones, joints, and supporting soft tissues. Zimmer also collaborates with physicians to develop procedures for joint reconstruction, bone and skeletal repair, and sports and spinal injuries. For close to a century, Zimmer's innovative musculoskeletal products/treatments have restored mobility, alleviated pain, and improved quality of life worldwide. As a result, Zimmer is a globally trusted brand for personalized bone and joint healthcare solutions.

10. Since 1927, Zimmer has continuously used and promoted the mark ZIMMER in connection with its musculoskeletal goods and services, e.g.:





Forever Young
Forever Active

FOREVER HIP™





11. By 2004—in addition to its ZIMMER name/mark—Zimmer began using and promoting its abbreviated “Z” logo/mark (the “Z Mark,” as shown below) across its extensive product lines.



12. The ZIMMER and Z Marks have been used and promoted individually and together, so that consumers have come to associate them with one source, namely Zimmer.



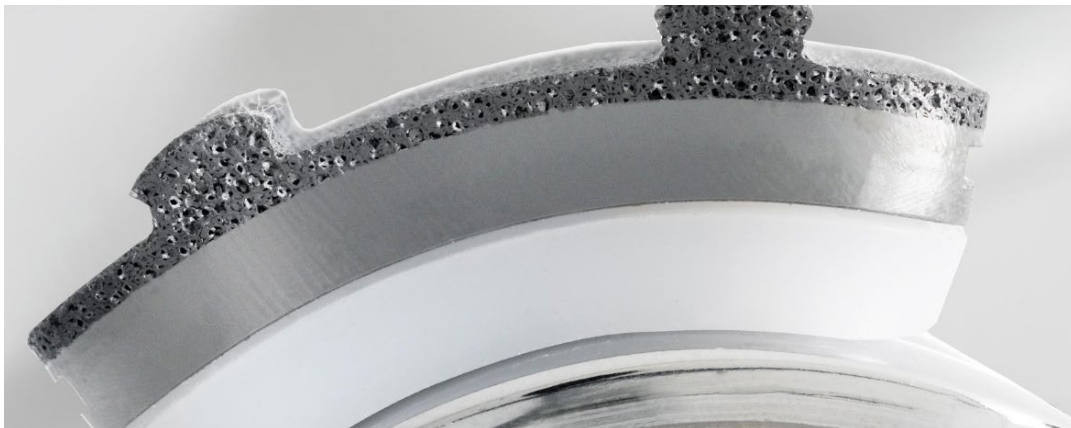
13. Among its various products, Zimmer has for years offered lines of sports-medicine and podiatry devices and apparatuses under its ZIMMER and Z Marks, e.g.:



Foot and Ankle Solutions

Technology that *Moves*

Zimmer Biomet understands the important role that you have in helping patients get back to a possible pain-free life. We make it our mission to help restore mobility, alleviate pain and improve the quality of life for patients around the world by adopting and developing new technologies, by embracing our responsibilities and by always looking to the future for inspiration.



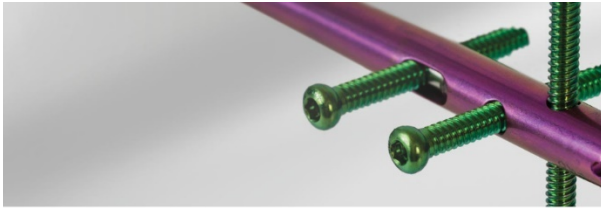
Zimmer Biomet Trabecular Metal™ Total Ankle



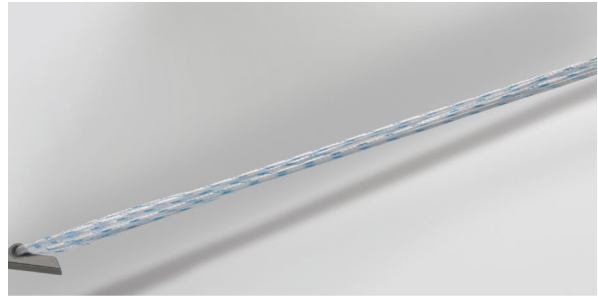
A.L.P.S.® Distal Tibia Plating System
Distinctly Contoured to Align with the Distal Tibia



MSP™ Metatarsal Shortening System



Phoenix™ Ankle Arthrodesis Nail System



ZipTight™ Ankle Fixation System



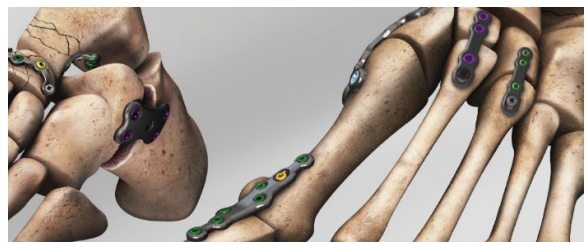
Nexta® Hammertoe Correction System



Re+Line® Bunion Correction System



Cannulated Screw System
Wide Variety of Cannulated Screws for Multiple Applications
in Foot & Ankle



A.L.P.S.® Total Foot System
Designed for Challenging Foot Surgery


**ZIMMERS’S SALES AND PROMOTION OF ITS ZIMMER
AND Z-BRANDED PRODUCTS**

14. Zimmer and its products, services, and marks have enjoyed substantial commercial success, with annual sales in the billions.

15. Zimmer has advertised and promoted its ZIMMER and Z Marks and musculoskeletal technology, devices, and related services in a variety of media, e.g., in trade publications, at trade shows/conferences, and on the Internet, including its website at <https://www.zimmerbiomet.com/> and social media (i.e., Facebook, Twitter, and LinkedIn). On average, Zimmer currently spends many millions of dollars per year advertising and promoting its marks, technologies, and products.

16. Zimmer owns, among others, the following valid and subsisting U.S. federal trademark registrations for its ZIMMER and Z Marks, including for orthopedic medical devices and apparatuses:

Mark	Reg. No.	Reg. Date	Products/Services
ZIMMER	1778807	06/29/93	Full line of surgical instruments and apparatuses in Class 10
ZIMMER	1633088	01/29/91	Dermatone skin grafting kit comprised of a skin grafting instrument, width plates, and blades in Class 10
ZIMMER	1437895	04/28/87	Anti-embolism stockings in Class 10
ZIMMER	3303411	10/02/07	Dental preparations and compounds, namely, bone growth substitutes, tissue matrices, tissue regeneration membranes, bone cements; orthopedic articles, namely, bone grafts and tissue grafts; and wound dressings for dental use in Class 5 Dental implants and prostheses; instruments, and apparatus and adaptors and accessories therefore, namely, abutments, copings, implants, fixtures, screws, collars, cuffs, drills, contouring tools, drivers, taps, reamers,

Mark	Reg. No.	Reg. Date	Products/Services
			wrenches, ratchets, vials, packaging materials, spacers, analogs, crowns, attachments, burs, tryins, handles, counter-torque tools, tissue punches, parallel pins, parallel tools, seating tools, caps, sleeves, attachments, adapters, inserts, extensions, fixture mounts, holders, replicas, posts, sheathes, transfers, liners, housings, bars, clips, patterns, rings, surgical templates, surgical motors; synthetic bone graft material for use as an implant in Class 10
	3308162	10/09/07	<p>Dental preparations and compounds, namely, growth substitutes and other osteoconductive materials, tissue matrices and other tissue regeneratives, bone cements and other tissue adhesives; orthopedic articles, namely, bone grafts and tissue grafts, and wound dressings for dental use in Class 5</p> <p>Dental implants and prostheses, instruments, and apparatus and adaptors and accessories therefore, namely, abutments, copings, implants, fixtures, screws, collars, cuffs, drills, contouring tools, drivers, taps, reamers, wrenches, ratchets, vials, packaging materials, spacers, analogs, crowns, attachments, burs, try ins, handles, counter-torque tools, tissue punches, parallel pins, parallel tools, seating tools, caps, sleeves, attachments, adapters, inserts, extensions, fixture mounts, holders, replicas, posts, sheathes, transfers, liners, housings, bars, clips, patterns, rings and the like, synthetic bone graft material for use as an implant in Class 10</p>

Printouts of these registrations from the U.S. Patent and Trademark Office database are attached as Exhibit A.

17. As a result of their distinctive nature and strength, significant commercial success, widespread advertising, and long-standing and extensive publicity, Zimmer’s ZIMMER and Z

Marks have been well-known in the medical (and, in particular, the musculoskeletal and sports-medicine) field for years.

DEFENDANTS' WRONGFUL ACTIVITIES

18. For years, Defendants have offered electro-medicine products and services focused on cosmetics and aesthetics applications—e.g., the treatment of cellulite and dermatological conditions. Zimmer had no objection to such uses so long as they were not directed to Zimmer's fields of use, including sports medicine or podiatry.

19. However, without Zimmer's authorization or approval, Defendants started offering, promoting, and selling medical devices for podiatry and sports medicine under the ZIMMER, ZIMMER MEDIZINSYSTEMS, and ZIMMER MEDIZINSYSTEME marks (the "Unauthorized ZIMMER Marks"), including devices designed and promoted "for the treatment of chronic foot, heel, and ankle pain as well as soft tissue pain and sports injuries" and for physical therapy (the "Disputed Goods/Services"), e.g.:

Zimmer
MedizinSystems

Products ▾ Order Electrodes Shop Z News Contact ▾

				
AESTHETICS	CRYO THERAPY	ICELAB	ELECTRODES & PHYSICAL MEDICINE	PODIATRY & SPORTS MEDICINE
Cellulite treatment, enhanced body contouring, and cold air for laser & IPL treatments.	State-of-the-art Cryo Therapy: <ul style="list-style-type: none">• Cryo for Aesthetics• Cryo for Physical Medicine	Whole Body Cryo Chamber – The ultimate cryo sauna experience at -110°C (-166°F).	Single use <i>Z Trodes</i> and modalities for e-stim, ultrasound, combo therapy, Laser, Radial Pulse Therapy & Shortwave Diathermy.	Cutting edge Zimmer modalities for the non-invasive treatment of chronic foot, heel, and ankle pain and chronic soft tissue pain and sports injuries.

Zimmer
MedizinSystems

Products ▾ Order Electrodes Shop Z News Contact ▾

Zimmer Modalities for Podiatry and Sports Medicine:
cutting-edge devices with state-of-the-art technology





**Join our Free 30 Minute
live Webinar**

***"The Benefits of Adding
Radial Shockwave Therapy
to your Practice"***

Speaker : Brian Fullem D.P.M.

*Learn how the enPuls Pro will not only benefit your patients,
but also increase your practice revenue!!*



DATE:
Thursday, November 29th, 2018

TIME:
*8:00pm EST, 7:00pm CST
5:00pm PST*

DURATION:
30 Minutes

[Register Now](#)


CONTACT ME IF YOU WOULD LIKE TO LEARN MORE!!

PAUL CUMMINGS
ZIMMER MEDIZIN SYSTEMS
PCUMMINGS@FNDFAVORPTC.COM
917-270-3592

20. Like Zimmer, Defendants also use a “Z” logo/mark (the “Unauthorized Z Mark”) to identify their company, products, and services:

Zimmer
MedizinSystems



 Zimmer MedizinSystems

Z CRYO ▾ Z WAVE ▾ Z SERVICE



21. Moreover, like Zimmer, Defendants use and promote their Unauthorized ZIMMER and Z Marks online, including on social media like Facebook, Twitter, and LinkedIn.

22. Defendants' uses of the Unauthorized ZIMMER and Z Marks for the Disputed Goods/Services have caused, and will continue to cause, consumer confusion.

23. The parties have interacted regarding the use of the ZIMMER name and mark in the past.

24. In 2003, Defendant Zimmer Elektromedizin GmbH entered into an agreement with Zimmer. Under the agreement, Zimmer consented to Zimmer Elektromedizin GmbH's use

and registration of the mark ZIMMER MEDIZINSYSTEME in the European Union for certain limited goods in International Class 10. Zimmer did not consent to such use in the United States, although Defendants claim that Zimmer did. Even if construed as such, however, Zimmer consented only to the limited use of the company name Zimmer Elektromedizin GmbH and not ZIMMER or ZIMMER MEDIZINSYSTEME as names or marks, alone—and certainly not in the ways Defendants use them.

25. Zimmer has written to Defendants (through counsel) multiple times objecting to the Unauthorized ZIMMER and Z Marks. Defendants have refused to stop using those marks in the complained-of manners.

26. Defendants have used the Unauthorized ZIMMER and Z Marks with full knowledge of Zimmer and its longstanding trademarks, and have thus acted knowingly, willfully, in reckless disregard of Zimmer's rights, and in bad faith.

INJURY TO ZIMMER AND THE PUBLIC

27. Defendants' uses of the Unauthorized ZIMMER and Z Marks have caused—and, if not enjoined, are likely to continue to cause—confusion, mistake, and deception as to the source or origin of Defendants' products and services, and a false suggestion of sponsorship, connection, or association between Defendants, their products and services, and/or their commercial activities with Zimmer.

28. Defendants' uses of the Unauthorized ZIMMER Marks are likely to dilute the distinctiveness and value of Zimmer's famous ZIMMER mark.

29. Defendants' acts, as described above, have damaged and irreparably injured and, if permitted to continue, will further damage and irreparably injure Zimmer and its ZIMMER and Z Marks.

30. Defendants' acts, as described above, have damaged and irreparably injured and, if permitted to continue, will further damage and irreparably injure the public, who has an interest in being free from confusion, mistake, and deception.

FIRST CLAIM FOR RELIEF
Federal Trademark Infringement Under
Section 32(1) of the Lanham Act, 15 U.S.C. § 1114(1)

31. Zimmer repeats and re-alleges each and every allegation set forth in paragraphs 1 through 30 of this Complaint.

32. Without Zimmer's consent, Defendants have used and continue to use in commerce the Unauthorized ZIMMER and Z Marks in connection with the offering, distribution, and advertising of the Disputed Goods/Services, which conflict with Zimmer's registered ZIMMER and Z Marks and have caused, and are likely to continue to cause, confusion, or to cause mistake, or to deceive, in violation of Section 32(1) of the Lanham Act, 15 U.S.C. § 1114(1).

SECOND CLAIM FOR RELIEF
Federal Trademark Infringement False Designation of Origin;
Passing Off; and Unfair Competition
Under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)

33. Plaintiff repeats and re-alleges each and every allegation set forth in paragraphs 1 through 32 of this Complaint.

34. Defendants' uses of the Unauthorized ZIMMER and Z marks, as described above, have caused, and are likely to continue to cause, confusion or mistake, or to deceive as to the origin, sponsorship, or approval of Defendants, their products, and/or their commercial activities by or with Zimmer, and thus constitute trademark infringement, false designation of origin, passing off, and unfair competition in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

THIRD CLAIM FOR RELIEF
Trademark Infringement and Unfair Competition
Under Indiana Common Law

35. Plaintiff repeats and realleges each and every allegation set forth in paragraphs 1 through 34 of this Complaint.

36. Defendants' actions, as described above, have caused, and will continue to cause, confusion or mistake, or to deceive as to the affiliation, connection, or association of Defendants with Zimmer, or as to the origin, sponsorship, or approval of Defendants, their products, and/or their commercial activities by or with Zimmer such that Defendants' acts constitute infringement of Zimmer's proprietary rights in its ZIMMER and Z trademarks, misappropriation of Zimmer's goodwill in those marks, and unfair competition under Indiana common law.

FOURTH CLAIM FOR RELIEF
Trademark Dilution Under Section
43(c) of the Lanham Act, 15 U.S.C. § 1125(c)

37. Plaintiff repeats and re-alleges each and every allegation set forth in paragraphs 1 through 36 of this Complaint.

38. Plaintiff's ZIMMER Mark is famous, as the term is used in 15 U.S.C. § 1125(c), and was famous prior to Defendants' uses of the Unauthorized ZIMMER Marks based on, among other things, the federal registration of Plaintiff's ZIMMER mark and the extensive nationwide use, advertising, promotion, and recognition of the mark.

39. Defendants' actions, as described above, are likely to dilute the distinctive quality of Plaintiff's ZIMMER mark in violation of Section 43(c) of the Lanham Act, § 1125(c), as amended by the Trademark Dilution Revisions Act of 2006.

JURY DEMAND

Pursuant to Fed. R. Civ. P. 38, Plaintiff respectfully demands a trial by jury on all issues properly triable by a jury in this action.

PRAYER FOR RELIEF

WHEREFORE, Zimmer respectfully requests that this Court enter judgment in its favor on each and every claim for relief set forth above and award it relief including, but not limited to, the following:

A. An Order declaring that Defendants' uses of the Unauthorized ZIMMER and Z Marks infringe Zimmer's ZIMMER and Z Marks, dilute Zimmer's ZIMMER Mark, and constitute unfair competition under federal and state law, as detailed above;

B. A permanent injunction enjoining Defendants and their employees, agents, partners, officers, directors, owners, principals, subsidiaries, related companies, affiliates, distributors, dealers, and all persons in active concert or participation with any of them:

1. From using, registering, or seeking to register ZIMMER, ZIMMER MEDIZINSYSTEMS, and ZIMMER MEDIZINSYSTEME in any form, including with any other wording or designs, and from using any other marks, logos, designs, designations, or indicators that are confusingly similar to, or dilutive of Zimmer's ZIMMER Mark in connection with medical devices, products, and services in the fields of podiatry, sports medicine, and/or related fields;

2. From using, registering, or seeking to register Z in any form, including with any other wording or designs, and from using any other marks, logos, designs, designations, or indicators that are confusingly similar to Zimmer's Z Mark in connection

with medical devices, products, and services in the fields of podiatry, sports medicine, and/or related fields;

3. From representing by any means whatsoever, directly or indirectly, that Defendants, any products or services offered by Defendants, or any activities undertaken by Defendants, are associated or connected in any way with Zimmer or sponsored or affiliated with Zimmer in any way;

4. From assisting, aiding or abetting any other person or business entity in engaging in or performing any of the activities referred to in subparagraphs B(1)-(3);

C. An order directing Defendants to destroy all products and any packaging, signage, advertisements, promotional materials, stationery, forms, and/or any other materials and things that contain ZIMMER, ZIMMER MEDIZINSYSTEMS, ZIMMER MEDIZINSYSTEME, and/or any other marks, names, logos, designs, designations, or indicators comprised of or containing ZIMMER, or that are confusingly similar to, or dilutive of, Zimmer's ZIMMER Mark in connection with medical devices, products, and services in the fields of podiatry, sports medicine, and/or related fields;

D. An order directing Defendants to destroy all products and any packaging, signage, advertisements, promotional materials, stationery, forms, and/or any other materials and things that contain Z and/or any other marks, names, logos, designs, designations, or indicators comprised of or containing Z, or that are confusingly similar to Zimmer's Z Mark in connection with medical devices, products, and services in the fields of podiatry, sports medicine, and/or related fields;

E. An Order directing Defendants to, within thirty (30) days after the entry of the injunction, file with this Court and serve on Zimmer's attorneys a report in writing and under

oath setting forth in detail the manner and form in which Defendants have complied with the injunction;

F. An Order requiring Defendants to account for and pay to Zimmer any and all profits arising from the foregoing acts, and increasing such profits, in accordance with 15 U.S.C. § 1117 and other applicable laws;

G. An Order requiring Defendants to pay damages in an amount as yet undetermined (and including prejudgment and post-judgment interest) caused by the foregoing acts, and trebling such damages in accordance with 15 U.S.C. § 1117 and other applicable laws;

H. An Order requiring Defendants to pay Zimmer's costs and attorneys' fees in this action pursuant to 15 U.S.C. § 1117 and other applicable laws; and

I. Other relief as the Court may deem appropriate.

Dated: May 24, 2019

Respectfully submitted,

/s/ Stephen M. Judge

John D. LaDue

Stephen M. Judge

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