

TTAB

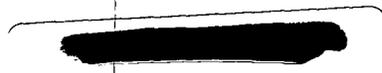
TRADEMARK
Docket No. 49269-24005.00

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

In the application of:
NuGEN Technologies, Inc.

Mark: NUGEN
Serial No.: 76/254,430
Class: 1, 5, 9, 42
Filing Date: May 8, 2001

NOTICE OF APPEAL



12-19-2002
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #33

BOX T.T.A.B. FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Please take notice that NuGEN Technologies, Inc. hereby appeals from the Examining Attorney's refusal to register the NUGEN trademark in application serial number 76/254,430.

Applicant has also filed a Request for Reconsideration of Office Action No. 2 with the Examining Attorney. A copy of that document is attached hereto as Exhibit A.

12/26/2002 CMAY11 00000242 031952 76254430
01 FC:6403 100.00 CH

02 DEC 27 AM 9:30
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

The Commissioner is hereby authorized to charge any fees which may be required, to Deposit Account No. 03-1952. A duplicate copy of this notice is enclosed for this purpose.

Dated: December 18, 2002

Respectfully submitted,

By: 

Rosemary S. Tarlton
Attorney for Applicant

Morrison & Foerster LLP
425 Market Street
San Francisco, California 94105-2482
Telephone: (415) 268-6327
Facsimile: (415) 268-7522

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

NuGEN Technologies, Inc.

Mark:

NUGEN

Serial No.:

76/254,430

Class:

1, 5, 9, 42

Filing Date:

May 8, 2001

Trademark Atty:

Marlene D. Bell

Law Office:

105

12-19-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #33

REQUEST FOR RECONSIDERATION

BOX RESPONSES NO FEE

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

This Request for Reconsideration is being filed in response to Office Action No. 2, dated June 28, 2002. The Examining Attorney has continued her refusal to register the instant mark in light of the prior registration of NUGENIX, Registration No. 2,366,319, for "chemical and biological research and consultation." Applicant has now contacted the Registrant for the cited registration, NuGenix LLC¹, to discuss and resolve this matter. NuGenix LLC has agreed to enter into a consent agreement with Applicant that specifically sets for the reasons why there is no likelihood of confusion between Applicant's NUGEN mark and the cited NUGENIX registration. A true and correct copy of the executed consent agreement between NuGenix LLC

¹ On April 29, 2002, NuGenix LLC acquired the NUGENIX registration from the original registrant NuGenix, Inc., 28 Holyone Street, Boston, Massachusetts 92116. The assignment of the registration from NuGenix, Inc. to NuGenix LLC is recorded at reel/frame 002509/0448.

and Applicant is attached hereto as Exhibit A. The agreement sets forth the following details supporting the conclusion that there is no likelihood of confusion between the mark NUGEN and the mark NUGENIX.

(a) The NUGEN and NUGENIX marks are dissimilar in appearance. The NUGENIX mark is three-syllables long, and the non-overlapping, unique element contains the letter "X." Because the letter "X" is both uncommon and highly-distinctive in appearance, the consumer's attention is strongly drawn to it. This difference creates a visual image distinct from that created by the NUGEN mark.

(b) NuGEN Technologies, Inc. provides products and technologies for nucleic acid amplification, sequencing and detection to researchers and scientists engaged in medical, pharmaceutical, and biological research projects. The NUGEN mark, owned and used by NuGEN Technologies, Inc. and set forth in U.S. Application Serial No. 76/254,430, is used solely in connection with chemicals, assays, reagents and kits for the analysis, amplification, sequencing and detection of nucleic acids; oligonucleotide, cDNA and RNA libraries and microarrays for clinical, diagnostic and medical laboratory use; computer software, hardware, and laboratory instruments for use in analysis of genetic material and genetic research and testing; and related products and services. NuGEN Technologies, Inc. does not use the NUGEN mark in connection with any type of nutritional supplements or skin care products, nor does it provide services relating to the design or development of such products.

(c) NuGenix LLC is in the business of designing, developing, and custom manufacturing nutritional supplements and skin care products tailored to an individual's genetic profile. The NUGENIX mark, owned and used by NuGenix LLC, is used in connection with the development and sale of such genetically-tailored nutritional supplements and skin care products, and is not used in connection with the chemicals, reagents, kits, and other nucleic acid amplification products and services offered by NuGEN Technologies, Inc.

(d) The customers for the NUGENIX and NUGEN marks are entirely distinct, in that NuGenix LLC's NUGENIX mark is used to market genetically-tailored nutritional supplements and skin care products to health-conscious lay people, while the NUGEN mark of NuGEN Technologies, Inc. is used in connection with highly sophisticated technology sold to universities, laboratories, and other research facilities for use by medical researchers and scientists.

(e) NuGEN Technologies, Inc.'s NUGEN products and services are highly sophisticated biotechnology products and services related to the analysis, amplification, sequencing and detection of nucleic acids. NuGEN Technologies, Inc.'s products and services will be used by medical researchers and other scientific professionals who conduct highly complex medical, pharmaceutical, and biological research. These NUGEN goods and services are likely to be purchased with considerable care after extensive consideration and investigation into their functioning and capabilities.

(f) NuGenix LLC's genetically-tailored nutritional supplements and skin care products also target sophisticated purchasers. These products are custom made for individual customers who are likely to be highly discriminating and particularly concerned with health issues. Such consumers are likely to be familiar with the source or origin of the goods and services they use, to know the goods and services they need, and to exercise a great deal of caution in their selection.

Applicant, respectfully requests that in light of this agreement, which details the reasons why there is no likelihood of confusion between the marks, the Examining Attorney withdraw the refusal based on Section 2(d) of the Lanham Act. "The Court of Appeals for the Federal Circuit has made it clear that consent agreements should be given great weight, and that the Office should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason." TMEP Section 1207.01(d)(viii), citing,

Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank, 842 F.2d 1270 (Fed. Cir. 1988).

The undersigned spoke with Marlene D. Bell, the Examining Attorney currently handling this file, on December 11, 2002 regarding the consent agreement. Ms. Bell indicated that a consent agreement would be acceptable as long as it was not a “naked consent,” but contained an appropriate recitation of the reasons why there would be no likelihood of confusion between the two marks. The undersigned sent Ms. Bell a copy of the agreement by telefacsimile, and Ms. Bell stated that it appeared to be sufficient upon her preliminary review, and that barring any unforeseen problems, she would approve the mark. Ms. Bell also inquired as to whether the goods and services offered under the two marks would be sold to different consumers. Applicant and the undersigned can confirm that we have no basis to believe that the researchers and scientists who will buy the NUGEN products will also be the intended consumers of the NUGENIX goods and services—namely, consumers interested in the purchase of custom nutritional and skin care products for personal use. Indeed, even if the customers were to overlap in rare instances, the services and goods will travel in entirely distinct channels of trade and will not be confused by the respective purchasers.

In the telephone conversation of December 11, 2002, Ms. Bell further informed applicant that the proper way of submitting the agreement would be to file a request for reconsideration that attached the documents for consideration by the Examining Attorney handling the file. Ms. Bell also confirmed that Applicant should file a Notice of Appeal with the TTAB to protect Applicant while the Request for Reconsideration and the consent agreement were under review. Applicant has filed such a Notice of Appeal with the Board. A true and correct copy of that Notice of Appeal is attached hereto as Exhibit B.

COMMENTS

It is believed that Applicant has responded to all of the Examining Attorney's questions and objections and that the application is now in condition to go forward to publication. If the Examining Attorney has any questions or wishes to discuss any of the information contained in this Request for Reconsideration, the Examining Attorney is invited to telephone the undersigned at (415) 268-6810.

Dated: December 19, 2002

Respectfully submitted,

By:



Rosemary S. Tarlton
Attorney for Applicant

Morrison & Foerster LLP
425 Market Street
San Francisco, California 94105-2482
Telephone: (415) 268-6327
Facsimile: (415) 268-7522

EXHIBIT A

CONSENT AGREEMENT

This Consent Agreement (the "Agreement") is made and entered into as of November __, 2002 by and between NuGEN Technologies, Inc., 821 Industrial Road, San Carlos California 94070 and NuGenix LLC, 1055 Westlake Drive, Berwyn, Pennsylvania 19312, with reference to the following facts:

A. NuGenix LLC is a company engaged in the design and development of genetically-profiled nutritional supplements and skin care products. NuGenix LLC is the owner of a trademark registered in the United States Patent & Trademark Office ("USPTO") for the word mark NUGENIX, Registration No. 2,366,319, for "chemical and biological research and consultation."¹ NuGenix LLC uses the NUGENIX mark in connection with the design, development, and sale of genetically-profiled nutritional supplements and skin care products.

B. NuGEN Technologies, Inc. is a company engaged in the development of products and technologies for the amplification, sequencing and detection of nucleic acids. NuGEN Technologies, Inc. is the owner of a trademark application in the USPTO for the mark NUGEN, Serial No. 76/254430, for use in connection with chemicals, assays, reagents and kits for the analysis, amplification, sequencing and detection of nucleic acids; oligonucleotide, cDNA and RNA libraries and microarrays for clinical, diagnostic and medical laboratory use; computer software, hardware, and laboratory instruments for use in analysis of genetic material and genetic research and testing; and related products and services. NuGEN Technologies, Inc. uses the NUGEN mark in connection with chemicals, reagents, and kits that improve the accuracy and efficiency of nucleic acid amplification, sequencing and detection over previously available technology.

C. The USPTO has cited NuGenix LLC's NUGENIX registration against the NUGEN application of NuGEN Technologies, Inc.

D. NuGEN Technologies, Inc. and NuGenix LLC desire to clarify for the USPTO that their respective use and registration of the NUGEN and NUGENIX marks are not likely to result in confusion, given the difference in the appearance of the marks, the difference in the products and services for which they use their respective marks, the difference in marketing channels and

¹ On April 29, 2002, NuGenix LLC acquired the NUGENIX registration from the original registrant NuGenix, Inc., 28 Holyone Street, Boston, Massachusetts 92116. The assignment of the registration from NuGenix, Inc. to NuGenix LLC is recorded at reel/frame _____ [FILL IN REEL/FAME] sf-1405859

007509/0448

customers for their respective products and services, and the discrimination and sophistication of their respective customers.

NOW THEREFORE, for good and valuable consideration the receipt and adequacy of which is hereby acknowledged, it is agreed as follows:

No Likelihood of Confusion

1. NuGEN Technologies, Inc. and NuGenix LLC agree that there is no likelihood of confusion between their respective uses and registration of the NUGEN and NUGENIX marks for the following reasons:

(a) The NUGEN and NUGENIX marks are dissimilar in appearance. The NUGENIX mark is three-syllables long, and the non-overlapping, unique element contains the letter "X." Because the letter "X" is both uncommon and highly-distinctive in appearance, the consumer's attention is strongly drawn to it. This difference creates a visual image distinct from that created by the NUGEN mark.

(b) NuGEN Technologies, Inc. provides products and technologies for nucleic acid amplification, sequencing and detection to researchers and scientists engaged in medical, pharmaceutical, and biological research projects. The NUGEN mark, owned and used by NuGEN Technologies, Inc. and set forth in U.S. Application Serial No. 76/154,984, is used solely in connection with chemicals, assays, reagents and kits for the analysis, amplification, sequencing and detection of nucleic acids; oligonucleotide, cDNA and RNA libraries and microarrays for clinical, diagnostic and medical laboratory use; computer software, hardware, and laboratory instruments for use in analysis of genetic material and genetic research and testing; and related products and services. NuGEN Technologies, Inc. does not use the NUGEN mark in connection with any type of nutritional supplements or skin care products, nor does it provide services relating to the design or development of such products.

(c) NuGenix LLC is in the business of designing, developing, and custom manufacturing nutritional supplements and skin care products tailored to an individual's genetic profile. The NUGENIX mark, owned and used by NuGenix LLC, is used in connection with the development and sale of such genetically-tailored nutritional supplements and skin care products, and is not used in connection with the chemicals, reagents, kits, and other nucleic acid amplification products and services offered by NuGEN Technologies, Inc.

(d) The customers for the NUGENIX and NUGEN marks are entirely distinct, in that NuGenix LLC's NUGENIX mark is used to market genetically-tailored nutritional supplements and skin care products to health-conscious lay people, while the NUGEN mark of NuGEN Technologies, Inc. is used in connection with highly sophisticated technology sold to universities, laboratories, and other research facilities for use by medical researchers and scientists.

(e) NuGEN Technologies, Inc.'s NUGEN products and services are highly sophisticated biotechnology products and services related to the analysis, amplification, sequencing and detection of nucleic acids. NuGEN Technologies, Inc.'s products and services will be used by medical researchers and other scientific professionals who conduct highly complex medical, pharmaceutical, and biological research. These NUGEN goods and services are likely to be purchased with considerable care after extensive consideration and investigation into their functioning and capabilities.

(f) NuGenix LLC's genetically-tailored nutritional supplements and skin care products also target sophisticated purchasers. These products are custom made for individual customers who are likely to be highly discriminating and particularly concerned with health issues. Such consumers are likely to be familiar with the source or origin of the goods and services they use, to know the goods and services they need, and to exercise a great deal of caution in their selection.

3. Each party agrees that it will in no way attempt to associate itself with the other party or the other party's goods or services, except pursuant to a valid trademark license agreement. NuGEN Technologies, Inc. and NuGenix LLC shall cooperate and find ways to eliminate or minimize confusion stemming from their respective uses of their respective marks, should any such confusion arises.

Agreement Binding

4. NuGEN Technologies, Inc. and NuGenix LLC are each entering into this Agreement on behalf of, and the Agreement shall be binding upon, itself and all of their respective affiliated, related and subsidiary entities, assigns, predecessors, successors, heirs, parents, past or present directors, officers, employees, principals, licensees, agents, servants, insurers, attorneys, shareholders, advisors, representatives, partners, joint ventures, consultants, independent contractors, and all others acting on its behalf and/or within its control.

Representation By Counsel

5. NuGEN Technologies, Inc. and NuGenix LLC acknowledge that they have been represented by counsel in negotiations and preparation of this Agreement, that they have reviewed this Agreement, that they understand and are fully aware of its contents and of its legal effect, and that they are voluntarily entering into this Agreement upon the legal advice of their counsel.

Representation Of Authority

6. Each party to this Agreement warrants and represents that the person signing this Agreement on behalf of the respective party has full authority to execute and perform this Agreement, that no promise, express or implied, has been made in order to induce its execution of this Agreement.

Severability

7. In the event any one or more of the provisions of this Agreement shall for any reason be held to be invalid, illegal or unenforceable, then: (a) the illegal or unenforceable provision shall be replaced by a revised provision, which, being valid, comes closest to the intention of the parties underlying the invalid, illegal, or unenforceable provision; and (b) the remainder of this Agreement will remain binding and in full force and effect.

Integration

8. This Agreement constitutes the entire agreement between the parties with respect to the subject matter hereof and supersedes all prior negotiations, promises, representations, and agreements, whether written or oral, relating to the subject matter. It is expressly understood and agreed that this Agreement may not be altered, amended, modified or otherwise changed in any respect or particular whatsoever except by a writing duly executed by authorized representatives of the parties hereto.

Counterparts And Copies

9. This Agreement may be signed by NuGEN Technologies, Inc. and NuGenix LLC in counterparts, each of which shall be deemed an original but all of which together shall constitute one and the same Agreement. A facsimile or photocopy of this Agreement, as signed by the parties, shall be as valid as if an original.

Notices

10. All notices, demands and other communications required or permitted to be given or made pursuant to this Agreement shall be given in writing, and shall be personally delivered, or sent by nationally recognized overnight delivery service (such as, but not limited to, Federal Express and United Parcel Service), or sent by certified mail, return receipt requested. Such notice shall be effective upon delivery or, if sent by certified mail, return receipt requested, three (3) days after deposit of such notice in the United States mail, postage prepaid and properly addressed. Each such notice shall be sent to such party at the address set forth below (or to such change of address as such party shall specify in a written notice sent to the other party hereto pursuant to this Agreement):

If to NuGEN Technologies, Inc.:

821 Industrial Road
San Carlos California 94070
Attention: Charlotte Rogers

with concurrent copy to:

Morrison & Foerster
425 Market Street
San Francisco, CA 94105
Attention: Rosemary S. Tarlton, Esq.
Facsimile: (415) 268-7522

If to NuGenix LLC:

1055 Westlake Drive
Berwyn, Pennsylvania 19312
Attention: William DePhillipo

with concurrent copy to:

John Lezdey and Associates
4625 East Bay Drive
Suite 302
Clearwater, FL 33764
Attention: John Lezdey, Esq.

IN WITNESS WHEREOF, the parties hereto have executed this Agreement on the dates indicated below.

Dated: 12/9/02

NuGEN Technologies, Inc.

By: [Signature]

Name: JAN D'ALVISE

Title: 12/9/02

Dated: 12/9/02

NuGenix LLC

By: [Signature]

Name: William R. DeFilipo

Title: member

EXHIBIT B

TRADEMARK
Docket No. 49269-24005.00

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

In the application of:

NuGEN Technologies, Inc.

Mark:

NUGEN

Serial No.:

76/254,430

Class:

1, 5, 9, 42

Filing Date:

May 8, 2001

NOTICE OF APPEAL

BOX T.T.A.B. FEE

Assistant Commissioner for Trademarks

2900 Crystal Drive

Arlington, VA 22202-3513

Please take notice that NuGEN Technologies, Inc. hereby appeals from the Examining Attorney's refusal to register the NUGEN trademark in application serial number 76/254,430.

Applicant has also filed a Request for Reconsideration of Office Action No. 2 with the Examining Attorney. A copy of that document is attached hereto as Exhibit A.

The Commissioner is hereby authorized to charge any fees which may be required, to Deposit Account No. 03-1952. A duplicate copy of this notice is enclosed for this purpose.

Dated: December 18, 2002

Respectfully submitted,

By: 

Rosemary S. Tarlton
Attorney for Applicant

Morrison & Foerster LLP
425 Market Street
San Francisco, California 94105-2482
Telephone: (415) 268-6327
Facsimile: (415) 268-7522

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

NuGEN Technologies, Inc.

Mark: NUGEN

Serial No.: 76/254,430

Filing Date: May 8, 2001

NOTICE OF APPEAL

CERTIFICATE OF MAILING BY EXPRESS MAIL

BOX TTAB FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Commissioner:

Express Mail Label No.: EV240722599US

Date of Deposit: December 19, 2002

I hereby certify that the attached Notice of Appeal with Exhibit A and receipt verification postcard are being deposited with the United States Postal Service Express Mail delivery as "Express Mail Post Office to Addressee" service under 37 C.F.R § 1.10 on the date indicated above, and is addressed to: BOX TTAB FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Respectfully submitted,

By: 

Chase Trombella

TRADEMARK
Docket No. 49269-24005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

NuGEN Technologies, Inc.

Mark: NUGEN

Serial No.: 76/254,430

Filing Date: May 8, 2001

Trademark Atty: Marlene D. Bell

Law Office: 105

CERTIFICATE OF MAILING BY EXPRESS MAIL

BOX RESPONSES NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Commissioner:

Express Mail Label No.: EV240722585US

Date of Deposit: December 19, 2002

I hereby certify that the attached Request for Reconsideration with Exhibits A and B and receipt verification postcard are being deposited with the United States Postal Service Express Mail delivery as "Express Mail Post Office to Addressee" service under 37 C.F.R § 1.10 on the date indicated above, and is addressed to: BOX TTAB FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Respectfully submitted,

By: 

Chase Trombella

[REDACTED]

EV 240722585 US

Mailing Label
Label 11-F June 2002



Post Office To Addressee

ORIGIN (POSTAL USE ONLY)			DELIVERY (POSTAL USE ONLY)		
PO ZIP Code	Day of Delivery <input type="checkbox"/> Next <input type="checkbox"/> Second <input type="checkbox"/>	Flat Rate Envelope	Delivery Attempt	Time <input type="checkbox"/> AM <input type="checkbox"/> PM	Employee Signature
Date In Mo. Day Year	<input type="checkbox"/> 12 Noon <input type="checkbox"/> 3 PM	Postage \$	Mo. Day		
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Weight lbs. ozs.	Int'l Alpha Country Code	COD Fee Insurance Fee	Mo. Day		
No Delivery <input type="checkbox"/> Weekend <input type="checkbox"/> Holiday	Acceptance Clerk Initials	Total Postage & Fees \$	Delivery Date	Time <input type="checkbox"/> AM <input type="checkbox"/> PM	Employee Signature
CUSTOMER USE ONLY			<input type="checkbox"/> WAIVER OF SIGNATURE (Domestic Only) Additional merchandise insurance is void if waiver of signature is requested. I wish delivery to be made without obtaining signature of addressee or addressee's agent (if delivery employee judges that article can be left in secure location) and I authorize that delivery employee's signature constitutes valid proof of delivery.		
METHOD OF PAYMENT: Express Mail Corporate Acct. No. X940848			Federal Agency Acct. No. or Postal Service Acct. No.		
FROM: (PLEASE PRINT) PHONE 415, 268 6520 IP GROUP JOEL BISCHOFF CHASE TROMBELLA MURRISON & FOERSTER LLP 425 MARKET ST FL 30 SAN FRANCISCO CA 94105-2406			TO: (PLEASE PRINT) PHONE () BOX RESPONSES NO FEE ASSISTANT COMMISSIONER FOR TRADEMARKS 2900 CRYSTAL DR ARLINGTON VA 22202-3513		
RST3/7062 49269-24005.00					
PRESS HARD. You are making 3 copies.			FOR PICKUP OR TRACKING CALL 1-800-222-1811 www.usps.com		

33/ 50

F:22 T:23

Attorney Dkt: 49269-24005.00 Date: December 19, 2002

Paper: Request for Reconsideration with Exhibits A and B;
Certificate of Express Mailing

Applicant: NuGen Technologies

Mark: NUGEN

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Respectfully submitted,

By: 

Chase Trombella