

TTAB



04-07-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #01

Certificate Under 37 CFR 1.8(a)
I hereby certify that this correspondence is being deposited with the United States Postal as first-class mail in an envelope addressed to: The Assistant Commissioner for Trademarks, Box TTAB - No Fee, 2900 Crystal Drive, Arlington, VA 22202-3513 on April 3, 2003.

Kelly Johnson
Kelly Johnson

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

RETAIL RESEARCH &)
DEVELOPMENT LIMITED)

Opposer,)

vs.)

ADVANCED RESEARCH AND)
TECHNOLOGY INSTITUTE, INC.,)

Applicant.)

OPPOSITION NO. 91155180
SERIAL NO. 76/317,620

ANSWER TO NOTICE OF OPPOSITION

Applicant, Advanced Research and Technology Institute, Inc. ("ARTI"), by counsel, in response to a Notice of Opposition filed in the United States Patent & Trademark Office January 21, 2003, by Opposer, Retail Research & Development Limited ("Opposer" or "RR&D"), in answer thereto states as follows:

1. Applicant Advanced Research and Technology Institute, Inc. ("Applicant" or "ARTI") seeks to register INGEN as a service mark for EDUCATIONAL RESEARCH SERVICES, NAMELY, CONDUCTING AND SPONSORING RESEARCH PROGRAMS IN THE FIELDS OF GENOMICS, NAMELY, INFORMATION TECHNOLOGY, PROTEOMICS, GENOTYPING, PHENOTYPING, BIOETHICS, BIOLOGY, CHEMISTRY, BIOINFORMATICS, MEDICAL INFORMATICS AND SUPERCOMPUTING in International

Class 41, with an Intent-To-Use filing date of September 26, 2001, as evidenced by the publication of this mark in the Official Gazette on page TM 845 of the September 24, 2002 issue.

ANSWER:

Admitted.

2. Opposer is the owner of United States Reg. No. 2,288,397 for INGEN as a trademark for COMPUTER SOFTWARE WHICH TRACKS, SUPERVISES AND MAINTAINS IN-STORE PLANNING, INVENTORY MANAGEMENT AND RELATED OPERATIONAL TASKS FOR RETAIL OUTLETS AND RETAIL OPERATIONS, in International Class 9, issued on October 26, 1999 (Exhibit A).

ANSWER:

ARTI has no knowledge, saved by the Opposer's attachment to the Notice of Opposition, as to any U.S. trademark registrations owned by the Opposer and must, therefore, deny the same.

3. Opposer is in the business of manufacturing and distributing products and offering services, including but not limited to the goods listed in its trademark registration described in paragraph 2 above. In regards to the identified goods, Opposer has invested a great deal of time, money and effort in promoting these goods under its INGEN trademark and is continuing to extensively promote these goods in association with the INGEN trademark.

ANSWER:

ARTI lacks knowledge or information sufficient to form a belief as to this allegation and must, therefore, deny the same.

4. As a result of the high quality of Opposer's goods and the extensive promotion, sales, and public acceptance thereof, Opposer's goods have acquired an outstanding reputation and the public now associates these goods with Opposer and the INGEN trademark.

ANSWER:

ARTI lacks knowledge or information sufficient to form a belief as to this allegation and must, therefore, deny the same.

5. Applicant's designation INGEN is identical to Opposer's INGEN trademark, at least as to visual appearance, sound, commercial impression and connotation.

ANSWER:

ARTI admits that its mark is designated by the letters I-N-G-E-N. ARTI denies any other allegations contained in paragraph 5.

6. The goods/services used in association with Opposer's INGEN trademark, and the goods identified in Opposer's Reg. No. 2,288,397, are related to at least some of the services listed in Applicant's INGEN App. Ser. No. 76/317,620. The simultaneous use of each party's mark in association with their respective goods/services will result in a likelihood of confusion as to the source or sponsorship of such goods/service.

ANSWER:

Denied.

7. The marketing and channels of trade for Opposer's goods used in association with Opposer's INGEN trademark, and the marketing and channels of trade for at least some of Applicant's services listed in Applicant's INGEN App. Ser. No. 76/317,620 are related.

ANSWER:

Denied.

8. Opposer's rights in its INGEN trademark precede any rights Applicant may have in the designation INGEN. Opposer's registration for its INGEN trademark issued on October 26, 1999, a date prior to the when Applicant filed its Intent-To-Use INGEN application (i.e., September 26, 2001).

ANSWER:

ARTI admits that its U.S. trademark application for INGEN was filed September 26, 2001, but otherwise ARTI lacks knowledge or information sufficient to form a believe as to the remaining allegations of paragraph 8 and must, therefore, deny the same.

9. Registration and use of Applicant's designation INGEN is likely to cause injury to Opposer's business reputation and to injure and impair Opposer's rights in its own INGEN trademark by causing confusion, mistake, and/or deception as to the respective rights of the parties, and as to the source or sponsorship of goods associated with these trademarks.

ANSWER:

Denied.

10. Opposer's INGEN trademark is distinctive and famous. Opposer's INGEN trademark became famous before Applicant filed its Intent-To-Use INGEN trademark application (i.e., before June 13, 2001). The registration or use of the INGEN designation by Applicant will cause dilution of the distinctive quality of Opposer's famous INGEN trademark.

ANSWER:

Denied.

AFFIRMATIVE DEFENSES

ESTOPPEL, ACQUIESCENCE AND PRIOR REGISTRATION

11. ARTI hereby incorporates by reference paragraphs 1-10 as if fully set forth herein.

12. GeoNorth, Inc. of Anchorage, Alaska ("GeoNorth") is the owner of U.S. Registration No. 2,244,951, for the mark INGENS used for COMPUTER SOFTWARE AND COMPUTER DATABASES FOR GIS (GRAPHIC INFORMATION SYSTEMS) AND AMFM (AUTOMATED MAPPING AND FACILITIES MANAGEMENT) APPLICATIONS PERFORMING THE FUNCTIONS OF GEOGRAPHIC AND SPATIAL DATA QUERY AND ANALYSIS, in International Class 9 (Attachment 1).

13. GeoNorth's INGENS mark is substantially similar to Opposer's INGEN mark.

14. GeoNorth's goods offered for sale in conjunction with its INGENS mark are substantially similar to Opposer's goods offered for sale under its INGEN mark.

15. Upon information and belief, Opposer has not opposed, petitioned for cancellation or otherwise challenged or alleged that it has or will be damaged by GeoNorth's trademark registration for its INGENS mark.

16. Opposer is, therefore, estopped from alleging that it will be damaged by ARTI's registration of its INGEN mark. Since there is no damage to Opposer by GeoNorth's INGENS

registration, there can be no damage to Opposer by ARTI's INGEN registration because the educational services provided in conjunction with ARTI's INGEN mark are dissimilar from both of the software products provided in conjunction with Opposer's (INGEN) and GeoNorth's (INGENS) marks.

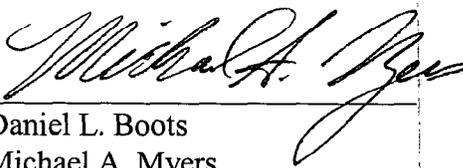
17. Opposer's acquiescence to GeoNorth's INGENS registration for computer software, which is the same designation of goods contained in Opposer's registration, should under principles of equity transfer to ARTI. Hence, Opposer has acquiesced to ARTI's use and registration of its INGEN mark.

WHEREFORE, ARTI prays that the Notice of Opposition is dismissed and that ARTI be granted registration of its trademark and for such other relief as deemed appropriate.

Respectfully submitted,

Date: April 3, 2003

By:


Daniel L. Boots
Michael A. Myers

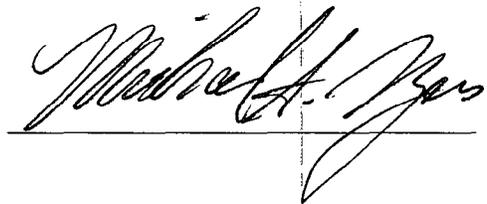
Attorneys for Applicant
Advanced Research & Technology Institute

BINGHAM McHALE LLP
2700 Market Tower
10 West Market Street
Indianapolis, Indiana 46204-4900
(317) 635-8900

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing was served on this 3rd day of April, 2003, via U.S. Mail, first-class postage pre-paid, to the address of the following counsel of record:

Gary J. Nelson
Christy Parker & Hale, LLP
P.O. Box 7068
Pasadena, California 91109-7068
(626) 795-9900



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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Electronic Search System (TESS)

TESS was last updated on Fri Mar 7 04:09:26 EST 2003

PTO HOME	TRADEMARK	TESS HOME	NEW USER	STRUCTURED	FREE FORM	BROWSE DICT	BOTTOM	HELP	PREV LIST
CURR LIST	NEXT LIST	FIRST DOC	PREV DOC	NEXT DOC	LAST DOC				

Logout Please logout when you are done to release system resources allocated for you.

Start List At: OR Jump to record: **Record 80 out of 108**

Check Status (TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark INGENS
Goods and Services IC 009. US 021 023 026 036 038. G & S: computer software and computer databases for GIS (Geographic Information **Systems**) and AMFM (Automated Mapping and Facilities Management) applications performing the functions of geographic and spatial data query and analysis. FIRST USE: 19960415. FIRST USE IN COMMERCE: 19960415
 IC 042. US 100 101. G & S: computer programming services for others. FIRST USE: 19960415. FIRST USE IN COMMERCE: 19960415

Mark Drawing Code (1) TYPED DRAWING

Serial Number 75231170

Filing Date January 22, 1997

Filed ITU FILED AS ITU

Published for Opposition November 4, 1997

Registration Number 2244951

Registration Date May 11, 1999

Owner (REGISTRANT) GeoNorth, Inc. CORPORATION ALASKA 3330 Arctic Boulevard, Suite 101 **Anchorage** ALASKA 99503

Assignment ASSIGNMENT RECORDED

Recorded
Attorney of Record GREGG B BRELSFORD
Type of Mark TRADEMARK. SERVICE MARK
Register PRINCIPAL
Live/Dead Indicator LIVE

PTO HOME	TRADEMARK	TESS HOME	NEW USER	STRUCTURED	FREE FORM	BROWSE DICT	TOP	HELP	PREV LIST
CURR LIST	NEXT LIST	FIRST DOC	PREV DOC	NEXT DOC	LAST DOC				

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-03-07 09:45:30 ET

Serial Number: 75231170

Registration Number: 2244951

Mark (words only): INGENS

Current Status: Registered.

Date of Status: 1999-05-11

Filing Date: 1997-01-22

Registration Date: 1999-05-11

Law Office Assigned: TMEG Law Office 102

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 1999-05-14

CURRENT APPLICANT(S)/OWNER(S)

1. GeoNorth, Inc.

Address:

GeoNorth, Inc.

3330 Arctic Boulevard, Suite 101

Anchorage, AK 99503

United States

State or Country of Incorporation: Alaska

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

computer software and computer databases for GIS (Geographic Information Systems) and AMFM (Automated Mapping and Facilities Management) applications performing the functions of geographic and spatial data query and analysis

International Class: 009

First Use Date: 1996-04-15

First Use in Commerce Date: 1996-04-15

Basis: 1(a)

Latest Status Info

computer programming services for others

International Class: 042**First Use Date:** 1996-04-15**First Use in Commerce Date:** 1996-04-15**Basis:** 1(a)**ADDITIONAL INFORMATION**

(NOT AVAILABLE)

PROSECUTION HISTORY

1999-05-11 - Registered - Principal Register

1999-02-24 - Allowed for Registration - Principal Register (SOU accepted)

1999-02-23 - Case file assigned to examining attorney

1999-02-05 - Statement of use processing complete

1999-01-19 - Amendment to Use filed

1998-05-26 - Extension 1 granted

1998-03-30 - Extension 1 filed

1998-01-27 - Notice of allowance - mailed

1997-11-04 - Published for opposition

1997-10-03 - Notice of publication

1997-09-09 - Approved for Pub - Principal Register (Initial exam)

1997-09-04 - Examiner's amendment mailed

1997-08-28 - Case file assigned to examining attorney

CONTACT INFORMATION**Correspondent (Owner)**

GREGG B BRELSFORD (Attorney of record)

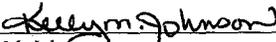
GREGG B BRELSFORD
 BURKE BAUERMEISTER & BRELSFORD PLLC
 921 W 6TH AVE STE 200
 ANCHORAGE AK 99501

United States

Bingham  **McHale** LLP
a t t o r n e y s a t l a w

Certificate Under 37 CFR 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal as first-class mail in an envelope addressed to: Assistant Commissioner for Trademarks, BOX TTAB – No Fee, 2900 Crystal Drive, Arlington, VA 22202-3513 on April 3, 2003.


Kelly M. Johnson

Michael A. Myers
Attorney
Intellectual Property & Technology
Phone: 317.635.8900
mmyers@binghammchale.com

April 3, 2003

Via U.S. Mail

APR 3 2003
9:31 AM
U.S. MAIL

Assistant Commissioner for Trademarks
BOX TTAB – NO FEE
2900 Crystal Drive
Arlington, VA 22202-3513

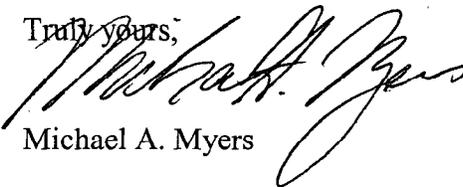
Re: Opposition No.: 91155180
Serial No.: 76/317,620
Our Ref.: 2623.42169

Dear Assistant Commissioner:

Enclosed please find an Answer to Notice of Opposition for filing in the above opposition.

Please stamp and return the enclosed postcard receipt to the Indianapolis address indicated on the cover page. Thank you for your assistance.

Truly yours,


Michael A. Myers

MAM/kmj
2623.42169#773953

Encls: Answer to Notice of Opposition
Postcard Receipt

