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

Applicant: Wicom GMBH International Class: 9
Serial No.: 78/095,516 Published for Opposition: January 7, 2003
Official Gazette: Page TM236
Filed: November 28, 2001
Mark: OPTIFLOW Attorney Docket No.: OPTI62384
Goods: LABORATORY FILTERS FOR PURIFICATION AND CLEANING OF FLUID
LABORATORY SAMPLES, SOLD SEPARATELY

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10:59:31 AM
TRADEMARK TRIAL AND APPEAL BOARD

OPTIMIZE TECHNOLOGIES, INC.

Opposer,

v.

WICOM GMBH,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION


05-05-2003
U.S. Patent & TMO/TM Mail Rpt Dt. #22

NOTICE OF OPPOSITION

Seattle, Washington 98101

May 1, 2003

TO THE COMMISSIONER FOR TRADEMARKS
TRADEMARK TRIAL AND APPEAL BOARD:

Opposer, Optimize Technologies, Inc., an Oregon corporation, whose business address is 13993 Fir Street, Oregon City, Oregon 97045, believes that it will be damaged by registration of the mark shown in application Serial No. 78/095,516 and hereby opposes the same.

06/10/2003 EPIM1 00000032 78095516
01 FC:6402 300.00 OP

1 This Notice of Opposition is timely filed as the mark OPTIFLOW was published on
2 January 7, 2003. Opposer filed a First Request for Extension of Time for thirty (30) days to
3 expire on March 8, 2003. The extension was approved by the TTAB on March 7, 2003.
4 Opposer filed a Second Request for Extension of Time for thirty (30) days to expire on April 7,
5 2003. Opposer filed a Third Request for Extension of Time for thirty (30) days to expire on
6 May 7, 2003. In accordance with 37 C.F.R. § 2.102, Opposer's requests for extension are for
7 good cause and within the 120 days of the date of publication, and therefore no consent or
8 stipulation from the Applicant is required. The current deadline for filing a Notice of Opposition
9 is May 7, 2003.

10 As published in the *Official Gazette of Trademarks*, at p. TM236, the mark sought to be
11 registered is **OPTIFLOW** for:

12 Laboratory filters for purification and cleaning of fluid laboratory samples,
13 sold separately, in International Class 9.

14 Applicant Wicom GmbH, filed the application based on its *bona fide* intent to use the
15 mark in commerce.

16 As grounds in support of its Opposition, Opposer asserts as follows:

17 1. Applicant, Wicom GmbH is a limited liability company organized under the laws
18 of the Federal Republic of Germany, having a place of business at Liebigstrasse 16D-64646
19 Heppenheim, Federal Republic of Germany (hereinafter "Applicant").

20 2. Applicant is seeking to obtain under the provisions of the Trademark Act of 1946,
21 as amended, registration on the Principal Register of the mark **OPTIFLOW** for the goods
22 identified above in International Class 9, filed November 28, 2001. The application is based on
23 an intent to use the mark, pursuant to Section 1(b) of the Trademark Act. No Amendment to
24 Allege Use has been filed.

25 3. Opposer is the owner of the following United States Trademark Registrations:
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Mark	Reg. No.	Class/Goods	First Use/ Commerce Use
OPTI	2,048,831; issued April 1, 1997	Liquid transfer components of chemical analysis equipment, namely High-Performance Liquid Chromatography (HPLC) - pistons and plunger seals for pumps; solvent reservoir filters; in-line filters; tubing; check valves; prime and purge valves; pump heads, precolumn filters; and fittings for tubing, in Int'l Class 9.	September 15, 1985/ September 15, 1985
OPTI-GUARD	2,100,804; issued September 30, 1997	Precolumn filters and guard columns for High-Performance Liquid Chromatography (HPLC), in Int'l Class 9.	January 1994/ January 1994
OPTI-MAX	2,023,739; issued December 17, 1996	Check valves for High-Performance Liquid Chromatography (HPLC) pumps, in Int'l Class 9.	1990/1990
OPTI-SEAL	2,023,740; issued December 17, 1996	Piston and plunger seals for High-Performance Liquid Chromatography (HPLC) pumps, in Int'l Class 9.	1988/1988

Mark	Reg. No.	Class/Goods	First Use/ Commerce Use
OPTIMIZE TECHNOLOGIES	2,107,751; issued October 21, 1997	Liquid transfer components of chemical analytic equipment, namely, High-Performance Liquid Chromatography (HPLC) - tubing; fittings; packed columns; guard columns; precolumn filters; seals; pump components, namely, pumpheads, pistons, plungers and seals; check valves; priming valves; priming adapters; detector source lamps; filters; manifold ball seals; injector components, namely, syringes, seals and needles; pressure regulators; sample processor components, namely, syringes, needles, seals, washers and frits, all for HPLC instruments; HPLC maintenance kits comprising inlet cartridge check valves, outlet cartridge check valves, replacement cartridges, pistons, pump seals, filters and fittings; and HPLC fitting kits comprising tubing, nuts and ferrules, in Int'l-Class 9.	October 15, 1985/ November 1, 1985

In addition to the registered marks noted above, Opposer also has the following pending use-based federal applications:

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Mark	Serial No.	Class/Goods	First Use/ Commerce Date
OPTI-PAK	78/235,546/ April 9, 2003	Capillary trap cartridges for High-Performance Liquid Chromatography (HPLC) and other analytical techniques involving analyte trapping and sample purification, in Int'l Class 9.	March 2002/ March 2002
OPTI-SOLV	78/235,551/ April 9, 2003	Filters for High-Performance Liquid Chromatography (HPLC), Mass Spectrometry, sample preparation, and other analytical techniques involving filtration of solvents, mobile phases, and samples, in Int'l Class 9.	February 1993/ January 30, 1996

4. Opposer has continuously used the trademark OPTI since as early as September 15, 1985, and in interstate commerce since September 15, 1985. The marks OPTI-GUARD, OPTI-MAX, OPTI-SEAL, and OPTIMIZE TECHNOLOGIES have been used continuously since January 1994, 1990, 1988, and October 15, 1985, respectively; and in interstate commerce since January 1994, 1990, 1988, and November 1, 1985, respectively. The pending use-based applications to register the marks OPTI-SOLV and OPTI-PAK have been in continuous use since at least as early as March 2002, and February 1993, respectively, and in use in commerce since at least as early as March 2002 and January 30, 1996, respectively.

All of these dates predate Applicant's filing date of November 28, 2001.

5. There is no issue of priority concerning application serial No. 78/095,516 since Opposer's first use dates of its OPTI, OPTI-GUARD, OPTI-MAX, OPTI-SEAL, and OPTIMIZE TECHNOLOGIES are all prior to Applicant's filing date and Applicant asserts no date of first use of its mark. In addition to their continuous use, Opposer has extensively advertised its marks. Opposer has invested considerable effort and expense in promoting the marks and the goods sold under the marks with the result that the purchasing public has come to know, rely

1 upon, and recognize the products of Opposer by its marks. Opposer has established valuable
2 goodwill and superior reputation in its marks.

3 6. Applicant's broad category of goods, namely, laboratory filters for purification of
4 fluid laboratory samples includes Opposer's high-performance liquid chromatography (HPLC)
5 filters, in-line filters, precolumn filters, and other similar goods, which are also used in a
6 laboratory for the purification and cleaning of fluid laboratory samples. Applicant's filters are
7 virtually identical in their application as the Opposer's filters and product line. Opposer's other
8 HPLC components are also very similar to Applicant's filters; because Applicant's filters are used
9 with the same HPLC equipment as Opposer's other HPLC components, and sample processor
10 components and HPLC maintenance kits.

11 7. Opposer's and Applicant's goods are sold in the same channels of trade to the
12 same consumers or class of consumers, namely, university research laboratories, biotech research
13 laboratories, pharmaceutical manufacturers, crime investigation laboratories, hospitals, and other
14 laboratories and institutions performing liquid study and analysis.

15 8. Due to the similarity of Opposer's previously used and registered OPTI, OPTI,
16 OPTI-GUARD, OPTI-MAX, OPTI-SEAL, and OPTIMIZE TECHNOLOGIES marks, with
17 Applicant's OPTIFLOW trademark application, and the identical and closely related nature of the
18 goods of the respective parties, consumers are likely to mistake Applicant's products for
19 Opposer's products or view them as a line extension of Opposer's products marketed under a
20 confusingly similar mark, thereby causing damage to Opposer.

21 9. Applicant's OPTIFLOW mark is confusingly similar to Opposer's OPTI, OPTI-
22 GUARD, OPTI-MAX, OPTI-SEAL, and OPTIMIZE TECHNOLOGIES and marks. Because of
23 the related nature of the goods and the near identity of the marks, use and registration of the mark
24 OPTIFLOW by Applicant is likely to cause confusion, mistake, or deception that Applicant's
25 goods are those of Opposer or otherwise endorsed, sponsored or approved by Opposer causing
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1 further damage to Opposer.

2 10. Registration of the mark shown in application Serial No. 78/095,516 will result in
3 damage to Opposer under the provisions of Section 2(d) of the U.S. Trademark Act, 15 U.S.C.
4 § 1052(a), pursuant to the allegations stated above.

5 11. Registration of the mark shown in application Serial No. 78/095,516 will falsely
6 suggest a connection with Opposer and result in damage to Opposer under the provisions of
7 Section 2(a) of the U.S. Trademark Act, 15 U.S.C. § 1052(a), pursuant to the allegations stated
8 above.

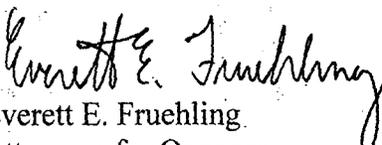
9 12. Opposer will be damaged if Applicant obtains a registration for the OPTIFLOW
10 mark because Applicant will obtain statutory rights in the mark in violation and in derogation of
11 the established prior rights of Opposer in its OPTI and OPTI prefixed marks.

12 Wherefore, Opposer prays that the Opposition to this application be sustained and that the
13 registration of the term OPTIFLOW set forth therein be refused.

14 Accompanying the duplicate signed copies of this Notice of Opposition is our check for
15 the required filing fee in the amount of \$300.00 (\$300.00 per class). Please charge any excess
16 fees to Deposit Account No. 03-1740 of Opposer's counsel noted below.

17 Respectfully submitted,

18 CHRISTENSEN O'CONNOR
19 JOHNSON KINDNESS^{PLLC}

20 
21 Everett E. Fruehling
22 Attorneys for Opposer

23 I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed
24 envelope as first class mail with postage thereon fully prepaid and addressed to the Commissioner for Trademarks,
25 Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington, VA 22202-3513, on the below date.

26 Date: May 1 2003 Shannon