

antiphlogistics, antirheumatics, antioxidants, chemotherapeutics; diuretics, antiarrhythmics, antiasthmatics, antiallergics, anticholinergics, anticonvulsants, antiemetics, fibrinolytics, anti-inflammatory preparations, antiproliferatives, antipyretics, antiviral preparations, antithrombotics; pharmaceutical preparations for the treatment of diabetes and insomnia; veterinary vaccines for dogs; blood substitute for animal use; sanitary preparations namely, sanitary pads and sanitary napkins; and medical services, namely, medical laboratories; medical and scientific research, namely, conducting clinical trials; medical research; scientific research and industrial product research, as evidenced by the publication of said trademark in the September 16, 2003 issue of the Official Gazette.

2. Opposer is now, and has been for some time, in the business of research and development of pharmaceuticals and medical diagnostic reagents for the treatment and diagnosis of cancer, autoimmune diseases, inflammatory diseases, allergic diseases, neurodegenerative diseases, brain damage, psychiatric disorders, pain, cardiovascular diseases, metabolic diseases, gastrointestinal disorders, endocrinological disorder, viral infections, bacterial infections and fungal infections.

3 Opposer adopted the trade name "GENPATH" and the mark "GENPATH" in connection with its activities, as set forth in paragraph 2, at least as early as April 19, 2002, and has been using the mark in connection with those activities ever since.

4. Opposer is the owner of United States pending trademark application, Serial No. 78/122867, for pharmaceuticals and medical diagnostic reagents for the treatment and diagnosis of cancer, autoimmune diseases, inflammatory diseases, allergic diseases, neurodegenerative diseases, brain damage, psychiatric disorders, pain, cardiovascular diseases, metabolic diseases,

gastrointestinal disorders, endocrinological disorder, viral infections, bacterial infections and fungal infections.

5. Opposer's mark "GENPATH" is symbolic of the goodwill and recognition built up by Opposer through continuous use of its trade name over a period of time.

6. Opposer has expended considerable effort and expense in promoting its mark "GENPATH" in the biotechnology field, with the result that people in the biotechnology field have come to know and recognize the work of Opposer by such trade name. Opposer has valuable goodwill established in its trade name.

7. Application Serial No. 76/421839 for registration of the mark "GENPAT 77" was filed on June 17, 2002, based upon Applicant's bona fide intent to use said mark. Thus, Opposer actually began using its trade name and filed the application for its trademark prior to the filing date of Applicant's application.

8. Opposer's mark "GENPATH" and Applicant's mark "GENPAT 77" are confusingly similar.

9. The goods that are identified in Opposer's application are closely related to the goods and services identified in the Applicant's application to register "GENPAT 77," and, on information and belief, will be marketed through the same or similar channels of trade to the same class of consumers.

10. By reason of Opposer's earlier adoption of the "GENPATH" mark, the public will believe that the Applicant's use of its mark "GENPAT 77" is sponsored or approved by Opposer and that the quality of the goods and services bearing the Applicant's mark has been approved and/or maintained by Opposer.

11. In view of these similarities, Applicant's use of the mark "GENPAT 77" is likely to cause confusion, mistake, or deception with respect to Opposer's mark "GENPATH" and to damage the goodwill represented and symbolized by the mark.

12. 12. On information and belief, Applicant has filed an opposition in the Community Trade Mark Office to Opposer's Community Trade Mark application corresponding to US Serial No. 78/122867, citing a likelihood of confusion between Applicant's Mark "GENPAT 77" and/or "GENPAT 77 PHARMACOGENETICS AG and Design" and Opposer's Mark "GENPATH."

13. Based on the foregoing, Applicant's registration of the mark "GENPAT 77" on the Principal Register of the United States Patent and Trademark Office would clearly cause injury and damage to the Opposer.

WHEREFORE, Opposer prays that this opposition be sustained and that registration of Applicant's mark "GENPAT 77" as shown in Application Serial No. 76/421839 be refused.

For the NOTICE OF OPPOSITION filing fee, the Patent and Trademark Office is authorized to charge \$900.00 to Hale and Dorr LLP's Deposit Order Account No. 08-0219 required by 37 C.F.R. §2.6(a) (17). The Patent and Trademark Office is also authorized to credit any overpayment or charge any deficit in connection with this mark to Hale and Dorr LLP's Deposit Order Account No. 08-0219. For the purposes of charging the deposit account, a duplicate copy of this notice is enclosed.

Respectfully submitted,

GENPATH PHARMACEUTICALS, INC.



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December 10, 2003

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, BOX TTAB FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on December 10, 2003.



Angela E. M. Dyer

Applicant/Registrant/Parties GenPath Pharmaceuticals, Inc., Opposer v.
Genpat 77 Pharmacogenetics AG, Applicant
No. (Application, Registration, Opposition, Cancellation) _____

Mark _____

In the above matter, the following have been received by the US Patent and Trademark Office on the date stamped hereon.

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|---|---|
| <input type="checkbox"/> Express Mail Label No. _____ | <input type="checkbox"/> Specimen(s) (# _____) |
| <input type="checkbox"/> Trademark Application w/Drawing (<input type="checkbox"/> ITU) | <input type="checkbox"/> Section 8 / <input type="checkbox"/> Section 15 Declaration |
| <input type="checkbox"/> Response to Office Action No. _____ dated _____ | <input type="checkbox"/> Section 9 (Renewal Application) |
| <input type="checkbox"/> Amendment to Allege Use | <input checked="" type="checkbox"/> Opposition; <input type="checkbox"/> Cancellation |
| <input type="checkbox"/> Statement of Use | <input type="checkbox"/> Req. for _____ days Ext. of Time to Oppose |
| <input type="checkbox"/> Req. for Extension of Time to File Statement of Use | <input type="checkbox"/> Transmittal Letter |
| <input type="checkbox"/> Req. for Correction _____ | <input type="checkbox"/> Check for \$ _____ ; check # _____ |
| <input type="checkbox"/> Notice of Change of Address of Applicant/Registrant | <input checked="" type="checkbox"/> Deposit Account Authorization \$ <u>900.00</u> |
| <input type="checkbox"/> Power of Attorney - Revocation, Appointment, Change of Address for Service | |
| <input type="checkbox"/> Recoration Form Cover Sheet with _____ | |
| <input type="checkbox"/> Other: <u>Notice of Opposition (in triplicate).</u> | |
| <input type="checkbox"/> Other: _____ | |

Mailing Date: 12/10/03 Docket No. 112813-122 Initials: BAB