

ESTTA Tracking number: **ESTTA115849**

Filing date: **12/20/2006**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Clinical Data, Inc.
Granted to Date of previous extension	12/20/2006
Address	One Gateway Center, Suite 411 Newton, MA 02458 UNITED STATES
Attorney information	Arthur J. DeBaugh Moore & Van Allen, PLLC 430 Davis Drive, Suite 500 Morrisville, NC 27560 UNITED STATES artdebaugh@mvalaw.com Phone:919-286-8000

Applicant Information

Application No	78735439	Publication date	08/22/2006
Opposition Filing Date	12/20/2006	Opposition Period Ends	12/20/2006
Applicant	Pharmacogenetics Diagnostic Laboratory, LLC 16629 Conner Station Road Simpsonville, KY 40067 UNITED STATES		

Goods/Services Affected by Opposition

Class 042. All goods and services in the class are opposed, namely: Laboratory research in the field of pharmacogenetics; scientific research and development; research on the subject of pharmaceuticals; laboratory research in the field of pharmacogenetics, namely, the identification of inherited genetic variation associated with predictable differences in medication dose or response, identifying patients with genetic variations that affect the body's ability to metabolize or appropriately respond to medications

Attachments	PGXL Laboratories Opposition.pdf (5 pages)(190964 bytes)
Signature	/Arthur J. DeBaugh/
Name	Arthur J. DeBaugh
Date	12/20/2006

pharmacogenetics, namely, the identification of inherited genetic variation associated with predictable differences in medication dose or response, identifying patients with genetic variations that affect the body's ability to metabolize or appropriately respond to medications” in International Class 042 (hereinafter “Applicant’s Services”), as evidenced by publication of said mark in the August 22, 2006 issue of the *Official Gazette* on page TM 969.

2. Applicant filed Applicant’s Mark in the United States on October 18, 2005, under the intent-to-use provisions of 15 U.S.C. § 1051(b).

3. Upon information and belief, Applicant has not begun use of Applicant’s Mark in commerce in the United States.

4. Prior to the filing date for Applicant’s application to register Applicant’s Mark, and prior to any date of use upon which Applicant can rely, Opposer and/or Opposer’s predecessors in interest used the trademark *PGX*, alone and/or together with other words or designs (collectively “Opposer’s Mark”) in International Class 042 in connection with research and development services in the fields of pharmaceuticals and medical diagnostics.

5. Opposer is the owner of the following U.S. trademark registration for Opposer’s Mark:

<u>Mark</u>	<u>Reg. No.</u>	<u>Reg. Date</u>	<u>First Use Date</u>	<u>Services</u>
<i>PGX</i>	2,591,885	07/09/2002	November 2000	Research and development services in the field of incorporating genetic analysis in the design, development, synthesis and testing of pharmaceuticals.

The foregoing registration is valid and subsisting, unrevoked and uncancelled.

6. Opposer is the owner of the following U.S. trademark applications for Opposer’s Mark:

<u>Mark</u>	<u>Serial No.</u>	<u>Filing Date</u>	<u>Services</u>
<i>PGxHEALTH</i>	78/809,590	02/08/2006	Research and development services in the field of medical diagnostics for optimizing therapy, drug class, or specific drug for a patient; and medical diagnostic testing services for optimizing therapy, drug class, or specific drug for a patient.

<u>Mark</u>	<u>Serial No.</u>	<u>Filing Date</u>	<u>Services</u>
<i>PGxHEALTH Therapeutic Diagnostics. & Design</i>	78/809,599	02/08/2006	Research and development services in the field of medical diagnostics for optimizing therapy, drug class, or specific drug for a patient; and medical diagnostic testing services for optimizing therapy, drug class, or specific drug for a patient.

7. Opposer's use of Opposer's Mark precedes the filing date for Applicant's application to register Applicant's Mark herein opposed and/or precedes any alleged first use date of Applicant's Mark.

8. Opposer's registration date for Opposer's U.S. trademark registration number 2,591,885 precedes the filing date for Applicant's application to register Applicant's Mark herein opposed and/or precedes any alleged first use date of Applicant's Mark.

9. Opposer has continuously used Opposer's Mark in connection with the services for which Opposer's Mark is registered as U.S. Registration Number 2,591,885.

10. Opposer has extended its use of Opposer's Mark into related services and into brand extensions, as evidenced by Opposer's U.S. Application Serial Numbers 78/809,590 and 78/809,599.

11. Opposer and Opposer's predecessors in interest have spent substantial amounts of time, money and effort in developing and marketing Opposer's services under Opposer's Mark in the United States.

12. Opposer's use of Opposer's Mark has been continuous and has not been abandoned.

13. Applicant's Mark is confusingly similar to Opposer's Mark and to each of Opposer's trademark applications and Opposer's trademark registration listed in paragraphs 5 and 6 above.

14. Applicant's Mark and Opposer's Mark are used or intended to be used with identical, similar, or related services.

15. On information and belief, it is expected that Applicant's Services, in connection with which Applicant will use Applicant's Mark, are or will be marketed to the same potential purchasers in the same relevant markets as are Opposer's services in connection with which Opposer uses Opposer's Mark.

16. On information and belief, Applicant uses or will use the same or similar media to advertise Applicant's Services under Applicant's Mark as used by Opposer to advertise Opposer's services under Opposer's Mark.

17. Upon information and belief, the services marketed under Applicant's Mark are or will be distributed through the same channels of distribution and are or will be purchased and used by many of the same individuals and entities as those who purchase and use services marketed under Opposer's Mark.

18. Because of the similarity of marks, services, relevant markets, advertising, channels of distribution, purchasers, and/or users, Opposer believes that there is a very strong likelihood of confusion if Applicant is permitted to register Applicant's Mark for use in conjunction with Applicant's Services.

19. Opposer's marketing efforts have caused Opposer and Opposer's Mark to be well-known and well-regarded in the community of consumers who are likely to consider purchasing Applicant's Services. Therefore, it is likely that some members of the relevant consumer market would be confused by the marketing of Applicant's Services under Applicant's Mark and would believe that Applicant's Services were associated with, endorsed by, related to, or actually the services of Opposer.

20. Any fault or defect in Applicant's Services would reflect upon and seriously injure Opposer's reputation. Furthermore, individuals or entities that are familiar with Opposer's Mark would confuse the same with Applicant's Mark and might purchase Applicant's Services in the mistaken belief that they are purchasing the services of Opposer.

21. If Applicant is granted the registration herein opposed, Applicant would be placed in a position to deceive or mislead the public, as the registration would give Applicant *prima facie* exclusive rights to Applicant's Mark and all confusingly similar marks, thereby causing damage and injury to Opposer.

22. Because of the similarity of marks, relevant markets, advertising, channels of commerce, purchasers, and/or consumers, registration of Applicant's Mark would cause damage and injury to Opposer.

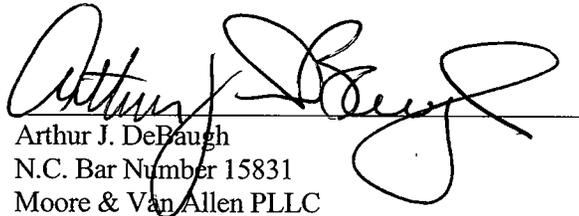
23. Because Applicant's Mark consists of a mark which closely resembles a non-abandoned mark prior used in the United States by Opposer, and Applicant's Mark is likely, when used in connection

with Applicant's Services, to cause confusion, to cause mistake, or to deceive, registration of Applicant's Mark is therefore barred under 15 U.S.C. §1052(d).

24. Accordingly, Opposer prays that said Application Serial Number 78/735,439 be rejected and the registration of the mark therein shown for the services therein specified be refused and denied.

The \$300 filing fee for this Notice of Opposition is being paid by electronic funds transfer at the time of online filing. The Patent and Trademark Office is hereby authorized to charge any additional fees that may be required to our USPTO Deposit Account Number 502316 in the name of Moore & Van Allen PLLC.

Respectfully submitted this 20th day of December, 2006.



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