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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91194218
Party	Plaintiff Illumina, Inc.
Correspondence Address	SUSAN M NATLAND KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN ST, 14TH FL IRVINE, CA 92614 UNITED STATES efiling@knobbe.com
Submission	Brief on Merits for Plaintiff
Filer's Name	Hans L. Mayer
Filer's e-mail	efiling@knobbe.com
Signature	/Hans L. Mayer/
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Illumina submits this case brief in support of its actions to cancel Meridian's registrations for its ILLUMIGENE and  marks, and also in support of Illumina's actions to oppose Meridian's applications to register its ILLUMIPRO and ILLUMIPRO-10 marks.

I. INTRODUCTION AND SUMMARY OF ILLUMINA'S ARGUMENT

The Board should deny Meridian's attempt to register marks confusingly similar to Illumina's famous ILLUMINA mark. Like Illumina before it, Meridian is attempting to register and use ILLUMI-formative marks on laboratory equipment and instruments that can detect genetic material to diagnose a disease. The additional elements in Meridian's marks are merely descriptive suffixes—GENE and PRO—that describe both parties' goods. And like Illumina, Meridian seeks to use its marks in lowercase and emphasize the "i" ( ). The parties' goods bearing these nearly-identical marks are sold to the same types of customers, the parties attend the same trade shows, and they advertise in the same periodicals. Therefore, the Board should cancel and refuse Meridian's ILLUMIGENE and ILLUMIPRO marks.

Illumina is an internationally-recognized leader in the identification and analysis of genetic materials, such as DNA, and enjoys sales of over \$1 billion a year. Founded in 1998, its Illumina company name and mark are famous within the life-science community. Illumina has been continuously using its registered ILLUMINA mark on its goods since 1999 and began filing trademark applications for the ILLUMINA mark in 2000. By 2003, Illumina had received three registrations for ILLUMINA. Illumina has also used other marks focusing on and emphasizing its ILLUMI-prefix, such as ILLUMICODE (2002) and ILLUMINOTES (2006), and it has used and registered the mark ILLUMINADX.

Illumina's products can be used for a variety of purposes. Early on, Illumina sold products for medical research purposes. In that context, for example, Illumina's products were

used to conduct cancer research. It is a natural progression for a research company to also sell products for medical diagnostic use. In diagnostics, products are used by someone diagnosing a patient to see if that patient has a particular disease.

Illumina followed this progression. By 2005, Illumina began to further position its products for diagnostic use. By 2006, Illumina had a plan to obtain FDA approval to sell its products specifically for diagnostic use. And by 2007, Illumina's products were purchased and used by diagnostic labs for diagnostic purposes.

Nevertheless, in November 2008, Meridian applied to register ILLUMIGENE for diagnostic test kits that can detect a disease by its genetic makeup. Shortly thereafter, Meridian applied for the marks , ILLUMIPRO, and ILLUMIPRO-10 for similar and related goods. The Board should cancel and refuse Meridian's confusingly-similar marks.

First, Meridian's marks are nearly identical to Illumina's marks. They share the same ILLUMI prefix, which is the dominate portion of the marks. Tellingly, in Meridian's  mark, the ILLUMI prefix is darker and even more prominent. Also, like Illumina's commercial use of its ILLUMINA mark, , the  mark is lower case with even more emphasis on the first letter "i". The marks also have the same number of syllables and differ only in their one-syllable suffix. They share the same cadence, rhythm, and sound. And the suffixes in the ILLUMIGENE and ILLUMIPRO marks are not only descriptive but connote an association with Illumina's products. "Gene" describes the genetic material that both parties' products analyze, and "pro" describes the professional users of the products.

Second, the parties' goods are similar. Both parties' goods include laboratory equipment and instruments (including test tubes, scanners and the like) used to detect DNA molecules (genetic material).

Images of the goods included under the ILLUMINA, ILLUMIGENE and ILLUMIPRO recitations are shown below:

ILLUMINA



ILLUMIGENE and ILLUMIPRO



In fact, the parties' goods have both been used to detect the same infectious disease. In 2007, Illumina's products were used to detect *C. difficile*, an infectious disease that causes diarrhea. Meridian later applied to register ILLUMIGENE with a recitation that refers to various diseases, including gastrointestinal and infectious diseases. And in 2010, when Meridian commercialized its ILLUMIGENE and ILLUMIPRO products, *C. difficile* was the first disease for which the products tested.

Finally, the parties advertise and promote their products at the same trade shows and in the same trade magazines. Illumina also distributes marketing materials to a wide variety of customers. This includes diagnostics laboratories, which are included in Meridian's target class of customers. Moreover, since 2007, Illumina's products have been purchased by diagnostics laboratories for diagnostics purposes.

But even if diagnostic customers were not purchasing Illumina's products when Meridian began filing in November 2008, diagnostic use was within Illumina's zone of expansion. It is normal for a company to move from selling products for research to selling products for

diagnostics. In 2005, Illumina had plans to do so, and in 2006 it began publicizing those plans. Therefore, the relevant public would certainly have expected Illumina to be a source of diagnostic products.

Faced with this evidence, Meridian offers a slew of unpersuasive arguments. To argue that the marks are not similar, Meridian contends that it is common for medical device marks to have a similar prefix. This is not true. Instead, it is only common for marks to share a *descriptive* component—not that it is common for marks to share a *distinctive* prefix. Although shared descriptive terms may be common in marks used with medical devices, those shared terms are not consistently found in the prefix. For example, amongst a sample of devices used to detect *C. difficile*, two use the descriptive term “gene” in the prefix and two use “gene” in the suffix.

To argue that the goods are not similar, Meridian makes granular comparisons to distinguish the technology that the parties’ products use to analyze genetic material. But many of these distinctions are missing from the respective recitation of goods. Further, the law does not require goods to be similar or competitive, as long as they are related in some way. And the specific way the products test for diseases cannot mitigate the fact that the products can test for similar types of diseases. Thus, Meridian cannot legitimately dispute that the goods are related.

To argue that the goods have separate trade channels, Meridian makes the dubious assertion that Illumina’s products have been limited to research, and that people working in diagnostic labs would have never heard of Illumina. To the contrary, by 2006, Illumina had been creating brand awareness in diagnostics, and by 2007 diagnostic laboratories had been purchasing Illumina’s products for diagnostic purposes.

Realizing that this assertion cannot pass muster, Meridian retreats and contends that within diagnostic labs, its products are used only within an infectious disease “department.” Meridian argues that this area would be segregated from other areas such as genetic health and cancer. Thus, Meridian argues, people working in infectious disease would have no familiarity with Illumina.

But this fallback argument also fails. First, the recitation of goods for the ILLUMIGENE and ILLUMIPRO marks do not limit Meridian’s products to be used with only infectious diseases, and Illumina’s recitations do not exclude infectious disease. Second, not all labs segregate infectious disease testing from other types of disease. And even if a lab were segregated, the evidence shows that people working in diagnostics labs are aware of products being used in areas other than the ones in which they work. In any event, Illumina’s marketing activities would reach people working in the infectious disease area of a lab.

Meridian also argues that the purchasers for its products are sophisticated, and that before purchasing the ILLUMIGENE and ILLUMIPRO products, the customers would be informed that the products come from Meridian. But the fact that customers are sophisticated with technology does not mean that they are also sophisticated with trademarks. The Board has previously found that sophisticated purchasers of expensive medical devices could nevertheless be confused. Moreover, Meridian’s argument ignores that Illumina would still suffer from initial and post-sale confusion.

Finally, Meridian rests on the fact that the parties have not been made aware of any instances of actual confusion. But it is not necessary for Illumina to show actual confusion to establish a likelihood of confusion, and the lack of actual confusion should be given little weight.

Therefore, Meridian's ILLUMIGENE and ILLUMIPRO marks are likely to cause confusion with Illumina's ILLUMINA, ILLUMICODE, ILLUMINOTES, and ILLUMINADX marks. Accordingly, the ILLUMIGENE registrations should be cancelled, and the ILLUMIPRO applications should be refused.

II. PROCEDURAL HISTORY

Illumina filed Opposition Nos. 91194218 and 91194219 on March 19, 2010. Illumina filed Cancellation Nos. 92053479 and 92053482 on January 6, 2011. The two opposition and two cancellation proceedings were consolidated into this parent opposition, No. 91194218, by way of the following: A stipulated motion was filed on August 12, 2010, in Opposition No. 91194218 to consolidate Opposition Nos. 91194218 and 91194219. On November 19, 2010 the Board granted the motion to consolidate. On December 8, 2010, in Opposition No. 91194218, a stipulated motion was filed to further consolidate the opposition proceedings to add the later-filed cancellation proceeding Nos. 92053479 and 92053482. On December 6, 2011, the Board granted the motion to further consolidate.

III. DESCRIPTION OF THE EVIDENTIARY RECORD

Pursuant to 37 C.F.R. § 2.122, the record includes the pleadings in this proceeding, the file history of Meridian's applications and registrations, and Illumina's pleaded registered ILLUMINA and ILLUMINADX marks. In addition, the parties have submitted evidence as described below.

A. Illumina's notices of reliance and testimony

On November 6, 2014, Illumina submitted a Notice of Reliance with Exhibits 1-78. TTABVUE #57-59. On November 7, 2014, Illumina submitted testimony declarations, and accompanying exhibits, from four of its employees—William Morrison, Karen Possemato,

Gregory Heath, and Naomi O’Grady.¹ TTABVUE #60-70. On December 4, 2014, Meridian took cross-examination depositions of Ms. O’Grady and Ms. Possemato. Both deposition transcripts were filed with the Board on March 19, 2015. TTABVUE #83-85.

On April 8, 2015, Illumina submitted a Rebuttal Notice of Reliance with Exhibits 403-421. TTABVUE #93. On the same day, Illumina submitted rebuttal testimony declarations from two employees—Ms. O’Grady and Mya Thomaе. TTABVUE #90-92. Ms. O’Grady’s rebuttal declaration contained Exhibits 1-9 (which differed from Exhibits 1-9 in Illumina’s original Notice of Reliance). On May 12, 2015, Meridian took a second cross-examination deposition of Naomi O’Grady. The transcript was filed with the Board on June 5, 2015. TTABVUE #97, 98.

B. Meridian’s notices of reliance and testimony

On February 06, 2015, Meridian submitted testimony declarations, and accompanying exhibits, from two of its employees—Vecheslav Elagin and Kenneth Kozak. TTABVUE #79-81. Meridian also submitted a testimony declaration and accompanying exhibits from Stephanie Ferguson, its attorneys’ paralegal. TTABVUE #82. Finally, Meridian submitted a Notice of Reliance with Exhibits 1–15. TTABVUE #76-78. On March 9-10, 2015, Illumina took cross-examination depositions of Mr. Kozak and Dr. Elagin. The transcripts of both depositions were filed on April 6, 2015 TTABVUE #86-88.

On May 20, 2015, Meridian also took the testimony deposition of Dr. Stephen Young, who is not employed by either party.² The transcript was filed with the Board on June 5, 2015.

¹ The parties agreed that they could take the testimony of their own witnesses via declaration during their respective testimony periods, and that the adverse party would then have a period of time to take live cross-examination of any declarant.

² Dr. Young had not previously submitted any direct testimony. Meridian deposed him after its rebuttal trial testimony period had ended, and did so without leave from the Board or stipulation from Illumina.

TTABVUE #96. On June 8, 2015, Meridian submitted a supplemental notice of reliance. TTABVUE #100. This supplement consisted of an email exchange between counsel for Meridian and Dr. Andrea Ferreira-Gonzales.³

IV. BACKGROUND

A. Illumina

1. Illumina is well-known

Illumina is a publicly-traded (NASDAQ) global leader in the life-science industry. Possemato Decl. ¶42. Its revenues have continued to skyrocket over time. From 2007 to 2008, its revenues were just shy of \$1 billion. From 2009-2013, its total revenues exceeded \$4.8 billion, and as of November 2014, its market capitalization was approximately \$25 billion. Opposer's Notice of Reliance, Ex. 220 at ILLUM-2332, Ex. 221 at ILLUM-2459, Ex. 222 at ILLUM-2552, Ex. 223 at ILLUM-2641, Ex. 224 at ILLUM-2792, Ex. 225 at ILLUM-2914, Ex. 228 at ILLUM-3151; Possemato Decl. ¶42.

In 2009, Forbes stated that Illumina was the fastest-growing technology company in America, based on five-year annualized sales growth. Possemato Decl. ¶43; Opposer's Notice of Reliance, Ex. 229 at ILLUM-0928. Illumina also ranked fourth on the Forbes 2010 ranking of the fastest growing technology companies in America. Possemato Decl. ¶43; Opposer's Notice of Reliance, Ex. 229 at ILLUM-0924-7. In fact, Illumina was on the Forbes top 25 list four times in the five-year period between 2006 and 2010. Possemato Decl. ¶43; Opposer's Notice of Reliance, Ex. 229 at ILLUM-0924-8.

³ Meridian submitted this exhibit after its rebuttal trial testimony period had ended, and did so without leave from the Board or stipulation from Illumina.

2. Illumina's business

Illumina develops, manufactures, and sells products and services that analyze genetic materials, such as DNA. Its products and related services have various uses, including for medical research and diagnostics. Possemato Decl. ¶3.

Research use generally refers to generating data to advance the knowledge and understanding of the medical community. For example, a researcher may be looking to determine whether multiple genetic sequences are responsible for the same type of cancer. Elagin Decl. ¶25. Medical research use is inextricably linked to medical diagnostics use, Heath Decl. ¶28, which generally refers to analyzing a sample to diagnose or treat a patient. Kozak Tr. 101:14-17. It is common for a company to produce and sell goods for research in addition to selling diagnostic products. Heath Decl. ¶29. Accordingly, many companies, such as Bayer and Roche, sell both research and diagnostic products. Heath Decl. ¶28; *see also* Opposer's Notice of Reliance, Ex. 120 at ILLUM-0679-684.

Although Illumina's first products were sold to be used for research purposes, it always aimed to make products for diagnostic use. Possemato Decl. ¶¶7-10, 12. In fact, it is a natural progression to begin using a technology for research and then transition the technology into diagnostics. Heath Decl. ¶29. Illumina followed this typical path. Although it has continued to sell goods for medical research, it began moving into diagnostics by 2005, and its products were purchased for diagnostic use by 2007.

3. Illumina's trademarks

In 1999, Illumina began filing applications to register its ILLUMINA mark. Illumina's registrations include those listed below, each of which has been made of record in this proceeding. The first three registrations—for ILLUMINA—are incontestable.

Mark	Filing Date/ Application No.	Registration Date/ Registration No.	Goods /Services
ILLUMINA	Filed: 15-JUN-2000 App No. 76072152	Reg Date: 24-JUN-2001 Reg No. 2471539	Developing, to the order and specification of others, biological and/or chemical sensing systems which use random array technology to identify organic molecules, compounds and substances in Class 40
ILLUMINA	Filed: 18-AUG-2000 App No. 75982227	Reg Date: 08-OCT-2002 Reg No. 2632507	Chemicals, namely reagents for scientific or medical research use for analyzing cells, proteins, nucleic acids and other molecules of 50 to 10,000 daltons, sequencing dna, genotyping, gene expression profiling and high through-putscreening in Class 1 Scientific and medical research, namely, analysis of cells, proteins, nucleic acids and other molecules of 50 to 10,000 daltons, sequencing dna, genotyping, gene expression profiling and high through-put screening in Class 42
ILLUMINA	Filed: 18-AUG-2000 App No. 76112547	Reg Date: 26-AUG-2003 Reg No. 2756703	Scientific equipment and instruments, namely scanners, hybridization stations and fluidics delivery and computer systems sold as a unit and cassettes containing molecular sensing optical fiber bundles for analyzing cells, proteins, nucleic acids and other molecules of 50 to 10,000 dalton, sequencing dna, genotype, gene expression profiling and high through-put screening in Class 9
ILLUMINADX	App Date: 28-MAY-2009 App No. 77982582	Reg Date: 08-NOV-2011 Reg No. 4053668	Clinical diagnostic reagents, reagent kits, and beads with attached biomolecules, comprised primarily of oligonucleotides and other nucleic acids, natural and modified nucleotides, buffers, labels, and substrates, for clinical diagnostic purposes in Class 5

Notice of Opposition TTABVUE #1; Opposer's Notice of Reliance, Ex. 1.

In addition to its registered ILLUMINA marks, Illumina has used other marks with the ILLUMI- prefix. Since August 2002, Illumina has continuously used the mark ILLUMICODE in connection with DNA microarrays, Possemato Decl. ¶40; Opposer's Notice of Reliance, Ex. 214, which are used to identify and analyze DNA. Possemato Decl. ¶6. And since April 2006, Illumina has continuously used the mark ILLUMINOTES in connection with newsletters featuring information in the fields of genetics, medical diagnostics, medical research, molecular diagnostics, nucleic acid sequencing and genotyping, life sciences, biology, molecular pathology, laboratory medicine, and biotechnology. Possemato Decl. ¶41; Opposer's Notice of Reliance, Ex. 215.

4. Illumina was moving into diagnostics long before Meridian filed its applications

Before Meridian filed its applications, Illumina moved into diagnostics by developing products for diagnostic use, issuing marketing that reached diagnostic customers, and reorganizing its business to better emphasize diagnostics.

a. Illumina developed products for medical diagnostic use

i. Illumina's VeraCode technology and BeadXpress instrument

In 2005, in order to expand its footprint in diagnostics, Illumina acquired a technology called VeraCode. Illumina acquired VeraCode so that it could develop the technology, in conjunction with Illumina's BeadXpress instrument, into a diagnostics product.⁴ Possemato Decl. ¶13; Heath Decl. ¶7.

Also in 2005, shortly after acquiring the VeraCode technology, Illumina hired Mickie Henshall as its Associate Director Product Marketing, Diagnostics. Ms. Henshall's sole

⁴ Like all of Illumina's products and services, Illumina branded products using its VeraCode technology with its house mark ILLUMINA. Possemato Decl. ¶13.

responsibility was to market and promote Illumina's diagnostic products and services. Possemato Decl. ¶14. Thus, Ms. Henshall assembled a team to market Illumina's BeadXpress product towards diagnostics and grow Illumina's diagnostic business. O'Grady Decl. ¶4.

By 2006, Illumina had established a formal development program to seek FDA clearance. Heath Decl. ¶13. Under this program, Illumina developed its VeraCode products under "design control," Opposer's Notice of Reliance, Ex. 303 at ILLUM-0579, 583-84, which is a design process often used to develop products specifically for FDA clearance for diagnostic use. Kozak Decl. ¶¶64-66.

In March 2009, Illumina shipped BeadXpress devices to three clinical sites in the United States to begin the required clinical trials. Heath Decl. ¶13. And in September 2009, Illumina submitted for FDA clearance, which was granted in April 2010. Heath Decl. ¶14; Opposer's Notice of Reliance, Exs. 36, 105.

Beginning in 2006, the public was made aware that Illumina's VeraCode technology had applications in diagnostics. O'Grady Decl. ¶¶6-8, 16-17; Opposer's Notice of Reliance, Ex. 4 (public article stating that Illumina's VeraCode technology "offers opportunities for in vitro and molecular diagnostic development."), Ex. 301 at ILLUM-0039-040 (2006 presentation referring to "infectious disease" and "molecular diagnostics"), Ex. 313 at ILLUM-0468 (2007 brochure referring to "Molecular diagnostic assay development"), Ex. 5 (2007 published interview with Illumina CEO discussing launch of VeraCode for diagnostics), Ex. 6 (2007 press release referring to BeadXpress as "the platform at the base of Illumina's molecular diagnostics strategy"). In fact, Illumina created a presentation titled "VeraCode Technology – From Research to Molecular Diagnostics." Opposer's Notice of Reliance, Ex. 302. In 2007, Illumina

provided this presentation to prospective customers and presented it at trade shows. O’Grady Decl. ¶7.

The same year, Illumina started collaborating with other companies to develop diagnostics products in connection with its VeraCode technology and BeadXpress instrument. Illumina entered into an agreement to work with deCODE Genetics, Inc., to develop and commercialize diagnostic products to serve in several major disease areas. Possemato Decl. ¶15; Opposer’s Notice of Reliance, Ex. 3. Illumina also collaborated with ReaMetrix, Inc. The companies planned to co-develop diagnostic panels for a range of disease areas. Possemato Decl. ¶16; Opposer’s Notice of Reliance, Ex. 203.

More importantly, when Illumina launched its BeadXpress product in 2007, clinical laboratories and hospitals began purchasing and using the system in their own lab-developed tests (“LDTs”) for medical diagnostic purposes. O’Grady Decl. ¶¶16, 18-20, 23-25. An LDT is a common tool in which a properly-certified diagnostics lab can use a product labeled as “Research Use Only” or “RUO” for a diagnostic test even though the FDA has not otherwise cleared that product for diagnostics use. O’Grady Decl. ¶16; Rebuttal O’Grady Decl. ¶¶10, 14, 15. In fact, the American Clinical Laboratory Association has advocated to Congress that “LDTs are an extremely common part of laboratory medicine” and that they are also “the backbone of clinical care in the United States.” Opposer’s Notice of Reliance, Ex. 405 at ILLUM-3840.

For example, in 2007, Children’s Hospital of Philadelphia (“CHOP”) developed a test to diagnose an inherited disease using Illumina’s BeadXpress system. Illumina publicized CHOP’s diagnostic work. O’Grady Decl. ¶19. Similarly, Illumina’s customer iGenix developed custom tests using Illumina’s BeadXpress reader. O’Grady Decl. ¶18.

The same year, Illumina collaborated with the Children’s Hospital of Eastern Ontario and the Mayo Clinic. These collaborations sought to develop diagnostic tests using Illumina’s products. O’Grady Decl. ¶20.

In addition to the collaborations, the University of Maryland used Illumina’s VeraCode technology in 2007 in connection with a grant the university received from the Bill and Melinda Gates Foundation. O’Grady Decl. ¶21; Opposer’s Notice of Reliance, Exs. 8, 314. The university used Illumina’s technology to detect *C. difficile*, Opposer’s Notice of Reliance, Ex. 8, an infectious disease that causes diarrhea. *Id.* Ex. 72. *C. difficile* is also the disease for which Meridian’s ILLUMIGENE and ILLUMIPRO products tested when the products were first commercialized in 2010. *Id.* Ex. 401 at 5.

In 2010, Illumina created a competition to challenge innovators to create diagnostic tests using the VeraCode technology. O’Grady Decl. ¶24. Of the two awards granted by Illumina relating to this challenge, one was for the development of a diagnostic method for infectious urethritis. O’Grady Decl. ¶24.

ii. Illumina’s gene sequencing technology

In 2007, Illumina acquired Solexa, Inc., a company that had developed a new method for genetic sequencing called next generation sequencing (“NGS”). Possemato Decl. ¶¶22-23. Genetic sequencing had been moving into diagnostic applications even before Illumina’s acquisition. Possemato Decl. ¶25.

In fact, by 2007, Dr. Stephen Young, the Scientific Director of Infectious Disease at a large diagnostic laboratory, had encountered Illumina at conferences and knew about Illumina’s NGS technology. Young Tr. 8:21-24, 19:7-18, 21:1-11. Dr. Young believed that, although

Illumina's NGS technology was new, the technology would evolve to be relevant to him in infectious disease diagnostics. *Id.* 21:1-17.

From 2007 through 2011, Illumina participated in various public projects geared towards applying sequencing to diagnostics. Possemato Decl. ¶24. And by 2010 and 2011, Illumina introduced products (its HiSeq and MiSeq instruments), which made genetic sequencing more economical and therefore practical to be used in diagnostic applications. Possemato Decl. ¶25.

In November 2011, Illumina partnered with Siemens Healthcare Diagnostics to make Siemens' HIV tests compatible with Illumina's NGS platform (MiSeq) and to develop additional sequencing-based infectious disease tests for diagnostics. Heath Decl. ¶10; Possemato Decl. ¶26; Opposer's Notice of Reliance, Ex. 17.

In 2012, Dr. Young attended a presentation by Illumina regarding its NGS technology. Illumina gave the presentation to scientific and medical directors of diagnostics labs. Young Tr. 23:8-14. Dr. Young attended that presentation because his lab was interested in Illumina's NGS technology as a tool to diagnose cancer. *Id.* 23:15-20. Although Dr. Young primarily worked in the field of infectious disease at the time, he attended the presentation because he planned to provide input regarding the technology that his lab would purchase for cancer diagnostics. *Id.* 23:25-24:10.

Dr. Young also wanted to see how far Illumina's sequencing technology had progressed because he "absolutely believe[s] Next-Generation Sequencing will constitute an important part of infectious disease, both diagnostic and prognostically [*sic*]." *Id.* 23:25-24:20. Dr. Young is not alone. The Center for Disease Control has recently stated that genetic sequencing is "on the verge of revolutionizing our ability to diagnose infectious diseases." Opposer's Rebuttal Notice of Reliance, Ex. 404 at ILLUM-3834.

In November 2013, Illumina received FDA clearance to sell its MiSeqDx sequencers for open use. This means that the FDA did not merely clear the MiSeqDX for a specific disease. Instead, Illumina could promote that diagnostic laboratories could use the MiSeqDx to develop diagnostic tests for any type of disease. Possemato Decl. ¶36; Heath Decl. ¶25; Opposer's Notice of Reliance, Exs. 34, 39, 115.

As one example, in January 2014, Illumina entered into a multi-year agreement with Quest Diagnostics, one of the largest diagnostic labs in the United States. That agreement gave Quest rights to use Illumina's technology to develop and commercialize its own diagnostic tests. Possemato Decl. ¶37; Opposer's Notice of Reliance, Ex. 211. Similarly, the University of California, San Francisco recently used an Illumina sequencer to create a test to detect multiple viruses, bacteria, etc. that cause a variety of infectious diseases—including diarrheal disease. Opposer's Rebuttal Notice of Reliance, Ex. 410. UCSF plans to launch the test as an LDT with an eye towards eventual FDA clearance. *Id.*

iii. Illumina's diagnostic laboratory

In addition to selling products, Illumina created its own diagnostic laboratory. Before the end of September 2008, Illumina began the project for a CLIA-certified diagnostics services lab. Heath Decl. ¶18. Illumina completed the lab by the first half of 2009, and Illumina performs diagnostic LDTs for third parties using its own products. Heath Decl. ¶¶17, 19; Opposer's Notice of Reliance, Exs. 11-12.

b. Illumina's robust marketing reached diagnostics customers

Illumina has a significant budget for marketing and selling its products and services. Possemato Decl. ¶44. During the period of January 2008 through December 31, 2013, Illumina has spent over \$8 million in advertising production cost, space, and fees; over \$6.8 million in

direct marketing and electronic marketing; and over \$4.2 million in public relations including news releases and agency fees. Possemato Decl. ¶44. These expenditures represent just a portion of Illumina's total marketing expenses during the noted period. Possemato Decl. ¶44. Approximately [REDACTED] of these marketing expenses were targeted to diagnostic customers. Possemato Decl. ¶44.

Sponsoring and exhibiting at various industry and trade shows is one of the main avenues through which Illumina markets its products. Many of these trade shows specifically address diagnostic-related goods and services. In fact, Meridian has exhibited at the same shows—sometimes concurrently with Illumina.

One such trade show is the annual meeting of the Association of Molecular Pathology (“AMP”). AMP is relevant to the diagnostic community. Attendees of the AMP annual meeting include people that work with infectious diseases, genetic disorders, hematopathology, and tumors. O’Grady Decl. ¶12.

Illumina has participated as an exhibitor at the AMP Annual Meetings every year since 2007. O’Grady Decl. ¶13. And it has been a “Silver Partner” corporate sponsor every year since 2009. O’Grady Decl. ¶12. In addition to being displayed at Illumina’s exhibit booth, AMP features Illumina’s products and technology in many of the scheduled programs and courses. For example, each year since 2008, Illumina has offered corporate-sponsored workshops featuring Illumina’s products and technology. O’Grady Decl. ¶12.

Meridian has also participated as an exhibitor at the AMP annual meetings. It began participating in 2010, the year that it commercialized its ILLUMIGENE and ILLUMIPRO products. O’Grady Decl. ¶13; Opposer’s Notice of Reliance, Ex. 310 at ILLUM-3470, Ex. 401.

Besides AMP, Illumina attends other industry and trade events relevant to diagnostics. These include the American Association for Clinical Chemistry (“AACC”) Annual Meeting and Clinical Lab Expo (in 2006 and continuously from 2008-2010) and the American Society of Microbiology general meeting (since 2012). O’Grady Decl. ¶14. In 2006, both Illumina and Meridian participated as Clinical Lab Expo exhibitors at the AACC Annual Meeting. O’Grady Decl. ¶15; Opposer’s Notice of Reliance, Ex. 56, Ex. 311 at ILLUM-0075-76, Ex. 312 at ILLUM-0008, 0010.

In addition to trade shows, Illumina distributes marketing materials that reach all aspects of diagnostic labs. Rebuttal O’Grady Decl. ¶5. A limited number of entities rent compiled lists of potential customers in molecular pathology, which includes diagnostics. Rebuttal O’Grady Decl. ¶¶7-8. Illumina rents customer lists from one or more of these entities, and it sends marketing materials covering the whole range of its products. Under this umbrella approach to marketing, Illumina gives no consideration to any particular customer’s specialty such as infectious disease, cancer, genetic health, etc. (assuming a customer even has a specialty). As a result, any laboratory that performs services within the context of molecular diagnostics is likely to receive Illumina’s marketing materials. Rebuttal O’Grady Decl. ¶9.

Finally, Illumina advertises in trade and scientific journals read by those involved with diagnostics. O’Grady Decl. ¶10; Opposer’s Notice of Reliance, Ex. 306. For example, Illumina has advertised in *CAP Today* (a journal published by the College of American Pathologists), *The Journal of Molecular Diagnostics* (a journal published by the Association for Molecular Pathology), and *Nature Genetics*. Opposer’s Notice of Reliance, Ex. 306 at ILLUM-1176.

[REDACTED]

[REDACTED]

c. Illumina reorganized its business to better emphasize diagnostics

In January 2008, Illumina publically touted the creation of a Diagnostics Business Unit to support its continued expansion in diagnostics and manage its diagnostics products. Possemato Decl. ¶17; Heath Decl. ¶8; Opposer’s Notice of Reliance, Exs. 101-02. By this time, Illumina had also formed a regulatory and quality group to support its diagnostics growth. Possemato Decl. ¶17. By the first half of that year, Ms. Henshall’s marketing team had focused on three diagnostic segments, including infectious disease. O’Grady Decl. ¶4.

Since its formation in 2008, the Diagnostic Business Unit became a major focus of Illumina. Heath Decl. ¶9; Opposer’s Notice of Reliance, Ex. 103. In 2011, Illumina hired a Chief Medical Officer to further support Illumina’s diagnostic capabilities. Heath Decl. ¶11. Among other responsibilities, that officer was tasked with improving Illumina’s ability to conduct FDA clinical trials. *Id.* ¶12.

B. Meridian

According to its website, “Meridian is a fully-integrated life-science company that manufactures, markets, and distributes a broad range of innovative diagnostic test kits, purified reagents and biopharmaceutical enabling technologies.” Opposer’s Notice of Reliance, Ex. 72. It actively markets its products to hospitals, laboratories, research centers, physician offices, and diagnostics manufacturers. *Id.*

Meridian’s marks relevant to this case are recited in the chart below.

Mark	Filing Date/ Application No.	Registration Date/ Registration No.	Goods
ILLUMIGENE	Filed: 17-NOV-2008 App No. 77615484	Reg Date: 26-OCT-2010 Reg No. 3868081	Diagnostic kits consisting of molecular assays for use in disease testing and treatment of gastrointestinal, viral, urinary, respiratory and

Mark	Filing Date/ Application No.	Registration Date/ Registration No.	Goods
			infectious diseases in Class 5
	Filed: 01-APR-2009 App No. 77704647	Reg Date: 07-DEC-2010 Reg No. 3887164	Diagnostic kits consisting of molecular assays for use in disease testing and treatment of gastrointestinal, viral, urinary, respiratory and infectious diseases in Class 5
ILLUMIPRO	Filed: 25-JUN-2009 App No. 77768176	N/A	Diagnostic machine, namely, a stand alone closed heater and turbidity meter to be used for the amplification and detection of a closed tube molecular assay in Class 10
ILLUMIPRO-10	App Date: 07-JUL-2009 App No. 77775316	N/A	Diagnostic machine, namely, a stand alone closed heater and turbidity meter to be used for the amplification and detection of a closed tube molecular assay in Class 10

Stated simply, the ILLUMIGENE marks relate to laboratory test kits used to prepare a sample. The ILLUMIPRO instrument reads the ILLUMIGENE-prepared sample by detecting DNA molecules (genetic material) to determine the presence of a disease. Opposer’s Notice of Reliance, Ex. 69; Rebuttal O’Grady Decl. ¶13.

Meridian commercialized its ILLUMIGENE and ILLUMIPRO products in 2010 with a test for *C. difficile*. Opposer’s Notice of Reliance, Ex. 401 at 5. As stated above, *C. difficile* is a commonly-recognized infectious disease that causes diarrhea. *Id.* Ex. 72. According to Meridian’s FDA submission, its ILLUMIGENE branded *C. difficile* product is intended for use in hospital and laboratory settings. *Id.* Ex. 69.

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[REDACTED]

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V. ARGUMENT

A. Illumina has standing

Illumina has properly plead its prior registrations of record, providing proof of standing and the damage suffered by Illumina by the registration of Meridian's ILLUMIGENE and ILLUMIPRO marks. *See Research in Motion Ltd. v. Defining Presence Mktg. Group Inc.*, 102 USPQ2d 1187, 1190 (TTAB 2012) (pleaded registrations of record established standing).

B. Illumina has priority of both use and registration

Illumina has continuously used its ILLUMINA mark in connection with its goods since 1999. By 2003, Illumina had obtained three registrations for its ILLUMINA mark (Registration Nos. 2471539, 2632507, and 2756703). Each of those registrations has been properly plead and made of record. *See supra*, section III.

Illumina has also continuously used its ILLUMICODE and ILLUMINOTES marks since 2002 and 2006, respectively. Possemato Decl. ¶¶40, 41; Opposer's Notice of Reliance, Exs. 214-15. Illumina also owns Registration No. 4053668 for its ILUMINADX mark, which was filed in May 2009. That registration was properly plead and made of record. *See supra*, section III.

Thus, all of these registrations and all of this use predates Meridian's ILLUMIPRO-inclusive marks, which were filed beginning June 25, 2009. Further, all of the registrations and all of this use except for the ILLUMINDX registration predates Meridian's ILLUMIGENE-inclusive marks, which were filed beginning November 17, 2008.

Therefore, Illumina has established priority via both its pleaded registrations of record as well as its prior use of its ILLUMINA, ILLUMINOTES, and ILLUMICODE marks. *TBMP* § 309.03; *Research in Motion*, 102 USPQ2d at 1191.

C. **Meridian’s ILLUMIGENE and ILLUMIPRO marks are likely to cause confusion with Illumina’s ILLUMINA, ILLUMINOTES, and ILLUMICODE marks**

1. **The DuPont factors are used to assess a likelihood of confusion**

Section 2(d) of the Lanham Act provides that a registration should be refused if the trademark “so resembles a mark registered in the Patent and Trademark Office, or a mark ... previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive” 15 U.S.C. § 1052(d). The Board’s “determination of likelihood of confusion is based upon [an] analysis of all of the probative facts in evidence that are relevant to the factors bearing on this issue.” *Research in Motion*, 102 USPQ2d at 1192. The test consists of thirteen factors, including (1) the fame of the prior mark; (2) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression; (3) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (4) the similarity or dissimilarity of established, likely-to-continue trade channels; (5) the variety of goods on which a mark is or is not used; (6) the number and nature of similar marks in use on similar goods; (7) the conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing; (8) the nature and extent of any actual confusion; and (9) any other established fact probative of the effect of use. *In re E.I. du Pont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973).

The *Du Pont* factors are not listed in order of merit, and each may play a dominant role, depending on the case. *Id.* However, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort. Howard Paper Co.*, 192 USPQ 24 (CCPA 1976). In assessing whether a likelihood of confusion exists, all doubts are resolved in favor of the prior user and registrant. *Nina Ricci S.A.R.L. v. E.T.F. Enters., Inc.*, 12 USPQ2d 1901, 1903-04 (Fed. Cir. 1989); *Hancock v. Am. Steel & Wire Co.*, 97 USPQ 330, 333 (CCPA 1953).

2. ILLUMINA is a famous mark

The ILLUMINA mark has extensive public recognition and renown, and is therefore entitled to a wide latitude of legal protection. “A mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark.” *Kenner Parker Toys v. Rose Art Indus.*, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). To determine fame for purposes of likelihood of confusion, the Board looks to the class of customers and potential customers of a product or service, and not the general public. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (Fame for likelihood of confusion purposes arises “as long as a significant portion of the relevant consuming public ... recognizes the mark as a source indicator.”). “[T]he fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.” *Bose Corp. v. QSC Audio Prods., Inc.*, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002).

Illumina is a publicly-traded company (NASDAQ) with a market capitalization of around \$25 billion. Possemato Decl. ¶42. It has experienced tremendous sales growth from \$366.8

million in 2007 to well over \$1 billion in 2013. Possemato Decl. ¶42; Opposer's Notice of Reliance, Ex. 220 at ILLUM-2332, Ex. 228 at ILLUM-3151. In 2009, Forbes stated that Illumina was the fastest growing technology company in America, based on five-year annualized sales growth. Possemato Decl. ¶43; Opposer's Notice of Reliance, Ex. 229 at ILLUM-0928. Illumina also ranked fourth on the Forbes 2010 ranking of the fastest growing technology companies in America. Possemato Decl. ¶43; Opposer's Notice of Reliance, Ex. 229 at ILLUM-0924-7. In fact, Illumina was on the Forbes top 25 list four times in the five-year period between 2006 and 2010. Possemato Decl. ¶43; Opposer's Notice of Reliance, Ex. 229 at ILLUM-0924-28.

Illumina also spends significant resources to promote its marks. Possemato Decl. ¶44. From 2008 through 2013, Illumina spent over \$8 million in advertising production cost, space, and fees; over \$6.8 million in direct marketing and electronic marketing; and over \$4.2 million in public relations including news releases and agency fees. *Id.* Approximately █████ of these marketing expenses were targeted to diagnostic customers. *Id.*

Given the exposure of the ILLUMINA mark due to its leading market position, years of use, high volume of sales, and extensive advertising and sales expenditures, the mark is a famous mark in the life-science industry. As a result, the ILLUMINA mark is entitled to a wide latitude of legal protection.

3. The ILLUMIGENE and ILLUMIPRO marks are similar to the ILLUMINA, ILLUMINOTES, and ILLUMICODE marks

To evaluate the similarity of the marks, the Board must determine whether the marks “are sufficiently similar that confusion as to the source of the goods and/or services offered under the respective marks is likely to result.” *Research in Motion*, 102 USPQ2d at 1193. The analysis is

not whether the marks are distinguishable in a side-by-side comparison, “but rather whether they so resemble one another as to be likely to cause confusion.” *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). “[T]he emphasis must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks.” *Id.*

The ILLUMIGENE, ILLUMIPRO, ILLUMINA, ILLUMICODE, and ILLUMINOTES marks are nearly identical. First, they share the same ILLUMI prefix, which is the dominant portion of the mark. *See Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.”); *Pathfinder Commc’ns Corp. v. Midwest Commc’ns Co.*, 224 USPQ 203, 205 (N.D. Ind. 1984) (it is an “accepted fact” that “people perceive differences which occur at the end of words less clearly than when differences occur at the beginning of words”). Meridian’s  mark emphasizes the ILLUMI prefix even more by making it bolder than the rest of the mark. Also, like Illumina’s commercial use of its ILLUMINA mark, , the  mark is lower case with even more emphasis on the “i”. *See, e.g.*, Opposer’s Notice of Reliance, Ex. 7 at ILLUM-3810 (commercial use of ILLUMINA mark).

Further, the suffixes of Meridian’s marks are descriptive and therefore subservient. And rather than distinguishing Meridian’s marks, Meridian’s subservient suffixes actually strengthen the association with Illumina’s marks and business. The ILLUMIGENE marks have the descriptive suffix –GENE. “Gene” describes both Illumina’s and Meridian’s products, which can be used to identify diseases by detecting genetic sequences. Rebuttal O’Grady Decl. ¶49.

Not surprisingly, “gene” is a common term used in connection with diagnostic devices similar to Meridian’s and Illumina’s products. For example, the Washington University School of Medicine published an article regarding various commercially-available products that could

be used to detect *C. difficile*, Opposer’s Notice of Reliance, Ex. 43, an infectious disease that both Meridian’s and Illumina’s products have been used to detect. *Id.* Ex. 8, Ex. 401 at 5. Four of those products use the term “gene” in their name—GeneOhm, GeneXpert, Illumigene, and Verigene. *Id.* Ex. 43 at ILLUM-3623 (Table 4).

In addition, Meridian’s ILLUMIPRO marks have the descriptive suffix –PRO. Pro is short for professional, Opposer’s Rebuttal Notice of Reliance, Ex. 421 at ILLUM-3966-7, which describes the purchasers of both parties’ products. *In re Camel Mfg. Co.*, 222 USPQ 1031, 1032 (TTAB 1984) (“[A] mark is merely descriptive if it describes the type of individuals to whom an appreciable number or all of a party’s goods or services are directed”).

In addition to having highly similar appearance and connotation, the marks ILLUMIGENE, ILLUMIPRO, and ILLUMINA have the same cadence and rhythm, and sound the same. The marks both have four syllables and differ only in their one-syllable suffix.

Finally, a recent search of Genome web, an online publication that serves “the global community of ... molecular biology research and molecular diagnostics” supports the similarity of the marks. When a search for “Illumigene” was entered, the Genome website not only returned a number of articles about Illumigene products, but also asked “Did you mean: Illumina.” Possemato Decl. ¶47; Opposer’s Notice of Reliance, Ex. 230.

Meridian contends that, at least for medical devices, it is common for products to have the same prefix. *See, e.g.*, Kozak Decl. ¶47. But in reality, the evidence shows that it is only common for marks to share a *descriptive* component—not that it is common for marks to share a *distinctive* prefix. For example, Meridian’s one example of different products with the same prefix involves a descriptive term—“Immuno.” Kozak Decl. ¶47; Opposer’s Rebuttal Notice of Reliance, Ex. 421 at ILLUM-3959 (Immuno means “immune, immunity, or immunology”).

Further, although shared descriptive terms may be common in marks used with medical devices, those shared terms are not consistently found in the prefix. Of the four devices referenced above that are used to detect *C. difficile*, two use the descriptive term “gene” in the prefix and two use “gene” in the suffix. Opposer’s Notice of Reliance, Ex. 43 at ILLUM-3623 (Table 4). The same article also refers to three similar devices—SmartCycler, LightCycler, and iCycler IQ—each of which has the same descriptive suffix—“Cycler.” *Id.* Ex. 43 at ILLUM-3622.

4. The goods identified in the ILLUMIGENE registrations and ILLUMIPRO applications are similar to goods covered under Illumina’s registrations and prior use

The parties’ goods “need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion.” *Weider Publ’ns, LLC v. D & D Beauty Care Co., LLC*, 109 USPQ2d 1347, 1356 (TTAB 2014). Instead, “[i]t is sufficient that the respective goods ... are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods ... are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source.” *Id.* “The issue to be determined in cases such as this is not whether the goods of plaintiff and defendant are likely to be confused but rather whether there is a likelihood that purchasers will be misled into the belief that they emanate from a common source.” *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989).

a. **The parties' goods relate to laboratory equipment and instruments to detect DNA molecules**

The goods recited in the ILLUMIGENE registrations and ILLUMIPRO applications consist of molecular test kits (“kits consisting of molecular assays”) and equipment to detect molecules in those test kits (“machine ... for the amplification and detection of a ... molecular assay”). Also, Meridian’s specimen submitted to support its ILLUMIGENE ‘647 registration shows laboratory equipment and instruments and states “Insert **illumigene** Test Device into **illumipro-10** and initiate amplification reaction and detection” (bolding in original).

Likewise, the laboratory sensing equipment described in the ILLUMINA ‘539 registration are used to identify molecules (“identify organic molecules”). The scientific equipment and instruments described in the ILLUMINA ‘703 registration also identify and analyze molecules (“molecular sensing optical fiber bundles for analyzing ... and other molecules”). And the reagents described in the ILLUMINA ‘507 registration are used for analyzing molecules (“analyzing ... and other molecules”).

Further, the goods in the ILLUMIPRO applications and ILLUMIGENE registrations cover the detection of DNA molecules (genetic material). Kozak Decl., Ex. F at ME-0010989 (describing ILLUMIGENE product as “DNA Amplification Assay for the Detection of Cytotoxigenic *C. difficile*”); Rebuttal O’Grady Decl. ¶13 (ILLUMIPRO instruments detect DNA). Likewise, Illumina’s ‘507 and ‘703 registrations identify genotyping, which involves detecting DNA. Possemato Decl. ¶¶5-6.

Images of goods covered by the ILLUMINA, ILLUMIPRO and ILLUMIGENE recitations are shown below.

ILLUMINA



ILLUMIGENE and ILLUMIPRO



Opposer's Notice of Reliance, Ex. 202 at 76; Kozak Decl., Ex. F at ME-00040532.

Not surprisingly, Illumina's goods sold before the ILLUMIGENE and ILLUMIPRO applications were also laboratory equipment and instruments used to detect DNA molecules. *See* Rebuttal O'Grady Decl. ¶13.

In addition to the use of ILLUMINA, since 2002 Illumina has continuously used the mark ILLUMICODE in connection with DNA microarrays, Possemato Decl. ¶40; Opposer's Notice of Reliance, Ex. 214, which are used to detect DNA molecules. Possemato Decl. ¶6. And since 2006, Illumina has continuously used the mark ILLUMINOTES in connection with newsletters featuring information in the fields of genetics, medical diagnostics, medical research, molecular diagnostics, nucleic acid sequencing and genotyping, life sciences, biology, molecular pathology, laboratory medicine, and biotechnology. Possemato Decl. ¶41; Opposer's Notice of Reliance, Ex. 215. These items are related to ILLUMIGENE and ILLUMIPRO recitations, which cover goods that detect molecules and goods related to life sciences, biology, laboratory medicine, medical diagnostics, etc.

Meridian wrongly argues that its goods are different from Illumina's goods because its recitations specifically refer to diagnostics and Illumina's recitations are limited to research.

To the contrary, Illumina's recitations that refer to research still relate to diagnostics. First, as discussed above, goods labeled for research use can nonetheless be used for diagnostics in LDTs. O'Grady Decl. ¶16; Rebuttal O'Grady Decl. ¶¶10, 14, 15. "LDTs are an extremely common part of laboratory medicine," that are "the backbone of clinical care in the United States." Opposer's Rebuttal Notice of Reliance, Ex. 405 at ILLUM-3840. Many such labs perform diagnostics using both LDTs and also purchase FDA-cleared products for diagnostic use. Rebuttal O'Grady Decl. ¶53. Second, numerous companies, such as Roche and Bayer sell products for both research and diagnostics. Heath Decl. ¶28; *see also* Opposer's Notice of Reliance, Ex. 120 at ILLUM-0679-684.

And not all of Illumina's recitations refer to research. For example, Illumina's '539 registration would cover sensing systems used for diagnostics because there is no limitation otherwise. Rebuttal O'Grady Decl. ¶44. *See In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) ("it is presumed that the scope of the registration encompasses all of the goods of the nature and type described therein"). Further, the ILLUMINADX registration, which is senior to the ILLUMIPRO marks, specifically recites kits for diagnostic use.

Finally, Illumina's goods have been used by customers for diagnostics since 2007, before Meridian's filing dates. O'Grady Decl. ¶¶16; 18, 21, 22; Rebuttal O'Grady Decl. ¶¶10, 14, 15.

Moreover, Illumina's laboratory equipment can also be used with some of the same types of diseases specifically referenced in the ILLUMIGENE recitations. Besides referring to infectious diseases, the ILLUMIGENE recitations refer to gastrointestinal, urinary, and respiratory diseases. This broadly-worded recitation covers a variety of diseases, including cystic fibrosis, cancer, and infectious disease, which Illumina's products can also be used to detect. Rebuttal O'Grady Decl. ¶¶38, 49, 58.

Further, the first commercial test kits sold under the ILLUMIGENE mark in 2010 were used to test for *C. difficile*, a type of infectious disease. Opposer’s Notice of Reliance, Ex. 401 at 5. This is three years after the University of Maryland used Illumina’s products to test for *C. difficile* in 2007. O’Grady Decl. ¶21-22; Opposer’s Notice of Reliance, Ex. 8. And after Meridian was on the market, the parties appeared in the same journal article that discussed tools to detect *C. difficile*. Opposer’s Notice of Reliance, Ex. 43 at ILLUM-3624 (referring to Illumigene assay), ILLUM-3632 (referring to Illumina platform).

b. Any distinction between the goods would not outweigh the similarities

Meridian argues that the goods are not similar because, based upon a much more granular analysis, the respective goods incorporate different methods to analyze or detect DNA. This, argument, however, does not overcome the fact that similar products with similar names can be used to test for the presence of similar diseases by detecting DNA for that disease.

To support its granularity argument, Meridian relies on testimony from Karen Possemato, an Illumina employee, comparing a third-party product to Illumina’s sequencing technology. Possemato Tr. 82-89. Ms. Possemato testified that comparing the two products would be like comparing “apples and oranges” because Illumina’s product can analyze more than 100,000 aspects of a sample, but the third-party product could only analyze about 100 aspects. *Id.* 86:3-87:7. Meridian argues that because its commercial ILLUMIGENE products only analyze one aspect of a sample, its goods are even more distinct from Illumina’s goods. Elagin Decl. ¶¶34-35.

Meridian, however, ignores a number of issues. First, the goods recited in the ILLUMIGENE registrations and ILLUMIPRO applications are not limited to analyzing only one aspect of a sample. Rebuttal O’Grady Decl. ¶41. Thus, it is irrelevant whether the commercial

ILLUMIGENE and ILLUMIPRO products are so limited. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat. Ass'n*, 811 F.2d 1490, 1493 (Fed. Cir. 1987) (“likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant’s application”).

Second, Ms. Possemato was referring to Illumina’s sequencing technology (which is one method of analyzing DNA). Possemato Tr. 85:3-8. Meridian ignores that Ms. Possemato also testified that Illumina’s BeadXpress product (utilizing a different type of technology) was competitive. *Id.* 85:3-8; 91:9-93:7. In any event, as stated above, the parties’ goods “need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion.” *Weider Publ’ns*, 109 USPQ 2d at 1356.

Third, Ms. Possemato testified that although Illumina’s sequencing technology would not be competing for the exact same sale as the lower-complexity product, the two would be “complementary technologies” and that “you would have both in the same lab.” Possemato Tr. 89:14-21.

Thus, Illumina’s and Meridian’s respective goods satisfy the “related in some manner” standard of *Weider Publ’ns*. See 109 USPQ 2d at 1356. See also *In Re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1274 (TTAB 2009) (finding likelihood of confusion because registrant’s MRI machine and applicant’s ultrasound machines were related goods even though they utilize “distinctly different technologies”).

Meridian argues that a customer would not confuse the ILLUMIGENE or ILLUMIPRO goods with ILLUMINA goods or products because of a supposed “extreme price difference between them.” Kozak Decl. ¶43. But Meridian ignores that the parties’ goods “need not be similar or competitive, or even offered through the same channels of trade, to support a holding

of likelihood of confusion.” *Weider Publ’ns.*, 109 USPQ2d at 1356. Also, nothing in either parties’ recitations suggests the price for which the products would be sold. *See Canadian Imperial Bank*, 811 F.2d at 1493 (likelihood of confusion based on goods and/or services as recited in applicant’s application). In fact, Meridian’s biggest competitor is a company named Cepheid. Elagin Tr. 106:5-8. Cepheid sells its instruments from \$20,000 to \$250,000, which is also much more expensive than Meridian. *Id.* 106:21-107:15. And any price difference between Illumina and Meridian is not as drastic as Meridian contends. Although Illumina’s instruments are expensive to purchase outright, Illumina has programs to place its instruments in labs at no upfront cost through the use of leasing and other means. Rebuttal O’Grady Decl. ¶33. Under these programs, Illumina’s tests sold to be used with Illumina’s instruments have a cost similar to Meridian. *Id.* ¶34.

5. The parties’ goods have similar and overlapping trade channels

As explained above, the parties’ goods “need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion.” *Weider Publ’ns.* 109 USPQ2d at 1356. Instead, “[i]t is sufficient that the respective goods ... are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods ... are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source.” *Id.*

a. The parties’ goods are advertised in similar and overlapping channels

To reach their customers, both parties advertise and promote their products through the same outlets, including the same trade shows and trade magazines. Both parties have exhibited at the Association for Molecular Pathology trade shows, as well as the American Association for

Clinical Chemistry (AACC) Annual Meeting and Clinical Lab Expo. O’Grady Decl. ¶¶13, 15; Opposer’s Notice of Reliance, Ex. 310 at ILLUM-3470, Ex. 311 at ILLUM-0074-75, Ex. 312 at ILLUM-0008-010. [REDACTED]

[REDACTED] Thus, the parties use the same marketing techniques to attract the same types of customers. *See Jenn-Air Corp. v. Jenn Mfg. Inc.*, 208 USPQ 948, 954 (TTAB 1980); *see also CAE Inc. v. Clean Air Eng’g Inc.*, 60 USPQ2d 1449, 1464 (7th Cir. 2001) (and cases cited therein).

Illumina also distributes marketing materials to a wide variety of customers. Rebuttal O’Grady Decl. ¶¶5-9. This includes diagnostics laboratories, *Id.* ¶5, which are included in Meridian’s target class of customers for its recited goods. Kozak Decl. ¶11.

**b. The parties’ ILLUMINA, ILLUMIGENE, and ILLUMIPRO
respective goods are sold to similar and overlapping customers**

Under this factor, “[I]t is presumed that the scope of the registration encompasses all goods of the nature and type described, that the identified goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers.” *See In re Elbaum*, 211 USPQ at 640. Both the goods recited in the ILLUMIGENE registration and ILLUMIPRO applications and the goods recited in Illumina’s registrations would include diagnostic laboratories as normal purchasers for such goods/services.

As discussed above, diagnostic labs would purchase the laboratory equipment and reagents described in Illumina’s ‘703 and ‘507 registrations to use those goods in their own LDTs. This is because even goods labeled for research use can be nonetheless used for diagnostics in LDTs. O’Grady Decl. ¶16; Rebuttal O’Grady Decl. ¶53. And the equipment

(i.e., the sensing systems) described in Illumina's '539 registration is not limited to any specific type of use and therefore would include use in diagnostic labs. Finally, Illumina's ILLUIMINADX registration specifically refers to diagnostics.

Therefore, it is not surprising that Illumina's products have been sold to and used by diagnostics laboratories since at least 2007. O'Grady Decl. ¶¶16; 18, 21, 22; Rebuttal O'Grady Decl. ¶¶10, 14, 15.

Meridian argues that consumers for the parties' products would be completely different. Meridian, however, makes a number of inaccurate statements contending that Illumina has had no presence in diagnostics:

- "In 2008, Illumina's products had zero presence inside a Clinical Diagnostic or Microbiology Laboratory." Elagin Decl. ¶27.
- In 2008 to 2009, Illumina's Research Use Only ("RUO") products "were used by ..., *not* the clinical diagnostic laboratories." Elagin Decl. ¶27 (emphasis in original).
- "Meridian's relevant consumers on the clinical diagnostic side of such labs probably have very little if any familiarity with Illumina." Kozak Decl. ¶15.
- "Personnel within clinical diagnostic laboratories in 2008 and 2009 would probably never have even heard of Illumina at all" Kozak Decl. ¶23.
- "At the time of Meridian's [November 2008 and April 2009 ILLUMIGENE] filings, consumers in the clinical diagnostic laboratory would not have had any awareness of Illumina or its products because Illumina did not offer any products they could use" Kozak Decl. ¶27.

To the contrary, as stated above, in 2007 Illumina began selling products that were used in diagnostic laboratories for diagnostic use. O'Grady Decl. ¶3.

And since 2006, Illumina has attended trade shows, distributed marketing materials, and otherwise informed diagnostic customers about its technology. Opposer's Notice of Reliance, Ex. 306 at ILLUM-1176, Exs. 307-311; Rebuttal O'Grady Decl. Exs. 4-6. By 2007, Dr. Stephen Young, the Director of Infectious Disease at a large reference laboratory, had encountered Illumina at conferences and was aware of Illumina's NGS technology. Young Tr. 8:21-24, 19:7-18, 21:1-11. Therefore, consumers in diagnostics labs were well aware of Illumina by the time Meridian filed the first of its ILLUMI- marks in November 2008.

Meridian makes the fallback argument that even if Illumina sold products to diagnostics labs, those labs are segregated by discipline, *e.g.*, cancer, genetic health, and infectious disease/microbiology. Kozak Decl. ¶31. Meridian argues that the labs are so segregated that those working in one area (*e.g.* infectious disease/microbiology) would be unaware of the products used in other areas (*e.g.* cancer). Thus, Meridian contends that individuals in the infectious disease area of a lab—where Meridian's commercial ILLUMIGENE and ILLUMIPRO products are used—would be unaware of Illumina's products. *Id.* ¶¶7, 11, 12, 14, 15, 23, 33.

Meridian's argument suffers from numerous flaws. First, even if Meridian has only sold its ILLUMIGENE and ILLUMIPRO products to diagnose infectious diseases, its recitations of goods are broader. As explained above, the recitation for the ILLUMIGENE marks covers diagnosis of other types of diseases, such as cystic fibrosis and cancer. Rebuttal O'Grady Decl. ¶38. The recitations for the ILLUMIPRO marks do not refer to any specific types of disease. In any event, Illumina's products can and have been used in connection with infectious disease. *Id.* ¶¶17-29.

Second, not all diagnostics labs segregate the infectious disease/microbiology personnel from other diseases. Instead, multiple individuals run labs that perform infectious disease diagnostics along with other areas of diagnostics such as genetic health. *Id.* ¶31.⁵ In fact, Dr. Young has held positions in which he worked in one department covering both molecular genetics and microbiology (infectious disease). Young Tr. 28:18-29:8.

Third, even if diagnostics labs are segregated, clinicians working in a particular department have familiarity with products targeted towards other departments. For example, although Dr. Young works in infectious disease, he also works with other groups within his laboratory to discuss the types of products those groups may purchase. *Id.* 27:13-19. Thus, in 2012, he attended an Illumina presentation regarding cancer genetics for such a purpose. *Id.* 23:8-24:10.

[REDACTED]

⁵ One such individual mentioned in her rebuttal declaration is Dr. Young. More specifically, Ms. O’Grady stated that Dr. Young “has purchased an Illumina Bead Array reader specifically for cytogenetics use.” Rebuttal O’Grady Decl. ¶31. After Ms. O’Grady submitted her rebuttal declaration, she realized that this statement was not accurate. Instead, although Illumina had called on Dr. Young as a potential customer, it had not actually sold a Bead Array reader to him. May 12, 2015 O’Grady Tr. 199:20-200:6. Illumina informed Meridian of the issue before Meridian deposed Ms. O’Grady regarding this declaration. *Id.* 202-03; *Id.* Ex. V.

Therefore, “the conditions and activities surrounding the marketing of the goods ... are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source.” *See Weider Publ’ns*, 109 USPQ2d at 1356.

6. In any event, diagnostics was within Illumina’s natural zone of expansion at the time of Meridian’s filings

As explained above, diagnostic laboratory purchasers are within the normal trade channels for the goods and services recited in Illumina’s prior registrations. And Illumina’s products were used for diagnostics before Meridian’s first filing in November 2008. But even if neither of these facts were true, diagnostic products—including for infectious disease—were within Illumina’s natural zone of expansion by November 2008. Indeed, it has long been held that the protection accorded registered marks includes such a zone. *See R.J. Reynolds Tobacco Co. v. R. Seelig & Hille*, 201 USPQ 856, 860 (TTAB 1978) (recognizing the common practice for large corporations, not only to expand their present line of products, but also to diversify their business to include new fields of endeavor); *see also CAE, Inc. v. Clean Air Eng’g, Inc.*, 60 USPQ2d at 1463 (rationale is “to protect the owner’s ability to enter product markets in which it does not now trade but into which it might reasonably be expected to expand in the future.”) (quoting *Sands, Taylor & Wood v. Quaker Oats Co.*, 24 USPQ2D 1001, 1010 (7th Cir. 1992)).

Although Illumina began as a research company, it always aimed to make the natural progression to diagnostics. Possemato Decl. ¶12. Indeed, it is a natural progression to start using a technology for research, develop and refine the technology, and then eventually put the technology into diagnostic use. Heath Decl. ¶29.

Illumina began accelerating this progression in 2005 when it acquired the VeraCode technology. Possemato Decl. ¶13; Heath Decl. ¶7. Shortly after doing this, Illumina hired Ms. Henshall as its Associate Director Product Marketing, Diagnostics. Her sole responsibility was to market and promote Illumina's diagnostic products and services. Possemato Decl. ¶14.

After Illumina acquired the VeraCode technology, it collaborated with third-party companies in 2006 to bring diagnostic products to market. Possemato Decl. ¶¶15-16; Opposer's Notice of Reliance, Exs. 3, 203. The public was made aware of these collaborations through public articles and press releases. *Id.*

By 2006, the public was also made aware of Illumina's acquisition of the VeraCode technology and the applicability of that technology to diagnostics. *See* Opposer's Notice of Reliance, Ex. 4 (2006 article explaining that VeraCode technology "offers opportunities for in vitro and molecular diagnostic development" and that "the VeraCode technology will form the basis of the company's BeadXpress diagnostic platform, which is scheduled for market introduction before the end of the year."), Ex. 301 at ILLUM-0039-040, Ex. 313 at ILLUM-0468, Exs. 5-6; *See also* O'Grady Decl. ¶¶6-8, 16-17. As an example, in 2007, Illumina provided to customers and used at trade shows a presentation titled "VeraCode Technology – From Research to Molecular Diagnostics." O'Grady Decl. ¶7; Opposer's Notice of Reliance, Ex. 302.

Illumina also made plans in 2006 to obtain FDA approval for diagnostic use of the BeadXpress System utilizing VeraCode technology. Heath Decl. ¶13. By that time, Illumina had a formal development program to seek FDA approval for the device. *Id.* ¶¶13-14. As part of the formalized process to seek FDA clearance, Illumina developed all of its VeraCode products under "design control," Opposer's Notice of Reliance, Ex. 303 at ILLUM-0579, which is a

design process often used to develop FDA-cleared diagnostic products. Kozak Decl. ¶¶64-66. In March 2009, Illumina shipped BeadXpress devices to three third-party clinical sites in the United States to begin the required clinical trials. Heath Decl. ¶13; Opposer's Notice of Reliance, Ex. 104 at ILLUM-3485. In September 2009, Illumina submitted for FDA clearance, which was granted in April 2010. Heath Decl. ¶14; Opposer's Notice of Reliance, Exs. 36, 105.

In addition, in 2007, Children's Hospital of Philadelphia ("CHOP") developed an LDT to diagnose an inherited disease using the BeadXpress system. Illumina publicized CHOP's diagnostic work. O'Grady Decl. ¶19.

That same year, Illumina collaborated with the Children's Hospital of Eastern Ontario to develop diagnostic tests for screening newborn babies for genetic diseases. In addition, Illumina entered into a collaborative agreement with the Mayo Clinic to co-develop diagnostic tests using Illumina's products. O'Grady Decl. ¶20.

Illumina's products also had application to infectious disease. In 2007, the University of Maryland used the VeraCode technology to detect *C. difficile*. O'Grady Decl. ¶21; Opposer's Notice of Reliance, Exs. 8, 314. *C. difficile* is the same infectious disease for which the first commercial ILLUMIGENE products tested three years later in 2010. Opposer's Notice of Reliance, Ex. 401 at 5.

In addition, in 2007 Dr. Stephen Young had become aware of Illumina and its sequencing technology at trade shows. Young Tr. 8:21-24, 19:7-18, 21:1-11. Dr. Young believed that, although Illumina's sequencing technology was in its infancy, the technology would evolve to be relevant to him in infectious disease diagnostics. *Id.* 21:1-17. Dr. Young continues to believe that next-generation sequencing "will constitute an important component of an infectious disease [diagnostics]." *Id.* 24:11-20.

Illumina continued to seek and obtain FDA clearance to market its sequencing technology for diagnostics use. Heath Decl. ¶13.

In addition to selling products, Illumina created its own diagnostic laboratory. Before the end of September 2008, Illumina began the project for a CLIA-certified diagnostics services lab. *Id.* ¶18. Illumina announced this plan by November, 2008. Opposer's Notice of Reliance, Ex. 11. The lab was complete by the first half of 2009, Heath Decl. ¶17, and it performs LDTs for third parties using its own equipment. *Id.* ¶19.

Finally, Illumina had begun reorganizing its internal structure in order to expand its presence to diagnostics. In January 2008, Illumina created a Diagnostics Business Unit. Possemato Decl. ¶17; Heath Decl. ¶8. Illumina publicized this business unit by press releases in at least January and March 2008. Opposer's Notice of Reliance, Exs. 101-02. By this time, Illumina had also formed a regulatory and quality group to support its growth in the diagnostics market. Possemato Decl. ¶17. Also, by the first half of 2008, Ms. Henshall's marketing team had focused on three molecular diagnostic areas, including infectious disease. O'Grady Decl. ¶4.

The actual use of Illumina's products for diagnostics by customers, Illumina's own plans to continue to expand into diagnostics, and the public awareness of and third-party involvement with those plans all support that diagnostics was will within Illumina's zone of natural expansion by November 2008. Especially because it is normal for a company to progress from selling research products to selling diagnostic products, by November 2008 the consuming public would certainly have expected Illumina to be a source for diagnostic products. This expectation was confirmed when Illumina continued this expansion and obtained FDA clearance to market its products for diagnostics.

By entering Illumina's natural zone of expansion, Meridian's adoption and use of similar marks is likely to cause confusion. *Virgin Enters. v. Nawab*, 67 USPQ2D 1420, 1428 (2d Cir. 2003) (finding likelihood of confusion when, although junior user entered market segment first, senior user had plans to enter the segment).

7. The variety of goods on which the ILLUMINA mark is used favors a finding of likelihood of confusion

Use of a mark on a variety of goods weighs in favor of likelihood of confusion. *Time Warner Entm't Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002). Since its founding in 1998, Illumina has extensively used ILLUMINA as a house mark for its products and services. Possemato Decl. ¶7; Opposer's Notice of Reliance, Ex. 201 at ILLUM-0775-79. Thus, the ILLUMINA mark has been used in connection with Illumina's entire line of goods and services. This weighs in favor of a likelihood of confusion.

8. The third-party mark LUMINEX does not undermine the likelihood of confusion here

Meridian contends that the mark LUMINEX, used by a third-party company in the research and diagnostic space, Ferguson Decl., Ex. 13 at 108, weakens Illumina's marks. This argument is flawed because Illumina's and Meridian's ILLUMI-formative marks are more similar to each other than to LUMINEX.

Unlike Illumina's and Meridian's ILLUMI-formative marks, Luminex does not use the ILLUMI prefix, does not have four syllables, has no "i" to emphasize, and does nothing to emphasize the first portion of the mark. Instead, if anything, Luminex's own branding emphasizes the "ex" suffix of its mark. *See* Opposer's Notice of Reliance, Ex. 54 (referring to Luminex's "xMAP" and "xTAG" technologies, as well as its "xPONENT" software). Further,

unlike the descriptive suffixes in Meridian's marks, the suffix in LUMINEX does nothing to describe a similarity to Illumina's products.

9. Sophisticated medical device consumers are not immune to confusion

Even sophisticated customers are not immune from source confusion. *See In re Research & Trading Corp.*, 230 USPQ 49, 50 (Fed. Cir. 1986) ("That the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods.") citing *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers ... are not infallible."). "Although many of the parties' customers are sophisticated and decide to buy only after extensive negotiations, these customers' technical sophistication about their particular industry does not equate to trademark sophistication." *See CAE*, 60 USPQ2d at 1464-65. Thus, that consumers for Illumina's and Meridian's products may be educated and sophisticated does not trump the similarity of marks, goods, and trade channels that demonstrate a likelihood of confusion.

The Board has previously found that sophisticated purchasers of expensive medical devices could nevertheless be confused. For example, in *In re Toshiba Med. Sys. Corp.*, the applicant's goods were MRI machines and the registrant's goods were ultrasound machines. 91 USPQ2d 1266, 1267 (TTAB 2009). The Board held that "[t]he fact that purchasers may study the specimens and determine that applicant's and registrant's imaging devices originate from different sources is not relevant. We must consider whether the marks ... when used on the identified goods are confusingly similar." *Id.* at 1274. In *In re TM Bioscience Corp.*, the products at issue were sold to research labs and clinical genetic labs, both of which were found to have highly-sophisticated end-users. No. 76485778, 2005 WL 1113336, at *6 (TTAB 2005)

(nonprecedential). The Board noted that “[w]hile sophisticated lead researchers may well be knowledgeable about the source of particular materials, even such sophisticated users may be confused as to source by substantially identical marks.” *Id.* at *6.

Meridian, however, contends that purchasers will be informed that the ILLUMIGENE and ILLUMIPRO products come from Meridian and will confirm the manufacturer of a particular product before ultimately purchasing it. Kozak Decl. ¶¶37-40. But Meridian’s argument ignores the likelihood that a buyer could be confused much earlier in the decision-making process before potentially being corrected that ILLUMIGENE and ILLUMIPRO products do not come from Illumina. *See, e.g.*, May 12, 2015 O’Grady Tr. 81:18-82:1. By the time such a correction takes place, Illumina would have already been harmed. *See Promatek Indus., Ltd. v. Equitrac Corp.*, 63 USPQ2D 2018, 2021 (7th Cir. 2002), *as amended* (Oct. 18, 2002) (“that confusion as to the source of a product or service is eventually dispelled does not eliminate the trademark infringement which has already occurred”) (quoting *Forum Corp. of N. Am. v. Forum, Ltd.*, 903 F.2d 434, 442 n.2 (7th Cir. 1990)); *Miyano Mach. USA v. Miyano Hitech Mach.*, 576 F.Supp.2d 868, 885-86 (N.D. Ill. 2008) (“A trade show ... where consumer [*sic*] are likely to be engaged in initial investigation of the machines, is particularly susceptible to initial interest confusion. ... It is irrelevant whether this initial confusion is brief or that the confusion is eventually cured if the trademark infringement has already occurred.”). *See also Dan Robbins & Assocs., Inc. v. Questor Corp.*, 202 USPQ 100, 104 n.6 (CCPA 1979) (“Likelihood of confusion occurs upon observance of the mark and goods. It need not await a reading of the book. The mark, not the specimen, is submitted for registration.”).

In addition, even after the products have been purchased, those involved in laboratory work could see the parties’ respective goods and believe that they come from a common source.

The trademark laws are meant to protect from this type of post-sale confusion. *See CAE*, 60 USPQ2d at 1465.

10. The fact that the parties are unaware of any incidents of actual confusion does not outweigh the evidence of a likelihood of confusion

“It is unnecessary to show actual confusion in establishing likelihood of confusion.” *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 218 USPQ 390, 396 (Fed. Cir. 1983). This makes good sense because the test in proceedings such as the one at hand is “likelihood of confusion not actual confusion.” *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 1023 (CCPA 1977). Accordingly, the lack of evidence in the record of incidents of actual confusion should be accorded minimal weight. *In re Majestic Distilling Co., Inc.*, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) (“A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight.”). Therefore, the fact that instances of actual confusion may not have been reported to Illumina cannot outweigh the evidence of a likelihood of confusion.

Meridian may rely on Dr. Young’s testified that he would not be confused by the parties’ respective marks. Young Tr. 14:18-15:11. But this “survey” of one person is hardly scientific. Moreover, reliance on Dr. Young’s opinion would be unreasonable because he had previously given a presentation at a Meridian-sponsored workshop that discussed Meridian’s ILLUMIGENE product. Elagin Decl. ¶44. Dr. Young was introduced at that workshop by Dr. Elagin—one of Meridian’s declarants in this case. *Id.* Not surprisingly, Dr. Young specifically answered the question, which was asked by Meridian’s attorney, “based on [his] personal opinion” and did not opine whether any other relevant consumers would be confused. Young Tr. 14:18-15:11.

Further, surveys finding confusion of as little as 10% have been found to support a likelihood of confusion. *Mutual of Omaha Ins. Co. v. Novak*, 5 USPQ2d 1314 (8th Cir. 1987). This necessarily means that, in those cases, even if certain survey respondents were not confused, there can still be a likelihood of confusion. Here, the lack of confusion of one individual in an unscientific and biased survey does not support that there is no likelihood of confusion.

VI. CONCLUSION

ILLUMIGENE and ILLUMIPRO are likely to cause confusion with Illumina's famous ILLUMINA mark and other ILLUMI marks. Like Illumina before it, Meridian is attempting to register and use these ILLUMI-formative marks on laboratory equipment and instruments that can detect genetic material to diagnose a disease. The parties' goods bearing these nearly-identical marks are sold to the same types of customers, the parties attend the same trade shows, and they advertise in the same periodicals. Therefore, the Board should cancel and refuse Meridian's marks.

Respectfully submitted

KNOBBE MARTENS OLSON & BEAR, LLP



Date: August 6, 2015

By: _____

Susan M. Natland
Brian C. Horne
Knobbe Martens Olson & Bear, LLP
2040 Main Street, 14th Floor
Irvine, California 92614
efiling@knobbe.com
Tel: (949) 760-0404
Fax: (949) 760-9502
Attorneys for Opposer, Illumina, Inc.

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **BRIEF OF OPPOSER/PLAINTIFF ILLUMINA, INC.** upon Applicant's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid, on August 6, 2015, addressed as follows:

J. Michael Hurst
Keating Muething & Klekamp PLL
One East 4th Street
Suite 1400
Cincinnati, OH 45202



Sarah Beno Couvillion

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