ESTTA Tracking number: **ESTTA382677**

Filing date: **12/08/2010**

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

Proceeding	91194218
Party	Plaintiff Illumina, Inc.
Correspondence Address	GABRIELLE A HOLLEY HOLLEY & MENKER PA PO BOX 96 SOLANA BEACH, CA 92075 UNITED STATES westdocket@holleymenker.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	James R Menker
Filer's e-mail	eastdocket@holleymenker.com
Signature	/jmenker/
Date	12/08/2010
Attachments	20101208 MOTION FOR LEAVE TO FILE AMENDED NOTICES OF OPPOSITION OPP NO. 91194218 (PARENT).pdf (3 pages)(162773 bytes) AMENDED NOTICE OF OPPOSITION SERIAL NO. 77768176 OPP NO 91194218 -parent.pdf (17 pages)(1100362 bytes) AMENDED NOTICE OF OPPOSITION SERIAL NO. 77775316 OPP NO 91194219 (91194218 -parent).pdf (17 pages)(1099672 bytes)

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

Illumina, Inc.,	)	
	)	
Opposer,	)	Opposition No. 91194218 (parent)
	)	Opposition No. 91194219
v.	)	
	)	Ser. No. 77775316
Meridian Bioscience, Inc.,	)	Ser. No. 77768176
	)	
Applicant.	)	

MOTION FOR LEAVE TO FILE AMENDED NOTICES OF OPPOSITION

In accordance with Rule 2.107 of the Trademark Rules of Practice, Rule 15(a) of the Federal Rules of Civil Procedure and TBMP Rule 507 *et seq.*, Illumina, Inc. ("Opposer") seeks leave to amend its Notices of Opposition to correct paragraph reference errors in the original Notices of Opposition and to include a claim to Opposer's common law mark ILLUMINOTES. Proposed Amended Notices of Opposition are submitted herewith.

Through its investigation in connection with the preparation of the Initial Disclosures, Opposer became aware of the relevance of the ILLUMINOTES mark to these oppositions. The consolidated opposition proceedings are still in the discovery period and Applicant, Meridian Bioscience, Inc., has not yet served any discovery requests on Opposer. Therefore, Applicant avers that the Amended Notice of Opposition will not create substantial prejudice to Applicant because the proceedings are still in a fairly early stage. *See Buffett v. Chi Chi's, Inc.*, 226 USPQ 428 (TTAB 1985); *see also Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989) (proceedings still in the discovery stage). Moreover, entry of the proposed amended pleadings would not violate

settled law.

Opposer requests that the Board grant Opposer leave to amend its Notice of Opposition.

Respectfully submitted,

ILLUMINA, INC.

By: _____
James R. Menker
Gabrielle A. Holley

Opposer's Attorneys

Holley & Menker, P.A.
PO Box 96
Solana Beach, CA 92075
(858) 353-9285
westdocket@holleymenker.com

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Motion for Leave to File Amended Notice of Opposition with attached registration records has been served on Applicant's attorney, J. Michael Hurst of Keating Meuthing & Klekamp PLL, at the address of record, One East 4th Street, Suite 1400, Cincinnati, OH 45202-3752, via first class mail, postage prepaid, today **December 8, 2010**.

Signed: _____
Laura K. Greer

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

Illumina, Inc.,	)	
	)	
Opposer,	)	
	)	Opposition No. 91194218 (parent)
v.	)	Opposition No. 91194219
	)	
Meridian Bioscience, Inc.,	)	Ser. No. 77768176
	)	
Applicant.	)	

AMENDED NOTICE OF OPPOSITION

Illumina, Inc. ("Opposer") is or will be damaged by the registration of the mark ILLUMIPRO, which is set forth in application Ser. No. 77768176 and owned by Meridian Bioscience, Inc. ("Applicant"), and hereby opposes the same.

As grounds for the opposition, Opposer, by its attorneys, avers as follows:

1. On June 25, 2009, Applicant submitted application Ser. No. 77768176 (hereinafter the "opposed application") to the United States Patent and Trademark Office.

2. On November 24, 2009, the opposed application was published for opposition.

3. On December 14, 2009, Opposer timely filed a request for a 90-day extension of time to oppose the opposed application. This request was granted by the Board on that same day.

4. Opposer is the owner of several marks using the prefix ILLUMI– for a variety of goods used for scientific and medical research and for clinical diagnostics as well as for information services related thereto and laboratory certification services. Opposer is also the

owner of incontestable United States trademark registrations, Reg. Nos. 2632507, 2756703, and 2471539, for the mark ILLUMINA; and United States trademark application Ser. No. 77747038 for the mark ILLUMINADX (Collectively, and with the marks cited in Paragraphs 6, 7 and 8, *infra*, "Opposer's ILLUMI Family of Marks"). Print-outs from the United States Patent and Trademark Office's TARR database and ASSIGN database satisfying the requirements of 37 C.F.R. § 2.122(d) for submitting a current status and title copy of the pleaded registrations, Reg. Nos. 2632507, 2756703, and 2471539 to make them of record, are submitted herewith.

5. Opposer's pleaded registrations, Reg. Nos. 2632507, 2756703, and 2471539 all issued prior to the filing date of the opposed application. In addition, the filing date of Opposer's Application Ser. No. 77747038 precedes the filing date of the opposed application.

6. Opposer is the owner of the mark ILLUMICODE, which it uses in connection with DNA microarrays. Opposer has been using the mark ILLUMICODE in commerce since at least as early as August of 2002, and before any actual use or constructive use of the mark set forth in the opposed application.

7. Opposer is the owner of the mark ILLUMINA CONNECT, which it uses in connection with providing an online forum for users of Opposer's goods to sharing information about innovative ways to use of Opposer's goods for DNA and RNA sequencing for scientific and medical research and for clinical diagnostics. Opposer has been using the mark ILLUMINA CONNECT since at least as early as January of 2007, and before any actual use or constructive use of the mark set forth in the opposed application.

8. Opposer is the owner of the mark ILLUMINOTES which is used in connection with newsletters that provides in-depth and timely information about Opposer's systems, assays

and software, product updates, technical document updates, conference workshops, and webinars.

9. Since well prior to either the filing date of the opposed application or Applicant's first use of the mark set forth in the opposed application, Opposer has been using Opposer's ILLUMI Family of Marks in connection with molecular tests, systems and services for diagnostic purposes, for selection of appropriate therapies and for monitoring of disease progression.

10. The goods set forth in the opposed application are closely related to the goods and services Opposer offers in connection with Opposer's ILLUMI Family of Marks including those set forth in the registrations and applications listed in Paragraph 4 and those specified in Paragraphs 6 through 9.

11. The conditions surrounding the marketing of the goods and services Opposer offers in connection with Opposer's ILLUMI Family of Marks including those set forth in the registrations and applications listed in Paragraph 4 and those specified in Paragraphs 6 through 9, and the conditions surrounding the marketing of the goods set forth in the opposed application are such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the parties' goods and/or services come from a common source.

11. The mark set forth in the opposed application is confusingly similar to Opposer's ILLUMI Family of Marks.

12. Opposer's ILLUMI Family of Marks were first used in commerce prior to any actual use or constructive use of the mark set forth in the opposed application, with the exception of Opposer's Application Ser. No. 77747038 which has an earlier filing date as noted supra.

13. Opposer has not abandoned Opposer's ILLUMI Family of Marks.

14. Having made its pleaded registrations of record, Opposer has standing to oppose the opposed application and priority is not an issue in this opposition.

15. Opposer will be damaged by the issuance of a registration based on the opposed application. Specifically, the mark set forth in the opposed application consists of or comprises a mark which so resembles Opposer's ILLUMI Family of Marks as to be likely to cause confusion, or to cause mistake, or to deceive, under Trademark Act Section 2(d), 15 U.S.C. § 1052(d).

16. Lastly, registration of the mark set forth in the opposed application should be refused pursuant to 15 U.S.C. § 1052(a), on the grounds that any use by Applicant of the mark ILLUMIPRO will falsely suggest a connection between Applicant and Opposer named herein, to the damage of Opposer.

WHEREFORE, Opposer requests that the opposed application, Ser. No. 77768176, be refused registration.

The required filing fee was previously submitted and it is believed that no further fees are due.

Respectfully submitted,

ILLUMINA, INC.

By: _____
James R. Menker
Gabrielle A. Holley

Opposer's Attorneys

Holley & Menker, P.A.
PO Box 96

Solana Beach, CA 92075
(858) 353-9285
westdocket@holleymenker.com

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Amended Notice of Opposition with attached registration records has been served on Applicant's attorney, J. Michael Hurst of Keating Meuthing & Klekamp PLL, at the address of record, One East 4th Street, Suite 1400, Cincinnati, OH 45202-3752, via first class mail, postage prepaid, today **December 8, 2010**.

Signed: _____
Laura K. Greer

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

This page was generated by the TARR system on 2010-12-08 14:49:55 ET

Serial Number: 75982227 Assignment Information Trademark Document Retrieval

Registration Number: 2632507

Mark (words only): ILLUMINA

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2007-12-13

Filing Date: 2000-08-18

Transformed into a National Application: No

Registration Date: 2002-10-08

Register: Principal

Law Office Assigned: LAW OFFICE 105

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

Current Location: 40S -Scanning On Demand

Date In Location: 2008-02-06

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Illumina, Inc.

Address:
Illumina, Inc.
9885 Towne Center Drive
San Diego, CA 92121
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 001
Class Status: Active
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-put screening
Basis: 1(a)
First Use Date: 2001-02-23
First Use in Commerce Date: 2001-02-23

International Class: 042
Class Status: Active
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
Basis: 1(a)
First Use Date: 2001-10-12
First Use in Commerce Date: 2001-10-12

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-02-06 - Case File In TICRS

2007-12-13 - Section 8 (6-year) accepted & Section 15 acknowledged

2007-12-12 - Assigned To Paralegal

2007-12-10 - TEAS Section 8 & 15 Received

2006-04-13 - TEAS Change Of Correspondence Received

2002-10-08 - Registered - Principal Register

2002-04-16 - Allowed for Registration - Principal Register (SOU accepted)

2002-04-12 - Assigned To Examiner

2002-03-28 - Statement Of Use Processing Complete

2002-02-28 - Use Amendment Filed

2002-03-28 - Divisional processing completed

2002-02-28 - Divisional request received

2001-08-28 - NOA Mailed - SOU Required From Applicant

2001-06-05 - Published for opposition

2001-05-23 - Notice of publication

2001-01-16 - Approved For Pub - Principal Register

2001-01-10 - Assigned To Examiner

2001-01-03 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Gabrielle A. Holley

Correspondent
Gabrielle A. Holley
Holley & Menker, P.A.
P.O. Box 96
Solana Beach CA 92075
Phone Number: 858 353 9285
Fax Number: 858 876 1604

United States Patent and Trademark Office

Assignments on the Web > Trademark Query

No assignment has been recorded at the USPTO

For Serial Number: 75982227

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.1
Web interface last modified: Apr 30, 2009 v.2.1

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

This page was generated by the TARR system on 2010-12-08 14:50:21 ET

Serial Number: 76112547 Assignment Information Trademark Document Retrieval

Registration Number: 2756703

Mark (words only): ILLUMINA

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2008-09-23

Filing Date: 2000-08-18

Transformed into a National Application: No

Registration Date: 2003-08-26

Register: Principal

Law Office Assigned: LAW OFFICE 105

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

Current Location: 830 -Post Registration

Date In Location: 2008-09-23

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Illumina, Inc.

Address:
Illumina, Inc.
9885 Towne Center Drive
San Diego, CA 92121
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 009
Class Status: Active
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
Basis: 1(a)
First Use Date: 2003-01-09
First Use in Commerce Date: 2003-01-09

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-09-23 - Section 8 (6-year) accepted & Section 15 acknowledged

2008-09-17 - TEAS Section 8 & 15 Received

2008-02-27 - Attorney Revoked And/Or Appointed

2008-02-27 - TEAS Revoke/Appoint Attorney Received

2008-01-18 - Case File In TICRS

2006-04-13 - TEAS Change Of Correspondence Received

2003-08-26 - Registered - Principal Register

2003-06-24 - Allowed for Registration - Principal Register (SOU accepted)

2003-06-03 - Assigned To Examiner

2003-05-30 - Statement Of Use Processing Complete

2003-02-26 - Use Amendment Filed

2003-03-03 - PAPER RECEIVED

2002-12-09 - Extension 2 granted

2002-10-11 - PAPER RECEIVED

2002-08-06 - Extension 2 filed

2002-08-06 - PAPER RECEIVED

2002-03-28 - Extension 1 granted

2002-02-28 - Extension 1 filed

2002-03-28 - Divisional processing completed

2002-02-28 - Divisional request received

2001-08-28 - NOA Mailed - SOU Required From Applicant

2001-06-05 - Published for opposition

2001-05-23 - Notice of publication

2001-01-16 - Approved For Pub - Principal Register

2001-01-10 - Assigned To Examiner

2001-01-03 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
Gabrielle A. Holley

Correspondent
Gabrielle A. Holley
Holley & Menker, P.A.
P.O. Box 96
Solana Beach CA 92075
Phone Number: 858 353 9285
Fax Number: 858 876 1604

United States Patent and Trademark Office

Assignments on the Web > Trademark Query

Trademark Assignment Abstract of Title

Total Assignments: 1

Serial #: 76112547 **Filing Dt:** 08/18/2000 **Reg #:** 2756703 **Reg. Dt:** 08/26/2003

Registrant: Illumina, Inc.

Mark: ILLUMINA

Assignment: 1

Reel/Frame: 2633/0270 **Received:** 12/13/2002 **Recorded:** 12/10/2002 **Pages:** 5

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: ILLUMINA, INC.
Exec Dt: 11/21/2002
Entity Type: CORPORATION
Citizenship: CALIFORNIA

Assignee: ILLUMINA, INC.
9885 TOWNE CENTER DRIVE
SAN DIEGO, CALIFORNIA 92121
Entity Type: CORPORATION
Citizenship: DELAWARE

Correspondent: DORSEY & WHITNEY LLP
DIANE J. MASON
FOUR EMBARCADERO CENTER, SUITE 3400
SAN FRANCISCO, CA 94111-4187

Search Results as of: 12/08/2010 02:50 PM

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.1
Web interface last modified: Apr 30, 2009 v.2.1

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

This page was generated by the TARR system on 2010-12-08 14:50:51 ET

Serial Number: 76072152 Assignment Information Trademark Document Retrieval

Registration Number: 2471539

Mark (words only): ILLUMINA

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2007-07-06

Filing Date: 2000-06-15

Transformed into a National Application: No

Registration Date: 2001-07-24

Register: Principal

Law Office Assigned: LAW OFFICE 105

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

Current Location: 830 -Post Registration

Date In Location: 2007-07-06

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Illumina, Inc.

Address:
Illumina, Inc.
9885 Towne Centre Drive
San Diego, CA 92121
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 040
Class Status: Active
Developing, to the order and specification of others, biological and/or chemical sensing systems which use random array technology to identify inorganic and organic molecules, compounds and substances
Basis: 1(a)
First Use Date: 1999-02-00
First Use in Commerce Date: 1999-02-00

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2007-07-06 - Section 8 (6-year) accepted & Section 15 acknowledged

2007-06-29 - Assigned To Paralegal

2007-06-01 - Section 8 (6-year) and Section 15 Filed

2007-06-01 - TEAS Section 8 & 15 Received

2007-02-20 - Case File In TICRS

2006-04-13 - TEAS Change Of Correspondence Received

2003-08-02 - Section 7 request abandoned

2002-09-24 - Post Registration action mailed - Section 7

2002-06-17 - Section 7 amendment filed

2001-07-24 - Registered - Principal Register

2001-05-01 - Published for opposition

2001-04-18 - Notice of publication

2000-11-15 - Approved for Pub - Principal Register (Initial exam)

2000-11-14 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
Gabrielle A. Holley

Correspondent
Gabrielle A. Holley
Pillsbury Winthrop Shaw Pittman LLP
Suite 300
12255 El Camino Real
San Diego CA 92130
Phone Number: 858-509-4009
Fax Number: 858-509-4010

United States Patent and Trademark Office

Assignments on the Web > Trademark Query

Trademark Assignment Abstract of Title

Total Assignments: 1

Serial #: 76072152 **Filing Dt:** 06/15/2000 **Reg #:** 2471539 **Reg. Dt:** 07/24/2001

Registrant: Illumina, Inc.

Mark: ILLUMINA

Assignment: 1

Reel/Frame: 2633/0270 **Received:** 12/13/2002 **Recorded:** 12/10/2002 **Pages:** 5

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: ILLUMINA, INC.

Exec Dt: 11/21/2002

Entity Type: CORPORATION

Citizenship: CALIFORNIA

Assignee: ILLUMINA, INC.
9885 TOWNE CENTER DRIVE
SAN DIEGO, CALIFORNIA 92121

Entity Type: CORPORATION

Citizenship: DELAWARE

Correspondent: DORSEY & WHITNEY LLP
DIANE J. MASON
FOUR EMBARCADERO CENTER, SUITE 3400
SAN FRANCISCO, CA 94111-4187

Search Results as of: 12/08/2010 02:50 PM

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.1
Web interface last modified: Apr 30, 2009 v.2.1

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

Illumina, Inc.,	)	
	)	
Opposer,	)	Opposition No. 91194218 (parent)
	)	Opposition No. 91194219
v.	)	
	)	Ser. No. 77775316
Meridian Bioscience, Inc.,	)	
	)	
Applicant.	)	

AMENDED NOTICE OF OPPOSITION

Illumina, Inc. ("Opposer") is or will be damaged by the registration of the mark ILLUMIPRO-10, which is set forth in application Ser. No. 77775316 and owned by Meridian Bioscience, Inc. ("Applicant"), and hereby opposes the same.

As grounds for the opposition, Opposer, by its attorneys, avers as follows:

1. On June 25, 2009, Applicant submitted application Ser. No. 77775316 (hereinafter the "opposed application") to the United States Patent and Trademark Office.

2. On December 1, 2009, the opposed application was published for opposition.

3. On December 14, 2009, Opposer timely filed a request for a 90-day extension of time to oppose the opposed application. This request was granted by the Board on that same day.

4. Opposer is the owner of several marks using the prefix ILLUMI– for a variety of goods used for scientific and medical research and for clinical diagnostics as well as for information services related thereto and laboratory certification services. Opposer is also the

owner of incontestable United States trademark registrations, Reg. Nos. 2632507, 2756703, and 2471539, for the mark ILLUMINA; and United States trademark application Ser. No. 77747038 for the mark ILLUMINADX (Collectively, and with the marks cited in Paragraphs 6, 7 and 8, *infra*, "Opposer's ILLUMI Family of Marks"). Print-outs from the United States Patent and Trademark Office's TARR database and ASSIGN database satisfying the requirements of 37 C.F.R. § 2.122(d) for submitting a current status and title copy of the pleaded registrations, Reg. Nos. 2632507, 2756703, and 2471539 to make them of record, are submitted herewith.

5. Opposer's pleaded registrations, Reg. Nos. 2632507, 2756703, and 2471539 all issued prior to the filing date of the opposed application. In addition, the filing date of Opposer's Application Ser. No. 77747038 precedes the filing date of the opposed application.

6. Opposer is the owner of the mark ILLUMICODE, which it uses in connection with DNA microarrays. Opposer has been using the mark ILLUMICODE in commerce since at least as early as August of 2002, and before any actual use or constructive use of the mark set forth in the opposed application.

7. Opposer is the owner of the mark ILLUMINA CONNECT, which it uses in connection with providing an online forum for users of Opposer's goods to sharing information about innovative ways to use of Opposer's goods for DNA and RNA sequencing for scientific and medical research and for clinical diagnostics. Opposer has been using the mark ILLUMINA CONNECT since at least as early as January of 2007, and before any actual use or constructive use of the mark set forth in the opposed application.

8. Opposer is the owner of the mark ILLUMINOTES which is used in connection with newsletters that provides in-depth and timely information about Opposer's systems, assays

and software, product updates, technical document updates, conference workshops, and webinars.

9. Since well prior to either the filing date of the opposed application or Applicant's first use of the mark set forth in the opposed application, Opposer has been using Opposer's ILLUMI Family of Marks in connection with molecular tests, systems and services for diagnostic purposes, for selection of appropriate therapies and for monitoring of disease progression.

10. The goods set forth in the opposed application are closely related to the goods and services Opposer offers in connection with Opposer's ILLUMI Family of Marks including those set forth in the registrations and applications listed in Paragraph 4 and those specified in Paragraphs 6 through 9.

11. The conditions surrounding the marketing of the goods and services Opposer offers in connection with Opposer's ILLUMI Family of Marks including those set forth in the registrations and applications listed in Paragraph 4 and those specified in Paragraphs 6 through 9, and the conditions surrounding the marketing of the goods set forth in the opposed application are such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the parties' goods and/or services come from a common source.

11. The mark set forth in the opposed application is confusingly similar to Opposer's ILLUMI Family of Marks.

12. Opposer's ILLUMI Family of Marks were first used in commerce prior to any actual use or constructive use of the mark set forth in the opposed application, with the exception of Opposer's Application Ser. No. 77747038 which has an earlier filing date as noted supra.

13. Opposer has not abandoned Opposer's ILLUMI Family of Marks.

14. Having made its pleaded registrations of record, Opposer has standing to oppose the opposed application and priority is not an issue in this opposition.

15. Opposer will be damaged by the issuance of a registration based on the opposed application. Specifically, the mark set forth in the opposed application consists of or comprises a mark which so resembles Opposer's ILLUMI Family of Marks as to be likely to cause confusion, or to cause mistake, or to deceive, under Trademark Act Section 2(d), 15 U.S.C. § 1052(d).

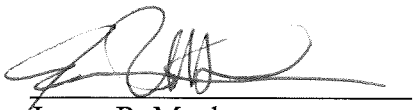
16. Lastly, registration of the mark set forth in the opposed application should be refused pursuant to 15 U.S.C. § 1052(a), on the grounds that any use by Applicant of the mark ILLUMIPRO-10 will falsely suggest a connection between Applicant and Opposer named herein, to the damage of Opposer.

WHEREFORE, Opposer requests that the opposed application, Ser. No. 77775316, be refused registration.

The required filing fee was previously submitted and it is believed that no further fees are due.

Respectfully submitted,

ILLUMINA, INC.

By: 

James R. Menker
Gabrielle A. Holley

Opposer's Attorneys

Holley & Menker, P.A.
PO Box 96

Solana Beach, CA 92075
(858) 353-9285
westdocket@holleymenker.com

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Amended Notice of Opposition with attached registration records has been served on Applicant's attorney, J. Michael Hurst of Keating Meuthing & Klekamp PLL, at the address of record, One East 4th Street, Suite 1400, Cincinnati, OH 45202-3752, via first class mail, postage prepaid, today **December 8, 2010**.

Signed: _____
Laura K. Greer

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Serial Number: 75982227 Assignment Information Trademark Document Retrieval

Registration Number: 2632507

Mark (words only): ILLUMINA

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2007-12-13

Filing Date: 2000-08-18

Transformed into a National Application: No

Registration Date: 2002-10-08

Register: Principal

Law Office Assigned: LAW OFFICE 105

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

Current Location: 40S -Scanning On Demand

Date In Location: 2008-02-06

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1. Illumina, Inc.

Address:
Illumina, Inc.
9885 Towne Center Drive
San Diego, CA 92121
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 001
Class Status: Active
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-put screening
Basis: 1(a)
First Use Date: 2001-02-23
First Use in Commerce Date: 2001-02-23

International Class: 042
Class Status: Active
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
Basis: 1(a)
First Use Date: 2001-10-12
First Use in Commerce Date: 2001-10-12

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-02-06 - Case File In TICRS

2007-12-13 - Section 8 (6-year) accepted & Section 15 acknowledged

2007-12-12 - Assigned To Paralegal

2007-12-10 - TEAS Section 8 & 15 Received

2006-04-13 - TEAS Change Of Correspondence Received

2002-10-08 - Registered - Principal Register

2002-04-16 - Allowed for Registration - Principal Register (SOU accepted)

2002-04-12 - Assigned To Examiner

2002-03-28 - Statement Of Use Processing Complete

2002-02-28 - Use Amendment Filed

2002-03-28 - Divisional processing completed

2002-02-28 - Divisional request received

2001-08-28 - NOA Mailed - SOU Required From Applicant

2001-06-05 - Published for opposition

2001-05-23 - Notice of publication

2001-01-16 - Approved For Pub - Principal Register

2001-01-10 - Assigned To Examiner

2001-01-03 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Gabrielle A. Holley

Correspondent
Gabrielle A. Holley
Holley & Menker, P.A.
P.O. Box 96
Solana Beach CA 92075
Phone Number: 858 353 9285
Fax Number: 858 876 1604

United States Patent and Trademark Office

Assignments on the Web > Trademark Query

No assignment has been recorded at the USPTO

For Serial Number: 75982227

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.1
Web interface last modified: Apr 30, 2009 v.2.1

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

This page was generated by the TARR system on 2010-12-08 14:50:21 ET

Serial Number: 76112547 Assignment Information Trademark Document Retrieval

Registration Number: 2756703

Mark (words only): ILLUMINA

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2008-09-23

Filing Date: 2000-08-18

Transformed into a National Application: No

Registration Date: 2003-08-26

Register: Principal

Law Office Assigned: LAW OFFICE 105

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

Current Location: 830 -Post Registration

Date In Location: 2008-09-23

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Illumina, Inc.

Address:
Illumina, Inc.
9885 Towne Center Drive
San Diego, CA 92121
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 009
Class Status: Active
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
Basis: 1(a)
First Use Date: 2003-01-09
First Use in Commerce Date: 2003-01-09

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-09-23 - Section 8 (6-year) accepted & Section 15 acknowledged

2008-09-17 - TEAS Section 8 & 15 Received

2008-02-27 - Attorney Revoked And/Or Appointed

2008-02-27 - TEAS Revoke/Appoint Attorney Received

2008-01-18 - Case File In TICRS

2006-04-13 - TEAS Change Of Correspondence Received

2003-08-26 - Registered - Principal Register

2003-06-24 - Allowed for Registration - Principal Register (SOU accepted)

2003-06-03 - Assigned To Examiner

2003-05-30 - Statement Of Use Processing Complete

2003-02-26 - Use Amendment Filed

2003-03-03 - PAPER RECEIVED

2002-12-09 - Extension 2 granted

2002-10-11 - PAPER RECEIVED

2002-08-06 - Extension 2 filed

2002-08-06 - PAPER RECEIVED

2002-03-28 - Extension 1 granted

2002-02-28 - Extension 1 filed

2002-03-28 - Divisional processing completed

2002-02-28 - Divisional request received

2001-08-28 - NOA Mailed - SOU Required From Applicant

2001-06-05 - Published for opposition

2001-05-23 - Notice of publication

2001-01-16 - Approved For Pub - Principal Register

2001-01-10 - Assigned To Examiner

2001-01-03 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
Gabrielle A. Holley

Correspondent
Gabrielle A. Holley
Holley & Menker, P.A.
P.O. Box 96
Solana Beach CA 92075
Phone Number: 858 353 9285
Fax Number: 858 876 1604

United States Patent and Trademark Office

Assignments on the Web > Trademark Query

Trademark Assignment Abstract of Title

Total Assignments: 1

Serial #: 76112547 **Filing Dt:** 08/18/2000 **Reg #:** 2756703 **Reg. Dt:** 08/26/2003

Registrant: Illumina, Inc.

Mark: ILLUMINA

Assignment: 1

Reel/Frame: 2633/0270 **Received:** 12/13/2002 **Recorded:** 12/10/2002 **Pages:** 5

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: ILLUMINA, INC.
Exec Dt: 11/21/2002
Entity Type: CORPORATION
Citizenship: CALIFORNIA

Assignee: ILLUMINA, INC.
9885 TOWNE CENTER DRIVE
SAN DIEGO, CALIFORNIA 92121
Entity Type: CORPORATION
Citizenship: DELAWARE

Correspondent: DORSEY & WHITNEY LLP
DIANE J. MASON
FOUR EMBARCADERO CENTER, SUITE 3400
SAN FRANCISCO, CA 94111-4187

Search Results as of: 12/08/2010 02:50 PM

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Web interface last modified: Apr 30, 2009 v.2.1

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

This page was generated by the TARR system on 2010-12-08 14:50:51 ET

Serial Number: 76072152 Assignment Information Trademark Document Retrieval

Registration Number: 2471539

Mark (words only): ILLUMINA

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2007-07-06

Filing Date: 2000-06-15

Transformed into a National Application: No

Registration Date: 2001-07-24

Register: Principal

Law Office Assigned: LAW OFFICE 105

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

Current Location: 830 -Post Registration

Date In Location: 2007-07-06

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Illumina, Inc.

Address:
Illumina, Inc.
9885 Towne Centre Drive
San Diego, CA 92121
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 040
Class Status: Active
Developing, to the order and specification of others, biological and/or chemical sensing systems which use random array technology to identify inorganic and organic molecules, compounds and substances
Basis: 1(a)
First Use Date: 1999-02-00
First Use in Commerce Date: 1999-02-00

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2007-07-06 - Section 8 (6-year) accepted & Section 15 acknowledged

2007-06-29 - Assigned To Paralegal

2007-06-01 - Section 8 (6-year) and Section 15 Filed

2007-06-01 - TEAS Section 8 & 15 Received

2007-02-20 - Case File In TICRS

2006-04-13 - TEAS Change Of Correspondence Received

2003-08-02 - Section 7 request abandoned

2002-09-24 - Post Registration action mailed - Section 7

2002-06-17 - Section 7 amendment filed

2001-07-24 - Registered - Principal Register

2001-05-01 - Published for opposition

2001-04-18 - Notice of publication

2000-11-15 - Approved for Pub - Principal Register (Initial exam)

2000-11-14 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
Gabrielle A. Holley

Correspondent
Gabrielle A. Holley
Pillsbury Winthrop Shaw Pittman LLP
Suite 300
12255 El Camino Real
San Diego CA 92130
Phone Number: 858-509-4009
Fax Number: 858-509-4010

United States Patent and Trademark Office

Assignments on the Web > Trademark Query

Trademark Assignment Abstract of Title

Total Assignments: 1

Serial #: 76072152 **Filing Dt:** 06/15/2000 **Reg #:** 2471539 **Reg. Dt:** 07/24/2001

Registrant: Illumina, Inc.

Mark: ILLUMINA

Assignment: 1

Reel/Frame: 2633/0270 **Received:** 12/13/2002 **Recorded:** 12/10/2002 **Pages:** 5

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: ILLUMINA, INC.

Exec Dt: 11/21/2002

Entity Type: CORPORATION

Citizenship: CALIFORNIA

Assignee: ILLUMINA, INC.
9885 TOWNE CENTER DRIVE
SAN DIEGO, CALIFORNIA 92121

Entity Type: CORPORATION

Citizenship: DELAWARE

Correspondent: DORSEY & WHITNEY LLP
DIANE J. MASON
FOUR EMBARCADERO CENTER, SUITE 3400
SAN FRANCISCO, CA 94111-4187

Search Results as of: 12/08/2010 02:50 PM

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.1
Web Interface last modified: Apr 30, 2009 v.2.1