

ESTTA Tracking number: **ESTTA338197**

Filing date: **03/19/2010**

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

Notice of Opposition

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

Opposer Information

Name	Illumina, Inc.
Granted to Date of previous extension	03/31/2010
Address	9885 Towne Centre Drive San Diego, CA 92121 UNITED STATES

Attorney information	Gabrielle A. Holley Holley & Menker, P.A. P.O. Box 96 Solana Beach, CA 92075 UNITED STATES westdocket@holleymenker.com Phone:858 353 9285
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Applicant Information

Application No	77775316	Publication date	12/01/2009
Opposition Filing Date	03/19/2010	Opposition Period Ends	03/31/2010
Applicant	Meridian Bioscience, Inc. 3471 River Hills Drive Cincinnati, OH 452443091 UNITED STATES		

Goods/Services Affected by Opposition

Class 010. All goods and services in the class are opposed, namely: 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
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Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2632507	Application Date	08/18/2000
Registration Date	10/08/2002	Foreign Priority Date	NONE
Word Mark	ILLUMINA		

Design Mark	ILLUMINA
Description of Mark	NONE
Goods/Services	Class 001. First use: First Use: 2001/02/23 First Use In Commerce: 2001/02/23 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 Class 042. First use: First Use: 2001/10/12 First Use In Commerce: 2001/10/12 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

U.S. Registration No.	2756703	Application Date	08/18/2000
Registration Date	08/26/2003	Foreign Priority Date	NONE
Word Mark	ILLUMINA		
Design Mark	ILLUMINA		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2003/01/09 First Use In Commerce: 2003/01/09 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		

U.S. Registration No.	2471539	Application Date	06/15/2000
Registration Date	07/24/2001	Foreign Priority Date	NONE
Word Mark	ILLUMINA		
Design Mark	ILLUMINA		

Description of Mark	NONE
Goods/Services	Class 040. First use: First Use: 1999/02/00 First Use In Commerce: 1999/02/00 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

U.S. Application No.	77747038	Application Date	05/28/2009
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	ILLUMINADX
Design Mark	

Description of Mark	NONE
Goods/Services	<p>Class 005. First use: Clinical diagnostic reagents, reagent kits, and beads with attached biomolecules, comprised primarily of enzymes, oligonucleotides and other nucleic acids, natural and modified nucleotides, buffers, labels, and substrates, for clinical diagnostic purposes</p> <p>Class 009. First use: Clinical diagnostic instruments, namely nucleic acid sequencers, imaging devices and analyzers for use in scientific, diagnostic and clinical research and for clinical diagnostic purposes; laboratory equipment, namely fluid containers, fluid mixers, fluid control valves and temperature-controlled incubators for sample preparation, amplification, mixing, hybridization, incubation, and washing; automated laboratory apparatus and systems, namely sample loaders and bar code readers; computer systems, namely computer hardware, computer software, and data files for collecting, storing, analyzing and reporting biological information, and for sample tracking and managing projects, laboratory workflow and data, all the foregoing for use in the fields of scientific, diagnostic and clinical research and for clinical diagnostic purposes</p> <p>Class 044. First use: Clinical diagnostic services in preparing, amplifying, labeling, detecting, analyzing and sequencing nucleic acids and other biological molecules from human beings or animals</p>

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	ILLUMICODE		
Goods/Services	DNA microarrays		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	ILLUMINACONNECT		
Goods/Services	online forum for sharing information about DNA sequencing		

Related Proceedings	Contemporaneously filing a notice of opposition to ILLUMIPRO, SN 77768167
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Attachments	75982227#TMSN.gif (1 page)(bytes) 76112547#TMSN.gif (1 page)(bytes) 76072152#TMSN.gif (1 page)(bytes) 77747038#TMSN.jpeg (1 page)(bytes) Notice of Opposition 7775316 ILLUMIPRO-10.pdf (5 pages)(166625 bytes) 2471539 TARR.pdf (3 pages)(56265 bytes) 2471539 Assign.pdf (1 page)(116342 bytes) 2632507 TARR.pdf (3 pages)(56504 bytes) 2632507 Assign.pdf (1 page)(101423 bytes) 2756703 TARR.pdf (4 pages)(57912 bytes) 2756703 Assign.pdf (1 page)(117117 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/GAHolley/
Name	Gabrielle A. Holley
Date	03/19/2010

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

Illumina, Inc.,)	
)	
Opposer,)	
)	Opposition No. _____
v.)	
)	Ser. No. 77775316
Meridian Bioscience, Inc.,)	
)	
Applicant.)	

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 the several marks using the prefix ILLUMI for a variety of scientific and medical goods and services and is the owner of incontestable United States trademark 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 and 7, infra, “Opposer’s ILLUMI 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 ILLUMINACONNECT, which it uses in connection with an online forum for sharing information about DNA sequencing. Opposer has been using the mark ILLUMINACONNECT 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. The mark set forth in the opposed application is confusingly similar to Opposer’s ILLUMI Marks.

9. The goods set forth in the opposed application are closely related to the goods and services set forth in the registrations and applications listed in Paragraph 1, and to the goods and services used in connection with the trademarks cited in Paragraphs 6 and 7.

10. The conditions surrounding the marketing of the goods and services set forth in registrations and applications cited in Paragraph 1, and the goods and services used in connection with the trademarks cited in Paragraphs 6 and 7, 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 goods and/or services come from a common source.

11. Opposer's ILLUMI 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.

12. Opposer has not abandoned Opposer's ILLUMI Marks.

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

14. 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 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).

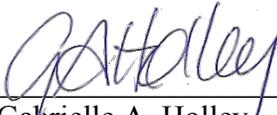
15. Lastly, registration of the mark set forth in the opposed application should be refused pursuant to 15 U.S.C. § 1052(a), on the grounds that any use by Applicant of the mark ILLUMIPRO-10 will falsely suggest a connection between Applicant and Opposer named herein, to the damage of Opposer.

WHEREFORE, Opposer requests that the opposed application, Ser. No. 7775316, be refused registration.

The required filing fee is submitted herewith.

Respectfully submitted,

Illumina, Inc.

By: 

Gabrielle A. Holley
James R. Menker

Opposer's Attorneys
Holley & Menker, P.A.
PO Box 96
Solana Beach, CA 92075
(858) 353-9285
westdocket@hollymenker.com

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Notice of Opposition with attached registration records has been served on Applicant's attorney, Patricia B. Hogan, 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 March 19, 2010.

Signed: 
Gabrielle A. Holley

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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



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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**Entity Type:** CORPORATION**Citizenship:** DELAWARE**Assignee:** [ILLUMINA, INC.](#)9885 TOWNE CENTER DRIVE
SAN DIEGO, CALIFORNIA 92121**Correspondent:** DORSEY & WHITNEY LLPDIANE J. MASON
FOUR EMBARCADERO CENTER, SUITE 3400
SAN FRANCISCO, CA 94111-4187

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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](#)

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 - Amendment to Use 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 (Initial exam)

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



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For Serial Number: 75982227

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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](#)

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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 - Amendment to Use 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 (Initial exam)
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



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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

Entity Type: CORPORATION

Citizenship: DELAWARE

Assignee: [ILLUMINA, INC.](#)9885 TOWNE CENTER DRIVE
SAN DIEGO, CALIFORNIA 92121

Correspondent: DORSEY & WHITNEY LLP

DIANE J. MASON
FOUR EMBARCADERO CENTER, SUITE 3400
SAN FRANCISCO, CA 94111-4187

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