

ESTTA Tracking number: **ESTTA425721**

Filing date: **08/17/2011**

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	Avista Technologies, Inc.
Granted to Date of previous extension	08/17/2011
Address	140 Bosstick Blvd. San Marcos, CA 92069 UNITED STATES
Attorney information	Katherine M. Hoffman Luce, Forward, Hamilton & Scripps, LLP 600 West Broadway, Suite 2600 San Diego, CA 92101 UNITED STATES khoffman@luce.com, sedge@luce.com, clopez@luce.com Phone:619-533-7392

Applicant Information

Application No	77531903	Publication date	04/19/2011
Opposition Filing Date	08/17/2011	Opposition Period Ends	08/17/2011
Applicant	bioMÃ©rieux, Inc. 100 Rodolphe Street Durham, NC 27712 UNITED STATES		

Goods/Services Affected by Opposition

Class 001. First Use: 2008/01/01 First Use In Commerce: 2008/01/01
All goods and services in the class are opposed, namely: Chemicals for use in industry and science, namely, chemical solutions, reagents and diagnostic test kits consisting primarily of reagents, test cards, and applicator sticks to control and detect contaminating substances in industrial, agricultural, cosmetic and pharmaceutical products for scientific research use

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3045716	Application Date	11/18/2004
Registration Date	01/17/2006	Foreign Priority Date	NONE
Word Mark	VITEC		

Design Mark	VITEC
Description of Mark	NONE
Goods/Services	Class 001. First use: First Use: 1999/06/00 First Use In Commerce: 1999/11/08 Water treatment chemicals, namely anti-scalants

Attachments	78519566#TMSN.jpeg (1 page)(bytes) Vitek Opposition Notice.pdf (5 pages)(346678 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	/Katherine M. Hoffman/
Name	Katherine M. Hoffman
Date	08/17/2011

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2 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
3 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**
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6 In re:

7 Applicant's Mark: VITEK

8 Serial No.: 77/531,903

9 Filed: July 25, 2008

10 Published: In the Official Gazette on April 19, 2011
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12

13 Avista Technologies, Inc.,)

14 Opposer,)

15 vs.)

16 bioMérieux, Inc.,)

17 Applicant.)
18

OPPOSITION NO. _____

NOTICE OF OPPOSITION

19 Opposer: Avista Technologies, Inc.

20 Citizenship: California corporation

21 Address: 140 Bosstick Boulevard
22 San Marcos, California 92069

23 Avista Technologies, Inc. ("Opposer") believes that it will be damaged by registration of
24 the mark shown in Serial No. 77/531,903 (the "Application"), and hereby opposes same. The
25 grounds for the opposition are as follows:

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- 1 1. Opposer is a California corporation having its principal office at 140 Bosstick
2 Boulevard, San Marcos, California 92069.
- 3 2. Upon information and belief, bioMérieux, Inc. (“Applicant”) is a Missouri
4 corporation having a place of business at 100 Rodolphe Street, Durham, North
5 Carolina 27712.
- 6 3. Opposer is the owner of and has used the mark VITEC (“Opposer’s Mark”), which
7 is the subject of Registration No. 3,045,716, in interstate commerce with goods
8 including “Water treatment chemicals, namely anti-scalants” (“Opposer’s Goods”).
- 9 4. Applicant seeks to register the mark VITEK (“Applicant’s Mark”) in connection
10 with “Chemicals for use in industry and science, namely, chemical solutions,
11 reagents and diagnostic test kits consisting primarily of reagents, test cards, and
12 applicator sticks to control and detect contaminating substances in industrial,
13 agricultural, cosmetic and pharmaceutical products for scientific research use, in
14 Class 01; (“Applicant’s Goods”).
- 15 5. Opposer has used Opposer’s Mark in interstate commerce with Opposer’s Goods
16 since at least June 1999, a date long that is prior to Applicant’s alleged date of first
17 use of January 1, 2008, and prior to the filing date of the Application of June 25,
18 2008.
- 19 6. Upon information and belief, neither Applicant nor any predecessor of Applicant
20 has made any actual or constructive use of Applicant’s Mark prior to June 25,
21 2008, the filing date of the Application.
- 22 7. Upon information and belief, neither Applicant nor any predecessor of Applicant
23 has made any actual or constructive use of Applicant’s Mark prior to January 1,
24 2008, the date of first use identified in the Application.
- 25 8. Applicant’s Mark is similar to Opposer’s Mark in appearance, sound and meaning.
- 26 9. Applicant’s Mark VITEK is phonetically the same as Opposer’s Mark, VITEC.
- 27 10. Applicant’s Goods are related to Opposer’s Goods in that the parties’ respective
28 goods are provided to the same or similar class of purchasers, and are available for

1 sale through the same or similar channels of trade.

2 11. Applicant's use and registration of Applicant's Mark are likely to cause confusion
3 and lead consumers to believe that Applicant and Opposer are related to, associated
4 with and/or sponsored by one another.

5 12. Opposer's Mark is inherently strong and has been registered on the Principal
6 Register since 2006 without a showing of acquired distinctiveness.

7 13. Opposer's Mark is deemed incontestable under Section 15 of the Lanham Act.

8 14. Notwithstanding Opposer's prior rights in and to Opposer's Mark, Applicant is
9 seeking to register Applicant's Mark for related goods.

10 15. Applicant's Mark so resembles Opposer's Mark that it is likely, when Applicant's
11 Mark is applied to Applicant's Goods, to cause confusion or mistake or to deceive
12 persons by creating the erroneous impression that Applicant's Goods originate
13 from the same source as Opposer's Goods, or are endorsed by, sponsored by, or
14 connected in some way with Opposer, and the registration thereof is injurious to
15 Opposer.

16 16. Applicant's use and registration of Applicant's Mark with Applicant's Goods is
17 likely to cause confusion among consumers as provided under Section 2(d) of the
18 Lanham Act.

19 17. Applicant's use of Applicant's Mark is without Opposer's license, permission or
20 consent.

21 18. Registration of Applicant's Mark would provide Applicant with prima facie
22 exclusive rights therein and would interfere with Opposer's rights in Opposer's
23 Mark.

24 19. Opposer has the right to continue using Opposer's Mark in connection with its
25 Goods without interference by Applicant and without a likelihood of confusion,
26 mistake or deception.

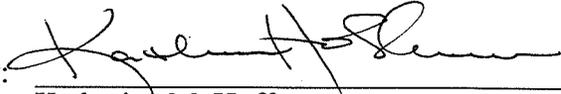
27 WHEREFORE, Opposer believes that it will be damaged by registration of the Application
28 and prays that registration be denied.

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The filing fee of \$300.00 is submitted herewith.

Dated: August 17, 2011

Respectfully submitted,

By: 
Katherine M. Hoffman
Attorney for Applicant

LUCE, FORWARD, HAMILTON & SCRIPPS LLP
600 West Broadway, Suite 2600
San Diego, California 92101
Telephone: (619) 533-7392

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PROOF OF SERVICE

I am employed in the City and County of San Diego; I am over the age of eighteen years and not a party to this action. My business address is Luce Forward Hamilton & Scripps, LLP located at 600 West Broadway, Suite 2600, San Diego, California 92101.

On August 17, 2011, I served the foregoing document(s) described as:

NOTICE OF OPPOSITION

by placing true copies thereof enclosed in a sealed envelope addressed as follows:

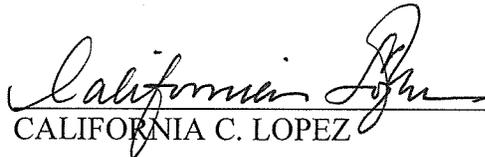
Andrea Anderson
Holland & Hart LLP
P.O. Box 8749
Denver, Colorado 80201-8749

(BY PERSONAL SERVICE) I caused to be delivered such envelope by hand to the persons named above.

(BY FIRST CLASS U.S. MAIL SERVICE) I placed such envelope(s) for collection and to be mailed on this date following ordinary business practices.

(State) I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed at San Diego, California, on August 17, 2011.


CALIFORNIA C. LOPEZ

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