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

Proceeding.	91215272
Applicant	Defendant Theranos, Inc.
Other Party	Plaintiff Becton, Dickinson and Company
Have the parties held their discovery conference as required under Trademark Rules 2.120(a)(1) and (a)(2)?	No

Motion for Suspension in View of Civil Proceeding With Consent

The parties are engaged in a civil action which may have a bearing on this proceeding. Accordingly, Theranos, Inc. hereby requests suspension of this proceeding pending a final determination of the civil action. Trademark Rule 2.117.

Theranos, Inc. has secured the express consent of all other parties to this proceeding for the suspension and resetting of dates requested herein.

Theranos, Inc. has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

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.

Respectfully submitted,

/Jedediah Wakefield/

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12/15/2014

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

In the matter of
Trademark Application Serial No. 85/606,345 for NANOTAINER

BECTON DICKINSON AND COMPANY,)	
)	
Opposer,)	Opposition No. 91215272
)	
v.)	
)	
THERANOS, INC.,)	
)	
Applicant.)	
)	

**CONSENTED MOTION TO SUSPEND
PENDING TERMINATION OF CIVIL ACTION**

Applicant Theranos, Inc. hereby moves to suspend the above-captioned opposition proceeding pursuant to 37 C.F.R. § 2.117(a) and TBMP § 510.02(a) pending termination of a civil proceeding filed by Theranos against Opposer Becton Dickinson and Company (“BD”) in the United States District Court for the Northern District of California (Case No. 3:14-cv-04880-MEJ) (the “Civil Action”) which may have a bearing on the opposition. BD consents to Theranos’s motion to suspend pending termination of the Civil Action.

In the Civil Action, Theranos seeks an order declaring that (1) Theranos’s use and registration of the NANOTAINER mark does not infringe any trademark rights of BD in the MICROTAINER mark, and (2) that BD’s registration for MICROTAINER (Reg. No. 1,042,544) be cancelled and BD’s registrations for BD MICROTAINER (Reg. Nos. 2,958,371 and 2,912,923) be amended to disclaim MICROTAINER because MICROTAINER has become generic for small collection tubes. BD answered Theranos’s complaint and filed counterclaims

asserting claims for trademark infringement, unfair competition and false designation of origin under the Lanham Act, and unfair competition under California law. BD's further seeks an injunction barring Theranos from using and registering the NANOTAINER mark. A copy of Theranos's Complaint and BD's Answer to Complaint and Counterclaims are attached hereto as Exhibits 1 and 2.

ARGUMENT

On March 5, 2014, BD filed a notice of opposition against Theranos's Application Serial No. 85/606,345 for NANOTAINER, alleging that the registration of NANOTAINER is likely to cause confusion, mistake, or deception with respect to its MICROTAINER and BD MICROTAINER marks. Theranos's Complaint and BD's Answer and Counterclaims in the pending Civil Action involve claims that require the district court to determine questions relating to the likelihood of consumer confusion. *See Brookfield Comm. v. West Coast Entertainment*, 174 F.3d 1036, 1053 (9th Cir. 1999) ("The core element of trademark infringement is the likelihood of confusion") (quotations omitted). Moreover, in the Civil Action Theranos asks the district court for a declaration regarding the validity of the MICROTAINER mark. These issues will be decided by the district court and may bear on this opposition. Accordingly, under 37 C.F.R. § 2.117, a suspension of the opposition proceeding is appropriate. *See* 37 C.F.R. § 2.117 ("Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding."); TBMP § 510.02(a) (same). Suspension is generally granted as a matter of course in situations such as this. *See, e.g., Vais v. Vais Arms, Inc.*, 2004 WL 390936, at *1 (TTAB 2004) (granting opposed motion for suspension and holding

that “it is the policy of the Board to suspend proceedings pursuant to Trademark Rule 2.117(a) when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case”); *Argo & Co. v. Carpetsheen Manufacturing, Inc.*, 187 USPQ 366, 367 (TTAB 1995) (suspension granted for opposition because state court litigation which would decide applicant’s ownership of mark “may have a bearing on the question of applicant’s right of registration”); *Whopper-Burger, Inc. v. Burger King, Inc.*, 171 USPQ 805, 807 (TTAB 1971) (suspension granted in cancellation proceeding where complaint sought to enjoin defendant from using mark and requested cancellation of the mark).

The district court’s resolution of the dispute will also decide issues not before the Board. For example, the Civil Action involves claims of unfair competition and false designation or origin under the Lanham Act, and unfair competition under California law. Moreover, BD seeks injunctive relief and damages, and the parties respectively seek attorneys’ fees. The opposition proceeding cannot dispose of all the issues before the district court, but the district court proceeding may dispose of certain issues involved in the opposition proceeding.

Finally, if both proceedings move forward simultaneously, two separate forums would face the expense and burden of resolving related issues. One of these forums—the district court—is better suited to resolve common questions that may bear on both proceedings because it possesses more comprehensive jurisdiction to consider all issues raised by the parties.

CONCLUSION

The interests of judicial economy and judicial consistency require that the Board suspend the present opposition proceeding until termination of the Civil Action. Accordingly, Theranos respectfully requests that the Board enter an order suspending the opposition proceeding pending termination of the Civil Action.

Respectfully submitted,

Dated: December 15, 2014

/s/ Jedediah Wakefield

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17
18 UNITED STATES DISTRICT COURT
19 NORTHERN DISTRICT OF CALIFORNIA
20

21 THERANOS, INC.,
22 Plaintiff,
23 v.
24 BECTON, DICKINSON AND COMPANY,
25 Defendant.

Case No.: _____

**COMPLAINT FOR DECLARATORY
RELIEF**

DEMAND FOR JURY TRIAL

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ATTORNEYS AT LAW
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1 Plaintiff Theranos, Inc. alleges as follows:

2 **NATURE OF THE ACTION**

3 1. This is an action for declaratory judgment, cancellation of federal trademark
4 registrations, and attorneys’ fees. By this action, Theranos seeks to eliminate any doubt that its
5 NANOTAINER mark, used in connection with innovative laboratory testing services, does not
6 infringe any trademark rights owned by Becton, Dickinson and Company (“BD”) in the generic
7 term MICROTAINER.

8 2. Specifically, Theranos seeks a declaration that the marks THERANOS
9 NANOTAINER and NANOTAINER do not infringe the purported marks MICROTAINER or
10 BD MICROTAINER (collectively the “MICROTAINER Marks”). Theranos also seeks a
11 declaration that the term MICROTAINER is generic for the type of blood collection containers
12 that BD markets under that term and cannot serve to indicate a unique source for such products,
13 and that BD’s trademark registration for MICROTAINER is invalid as a result. For the same
14 reason, BD’s registrations for BD MICROTAINER should be amended to disclaim
15 MICROTAINER.

16 **THE PARTIES**

17 3. Theranos is a Delaware corporation with its principal place of business in Palo
18 Alto, California.

19 4. Theranos believes and therefore alleges that BD is a New Jersey corporation with
20 its principal place of business in Franklin Lakes, New Jersey. BD is a registered corporation with
21 the California Secretary of State. Theranos believes and therefore alleges that BD has continuous
22 and systematic contacts in California and within this judicial district, including by selling
23 products bearing the purported MICROTAINER mark in this judicial district.

24 **JURISDICTION AND VENUE**

25 5. Theranos brings this action pursuant to 15 U.S.C. §§ 1051, *et seq.* (the Lanham
26 Act) including § 1121. The Court has subject-matter jurisdiction over this action under 28 U.S.C.
27 § 1331 (federal question), 28 U.S.C. § 1338 (original jurisdiction of trademark claims), and 28
28 U.S.C. § 2201 (the Declaratory Judgment Act).

1 and lancets for the acquisition and collection of blood.”

2 16. BD purports to be the owner of U.S. Trademark Registration No. 2,912,923 for
3 BD MICROTAINER and design in international class 10 for “[c]ontainers for use in sample
4 collection, namely medical specimen tubes.”

5 **BD’S CLAIMS OF INFRINGEMENT**

6 17. BD has asserted that Theranos’s use of NANOTAINER in connection with blood
7 collection services infringes its rights in the MICROTAINER Marks, and has demanded that
8 Theranos refrain from any use of the NANOTAINER mark.

9 18. On March 5, 2014, BD filed an opposition to the Application with the USPTO’s
10 Trademark Trial and Appeals Board. BD’s opposition cites its three MICROTAINER
11 registrations and alleges that NANOTAINER is confusingly similar in sound, meaning,
12 appearance, and commercial impression to its MICROTAINER Marks.

13 19. BD alleges in its opposition that Theranos’s NANOTAINER mark is likely to
14 create an association with BD’s MICROTAINER Marks.

15 20. BD alleges in its opposition that Theranos’s NANOTAINER mark “is likely to
16 cause confusion or cause mistake or to deceive the purchasing public into mistakenly believing
17 that [Theranos’s] goods and services offered under [NANOTAINER] originate from, come from,
18 or are otherwise associated with [BD], or that [Theranos’s] goods and services offered in
19 connection with [NANOTAINER] are endorsed, sponsored, or in some way connected with
20 [BD].”

21 21. On July 8, 2014, BD, through counsel, challenged Theranos’s use and planned use
22 of NANOTAINER and claimed that such use would result in purchasers assuming that there is an
23 association between BD and Theranos. BD demanded that Theranos withdraw the Application
24 and cease use of the mark.

25 22. On September 16, 2014, BD, through counsel, again demanded that Theranos
26 discontinue use of the NANOTAINER mark and claimed that any use of NANOTAINER in
27 connection with blood collection services would create a likelihood of confusion.
28

FIRST CAUSE OF ACTION

(Declaratory Judgment of Non-Infringement)

23. Theranos restates and incorporates by reference each of the allegations set forth in paragraphs 1 through 22 above.

24. BD has claimed that Theranos’s use of its NANOTAINER mark is likely to cause confusion with the MICROTAINER Marks. Because of BD’s actions and demands described herein, Theranos has a reasonable and strong apprehension that it will soon face a claim for trademark infringement under at least Section 43(a) of the Lanham Act brought by BD. By virtue of BD’s actions, there is an actual, existing and substantial controversy between the parties, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

25. Theranos believes and therefore alleges that MICROTAINER has become a generic term and cannot serve to indicate a unique source for blood collection tubes and related products.

26. Theranos is not aware of any actual or potential confusion between the parties’ trademarks.

27. The differences between the parties’ trademarks and use prevent any likelihood of confusion, including without limitation the dissimilarities as to sight, sound, appearance, meaning and commercial impression of the marks.

28. The parties sell their respective goods and services in different commercial markets and in different channels of trade. Theranos believes and therefore alleges that customers are not likely to encounter the parties’ respective products and services in proximity to each other further preventing any likelihood of confusion.

29. The parties’ respective customers exercise a high degree of care further preventing any likelihood of confusion.

30. There is no likelihood that any relevant consumers would be confused, mistaken, or deceived into believing that NANOTAINER products and services are affiliated, connected, or otherwise associated with BD, or that BD is sponsoring or has otherwise approved of Theranos’s NANOTAINER products and services.

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1 31. Theranos therefore requests that the Court declare that Theranos’s use of
2 NANOTAINER and THERANOS NANOTAINER does not infringe any of BD’s trademark
3 rights under 15 U.S.C. § 1114 or the common law, and does not constitute false designation of
4 origin under 15 U.S.C. § 1125(a).

5 **SECOND CAUSE OF ACTION**

6 **(Declaratory Judgment of Invalidity of the MICROTAINER Mark)**

7 32. Theranos restates and incorporates by reference each of the allegations set forth in
8 paragraphs 1 through 31 above.

9 33. Theranos believes and therefore alleges that the primary significance of
10 MICROTAINER among the relevant public is as the generic term.

11 34. Theranos believes and therefore alleges that purchasers and potential purchasers
12 use the term MICROTAINER to generically refer to small collection tubes.

13 35. Because a generic term can never function as a trademark to indicate origin, BD’s
14 registration for MICROTAINER (Reg. No. 1,042,544) is invalid and unenforceable for failing to
15 comply with one or more of the requirements of registration for trademark protection as required
16 by the United States Patent and Trademark Office and the Lanham Act. Similarly, BD’s
17 registrations for BD MICROTAINER (Reg. Nos. 2,958,371 and 2,912,923) should be amended to
18 disclaim MICROTAINER.

19 36. In accordance with 15 U.S.C. §§ 1064 and 1119, U.S. Trademark Registration
20 Nos. 1,042,544 should be cancelled and U.S. Trademark Registration Nos. 2,958,371 and
21 2,912,923 should be amended to disclaim MICROTAINER.

22 **PRAYER FOR RELIEF**

23 WHEREFORE, Plaintiff Theranos, Inc. prays for judgment as follows:

24 1. That the Court issue an order declaring that Theranos’s use and registration of its
25 NANOTAINER trademark does not infringe upon any trademark rights of BD under 15 U.S.C.
26 § 1114 or the common law, and does not constitute false designation of origin under 15 U.S.C. §
27 1125(a).;

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DEMAND FOR JURY TRIAL

Theranos hereby demands trial by jury on all issues and claims so triable.

Dated: November 3, 2014 FENWICK & WEST LLP

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13 **UNITED STATES DISTRICT COURT**
14 **NORTHERN DISTRICT OF CALIFORNIA**

15 THERANOS, INC.,
16 Plaintiff,
17 v.
18 BECTON, DICKINSON AND COMPANY ,
19 Defendant.

Case No.: 3:14-cv-04880-MEJ

[Assigned to Magistrate Judge Maria-Elena James]

**ANSWER TO COMPLAINT AND
COUNTERCLAIMS**

DEMAND FOR JURY TRIAL

20
21 BECTON, DICKINSON AND COMPANY,
22 Counter-Plaintiff,
23 v.
24 THERANOS, INC.,
25 Counter-Defendant.

Action Filed: November 3, 2014

28 {F1579490.1 }

1 Defendant Becton, Dickinson and Company (“BD”), by its attorneys Epstein Becker & Green,
2 P.C. and Fross Zelnick Lehrman & Zissu, P.C., for its answer to the Complaint of Plaintiff
3 Theranos, Inc. (“Theranos”), alleges as follows:

4 **RESPONSE TO NATURE OF THE ACTION**

5 1. Admits that Theranos purports to seek the claims for relief summarized in
6 paragraph 1 of the Complaint, but denies that Theranos is entitled to the relief sought.

7 2. Admits that Theranos purports to seek the claims for relief summarized in
8 paragraph 2 of the Complaint, but denies that Theranos is entitled to the relief sought in the
9 Complaint.

10 **RESPONSE TO THE PARTIES**

11 3. Without knowledge or information sufficient to form a belief as to the truth of the
12 allegations in paragraph 3 of the Complaint, and therefore denies the same.

13 4. Admits that BD is a New Jersey corporation registered with the California
14 Secretary of State and that BD’s principal place of business is in Franklin Lakes, New Jersey, but
15 otherwise denies the allegations in paragraph 4 of the Complaint.

16 **RESPONSE TO JURISDICTION AND VENUE**

17 5. Paragraph 5 of the Complaint sets forth conclusions of law to which no response is
18 required. To the extent a response is deemed to be required, BD admits that the Court has subject-
19 matter jurisdiction over this action, but otherwise denies the allegations in paragraph 5 of the
20 Complaint.

21 6. Paragraph 6 of the Complaint sets forth conclusions of law to which no response is
22 required. To the extent a response is deemed to be required, BD denies the allegations in
23 paragraph 6 of the Complaint, but does not contest the Court’s exercise of personal jurisdiction
24 over BD.

25 **RESPONSE TO INTRADISTRICT ASSIGNMENT**

26 7. Paragraph 7 of the Complaint sets forth conclusions of law to which no response is
27 required. To the extent a response is deemed to be required, the allegations are denied.

28 {F1579490.1 }

**RESPONSE TO THE PARTIES' USE AND
REGISTRATION OF THEIR RESPECTIVE MARKS**

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2
3 8. Without knowledge or information sufficient to form a belief as to the truth of the
4 allegations in paragraph 8 of the Complaint, and therefore denies the same.

5 9. Without knowledge or information sufficient to form a belief as to the truth of the
6 allegations in paragraph 9 of the Complaint, and therefore denies the same.

7 10. Without knowledge or information to form a belief as to the truth of the allegations
8 in paragraph 10 of the Complaint, and therefore denies the same.

9 11. Without knowledge or information to form a belief as to the truth of the allegations
10 in paragraph 11 of the Complaint, and therefore denies the same.

11 12. Without knowledge or information to form a belief as to the truth of the allegations
12 in paragraph 12 of the Complaint, and therefore denies the same, except admits that Theranos is
13 the listed owner of record of Application Serial No. 85/606,345 filed with the U.S. Patent &
14 Trademark Office for the mark NANOTAINER.

15 13. Admits that BD sells a variety of medical supplies, devices and equipment, but
16 denies that paragraph 13 of the Complaint characterizes BD's entire business.

17 14. Admits that BD is the owner of U.S. Registration No. 1,042,544, and avers that the
18 records of the U.S. Patent and Trademark Office regarding such registration speak for themselves.

19 15. Admits that BD is the owner of U.S. Registration No. 2,958,371, and avers that the
20 records of the U.S. Patent and Trademark Office regarding such registration speak for themselves.

21 16. Admits that BD is the owner of U.S. Registration No. 2,912,923, and avers that the
22 records of the U.S. Patent and Trademark Office regarding such registration speak for themselves.

RESPONSE TO BD'S CLAIMS OF INFRINGEMENT

23
24 17. Denies the allegations in paragraph 17 of the Complaint, except admits that BD
25 herewith asserts a counterclaim for trademark infringement based on Theranos's use of its
26 NANOTAINER mark and seeks relief from the Court that would enjoin Theranos from using its
27 NANOTAINER mark.

28 {F1579490.1 }

1 18. Admits that on March 5, 2014, BD filed a notice of opposition in the Trademark
2 Trial and Appeal Board against Theranos's application to register the NANOTAINER mark (App.
3 Ser. No. 85/606,345), which asserts a claim for relief under Section 2(d) of the Lanham Act, 15
4 U.S.C. § 1052(d). BD avers that the notice of opposition speaks for itself, and otherwise denies
5 the allegations in paragraph 18 of the Complaint.

6 19. Avers that the notice of opposition speaks for itself, and otherwise denies the
7 allegations in paragraph 19 of the Complaint.

8 20. Avers that the notice of opposition speaks for itself, and otherwise denies the
9 allegations in paragraph 20 of the Complaint.

10 21. Admits that on July 8, 2014, counsel for BD emailed Theranos's counsel with a
11 request that Theranos withdraw its application to register the NANOTAINER mark and cease use
12 of the NANOTAINER mark, but otherwise denies the allegations in paragraph 21 of the
13 Complaint.

14 22. Admits that on September 16, 2014, counsel for BD emailed Theranos's counsel
15 regarding the status of the opposition proceeding, and that in the September 16 email, BD repeated
16 its demand that Theranos withdraw its application to register the NANOTAINER mark and cease
17 use of the NANOTAINER mark, but otherwise denies the allegations in paragraph 22 of the
18 Complaint.

19 **RESPONSE TO FIRST CAUSE OF ACTION**

20 **(Declaratory Judgment of Non-Infringement)**

21 23. Repeats and re-alleges the above responses to paragraphs 1 through 22 of the
22 Complaint.

23 24. Admits that there is an actual case or controversy between the parties, but otherwise
24 denies the allegations in paragraph 24 of the Complaint.

25 25. Denies the allegations in paragraph 25 of the Complaint.

26 26. Without knowledge or information to form a belief as to the truth of the allegations
27 in paragraph 26 of the Complaint, and therefore denies the same.

28 {F1579490.1 }

- 1 27. Denies the allegations in paragraph 27 of the Complaint.
- 2 28. Denies the allegations in paragraph 28 of the Complaint.
- 3 29. Denies the allegations in paragraph 29 of the Complaint.
- 4 30. Denies the allegations in paragraph 30 of the Complaint.
- 5 31. Denies the allegations in paragraph 31 of the Complaint.

6 **RESPONSE TO SECOND CAUSE OF ACTION**

7 **(Declaratory Judgment of Invalidity of the MICROTAINER Mark)**

- 8 32. Repeats and re-alleges the above responses to paragraphs 1 through 31 of the
9 Complaint.
- 10 33. Denies the allegations in paragraph 33 of the Complaint.
- 11 34. Denies the allegations in paragraph 34 of the Complaint.
- 12 35. Paragraph 35 of the Complaint sets forth conclusions of law to which no response
13 is required. To the extent a response is deemed to be required, BD denies the allegations in
14 paragraph 35 of the Complaint.
- 15 36. Denies the allegations in paragraph 36 of the Complaint.

16
17 WHEREFORE, BD requests that the Court deny and dismiss Theranos's Complaint and
18 enter judgment in favor of BD and against Theranos as to the Complaint and further that the Court
19 award BD such other and further relief as the Court deems just and proper.

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{F1579490.1 }

1 **COUNTERCLAIM**

2 Counterclaim-Plaintiff BD, Dickinson and Company (or “BD”), in support of its
3 counterclaims against Counterclaim-Defendant Theranos, Inc. (“Theranos”), alleges as follows:

4 **NATURE OF THE ACTION**

5 1. BD is a Fortune 500 medical technology company that develops, manufactures, and
6 sells various products for use in the medical field. Since at least as early as 1970, BD has
7 manufactured and distributed devices and containers used to collect and store blood samples under
8 its MICROTAINER mark.

9 2. In violation of BD’s rights, Theranos has begun to manufacture and promote
10 containers for the storage of blood under the mark NANOTAINER, a confusingly similar mark to
11 BD’s MICROTAINER mark.

12 3. In order to protect its rights in its MICROTAINER mark, BD brings this action for
13 trademark infringement in violation of Section 32 of the Trademark Act of 1946 (the “Lanham
14 Act”), 15 U.S.C. § 1114; false designation of origin and unfair competition in violation of Section
15 43(a)(1)(A) of the Lanham Act, 15 U.S.C. § 1125 (a)(1)(A); and unfair competition in violation of
16 California State Law, Cal. Bus. & Prof. Code §§ 17200 *et seq.* BD seeks permanent injunctive
17 relief and damages.

18 **JURISDICTION AND VENUE**

19 4. The Court has jurisdiction over the subject matter of this action under Section 39(a)
20 of the Lanham Act, 15 U.S.C. § 1121, and Sections 1331, 1338(a), and 1338(b) of the Judicial
21 Code, 28 U.S.C. § 1331, 1338 (a) and (b), and under principles of supplemental jurisdiction, 28
22 U.S.C. § 1367(a).

23 5. Upon information and belief, this Court has personal jurisdiction over Theranos
24 because Theranos’s principal place of business is in this district and the exercise of jurisdiction
25 over it is not inconsistent with the Constitution of California or the United States. Cal. Code Civ.
26 Proc. § 410.10.

27
28 {F1579490.1 }

1 placed in the testing instrument, and the blood can be tested without any manual processing, which
2 makes for more reliable processing and results.

3 14. BD sells its MICROTAINER products directly to doctors' offices, hospitals, and
4 pathology laboratories, and such products are used by doctors, nurses, phlebotomists, and other
5 healthcare providers.

6 15. BD has achieved great commercial success under the MICROTAINER mark over
7 the last four decades.

8 16. BD has invested a significant amount of time, effort, and money in advertising and
9 promoting products sold under the MICROTAINER mark, including spending substantial sums in
10 advertising and promoting such products in various media, such as in print, on the internet, and at
11 trade shows. BD also advertises and promotes its MICROTAINER products directly to doctors,
12 nurses, phlebotomists, and other healthcare providers.

13 17. In addition to BD's extensive and strong common law rights in the
14 MICROTAINER trademark that have resulted from this use, BD owns the following U.S.
15 trademark registrations for the MICROTAINER mark and MICROTAINER-inclusive marks:
16 U.S. Registration No. 1,042,544 for the mark MICROTAINER for use in connection with a
17 "container for use in the collection of blood samples for later analysis" in International Class 20,
18 which issued on June 29, 1976, and is based on first use in commerce of May 11, 1970; U.S.
19 Registration No. 2,912,923 for the mark BD MICROTAINER and Design for use in connection
20 with "containers for use in sample collection, namely medical specimen tubes" in International
21 Class 10, which issued on December 21, 2004, and is based on a first use in commerce of January
22 1, 2000; and U.S. Registration No. 2,958,371 for the mark BD MICROTAINER and Design for
23 use in connection with "medical devices, namely tubes and lancets for the acquisition and
24 collection of blood" in International Class 10, which issued on May 31, 2005, and is based on a
25 first use in commerce of January 1, 2000.

26 18. These registrations are all valid, subsisting, and in full force and effect. Moreover,
27 the above registrations have become incontestable under Section 15 of the Lanham Act, 15 U.S.C.

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1 § 1065, and serve as conclusive evidence of the validity of the registered marks, of the registration
2 of the marks, and of BD's exclusive right to use the marks in commerce on or in connection with
3 the products for which the marks are registered, as provided by Section 33(b) of the Lanham Act,
4 15 U.S.C. § 1115(b).

5 19. As a result of BD's extensive advertising and promotional efforts and commercial
6 success, as well as the amount, volume, and geographic extent of sales made under the
7 MICROTAINER mark, the MICROTAINER mark has become associated exclusively with BD
8 and represents enormous goodwill.

9 **B. Theranos's Wrongful Conduct**

10 20. On information and belief, Theranos is in the business of manufacturing products
11 for use in the collection, storage, and testing of blood samples. Theranos also operates "wellness
12 centers," where blood samples are collected from patients, which are then sent to a laboratory
13 operated by Theranos. On information and belief, the Theranos laboratory also accepts blood
14 samples for testing from doctors who collect the blood samples in their own offices.

15 21. Like BD, Theranos manufactures a container for the storage of blood samples.
16 Theranos promotes its blood storage container under the mark NANOTAINER.

17 22. On information and belief, one of the primary ways in which Theranos markets its
18 blood collection and blood testing services is directly to doctors and other healthcare providers.
19 Specifically, on information and belief, Theranos's sales representatives conduct visits to doctors'
20 offices, during which they provide doctors with information on Theranos's services and coupon
21 vouchers for discounts on such services.

22 23. On information and belief, Theranos's sales representatives use the
23 NANOTAINER mark in connection with their promotion of Theranos's blood collection and
24 blood testing services to doctors and other healthcare providers, the same consumers who already
25 are very familiar with BD's MICROTAINER mark through BD's years of sales and marketing to
26 them.

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1 24. Theranos also promotes its services to doctors on its website, which instructs
2 doctors and other healthcare providers that they can send patients to one of Theranos’s “wellness
3 centers” to have blood samples drawn, or that they can collect their patients’ blood samples
4 themselves and send such samples to Theranos’s laboratory for testing. *See*
5 <http://www.theranos.com/easy-integration>. Theranos advises the latter group—doctors and other
6 healthcare providers who collect blood samples themselves and then send them to Theranos for
7 testing—that “[s]mall specimens in your smallest collection containers are all we need.” *See*
8 <http://www.theranos.com/easy-integration>. Thus, there exists the likelihood that such doctors and
9 other healthcare providers will send blood to Theranos’s laboratory in MICROTAINER blood
10 storage containers, further associating Theranos with BD’s well-known MICROTAINER mark.

11 25. This is not the only instance in which the parties’ respective products are used side-
12 by-side. On information and belief, BD’s MICROTAINER lancet is used at Theranos’s “wellness
13 centers” to collect blood samples. Such blood samples are then stored in Theranos’s
14 NANOTAINER blood storage container.

15 26. The NANOTAINER mark is confusingly similar to BD’s MICROTAINER mark in
16 sight, sound, and commercial meaning. Both marks pair synonymous words meant to connote a
17 small size with the suffix TAINER. As a result, the commercial impression left by both marks
18 would be essentially identical, as is the suffix of each mark.

19 27. Theranos’s use of its confusingly similar NANOTAINER mark when promoting its
20 blood testing services to doctors and other healthcare providers is likely to confuse such doctors
21 and other healthcare providers into mistakenly believing that Theranos’s services are provided,
22 authorized, endorsed, or sponsored by BD.

23 28. Theranos’s use of its confusingly similar NANOTAINER mark commenced long
24 after BD developed strong rights in its well-known MICROTAINER mark and long after BD’s
25 MICROTAINER mark was first registered in the USPTO, and is without authorization or license
26 from BD.

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1 provided, authorized, endorsed, or sponsored by BD, thereby damaging BD's reputation, goodwill,
2 and sales.

3 34. Theranos's unauthorized use of the NANOTAINER mark and name constitutes
4 trademark infringement in violation of § 32(1) of the Lanham Act, 15 U.S.C. § 1114(1).

5 35. Theranos's conduct is causing immediate and irreparable injury to BD and will
6 continue both to damage BD and deceive doctors and other healthcare providers until enjoined by
7 this Court.

8 36. BD has no adequate remedy at law.

9 **SECOND CLAIM FOR RELIEF**

10 **Unfair Competition and False Designation of Origin**

11 **Under Section 43(A) of the Lanham Act**

12 37. BD repeats and realleges each and every allegation contained in paragraphs 1
13 through 36 above as if fully set forth herein.

14 38. Theranos's use of the NANOTAINER mark, as alleged above, is likely to confuse,
15 mislead, or deceive doctors and other healthcare providers as to the origin, source, sponsorship, or
16 affiliation of Theranos's NANOTAINER mark and its related goods and services, and is likely to
17 cause such doctors and other healthcare providers to believe, contrary to fact, that such goods and
18 services are made, provided, authorized, endorsed, or sponsored by BD, or that Theranos is in
19 some way affiliated with or sponsored by BD.

20 39. Theranos's actions in the manner alleged above constitute a false designation of
21 origin, false and misleading descriptions of fact, and false and misleading representations of fact,
22 which are likely to cause confusion, mistake, and deception, in violation of Section 43(a) of the
23 Lanham Act, 15 U.S.C. § 1125(a).

24 40. Upon information and belief, Theranos's infringement of the NANOTAINER mark
25 is willful, intended to reap the benefit of the goodwill of BD, and violates Section 32(1) of the
26 Lanham Act, 15 U.S.C. § 1114(1).

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1 41. Theranos’s conduct is causing immediate and irreparable injury to BD and will
2 continue both to damage BD and deceive doctors and other healthcare providers until enjoined by
3 this Court.

4 42. BD has no adequate remedy at law.

5 **THIRD CLAIM FOR RELIEF**

6 **Unfair Competition Under California Law**

7 **(Cal. Bus. & Prof. Code §§ 17200 et seq.)**

8 43. BD repeats and realleges each and every allegation contained in paragraphs 1
9 through 42 above as if fully set forth herein.

10 44. The aforesaid conduct of Theranos—trademark infringement and false designation
11 of origin—constitutes unfair competition in violation of Cal. Bus. & Prof. Code §§ 17200 *et seq.*

12 45. Theranos’s conduct is causing immediate and irreparable injury to BD and will
13 continue both to damage BD and deceive doctors and other healthcare providers until enjoined by
14 this Court.

15 46. BD have no adequate remedy at law.

16 **WHEREFORE**, BD demands judgment as follows:

17 1. Entering judgment for BD on each of its claims.

18 2. Directing that Theranos and, where applicable, its officers, directors, agents,
19 representatives, successors or assigns, and all persons acting in concert or in participation with any
20 of them, be immediately and permanently enjoined from:

21 (a) infringing the MICROTAINER mark;

22 (b) falsely designating the origin, sponsorship, or affiliation of their business,
23 goods, or services;

24 (c) using the NANOTAINER mark, or any derivation or colorable imitation of
25 the MICROTAINER mark, or any name or mark that is confusingly similar to the
26 MICROTAINER mark (collectively, the “Prohibited Marks”), on or in connection with
27 Theranos’s goods or services;

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1 (d) seeking to register any Prohibited Marks;

2 (e) making or employing any other commercial use of any of the Prohibited
3 Marks;

4 (f) making or displaying any statement or representation that is likely to lead
5 the public or the trade to believe that Theranos's goods and services are in any manner associated
6 or affiliated with or made, approved, endorsed, licensed, sponsored, authorized, or franchised by
7 or are otherwise connected with BD;

8 (g) using any other false designation of origin calculated or likely to cause
9 confusion or mistake in the mind of the trade or public or to deceive the trade or public into
10 believing that Theranos's products or activities are in any way made, sponsored, licensed,
11 endorsed, or authorized by, or affiliated or connected with BD, or originate from BD;

12 (h) doing any other acts or things calculated or likely to cause confusion or
13 mistake in the mind of the trade or public or to lead purchasers or consumers or investors into the
14 belief that the products or services promoted, offered, or sponsored by Theranos emanate from or
15 originate with BD or its licensees, or are somehow sponsored, licensed, endorsed, or authorized
16 by, or affiliated or connected with BD, or originate from BD;

17 (i) engaging in any other activity constituting unfair competition with BD;

18 (j) further infringing the MICROTAINER mark and damaging BD's goodwill;

19 (k) aiding, assisting, or abetting any other party in doing any act prohibited by
20 sub-paragraphs (a) through (j) above.

21 3. Directing that Theranos deliver up to BD's attorneys for destruction all products,
22 labels, signs, stationery, prints, packages, promotional and marketing materials, advertisements,
23 and other materials (a) currently in its possession or under its control or (b) recalled by Theranos
24 pursuant to any order of the Court or otherwise, incorporating, featuring, or bearing the Prohibited
25 Marks or any other simulation, reproduction, copy, or colorable imitation thereof.

26 4. Directing that Theranos file with the Court and serve upon BD's counsel within
27 thirty (30) days after entry of judgment a report in writing under oath, setting forth in detail the

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1 manner and form in which they have complied with the above.

2 5. Awarding BD such damages it has sustained or will sustain by reason of
3 Theranos's acts of trademark infringement and unfair competition and that such sums be trebled
4 pursuant to 15 U.S.C. § 1117.

5 6. Awarding BD all damages, including Theranos's profits, that are recoverable under
6 Cal. Bus. & Prof. Code §§ 17200 *et seq.*

7 7. Awarding BD all other recoverable gains, profits, property, and advantages derived
8 by Theranos from its unlawful conduct.

9 8. Awarding to BD exemplary and punitive damages to deter any further willful
10 infringement as the Court finds appropriate.

11 9. Awarding to BD its costs and disbursements incurred in this action, including
12 reasonable attorneys' fees pursuant to 15 U.S.C. §1117(a).

13 10. Awarding BD interest, including pre-judgment interest on the foregoing sums.

14 11. Awarding to BD such other and further relief as the Court may deem just and
15 proper.

16
17 Dated: December 1, 2014

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