

ESTTA Tracking number: **ESTTA630477**

Filing date: **10/01/2014**

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	Clontech Laboratories, Inc.
Granted to Date of previous extension	10/01/2014
Address	1290 Terra Bella Avenue Mountain View, CA 94043 UNITED STATES
Attorney information	Ian K. Boyd Harvey Siskind LLP 4 Embarcadero Center, 39th Floor San Francisco, CA 94111 UNITED STATES iboyd@harveysiskind.com, kmcknight@harveysiskind.com, clee@harveysiskind.com Phone:415-354-0100

Applicant Information

Application No	85868160	Publication date	06/03/2014
Opposition Filing Date	10/01/2014	Opposition Period Ends	10/01/2014
International Registration No.	NONE	International Registration Date	NONE
Applicant	MERCK KGAA Frankfurter Str. 250 64293 Darmstadt, GERMANY		

Goods/Services Affected by Opposition

Class 001. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Chemicals used in industry and science; assays and reagents for genetic research; chemical test kits for genetic research for laboratory or research use; biochemical reagents commonly known as probes and detection probes for detecting RNA

Grounds for Opposition

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

U.S. Registration No.	4553718	Application Date	10/22/2009
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Registration Date	06/24/2014	Foreign Priority Date	NONE
Word Mark	SMART		
Design Mark	<h1>SMART</h1>		
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1996/01/12 First Use In Commerce: 1996/01/12 Reagents for use in scientific or medical research use		

U.S. Registration No.	4262866	Application Date	10/27/2009
Registration Date	12/25/2012	Foreign Priority Date	NONE
Word Mark	SMARTER		
Design Mark	<h1>SMARTER</h1>		
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 2009/02/18 First Use In Commerce: 2009/02/18 Reagents for use in scientific or medical research use		

U.S. Application No.	85951310	Application Date	06/05/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SMART-SEQ		

Design Mark	<h1>SMART-SEQ</h1>		
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 0 First Use In Commerce: 0 Reagents for use in scientific or medical research use		

U.S. Application No.	85951313	Application Date	06/05/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SMARTER-SEQ		
Design Mark	<h1>SMARTER-SEQ</h1>		
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 0 First Use In Commerce: 0 Reagents for use in scientific or medical research use		

U.S. Application No.	86035119	Application Date	08/12/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SMARTSEQ		
Design Mark	<h1>SmartSeq</h1>		

Description of Mark	NONE
Goods/Services	Class 001. First use: First Use: 0 First Use In Commerce: 0 Reagents for use in scientific or medical research use

U.S. Application No.	86035125	Application Date	08/12/2013
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	SMARTERSEQ
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Design Mark	
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Description of Mark	NONE
Goods/Services	Class 001. First use: First Use: 0 First Use In Commerce: 0 Reagents for use in scientific or medical research use

Attachments	77855307#TMSN.png(bytes) 77858660#TMSN.png(bytes) 85951310#TMSN.png(bytes) 85951313#TMSN.png(bytes) 86035119#TMSN.png(bytes) 86035125#TMSN.png(bytes) SMARTFLARE Notice of Opposition.141001.FINAL (00049032xA1ADA).pdf(113798 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	/Ian K. Boyd/
Name	Ian K. Boyd
Date	10/01/2014

1 HARVEY SISKIND LLP
2 IAN K. BOYD (CA SBN 191434)
3 iboyd@harveysiskind.com
4 KATE W. MCKNIGHT (CA SBN 264197)
5 kmcknight@harveysiskind.com
6 Four Embarcadero Center, 39th Floor
7 San Francisco, CA 94111
8 Telephone: (415) 354-0100
9 Facsimile: (415) 391-7124

10 Attorneys for Opposer,
11 Clontech Laboratories, Inc.

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

14 CLONTECH LABORATORIES, INC., a
15 Delaware corporation,

16 Opposer,

17 v.

18 Merck KGaA, a German corporation,

19 Applicant.

20 **NOTICE OF OPPOSITION**

21 Opposition No.

22 App. Serial No. 85/868160

23 Mark: SMARTFLARE

24 Clontech Laboratories, Inc. (“Opposer”) believes it will be damaged by registration of the mark
25 shown in Serial No. 85/868160 (“Applied-For Mark”) by Merck KGaA (“Applicant”) and hereby
26 opposes the same. As grounds for opposition, Opposer alleges:

27 **DESCRIPTION OF THE APPLIED-FOR MARK**

28 1. Applicant filed the Applied-For Mark with the United States Patent and Trademark
Office (“USPTO”) on March 6, 2013 and it was published for opposition in the Official Gazette on June
3, 2014.

2. The Applied-For Mark consists of the word mark SMARTFLARE in International Class
1 for “chemicals used in industry and science; assays and reagents for genetic research; chemical test kits

1 for genetic research for laboratory or research use; biochemical reagents commonly known as probes
2 and detection probes for detecting RNA” and International Class 9 for “detection probes, not for medical
3 purposes, for use in detecting RNA,” and was filed under Section 44(e).

4 **GROUND FOR OPPOSITION**

5 3. Opposer owns a U.S. Trademark Registration for SMART, Reg. No. 4553718 “SMART
6 Registration”) in Class 1 for “reagents for use in scientific or medical research use,” filed on October 22,
7 2009. Opposer also owns a U.S. Trademark Registration for SMARTER, Reg. No. 4262866
8 (“SMARTER Registration”) in Class 1 for “reagents for use in scientific or medical research use,” filed
9 on October 27, 2009 (both registrations collectively referred to herein as the “Registrations”).

10 4. Opposer also owns the following pending U.S. Trademark Applications for SMART-
11 formative marks (collectively, the “Pending Applications”):

- 12 a. SMART-SEQ, Serial No. 85/951310 in Class 1 for “reagents for use in scientific or
13 medical research use,” filed on June 5, 2013;
- 14 b. SMARTER-SEQ, Serial No. 85/951313 in Class 1 for “reagents for use in scientific or
15 medical research use,” filed on June 5, 2013;
- 16 c. SMARTSEQ, Serial No. 86/035119 in Class 1 for “reagents for use in scientific or
17 medical research use,” filed on August 12, 2013; and
- 18 d. SMARTERSEQ, Serial No. 86/035125 in Class 1 for “reagents for use in scientific or
19 medical research use,” filed on August 12, 2013.

20 5. Opposer’s Registrations have priority over the Applied-For Mark because Opposer filed
21 them with the USPTO before Applicant filed the Applied-For Mark.

22 6. The Applied-For Mark is likely to cause confusion, mistake, or to deceive, as to source,
23 sponsorship, or affiliation because its dominant word element is identical to the mark appearing in
24 Opposer’s SMART Registration and is highly similar to the marks appearing in Opposer’s SMARTER
25 Registration and SMART-formative Pending Applications, and its goods are nearly identical to those
26 referenced by Opposer’s Registrations and Pending Applications.

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1 **PRAYER**

2 WHEREFORE, Opposer prays that Application Serial No. 85/868160 be rejected, no registration
3 thereon be issued to Applicant, and this Opposition be sustained in favor of Opposer. Opposer hereby
4 appoints as its attorneys Harvey Siskind LLP, a law firm composed of members of the Bar of the State of
5 California, with full power to prosecute this Opposition, transact all relevant business with the USPTO
6 and the U.S. Courts, and receive all official communication in connection with this Opposition.

7 Dated: October 1, 2014

8 Respectfully submitted,

9 HARVEY SISKIND LLP
10 IAN K. BOYD
11 KATE W. MCKNIGHT

12 By /Ian K. Boyd/

13 Ian K. Boyd

14 Attorneys for Opposer,
15 Clontech Laboratories, Inc.

1 **CERTIFICATE OF TRANSMISSION**

2 I hereby certify that a true and correct copy of the attached NOTICE OF OPPOSITION
3 (Serial No. 85/868160) is being electronically transmitted to the Trademark Trial and Appeal Board
4 on October 1, 2014.
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7 */Ian K. Boyd/*
8 Ian K. Boyd
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