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

Proceeding	91218632
Party	Plaintiff Clontech Laboratories, Inc.
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Date	10/27/2014
Attachments	Amended Notice of Opposition.141027.FINAL (00049941xA1ADA).pdf(108516 bytes)

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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 **AMENDED NOTICE OF OPPOSITION**

21 Opposition No. 91218632

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
for genetic research for laboratory or research use; biochemical reagents commonly known as probes

1 and detection probes for detecting RNA” and International Class 9 for “detection probes, not for medical
2 purposes, for use in detecting RNA,” and was filed under Section 44(e).

3 **GROUND FOR OPPOSITION**

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

9 4. Opposer’s Registrations have priority over the Applied-For Mark because Opposer filed
10 them with the USPTO before Applicant filed the Applied-For Mark.

11 5. The Applied-For Mark is likely to cause confusion, mistake, or to deceive, as to source,
12 sponsorship, or affiliation because its dominant word element is identical to the mark appearing in
13 Opposer’s SMART Registration and is highly similar to the mark appearing in Opposer’s SMARTER
14 Registration, and its goods are nearly identical to those referenced by Opposer’s Registrations.

15 **PRAYER**

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

21 Dated: October 27, 2014

Respectfully submitted,

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23 HARVEY SISKIND LLP
24 IAN K. BOYD
KATE W. MCKNIGHT

25 By /Ian K. Boyd/

26 Ian K. Boyd

27 Attorneys for Opposer,
28 Clontech Laboratories, Inc.

1 **CERTIFICATE OF TRANSMISSION**

2 I hereby certify that a true and correct copy of the attached AMENDED NOTICE OF
3 OPPOSITION (Opposition No. 91218632) is being electronically transmitted to the Trademark Trial
4 and Appeal Board on October 27, 2014.

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6 */Ian K. Boyd/*
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