

ESTTA Tracking number: **ESTTA648430**

Filing date: **01/06/2015**

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	NuGEN Technologies, Inc.		
Entity	Corporation	Citizenship	Deleware
Address	201 Industrial Road, Suite 310 San Carlos, CA 94070 UNITED STATES		

Attorney information	John L. Slafsky Wilson Sonsini Goodrich & Rosati 650 Page Mill Road Palo Alto, CA 94304 UNITED STATES jslafsky@wsgr.com, nferguson@wsgr.com, trademarks@wsgr.com Phone:(650) 493-9300		
----------------------	--	--	--

Applicant Information

Application No	86332995	Publication date	12/16/2014
Opposition Filing Date	01/06/2015	Opposition Period Ends	01/15/2015
Applicant	NVIGEN, Inc. Building 36A Santa Clara, CA 95054 UNITED STATES		

Goods/Services Affected by Opposition

Class 042. First Use: 2011/01/01 First Use In Commerce: 2011/01/01 All goods and services in the class are opposed, namely: Biotechnology research; Development of new technology for others in the field of genomics, biotechnology, medical and clinical diagnostics, therapeutics; Research and development in the pharmaceutical and biotechnology fields
--

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3073884	Application Date	05/08/2001
Registration Date	03/28/2006	Foreign Priority Date	NONE
Word Mark	NUGEN		

Design Mark	<h1>NUGEN</h1>
Description of Mark	NONE
Goods/Services	Class 001. First use: First Use: 2003/03/24 First Use In Commerce: 2003/04/16 Chemicals, assays, reagents and kits consisting primarily of chemicals, assays, and reagents for the analysis of nucleic acids, sequencing, and nucleic acids detection

U.S. Registration No.	2882764	Application Date	05/08/2001
Registration Date	09/07/2004	Foreign Priority Date	NONE

Word Mark	NUGEN
Design Mark	<h1>NUGEN</h1>
Description of Mark	NONE
Goods/Services	Class 001. First use: First Use: 2003/04/16 First Use In Commerce: 2003/04/22 Chemicals, assays, reagents and kits consisting primarily of chemicals, assays, and reagents for the analysis of nucleic acids, proteins and antibodies or scientific and research use; chemicals, assays, reagents and kits consisting primarily of chemicals, assays, and reagents for nucleic acid sequence amplification, sequence analysis and oligonucleotides, cDNA and RNA libraries and microarrays for scientific and research use Class 042. First use: First Use: 2003/04/11 First Use In Commerce: 2003/04/11 Biotechnology services, namely, research and development of nucleic acid analysis technology for use in drug discovery, and clinical applications; licensing intellectual property in the field of biotechnology

U.S. Registration No.	3941663	Application Date	12/18/2009
Registration Date	04/05/2011	Foreign Priority	NONE

		Date	
Word Mark	NUGEN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 2010/01/31 First Use In Commerce: 2010/01/31 chemicals, assays, reagents and kits consisting primarily of chemicals, assays, and reagents for the analysis of nucleic acids, proteins and antibodies for clinical medical and medical diagnostic use; chemicals, assays, reagents and kits consisting primarily of chemicals, assays, and reagents for nucleic acid sequence amplification, sequencing and sequence analysis and detection, oligonucleotides, cDNA and RNA libraries and microarrays for clinical medical and medical diagnostic use		

Attachments	76254430#TMSN.png(bytes) 76976766#TMSN.png(bytes) 77896940#TMSN.png(bytes) Notice of Opposition.pdf(101858 bytes)
-------------	---

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	/John L. Slafsky/
Name	John L. Slafsky
Date	01/06/2015

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

NuGEN Technologies, Inc., a Delaware corporation,)	
)	
Opposer,)	Application Serial No. 86,332,995
)	
v.)	Published for Opposition on
)	December 16, 2014
)	
NVIGEN, Inc., a California corporation,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Mark: NVIGEN

Serial No.: 86,332,995

International Class: 42

Goods and services: Biotechnology research; Development of new technology for others in the field of genomics, biotechnology, medical and clinical diagnostics, therapeutics; Research and development in the pharmaceutical and biotechnology fields.

Filed: July 10, 2014

Published: December 16, 2014

Opposer NuGEN Technologies, Inc. (the “Opposer”), a Delaware corporation with its principal place of business at 201 Industrial Road, Suite 310, San Carlos, California 94070, believes that it will be damaged by the registration of the mark shown in Application Serial No. 86,332,995 (the “Application”), and hereby opposes that application.

As grounds for opposition, Opposer alleges that:

1. Opposer is filing this Notice of Opposition following publication of the Application on December 16, 2014.

2. Opposer has been using the trademark NUGEN since at least as early as October 23, 2003. Opposer has used, and continues to use, NUGEN on and in connection with a variety of goods and services.

3. Opposer owns the following United States registrations for the mark NUGEN:

Registration No. 3,073,884 filed May 8, 2001 and registered March 28, 2006 for “chemicals, assays, reagents and kits consisting primarily of chemicals, assays, and reagents for the analysis of nucleic acids, sequencing, and nucleic acids detection” in International Class 1;

Registration No. 2,882,764 filed May 5, 2001 and registered September 7, 2004 for “chemicals, assays, reagents and kits consisting primarily of chemicals, assays, and reagents for the analysis of nucleic acids, proteins and antibodies or scientific and research use; chemicals, assays, reagents and kits consisting primarily of chemicals, assays, and reagents for nucleic acid sequence amplification, sequence analysis and oligonucleotides, cDNA and RNA libraries and microarrays for scientific and research use” in International Class 1, and “biotechnology services, namely, research and development of nucleic acid analysis technology for use in drug discovery, and clinical applications; licensing intellectual property in the field of biotechnology” in International Class 42; and

Registration No. 3,941,663 filed December 18, 2009 and registered April 5, 2011 for “chemicals, assays, reagents and kits consisting primarily of chemicals, assays, and reagents for the analysis of nucleic acids, proteins and antibodies for clinical medical and medical diagnostic use; chemicals, assays, reagents and kits consisting primarily of chemicals, assays, and reagents for nucleic acid sequence amplification, sequencing and sequence analysis and detection, oligonucleotides, cDNA and RNA libraries and microarrays for clinical medical and medical diagnostic use” in International Class 5.

4. Opposer has long offered and sold its goods and services under its NUGEN mark in interstate commerce in the United States.

5. Opposer’s use of the NUGEN mark has been valid and continuous since the date of first use and Opposer has not abandoned the NUGEN mark.

6. Opposer’s NUGEN mark is symbolic of the extensive goodwill and customer recognition built up by Opposer through substantial amounts of time, money and effort in advertising and promotion and by virtue of the excellence of its goods and services.

7. Opposer is informed and believes, and therefore alleges, that Applicant NVIGEN, Inc. (the “Applicant”) is a California corporation with an address at Building 36A, 3350 Scott Blvd., Santa Clara, California 95054.

8. Opposer is informed and believes, and therefore alleges, that Applicant filed a use-based application on July 10, 2014 to register NVIGEN as a trademark.

9. Applicant’s application to register NVIGEN as a trademark covers biotechnology research; development of new technology for others in the field of genomics, biotechnology, medical and clinical diagnostics, therapeutics; and research and development in the pharmaceutical and biotechnology fields in International Class 42.

10. Opposer is informed and believes, and therefore alleges, that Applicant made no use of the NVIGEN mark before Opposer adopted and commenced use of its NUGEN mark.

11. Opposer is informed and believes, and therefore alleges, that Applicant made no use of the NVIGEN mark before 2011.

12. Opposer’s application dates for its three registrations and Opposer’s actual dates of first use and first use in commerce all precede Applicant’s filing date.

13. Applicant’s NVIGEN mark is virtually identical to Opposer’s NUGEN mark.

14. Applicant seeks to register the NVIGEN mark in connection with services that are highly related to Opposer’s goods and services sold under its NUGEN mark.

15. In view of the virtually identical marks and the substantially similar goods and services of the parties, Applicant’s mark so resembles Opposer’s mark as to be likely to cause confusion, to cause mistake, or to deceive.

16. Opposer's NUGEN mark is a well-known and distinctive trademark. Opposer's NUGEN mark was well-known and distinctive before Applicant filed its application for registration of the NVIGEN mark and before Applicant used the NVIGEN mark in commerce.

17. If Applicant is permitted to register NVIGEN for the services described in the application, confusion in the trade and in the public is likely to result. Confusion caused by Applicant will damage Opposer and injure its reputation in the trade and with the public. That confusion will also injure the public, in that consumers, upon seeing Applicant's mark used in connection with Applicant's services, are likely to believe that Applicant's services are somehow associated with or approved by Opposer.

WHEREFORE, Opposer prays that Application Serial No. 86,332,995 be rejected, that no registration be issued to Applicant, and that this opposition be sustained in favor of Opposer.

Please address all communications regarding this Notice of Opposition to:

John L. Slafsky
Nathan E. Ferguson
Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, California 94304-1050
(650) 493-9300
trademarks@wsgr.com

Dated: January 6, 2015

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

By: /Nathan E. Ferguson/
John L. Slafsky
Nathan E. Ferguson

Attorneys for Opposer
NuGEN Technologies, Inc.

CERTIFICATE OF SERVICE BY MAIL

I, Elvira Minjarez, declare:

I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California, 94304-1050.

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

On this date, I caused to be personally served **NOTICE OF OPPOSITION** on the person(s) listed below by placing the document(s) described above in an envelope addressed as indicated below, which I sealed. I placed the envelope(s) for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

Aihua Fu, CEO
NVIGEN, Inc.
Building 36A
3350 Scott Blvd.
Santa Clara, CA 95054

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed at Palo Alto, California on January 6, 2015.

