

ESTTA Tracking number: **ESTTA729173**

Filing date: **02/24/2016**

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 parties oppose registration of the indicated application.

Opposers Information

Name	Malvern Instruments Ltd.
Granted to Date of previous extension	02/24/2016
Address	Enigma Business Park, Grovewood Road Malvern, Worcestershire, WR14 1XZ UNITED KINGDOM

Name	NanoSight Limited
Granted to Date of previous extension	02/24/2016
Address	Enigma Business Park, Grovewood Road Malvern Instruments Ltd. Malvern, Worcestershire, WR14 1XZ UNITED KINGDOM

Attorney information	Jennifer Lee Taylor Morrison & Foerster LLP 425 Market Street San Francisco, CA 94105 UNITED STATES jtaylor@mofo.com, aphillips@mofo.com, tmdocket@mofo.com
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Applicant Information

Application No	86660825	Publication date	10/27/2015
Opposition Filing Date	02/24/2016	Opposition Period Ends	02/24/2016
Applicant	nanoView Diagnostics, Inc. 8 Saint Mary's St. Boston, MA 02215 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Scientific instrumentation for measuring nanoparticles

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.	4041965	Application Date	03/22/2011
Registration Date	10/18/2011	Foreign Priority Date	NONE
Word Mark	NANOSIGHT		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2004/10/01 First Use In Commerce: 2005/01/01 Electrical and scientific apparatus, namely, instruments and machines for measuring and characterizing nano particles; computer software for tracking, analyzing, viewing and characterizing nano particles</p> <p>Class 010. First use: First Use: 2004/10/01 First Use In Commerce: 2005/01/01 Medical instruments for measuring, tracking, analyzing, viewing and characterizing nano particles for application in the field of drug delivery, toxicology and medical research and development</p>		

Attachments	85272967#TMSN.png(bytes) Nanosight Ltd etc vs NanoView Diagnostics Inc - Notice of Opposition.pdf(359885 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	/Jennifer Lee Taylor/
Name	Jennifer Lee Taylor
Date	02/24/2016

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

NANOSIGHT LTD. and MALVERN
INSTRUMENTS LIMITED,

Opposers,

vs.

NANOVIEW DIAGNOSTICS, INC.,

Applicant.

Opposition No.:

Application Serial No.: 86/660,825

Mark: NANOVISION

Published: October 27, 2015

NOTICE OF OPPOSITION

Box TTAB FEE
Commissioner for Trademarks
P.O. Box 1451
Arlington, VA 22313-1451

NanoSight Ltd., a United Kingdom limited company, and Malvern Instruments Limited, a United Kingdom limited company, each having its principal place of business at Enigma Business Park, Grovewood Road, Malvern, United Kingdom, WR141XZ, each believe that it will be damaged by the use and registration of the NANOVISION mark in Application Serial No. 86/660,825, filed by nanoView Diagnostics, Inc. (“Applicant”), for “scientific instrumentation for measuring nanoparticles” in International Class 9.

As grounds for the opposition, it is alleged as follows:

1. Opposer NanoSight Ltd. (“NanoSight”) was founded in 2003 for the design and manufacture of instruments for the scientific analysis of nanoparticles. In 2004, NanoSight commercialized Nanoparticle Tracking Analysis, a patented technology that allowed for the development of a series of instruments that count, measure, and visualize nanoparticles in liquid

suspension for the development of drug delivery systems, viral vaccine research, and nanotoxicology and biomarker detection, among other applications.

2. Opposer Malvern Instruments Limited (“Malvern Instruments”) is a global leader in the manufacture of particle characterization systems. Malvern Instruments has been at the forefront of particle science since the 1970s, and maintains a global distributor network for its products. In 2013, Malvern Instruments acquired NanoSight and began promoting NanoSight nanoparticle analysis technology as part of the Malvern Instruments range of products.

3. Since at least as early as January 1, 2005, and well prior to Applicant’s filing date for the opposed application, NanoSight and Malvern Instruments (“Opposers”) have continuously offered and promoted the NANOSIGHT trademark in commerce in the United States, including through their affiliate NanoSight Inc., in connection with nanoparticle analysis technology. Through continuous and widespread use and promotion of the NANOSIGHT mark, Opposers have acquired common law rights in the NANOSIGHT mark.

4. NanoSight owns U.S. Registration No. 4,041,965 for the NANOSIGHT word mark for “electrical and scientific apparatus, namely, instruments and machines for measuring and characterizing nano particles; computer software for tracking, analyzing, viewing and characterizing nano particles” in International Class 9 and “medical instruments for measuring, tracking, analyzing, viewing and characterizing nano particles for application in the field of drug delivery, toxicology and medical research and development” in International Class 10. The application to register the NANOSIGHT mark as shown in registration No. 4,041,965 was filed on March 22, 2011, with a first use date of October 1, 2004 and a first use-in-commerce date of January 1, 2005, well prior to Applicant’s filing date for Application Serial No. 86/660,825.

Attached hereto as Exhibit A is a true and correct copy of the registration certificate for Registration No. 4,041,965.

5. NanoSight, and its parent Malvern Instruments, own the goodwill and reputation of the goods connected with and symbolized by the above-referenced NANOSIGHT mark. As a result of extensive marketing, promotion, and sales of Opposers' goods offered under the NANOSIGHT mark, NanoSight and its parent, Malvern Instruments, have built up highly valuable goodwill in the NANOSIGHT mark, and said goodwill has become closely and uniquely identified and associated with Opposers and Opposers' goods.

6. Applicant filed Application Serial No. 86/660,825 for the NANOVISION mark on June 12, 2015. The application was published in the *Official Gazette* on October 27, 2015.

7. By the application herein opposed, Applicant seeks to register the NANOVISION mark for "scientific instrumentation for measuring nanoparticles" in International Class 9.

LIKELIHOOD OF CONFUSION

8. Since at least as early as January 1, 2005, substantially prior to Applicant's filing date for the NANOVISION application and, on information and belief, substantially prior to any use or use-in-commerce by Applicant of the NANOVISION mark, Opposers have continuously offered and promoted in commerce the nanoparticle characterization technology goods under the NANOSIGHT mark.

9. On information and belief, any use or use-in-commerce of the NANOVISION mark by Applicant does not predate Opposers' rights in the NANOSIGHT mark and/or the priority date for the NANOSIGHT mark owned by NanoSight.

10. Applicant's NANOVISION mark is highly similar to the NANOSIGHT mark. The first two syllables of both marks—the letters 'NANO'—are phonetically and visually

identical. Each mark is then followed by a final element comprised of a word meaning ‘to see’: SIGHT versus VISION. Since the two marks utilize the same structure and impart identical meanings, consumers could easily mistake Applicant’s mark as a variant on Opposers’ mark. For these reasons, Applicant’s and Opposers’ respective marks are confusingly similar in appearance, sound, meaning, connotation, and commercial impression.

11. The goods of “scientific instrumentation for measuring nanoparticles” in International Class 9 covered by the opposed application are identical, complementary, or otherwise closely related to the goods of “electrical and scientific apparatus, namely, instruments and machines for measuring and characterizing nano particles; computer software for tracking, analyzing, viewing and characterizing nano particles” in International Class 9 and “medical instruments for measuring, tracking, analyzing, viewing and characterizing nano particles for application in the field of drug delivery, toxicology and medical research and development” in International Class 10, offered under Opposers’ NANOSIGHT mark.

12. Opposers are informed, believe, and on that basis allege that Applicant’s consumers for the goods identified in the opposed application are likely to consist of many of the same consumers of Opposers’ goods, who are already familiar with Opposers’ NANOSIGHT mark and the goods offered under that mark.

13. Opposers are informed, believe, and on that basis allege that Applicant is likely to offer and distribute its goods through channels of trade that will overlap with those used by Opposers to offer and distribute Opposers’ NANOSIGHT goods, and that Applicant is likely to target consumers of Opposers’ NANOSIGHT goods for Applicant’s goods.

14. In view of the fact that Applicant’s NANOVISION mark is confusingly similar to Opposers’ NANOSIGHT mark, that Applicant’s and Opposers’ respective goods are identical,

complementary and/or closely related, and that the customers for Applicant's and Opposers' respective goods will be the same or overlapping, Applicant's NANOVISION mark is likely to cause confusion with Opposers' NANOSIGHT mark, or to cause mistake or to deceive as to the origin, sponsorship, or approval of Applicant's goods. Opposers would thereby be injured by Applicant's intended use and registration of the NANOVISION mark in Application Serial No. 86/660,825.

Filing Fee: The USPTO is authorized to charge \$600.00 for the Notice of Opposition to Application Serial No. 86/660,825 to Morrison & Foerster LLP's Deposit Account 03-1952 (Reference No. 73971-6001.501).

WHEREFORE, Opposers pray that Application Serial No. 86/660,825 be rejected, and that this opposition be sustained in favor of Opposers.

Respectfully submitted,

Dated: February 24, 2016

By: /s/Jennifer Lee Taylor

Jennifer Lee Taylor
Attorney for Opposers
NanoSight Ltd.
Malvern Instruments Limited

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EXHIBIT A

United States of America
United States Patent and Trademark Office

NANOSIGHT

Reg. No. 4,041,965

Registered Oct. 18, 2011

Int. Cls.: 9 and 10

TRADEMARK

PRINCIPAL REGISTER

NANOSIGHT LTD (UNITED KINGDOM LIMITED COMPANY (LTD.))
MINTON PARK, LONDON ROAD
AMESBURY, UNITED KINGDOM

FOR: ELECTRICAL AND SCIENTIFIC APPARATUS, NAMELY, INSTRUMENTS AND MACHINES FOR MEASURING AND CHARACTERIZING NANO PARTICLES; COMPUTER SOFTWARE FOR TRACKING, ANALYZING, VIEWING AND CHARACTERIZING NANO PARTICLES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 10-1-2004; IN COMMERCE 1-1-2005.

FOR: MEDICAL INSTRUMENTS FOR MEASURING, TRACKING, ANALYZING, VIEWING AND CHARACTERIZING NANO PARTICLES FOR APPLICATION IN THE FIELD OF DRUG DELIVERY, TOXICOLOGY AND MEDICAL RESEARCH AND DEVELOPMENT, IN CLASS 10 (U.S. CLS. 26, 39 AND 44).

FIRST USE 10-1-2004; IN COMMERCE 1-1-2005.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 85-272,967, FILED 3-22-2011.

REBECCA SMITH, EXAMINING ATTORNEY



David J. Kyffers

Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

Requirements in the First Ten Years*

What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.* See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*

What and When to File:

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or
reminder of these filing requirements.**

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

PROOF OF SERVICE BY MAIL

I am employed with the law firm of Morrison & Foerster LLP, whose address is 425 Market Street, San Francisco, California, 94105; I am not a party to the within cause; I am over the age of eighteen years and I am readily familiar with Morrison & Foerster's practice for collection and processing of correspondence for mailing with the United States Postal Service and know that in the ordinary course of Morrison & Foerster's business practice the document described below will be deposited with the United States Postal Service on the same date that it is placed at Morrison & Foerster with postage thereon fully prepaid for collection and mailing.

I further declare that on February 24, 2016, I served a copy of:

NOTICE OF OPPOSITION

on the following by placing a true copy thereof enclosed in a sealed envelope addressed as follows for collection and mailing at Morrison & Foerster LLP, 425 Market Street, San Francisco, California, 94105, in accordance with Morrison & Foerster's ordinary business practices:

**Matthew H. Swyers
The Trademark Company
344 Maple Ave W PMB 151
Vienna, Virginia 22180-5612**

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

Executed at San Francisco, California, this 24th day of February, 2016.

Grace Gabriel
(typed)


(signature)