

ESTTA Tracking number: **ESTTA749172**

Filing date: **05/31/2016**

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 party opposes registration of the indicated application.

Opposer Information

Name	TAQKEY SCIENCE CO., LTD.
Granted to Date of previous extension	06/04/2016
Address	1F., NO.60, JIABEI 2ND ST. JHUNAN TOWNSHIP, MIAOLI COUNTY, 350 TAIWAN

Attorney information	Stacey R. Halpern KNOBBE MARTENS OLSON & BEAR LLP 2040 Main Street, 14th Floor Irvine, CA 92614 UNITED STATES efiling@knobbe.com Phone:949 760 0404
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Applicant Information

Application No	86721236	Publication date	04/05/2016
Opposition Filing Date	05/31/2016	Opposition Period Ends	06/04/2016
Applicant	BIO-HELIX CO., LTD. 1F., No. 19, Ln. 199, Sec. 3 Taipei City 105, TAIWAN		

Goods/Services Affected by Opposition

<p>Class 001. First Use: 2000/01/07 First Use In Commerce: 2000/01/07 All goods and services in the class are opposed, namely: Nucleic acid for laboratory use, namely, DNA molecular weight ladders; Prestained protein molecular weight ladders comprising nucleic acid for laboratory use; Stains and tracking dyes for electrophoresis for scientific and research purposes; Reagents for preparative electrophoresis for scientific and research purposes; Biochemicals for electrophoretic blotting for scientific and research purposes; Reagents for biochemical imaging and analysis for scientific and research purposes; Gels, namely, protein gels and agarose gels for scientific and research purposes; Reagents and chemicals for medical and scientific research use, namely, reagents for amplifying nucleic acid; Reagents and chemicals used for nucleic acid purification, amplification and detection, chemical standards, chemicals for biochemical assays, and immunoassay all for scientific and research purposes; Biochemical reagents commonly known as probes, for detecting and analyzing molecules in protein or nucleotide arrays, namely, stains and tracking dyes for electrophoresis for scientific and research purposes; Biochemical reagents used for non-medical purposes; Electrophoresis gels other than for medical or veterinary purposes; Protein in raw material form for scientific and medical research, namely, prestained protein molecular weight ladders; Nucleic acid for laboratory use</p>
<p>Class 005. First Use: 2000/01/07 First Use In Commerce: 2000/01/07 All goods and services in the class are opposed, namely: Diagnostic preparations for medical andve-</p>

terinary use, namely, nucleic acid amplification mix/kit, PCR mix/kit; Diagnostic biomarker reagents for medical purposes, namely, DNA molecular weight ladders; Reagents and chemical reagents for clinical, medical, and diagnostic uses; Diagnostic biomarker reagents for medical purposes; Diagnostic reagents for medicinal use

Class 009. First Use: 2000/01/07 First Use In Commerce: 2000/01/07

All goods and services in the class are opposed, namely: Electrophoresis imaging instruments; Gel documentation instruments; Computerized biochemical imaging instruments and densitometers; Computer programs for biochemical imaging and analysis; Preparative electrophoresis instrument; Blotting cells and membranes for electrophoretic transfer and for biochemical laboratory quality; Apparatus and instruments for electrophoresis and mass spectrometry; Electrophoresis apparatus not for medical purposes; Scientific apparatus and instruments for measuring relative DNA, RNA and protein and parts and fittings therefore, namely, electrophoresis imaging instruments, gel documentation instruments

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Applicant not rightful owner of mark for identified goods or services	Trademark Act Section 1
Other	Common law rights as asserted in the Notice of Opposition

Marks Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	GeneDireX		
Goods/Services	Molecular biology reagents, DNA and protein ladders, gel staining reagents, nucleic acid purification systems, molecular biology reagents, lab consumables. nucleic acid, prestained protein molecular weight ladders stains and tracking dyes for electrophoresis for scientific and research purposes; reagents for preparative electrophoresis for scientific and research purposes; biochemicals for electrophoretic blotting for scientific and research purposes; reagents and chemicals for medical, non-medical, scientific, biochemical and research purposes, protein in Class 1 diagnostic preparations for medical and veterinary use, reagents and chemical reagents for clinical, medical, and diagnostic uses in Class 5 and electrophoresis imaging instruments; gel documentation instruments; computerized biochemical imaging instruments and densitometers; computer programs for biochemical imaging and analysis; preparative electrophoresis instrument; blotting cells and membranes for electrophoretic transfer and for biochemical laboratory quality; apparatus and instruments for electrophoresis and mass spectrometry; electrophoresis apparatus not for medical purposes; scientific apparatus and instruments for measuring relative DNA, RNA and protein and parts and fittings in Class 9 as well as services related to all of the foregoing goods		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Design Mark	 <p>The logo for GeneDireX features the word "GeneDireX" in a bold, black, sans-serif font. The letter "i" in "DireX" is stylized with a small, grey, starburst-like graphic above it. The "X" is also stylized with a slight shadow effect.</p>
Goods/Services	<p>Molecular biology reagents, DNA and protein ladders, gel staining reagents, nucleic acid purification systems, molecular biology reagents, lab consumables. nucleic acid, prestained protein molecular weight ladders stains and tracking dyes for electrophoresis for scientific and research purposes; reagents for preparative electrophoresis for scientific and research purposes; biochemicals for electrophoretic blotting for scientific and research purposes; reagents and chemicals for medical, non-medical, scientific, biochemical and research purposes, protein in Class 1 diagnostic preparations for medical and veterinary use, reagents and chemical reagents for clinical, medical, and diagnostic uses in Class 5 and electrophoresis imaging instruments; gel documentation instruments; computerized biochemical imaging instruments and densitometers; computer programs for biochemical imaging and analysis; preparative electrophoresis instrument; blotting cells and membranes for electrophoretic transfer and for biochemical laboratory quality; apparatus and instruments for electrophoresis and mass spectrometry; electrophoresis apparatus not for medical purposes; scientific apparatus and instruments for measuring relative DNA, RNA and protein and parts and fittings in Class 9 as well as services related to all of the foregoing goods</p>

Attachments	<p>GENEDIREX logo2.jpg Notice of Opposition ALFJ006.001ZTUS.pdf(37802 bytes)</p>
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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	/Stacey R. Halpern/
Name	Stacey R. Halpern
Date	05/31/2016

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

Taqkey Science Co., Ltd.)
Opposer,)
v.)
Bio-Helix Co., Ltd.,)
Applicant.)

NOTICE OF OPPOSITION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir or Madam:

Opposer, Taqkey Science Co., Ltd., a Taiwanese Corporation believes it is or will be damaged by registration of the mark shown in Application Serial No. 86721236 (“Applicant’s Application”) filed August 11, 2015 by Bio-Helix Co., Ltd. (“Applicant”), and hereby opposes the same.

A description of Applicant’s Application is as follows:

GeneDireX

Mark	:	
Serial No.	:	86721236
Filed	:	August 11, 2015
Published	:	April 5, 2016
Int’l. Classes	:	1, 5 and 9
Goods/Services	:	Nucleic acid for laboratory use, namely, DNA molecular weight ladders; Prestained protein molecular weight ladders comprising nucleic acid for laboratory use; Stains and tracking dyes for electrophoresis for scientific and research purposes; Reagents for preparative electrophoresis for scientific and research purposes;

Biochemicals for electrophoretic blotting for scientific and research purposes; Reagents for biochemical imaging and analysis for scientific and research purposes; Gels, namely, protein gels and agarose gels for scientific and research purposes; Reagents and chemicals for medical and scientific research use, namely, reagents for amplifying nucleic acid; Reagents and chemicals used for nucleic acid purification, amplification and detection, chemical standards, chemicals for biochemical assays, and immunoassay all for scientific and research purposes; Biochemical reagents commonly known as probes, for detecting and analyzing molecules in protein or nucleotide arrays, namely, stains and tracking dyes for electrophoresis for scientific and research purposes; Biochemical reagents used for non-medical purposes; Electrophoresis gels other than for medical or veterinary purposes; Protein in raw material form for scientific and medical research, namely, prestained protein molecular weight ladders; Nucleic acid for laboratory use in Class 1; Diagnostic preparations for medical and veterinary use, namely, nucleic acid amplification mix/kit, PCR mix/kit; Diagnostic biomarker reagents for medical purposes, namely, DNA molecular weight ladders; Reagents and chemical reagents for clinical, medical, and diagnostic uses; Diagnostic biomarker reagents for medical purposes; Diagnostic reagents for medicinal use in Class 5 and Electrophoresis imaging instruments; Gel documentation instruments; Computerized biochemical imaging instruments and densitometers; Computer programs for biochemical imaging and analysis; Preparative electrophoresis instrument; Blotting cells and membranes for electrophoretic transfer and for biochemical laboratory quality; Apparatus and instruments for electrophoresis and mass spectrometry; Electrophoresis apparatus not for medical purposes; Scientific apparatus and instruments for measuring relative DNA, RNA and protein and parts and fittings therefore, namely, electrophoresis imaging instruments, gel documentation instruments in Class 9.

As grounds for opposition, it is alleged:

1. Taqkey Science Co., Ltd., founded in 2000, is the owner of the name GeneDireX

GeneDireX

and the mark

. For many years prior to the filing date of Applicant's Application, Taqkey Science Co., Ltd. and its related company, GeneDireX Inc. (collectively, "Opposer") have used the name GeneDireX and marks GeneDireX and

GeneDireX

in connection with various goods and services. Among the goods and services provided by Opposer are molecular biology reagents, DNA and protein ladders, gel staining reagents, nucleic acid purification systems, molecular biology reagents, lab consumables, nucleic acid, prestained protein molecular weight ladders stains and tracking dyes for electrophoresis for scientific and research purposes; reagents for preparative electrophoresis for scientific and research purposes; biochemicals for electrophoretic blotting for scientific and research purposes; reagents and chemicals for medical, non-medical, scientific, biochemical and research purposes, protein in Class 1 diagnostic preparations for medical and veterinary use, reagents and chemical reagents for clinical, medical, and diagnostic uses in Class 5 and electrophoresis imaging instruments; gel documentation instruments; computerized biochemical imaging instruments and densitometers; computer programs for biochemical imaging and analysis; preparative electrophoresis instrument; blotting cells and membranes for electrophoretic transfer and for biochemical laboratory quality; apparatus and instruments for electrophoresis and mass spectrometry; electrophoresis apparatus not for medical purposes; scientific apparatus and instruments for measuring relative DNA, RNA and protein and parts and fittings in Class 9 as well as services related to all of the foregoing goods (collectively, “Opposer’s Goods and Services”).

2. For many years prior to the filing date of Applicant’s Application, Opposer has developed, marketed, promoted, advertised, offered, provided and sold Opposer’s Goods and Services in connection with the name GeneDireX and marks GeneDireX and

GeneDireX

in the United States and around the world.

3. One of Opposer’s former employees and shareholders is Zheng-Yan-LEE, the

President of Applicant.

4. Despite Applicant's knowledge of Opposer's prior and senior rights in the

GeneDireX name and GeneDireX and  marks, Applicant filed Applicant's Application.

5. The mark in Applicant's Application consists of Opposer's

 mark.

6. Applicant is not the owner of the mark shown in Applicant's Application. Instead, the mark is owned by Opposer. Applicant was aware of this at the time it filed Applicant's Application. Despite this knowledge, Applicant filed Applicant's Application.

7. In Applicant's Application, Applicant claims under penalty of perjury that, "the applicant is the owner of the trademark/service mark sought to be registered." As Applicant is not the owner of the mark shown in Applicant's Application, the application is void.

8. Since prior to the filing date of Applicant's Application, Opposer has used the

GeneDireX and  marks in interstate commerce. The GeneDireX and

 marks by virtue of Opposer's use, distinguish Opposer's Goods and

Services from those of others. Further, Opposer has built up through time and effort, the

valuable goodwill symbolized by the GeneDireX and  marks. In

addition, the relevant class of consumers has come to associate Opposer with the GeneDireX and

GeneDireX marks.

9 If Applicant is allowed to register the mark in Applicant's Application,

Applicant's corresponding *prima facie* exclusive right to use the **GeneDireX** mark nationwide will conflict with Opposer's nationwide rights in the GeneDireX and

GeneDireX marks.

10. Opposer has invested substantial amounts of time and effort in the GeneDireX

and **GeneDireX** marks throughout the United States and the world. By reason of

Opposer's widespread and continuous use of the GeneDireX and **GeneDireX** marks, Opposer has extensive, non-registered statutory and common law rights in the marks. In view of the similarity of the respective marks and the related nature of the goods in Applicant's Application and Opposer's Goods and Services, it is alleged that the mark in Applicant's Application so resembles Opposer's marks as to be likely to cause confusion, or to cause mistake or deceive.

11. In view of Opposer's prior rights in the **GeneDireX** mark, Applicant

is not entitled to registration of the **GeneDireX** mark pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

12. In view of Opposer's prior rights in the GeneDireX and **GeneDireX**

marks, Applicant is not entitled to registration of the mark in Applicant's Application pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

13. As the mark in Applicant's Application (**GeneDireX**) is identical to Opposer's **GeneDireX** mark, Applicant is not entitled to registration of the **GeneDireX** mark pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

14. Applicant has no license, consent or permission from Opposer to use or register the **GeneDireX** mark.

15. Applicant adopted and applied to register the **GeneDireX** mark with full knowledge of Opposer's prior rights in the GeneDireX name and the GeneDireX and **GeneDireX** marks.

16. Use of the mark sought to be registered by Applicant is likely to cause confusion or to cause mistake or to deceive the purchasing public by creating the mistaken belief that Applicant's goods are approved of, endorsed, or sponsored by Opposer, or that Opposer is the source of Applicant's goods, or that the services of Applicant are in some other way associated with Opposer, all to Opposer's grave injury and harm.

17. Opposer will be damaged by registration of the mark in Applicant's Application in that the **GeneDireX** mark in the Applicant's Application is identical to Opposer's

GeneDireX

mark and in that the Applicant seeks registration for goods identical or closely related to Opposer's Goods. Thus, the mark in Applicant's Application is likely to cause

confusion with Opposer's **GeneDireX**

mark in that the purchasing public is likely to be confused, mistaken, or deceived into believing that Applicant's goods originate with Opposer or are otherwise authorized, licensed, or sponsored by Opposer's, within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

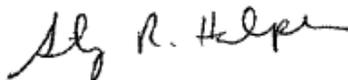
18. As Applicant is not the owner of the mark in Applicant's Application, Opposer is or will be gravely damaged by the registration of the mark shown in Applicant's Application.

19. By reason of all the foregoing, Opposer is or will be gravely damaged by the registration of the mark shown in Applicant's Application because registration of this mark would be in violation of Opposer's rights.

WHEREFORE, Opposer requests that Applicant's Application be rejected and stricken, that no registration be issued thereon to Applicant, and that this Opposition be sustained in its favor.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP



Dated: May 31, 2016

By: _____

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Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **NOTICE OF OPPOSITION** upon Applicant's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid on May 31, 2016 addressed as follows:

STEVEN M. RABIN
Rabin & Berdo P C
1101 14th St NW Ste 500
Washington, DC 20005-5633



Sarah Beno Couvillion

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