

ESTTA Tracking number: **ESTTA757885**

Filing date: **07/12/2016**

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	The Board of Trustees of the Leland Stanford Junior University
Granted to Date of previous extension	07/13/2016
Address	Building 170, 3rd Floor, Main Quad Stanford, CA 94305 UNITED STATES
Attorney information	Sam E. Iverson Pillsbury Winthrop Shaw Pittman LLP P.O. Box 2824 San Francisco, CA 94126-2824 UNITED STATES sfrademarks@pillsburylaw.com

Applicant Information

Application No	79169977	Publication date	03/15/2016
Opposition Filing Date	07/12/2016	Opposition Period Ends	07/13/2016
International Registration No.	1258878	International Registration Date	06/24/2015
Applicant	Medicine X Pty Ltd 39 Sunrise Rd AUSTRALIA		

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: Computer software for providing medical information with storytelling and illustrations; downloadable computer software for providing medical information with storytelling and illustrations; downloadable mobile phone applications for providing medical information with storytelling and illustrations
Class 044. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Medical services; provision of medical information; provision of information relating to medicine

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)

False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)
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Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	86673446	Application Date	06/24/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	MEDICINE X		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2011/10/31 First Use In Commerce: 2011/10/31 Educational services, namely, teaching, training, lectures, courses of instruction and conferences in the field of medicine and healthcare Class 042. First use: First Use: 2011/10/31 First Use In Commerce: 2011/10/31 Medical research services		

U.S. Application No.	86673451	Application Date	06/24/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	STANFORD MEDICINE X		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2011/10/31 First Use In Commerce: 2011/10/31 Educational services, namely, teaching, training, lectures, courses of instruction and conferences in the field of medicine and healthcare Class 042. First use: First Use: 2011/10/31 First Use In Commerce: 2011/10/31		

	Medical research services
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Attachments	86673446#TMSN.png(bytes) 86673451#TMSN.png(bytes) Notice of Opposition - MEDICINE X.PDF(575700 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	/Sam E. Iverson/
Name	Sam E. Iverson
Date	07/12/2016

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

_____)	
THE BOARD OF TRUSTEES OF THE)	OPPOSITION NO.
LELAND STANFORD JUNIOR)	
UNIVERSITY)	<u>NOTICE OF OPPOSITION</u>
)	
Opposer,)	
)	Trademark: MEDICINE X
v.)	
)	
MEDICINE X PTY LTD.)	Serial Number 79-169977
)	
Applicant.)	
_____)	

Opposer, The Board of Trustees of the Leland Stanford Junior University, a California non-profit entity having corporate powers, having a business address at Stanford University, Office of the General Counsel, Building 170, Main Quad, 3rd Floor, Stanford, California 94305 ("Opposer"), believes that it is being or will be damaged by registration of the mark shown in Serial No. 79-169977 and filed by Medicine X Pty Ltd., an Australian company with an address at 39 Sunrise Rd., Palm Beach NSW 2108, Australia ("Applicant"), and hereby opposes the registration of said mark.

The grounds for the opposition are as follows:

1. Opposer owns and has continuously used since 2011 and is using in commerce the names and marks MEDICINE X and STANFORD MEDICINE X (the "Opposer's Marks" or "MEDICINE X Marks") for and in connection with its world-renowned educational services, namely, teaching, training, lectures, courses of instruction and conferences in the field of medicine and healthcare, and medical research services (the "Opposer's Services").

2. Opposer owns pending applications for MEDICINE X (Serial No. 86-673446) and STANFORD MEDICINE X (Serial No. 86-673451) covering “educational services, namely, teaching, training, lectures, courses of instruction and conferences in the field of medicine and healthcare” in Class 41 and “medical research services” in Class 42, filed June 24, 2015.

3. Opposer first used the MEDICINE X Marks in commerce at least as early as October 31, 2011.

4. Through extensive advertising, sales, promotion and long use, Opposer’s MEDICINE X Marks have become and are famous.

5. On June 24, 2015, Applicant filed an international application, designating the United States, to register the mark MEDICINE X for “computer software for providing medical information with storytelling and illustrations; downloadable computer software for providing medical information with storytelling and illustrations; downloadable mobile phone applications for providing medical information with storytelling and illustrations” in Class 9 and “medical services; provision of medical information; provision of information relating to medicine” in Class 44 (IR 1258878) (U.S. Serial Number 79-169977) (“Applicant’s Mark”):



6. On information and belief, Applicant has not made actual trademark use in commerce of Applicant’s Mark for the goods and services listed in U.S. Serial Number 79-169977.

7. On information and belief, no actual or constructive use was made of Applicant’s Mark in the United States for the covered goods and services prior to either its June 24, 2015

international registration date, or to the December 22, 2014 filing date for its base application in Australia.

8. Opposer has been using the MEDICINE X Marks continuously in interstate commerce for Opposer's Services since long prior to Applicant's application priority date, and long prior to any actual use by Applicant in the United States of Applicant's Mark.

9. Opposer first used the MEDICINE X Marks and trade name in commerce for Opposer's Services and said mark was distinctive of Opposer, and became famous, long prior to Applicant's application priority date and long prior to the first actual or constructive use of Applicant's Mark.

10. Opposer made and continues to make extensive sales and promotion of Opposer's Services under the MEDICINE X Marks and said names and marks became distinctive and famous long prior to the first actual or constructive use of Applicant's Mark.

11. Applicant's Mark, incorporating MEDICINE X as its dominant term, so resembles Opposer's MEDICINE X Marks, previously used in the United States and not abandoned, as to be likely, when used on or in connection with the goods and services of Applicant, to cause confusion, or to cause mistake, or to deceive in violation of Section 2(d) of the Lanham Act.

12. Applicant's Mark dilutes or is likely to dilute or will dilute Opposer's distinctive and famous MEDICINE X Marks in violation of Section 43(c) of the Act.

WHEREFORE, the Board should sustain this opposition and Application 79-169977 should be refused registration.

The official fee is submitted herewith. Charge any missing fee to Account No. 033975 Order No. 082288-0000056.

Date: July 12, 2016

Respectfully submitted,

The Board of Trustees of the Leland Stanford Junior University

By: 

LAURA C. GUSTAFSON

SAM E. IVERSON

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PROOF OF SERVICE BY FIRST-CLASS MAIL

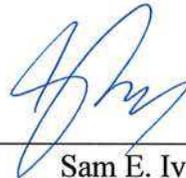
I, Sam E. Iverson, the undersigned, hereby certify and declare under penalty of perjury that the following statements are true and correct:

1. I am over the age of 18 years and am not a party to the within cause. I am employed by Pillsbury Winthrop Shaw Pittman LLP in San Francisco, CA.
2. My business address is Four Embarcadero Center, 22nd Floor, San Francisco, CA 94111. My mailing address is P.O. Box 2824, San Francisco, CA 94126-2824.
3. On July 12, 2016, I served a true copy of the attached document titled exactly "NOTICE OF OPPOSITION" by placing it in an addressed and sealed envelope and transmitting it by first-class mail, to the following:

Todd A. Sullivan
Hayes Soloway PC
175 Canal Street
Manchester, New Hampshire, U.S.A. 03101

4. On July 12, 2016, I also sent a copy of the Notice of Opposition by email to applicant's correspondent at tsullivan@hayes-soloway.com.

I declare under penalty of perjury that the foregoing is true and correct. Executed this 12th day of July, 2016, at San Francisco, CA.



Sam E. Iverson