

TTAB

EXPRESS MAIL NO. EL913523836US

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

QIAGEN GmbH,)
)
 Petitioner,)
)
 v.)
)
 BIO-RAD LABORATIES, INC.,)
)
 Registrant/Respondent)

CANCELLATION NO.
Registration No. 2,108,028
Docket No. 770025.803

02 OCT 18
9:30
TRADEMARK TRIAL AND APPEAL BOARD

Box TTAB/FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513


10-07-2002
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #77

PETITION FOR CANCELLATION

Petitioner QIAGEN GmbH ("Petitioner" or "QIAGEN"), which has a place of business at Max-Volmer-Strasse 4, D-4010 Hilden, Federal Republic of Germany, believes that it is or will be damaged by U.S. Trademark Registration No. 2,108,028 for "MDX" for chemical reagents for scientific and research use in detecting, visualizing and quantitating DNA and RNA; scientific and research test kits consisting primarily of reagents for detecting, visualizing and quantitating DNA and RNA, in International Class 1, registered October 21, 1997, and hereby petitions to cancel the same.

The grounds asserted by Petitioner for cancellation are as follows:

1. Upon information and belief, Registrant-Respondent Bio-Rad Laboratories, Inc. ("Bio-Rad") is the owner of U.S. Trademark Registration No. 2,108,028 for the mark MDX for chemical reagents for scientific and research use in detecting, visualizing and quantitating DNA and RNA; scientific and research test kits consisting primarily of reagents for detecting, visualizing and quantitating DNA and RNA. Bio-Rad and any predecessors-in-interest and

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successors-in-interest as to U.S. Trademark Registration No. 2,108,028 are hereinafter jointly referred to as "Respondent."

2. Petitioner and others in the biomedical and biotechnical industry use the term "MDX" descriptively and/or generically as an abbreviation or acronym for the term "molecular diagnostics."

3. On July 25, 2002, counsel for Bio-Rad sent a letter to QIAGEN asserting U.S. Trademark Registration No. 2,108,028 and demanding that QIAGEN cease all use of the term "MDX."

4. Petitioner is informed and believes that the goods described in Respondent's registration--namely, "chemical reagents for scientific and research use in detecting, visualizing and quantitating DNA and RNA; scientific and research test kits consisting primarily of reagents for detecting, visualizing and quantitating DNA and RNA"--include products that are molecular diagnostics.

5. The term "MDX" has become and is recognized in the biomedical and biotechnical industry and by relevant consumers as the common, apt name for molecular diagnostics, and thus is a generic term.

6. Petitioner is informed and believes that the goods described in Respondent's registration--namely, "chemical reagents for scientific and research use in detecting, visualizing and quantitating DNA and RNA; scientific and research test kits consisting primarily of reagents for detecting, visualizing and quantitating DNA and RNA"--include kits and other products intended for use, and used, for performing molecular diagnostics.

7. The term "MDX" is thus an apt term for describing Respondent's goods and, when applied to the goods identified in Respondent's registration, is merely descriptive of those goods and/or generic for those goods.

8. The term "MDX" was used and recognized in the industry as an abbreviation or acronym "molecular diagnostics" prior to Respondent's use of the alleged "MDX" mark.

9. Respondent has not established secondary meaning in the alleged mark "MDX."

10. Respondent is not entitled to the subject registration of the alleged mark "MDX" because the alleged mark does not serve to identify Respondent's goods and distinguish them from those offered by others.

11. Respondent is not entitled to the subject registration of the alleged mark "MDX" in that Respondent is not entitled to exclusive use of the term "MDX" in commerce on the specified goods and Petitioner has a valid and legal right to use the term "MDX" in connection with Petitioner's goods and services.

12. Petitioner will be damaged by continuance of said registration.

WHEREFORE, Petitioner prays that U.S. Trademark Registration No. 2,108,028 be canceled and that this Petition for Cancellation be sustained.

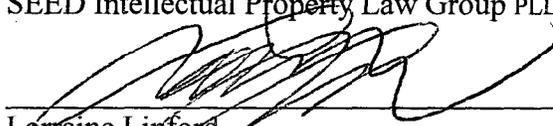
Petitioner submits this Petition for Cancellation in duplicate along with the requisite filing fee of three hundred dollars (\$300) to cover the cost of filing. Please charge any additional fees or credit any excess to our Deposit Account No. 19-1090. A duplicate copy of this petition is enclosed.

Please direct all communications to Lorraine Linford of Seed Intellectual Property Law Group PLLC, 701 Fifth Avenue, Suite 6300, Seattle, Washington 98104-7092.

DATED this 7th day of October, 2002.

Respectfully submitted,

SEED Intellectual Property Law Group PLLC



Lorraine Linford
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Seattle, Washington 98104-7092
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Fax: (206) 682-6031

Attorneys for Petitioner

Enclosures:

Postcard
Check for \$300
Copy of Petition for Cancellation

cc: QIAGEN GmbH

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CERTIFICATE OF MAILING BY "EXPRESS MAIL"

I hereby certify that the documents listed below are being deposited with the United States Postal Service "EXPRESS MAIL Post Office to Addressee" service under 37 C.F.R. § 1.10, Mailing Label Certificate No. EL913523836US, on October 7, 2002, addressed to:

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02 OCT 18 PM 9:30

Box TTAB/FEE
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2900 Crystal Drive
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Respectfully submitted,
SEED Intellectual Property Law Group PLLC

LL:ab
Enclosures:
Postcard
Check for \$300
Petition for Cancellation (+ 1 copy)

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