

ESTTA Tracking number: **ESTTA387015**

Filing date: **01/06/2011**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Illumina, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	9885 Towne Center Drive San Diego, CA 92121 UNITED STATES		

Attorney information	James Menker Holley & Menker, PA PO Box 331937 Atlantic Beach, FL 32233 UNITED STATES eastdocket@holleymenker.com Phone:9042472620		
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Registration Subject to Cancellation

Registration No	3868081	Registration date	10/26/2010
Registrant	Meridian Bioscience, Inc. 3471 River Hills Drive Cincinnati, OH 45244 UNITED STATES		

Goods/Services Subject to Cancellation

Class 005. First Use: 2009/12/14 First Use In Commerce: 2010/07/21 All goods and services in the class are cancelled, namely: Diagnostic kits consisting of molecular assays for use in disease testing and treatment of gastrointestinal, viral, urinary, respiratory and infectious diseases

Grounds for Cancellation

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2632507	Application Date	08/18/2000
Registration Date	10/08/2002	Foreign Priority Date	NONE
Word Mark	ILLUMINA		

Design Mark	ILLUMINA
Description of Mark	NONE
Goods/Services	Class 001. First use: First Use: 2001/02/23 First Use In Commerce: 2001/02/23 chemicals, namely reagents for scientific or medical research use for analyzing cells, proteins, nucleic acids and other molecules of 50 to 10,000 daltons, sequencing DNA, genotyping, gene expression profiling and high through-put screening Class 042. First use: First Use: 2001/10/12 First Use In Commerce: 2001/10/12 scientific and medical research, namely, analysis of cells, proteins, nucleic acids and other molecules of 50 to 10,000 daltons, sequencing DNA, genotyping, gene expression profiling and high through-put screening

U.S. Registration No.	2756703	Application Date	08/18/2000
Registration Date	08/26/2003	Foreign Priority Date	NONE
Word Mark	ILLUMINA		
Design Mark	ILLUMINA		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2003/01/09 First Use In Commerce: 2003/01/09 Scientific equipment and instruments, namely scanners, hybridization stations and fluidics delivery and computer systems sold as a unit and cassettes containing molecular sensing optical fiber bundles for analyzing cells, proteins, nucleic acids and other molecules of 50 to 10,000 Dalton, sequencing DNA, genotype, gene expression profiling and high through-put screening		

U.S. Registration No.	2471539	Application Date	06/15/2000
Registration Date	07/24/2001	Foreign Priority Date	NONE
Word Mark	ILLUMINA		
Design Mark	ILLUMINA		

Description of Mark	NONE
Goods/Services	Class 040. First use: First Use: 1999/02/00 First Use In Commerce: 1999/02/00 Developing, to the order and specification of others, biological and/or chemical sensing systems which use random array technology to identify inorganic and organic molecules, compounds and substances

U.S. Application No.	77747038	Application Date	05/28/2009
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	ILLUMINADX
Design Mark	

Description of Mark	NONE
Goods/Services	<p>Class 005. First use: Clinical diagnostic reagents, reagent kits, and beads with attached biomolecules, comprised primarily of enzymes, oligonucleotides and other nucleic acids, natural and modified nucleotides, buffers, labels, and substrates, for clinical diagnostic purposes</p> <p>Class 009. First use: Clinical diagnostic instruments, namely, nucleic acid sequencers, imaging devices and analyzers for use in scientific, diagnostic and clinical research and for clinical diagnostic purposes; laboratory equipment, namely, fluid containers, fluid mixers, fluid control valves and temperature-controlled incubators for sample preparation, amplification, mixing, hybridization, incubation, and washing; automated laboratory apparatus and systems, namely, sample loaders and bar code readers; computer systems, namely, computer hardware, computer software, and data files for collecting, storing, analyzing and reporting biological information, and for sample tracking and managing projects, laboratory workflow and data, all the foregoing for use in the fields of scientific, diagnostic and clinical research and for clinical diagnostic purposes</p> <p>Class 042. First use: Clinical diagnostic services in preparing, amplifying, labeling, detecting, analyzing and sequencing nucleic acids and other biological molecules from human beings or animals</p>

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	ILLUMICODE		
Goods/Services	DNA microarrays		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	ILLUMINA CONNECT		
Goods/Services	providing an online forum for users of Petitioner#s goods to sharing information about innovative ways to use of Petitioner#s goods for DNA and RNA sequencing for scientific and medical research and for clinical diagnostics		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	ILLUMINOTES		
Goods/Services	newsletters that provides in-depth and timely information about Petitioner#s systems, assays and software, product updates, technical document updates, conference workshops, and webinars		

Attachments	75982227#TMSN.gif (1 page)(bytes) 76112547#TMSN.gif (1 page)(bytes) 76072152#TMSN.gif (1 page)(bytes) 77747038#TMSN.jpeg (1 page)(bytes) 20110106 PETITION TO CANCEL 3868081 ILLUMIGENE.pdf (16 pages) (1046629 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	/jmenker/
Name	James Menker
Date	01/06/2011

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

Illumina, Inc.,)	
)	
Petitioner,)	
)	
v.)	
)	
Meridian Bioscience, Inc.,)	Reg. No. 3868081
)	
Registrant.)	

PETITION TO CANCEL

Illumina, Inc. (“Petitioner”) is or will be damaged by the continued registration of the mark ILLUMIGENE, which is set forth in registration Reg. No. 3868081 and owned by Meridian Bioscience, Inc. (“Registrant”), and hereby requests cancellation of the same under Section 14 of the Trademark Act, 15 U.S.C. § 1064.

As grounds for the petition, Petitioner, by its attorneys, avers as follows:

1. On November 17, 2008, Registrant submitted to the United States Patent and Trademark Office application Ser. No. 77615484 to register the mark ILLUMIGENE for “diagnostic kits consisting of molecular assays for use in disease testing and treatment of gastrointestinal, viral, urinary, respiratory and infectious diseases”.
2. On October 26, 2010, application Ser. No. 77615484 issued as Reg. No. 3868081.
3. Petitioner is the owner of several marks using the prefix ILLUMI– for a variety of goods used for scientific and medical research and for clinical diagnostics as well as for information services related thereto and laboratory certification services. Petitioner is also the

owner of incontestable United States trademark registrations, Reg. Nos. 2632507, 2756703, and 2471539, for the mark ILLUMINA; and United States trademark application Ser. No. 77747038 for the mark ILLUMINADX (collectively, and with the marks cited in Paragraphs 6, 7 and 8, *infra*, “Petitioner’s ILLUMI Family of Marks”). Print-outs from the United States Patent and Trademark Office’s TARR database and ASSIGN database satisfying the requirements of 37 C.F.R. § 2.122(d) for submitting a current status and title copy of the pleaded registrations, Reg. Nos. 2632507, 2756703, and 2471539 to make them of record, are submitted herewith.

4. Petitioner’s pleaded registrations, Reg. Nos. 2632507, 2756703, and 2471539 all issued prior to the filing date of application Ser. No. 77615484 and prior to the actual use of the mark set forth in Reg. No. 3868081.

5. Petitioner is the owner of the mark ILLUMICODE, which it uses in connection with DNA microarrays. Petitioner has been using the mark ILLUMICODE in commerce since at least as early as August of 2002, and before any actual use or constructive use of the mark set forth in Reg. No. 3868081.

6. Petitioner is the owner of the mark ILLUMINA CONNECT, which it uses in connection with providing an online forum for users of Petitioner’s goods to sharing information about innovative ways to use of Petitioner’s goods for DNA and RNA sequencing for scientific and medical research and for clinical diagnostics. Petitioner has been using the mark ILLUMINA CONNECT since at least as early as January of 2007, and before any actual use or constructive use of the mark set forth in Reg. No. 3868081.

7. Petitioner is the owner of the mark ILLUMINOTES which is used in connection with newsletters that provides in-depth and timely information about Petitioner’s systems, assays

and software, product updates, technical document updates, conference workshops, and webinars.

8. Since well prior to either the filing date of application Ser. No. 77615484 or Registrant's first use of the mark set forth in Reg. No. 3868081, Petitioner has been using Petitioner's ILLUMI Family of Marks in connection with molecular tests, systems and services for diagnostic purposes, for selection of appropriate therapies and for monitoring of disease progression.

9. The goods set forth in Reg. No. 3868081 are closely related to the goods and services Petitioner offers in connection with Petitioner's ILLUMI Family of Marks including those set forth in the registrations and applications listed in Paragraph 3 and those specified in Paragraphs 5 through 8.

10. The conditions surrounding the marketing of the goods and services Petitioner offers in connection with Petitioner's ILLUMI Family of Marks including those set forth in the registrations and applications listed in Paragraph 3 and those specified in Paragraphs 5 through 8, and the conditions surrounding the marketing of the goods set forth in Reg. No. 3868081 are such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the parties' goods and/or services come from a common source.

11. The mark set forth in Reg. No. 3868081 is confusingly similar to Petitioner's ILLUMI Family of Marks.

12. Petitioner began using Petitioner's ILLUMI Family of Marks in commerce well prior to any actual use or constructive use of the mark set forth in Reg. No. 3868081.

13. Petitioner has not abandoned Petitioner's ILLUMI Family of Marks.

14. Because of the likelihood of confusion, Petitioner will be damaged by the existence of Reg. No. 3868081. Specifically, the mark set forth in Reg. No. 3868081 consists of or comprises a mark which so resembles Petitioner's ILLUMI Family of Marks that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of Petitioner and Registrant. Therefore, Petitioner requests cancellation of Reg. No. 3868081 pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d).

15. Because the mark set forth in Reg. No. 3868081 consists of matter which may falsely suggest a connection between Registrant and Petitioner, to the damage of Petitioner, registration of Reg. No. 3868081 should be cancelled pursuant to Trademark Act Section 2(a), 15 U.S.C. § 1052(a).

WHEREFORE, Petitioner respectfully requests that Reg. No. 3868081 be cancelled.

The required filing fee is submitted herewith.

Respectfully submitted,

ILLUMINA, INC.

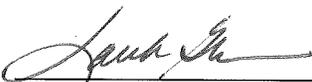
By: 
James R. Menker
Gabrielle A. Holley

Petitioner's Attorneys

Holley & Menker, P.A.
PO Box 96
Solana Beach, CA 92075
(858) 353-9285
westdocket@holleymenker.com

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Petition to Cancel with attached registration records has been served on Registrant's attorney, J. Michael Hurst of Keating Meuthing & Klekamp PLL, at the address of record, One East 4th Street, Suite 1400, Cincinnati, OH 45202-3752, via first class mail, postage prepaid, today **January 6, 2011**.

Signed: 
Laura K. Greer

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This page was generated by the TARR system on 2010-12-08 14:49:55 ET

Serial Number: 75982227 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2632507

Mark (words only): ILLUMINA

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2007-12-13

Filing Date: 2000-08-18

Transformed into a National Application: No

Registration Date: 2002-10-08

Register: Principal

Law Office Assigned: LAW OFFICE 105

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 40S -Scanning On Demand

Date In Location: 2008-02-06

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Illumina, Inc.

Address:

Illumina, Inc.
9885 Towne Center Drive
San Diego, CA 92121
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 001

Class Status: Active

chemicals, namely reagents for scientific or medical research use for analyzing cells, proteins, nucleic acids and other molecules of 50 to 10,000 daltons, sequencing DNA, genotyping, gene expression profiling and high through-put screening

Basis: 1(a)

First Use Date: 2001-02-23

First Use in Commerce Date: 2001-02-23

International Class: 042

Class Status: Active

scientific and medical research, namely, analysis of cells, proteins, nucleic acids and other molecules of 50 to 10,000 daltons,

sequencing DNA, genotyping, gene expression profiling and high through-put screening

Basis: 1(a)

First Use Date: 2001-10-12

First Use in Commerce Date: 2001-10-12

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-02-06 - Case File In TICRS
2007-12-13 - Section 8 (6-year) accepted & Section 15 acknowledged
2007-12-12 - Assigned To Paralegal
2007-12-10 - TEAS Section 8 & 15 Received
2006-04-13 - TEAS Change Of Correspondence Received
2002-10-08 - Registered - Principal Register
2002-04-16 - Allowed for Registration - Principal Register (SOU accepted)
2002-04-12 - Assigned To Examiner
2002-03-28 - Statement Of Use Processing Complete
2002-02-28 - Use Amendment Filed
2002-03-28 - Divisional processing completed
2002-02-28 - Divisional request received
2001-08-28 - NOA Mailed - SOU Required From Applicant
2001-06-05 - Published for opposition
2001-05-23 - Notice of publication
2001-01-16 - Approved For Pub - Principal Register
2001-01-10 - Assigned To Examiner
2001-01-03 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Gabrielle A. Holley

Correspondent

Gabrielle A. Holley
Holley & Menker, P.A.
P.O. Box 96
Solana Beach CA 92075
Phone Number: 858 353 9285
Fax Number: 858 876 1604



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No assignment has been recorded at the USPTO

For Serial Number: 75982227

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Web interface last modified: Apr 30, 2009 v.2.1

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Serial Number: 76112547 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2756703

Mark (words only): ILLUMINA

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2008-09-23

Filing Date: 2000-08-18

Transformed into a National Application: No

Registration Date: 2003-08-26

Register: Principal

Law Office Assigned: LAW OFFICE 105

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2008-09-23

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Illumina, Inc.

Address:

Illumina, Inc.
9885 Towne Center Drive
San Diego, CA 92121
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 009

Class Status: Active

Scientific equipment and instruments, namely scanners, hybridization stations and fluidics delivery and computer systems sold as a unit and cassettes containing molecular sensing optical fiber bundles for analyzing cells, proteins, nucleic acids and other molecules of 50 to 10,000 Dalton, sequencing DNA, genotype, gene expression profiling and high through-put screening

Basis: 1(a)

First Use Date: 2003-01-09

First Use in Commerce Date: 2003-01-09

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-09-23 - Section 8 (6-year) accepted & Section 15 acknowledged
2008-09-17 - TEAS Section 8 & 15 Received
2008-02-27 - Attorney Revoked And/Or Appointed
2008-02-27 - TEAS Revoke/Appoint Attorney Received
2008-01-18 - Case File In TICRS
2006-04-13 - TEAS Change Of Correspondence Received
2003-08-26 - Registered - Principal Register
2003-06-24 - Allowed for Registration - Principal Register (SOU accepted)
2003-06-03 - Assigned To Examiner
2003-05-30 - Statement Of Use Processing Complete
2003-02-26 - Use Amendment Filed
2003-03-03 - PAPER RECEIVED
2002-12-09 - Extension 2 granted
2002-10-11 - PAPER RECEIVED
2002-08-06 - Extension 2 filed
2002-08-06 - PAPER RECEIVED
2002-03-28 - Extension 1 granted
2002-02-28 - Extension 1 filed
2002-03-28 - Divisional processing completed
2002-02-28 - Divisional request received
2001-08-28 - NOA Mailed - SOU Required From Applicant
2001-06-05 - Published for opposition
2001-05-23 - Notice of publication

2001-01-16 - Approved For Pub - Principal Register

2001-01-10 - Assigned To Examiner

2001-01-03 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Gabrielle A. Holley

Correspondent

Gabrielle A. Holley

Holley & Menker, P.A.

P.O. Box 96

Solana Beach CA 92075

Phone Number: 858 353 9285

Fax Number: 858 876 1604


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Trademark Assignment Abstract of Title
Total Assignments: 1
Serial #: [76112547](#)
Filing Dt: 08/18/2000

Reg #: [2756703](#)
Reg. Dt: 08/26/2003

Registrant: Illumina, Inc.

Mark: ILLUMINA

Assignment: 1
Reel/Frame: [2633/0270](#)
Received: 12/13/2002

Recorded: 12/10/2002

Pages: 5

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: [ILLUMINA, INC.](#)
Exec Dt: 11/21/2002

Entity Type: CORPORATION

Citizenship: CALIFORNIA

Entity Type: CORPORATION

Citizenship: DELAWARE

Assignee: [ILLUMINA, INC.](#)

 9885 TOWNE CENTER DRIVE
 SAN DIEGO, CALIFORNIA 92121

Correspondent: DORSEY & WHITNEY LLP

 DIANE J. MASON
 FOUR EMBARCADERO CENTER, SUITE 3400
 SAN FRANCISCO, CA 94111-4187

Search Results as of: 12/08/2010 02:50 PM

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Serial Number: 76072152 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2471539

Mark (words only): ILLUMINA

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2007-07-06

Filing Date: 2000-06-15

Transformed into a National Application: No

Registration Date: 2001-07-24

Register: Principal

Law Office Assigned: LAW OFFICE 105

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2007-07-06

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Illumina, Inc.

Address:

Illumina, Inc.
9885 Towne Centre Drive
San Diego, CA 92121
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 040

Class Status: Active

Developing, to the order and specification of others, biological and/or chemical sensing systems which use random array technology to identify inorganic and organic molecules, compounds and substances

Basis: 1(a)

First Use Date: 1999-02-00

First Use in Commerce Date: 1999-02-00

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2007-07-06 - Section 8 (6-year) accepted & Section 15 acknowledged

2007-06-29 - Assigned To Paralegal

2007-06-01 - Section 8 (6-year) and Section 15 Filed

2007-06-01 - TEAS Section 8 & 15 Received

2007-02-20 - Case File In TICRS

2006-04-13 - TEAS Change Of Correspondence Received

2003-08-02 - Section 7 request abandoned

2002-09-24 - Post Registration action mailed - Section 7

2002-06-17 - Section 7 amendment filed

2001-07-24 - Registered - Principal Register

2001-05-01 - Published for opposition

2001-04-18 - Notice of publication

2000-11-15 - Approved for Pub - Principal Register (Initial exam)

2000-11-14 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Gabrielle A. Holley

Correspondent

Gabrielle A. Holley

Pillsbury Winthrop Shaw Pittman LLP

Suite 300

12255 El Camino Real

San Diego CA 92130

Phone Number: 858-509-4009

Fax Number: 858-509-4010



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Trademark Assignment Abstract of Title

Total Assignments: 1**Serial #:** [76072152](#)**Filing Dt:** 06/15/2000**Reg #:** [2471539](#)**Reg. Dt:** 07/24/2001**Registrant:** Illumina, Inc.**Mark:** ILLUMINA**Assignment: 1****Reel/Frame:** [2633/0270](#)**Received:** 12/13/2002**Recorded:** 12/10/2002**Pages:** 5**Conveyance:** ASSIGNS THE ENTIRE INTEREST**Assignor:** [ILLUMINA, INC.](#)**Exec Dt:** 11/21/2002**Entity Type:** CORPORATION**Citizenship:** CALIFORNIA**Entity Type:** CORPORATION**Citizenship:** DELAWARE**Assignee:** [ILLUMINA, INC.](#)9885 TOWNE CENTER DRIVE
SAN DIEGO, CALIFORNIA 92121**Correspondent:** DORSEY & WHITNEY LLP
DIANE J. MASON
FOUR EMBARCADERO CENTER, SUITE 3400
SAN FRANCISCO, CA 94111-4187

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Web Interface last modified: Apr 30, 2009 v.2.1

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