

**This Opinion is Not a
Precedent of the TTAB**

Mailed: March 14, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Illumina, Inc.
v.
Meridian Bioscience, Inc.
—

Opposition No. 91194218
Opposition No. 91194219
Cancellation No. 92053479
Cancellation No. 92053482
—

Susan M. Natland and Brian C. Horne of Knobbe Martens Olson & Bear, LLP
for Illumina, Inc.

J. Michael Hurst of Keating Muething & Klekamp PLL
For Meridian Bioscience, Inc.

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Before Bergsman, Heasley and Lynch,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Meridian Bioscience, Inc. (“Applicant”) filed applications to register the marks ILLUMIPRO¹ (standard character form) and ILLUMIPRO-10² (standard character form) both for a “diagnostic machine, namely, a stand alone closed heater and turbidity meter to be used for the amplification and detection of a closed tube molecular assay,” in Class 10.

Applicant also owns registrations for the marks ILLUMIGENE³ (standard character form) and ILLUMIGENE MOLECULAR SIMPLIFIED⁴ and design, shown below, both for “diagnostic kits consisting of molecular assays for use in disease testing and treatment of gastrointestinal, viral, urinary, respiratory and infectious diseases,” in Class 5.



¹ Application Serial No. 77768176 was filed on June 25, 2009, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

² Application Serial No. 77775316 was filed on July 7 2009, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

³ Registration No. 3868081 registered on October 26, 2010 based on an intent-to-use application filed on November 17, 2008. Applicant claimed a date of first use anywhere on December 14, 2009 and a date of first use in commerce on July 21, 2010.

⁴ Registration No. 3887164 registered on December 7, 2010 based on an intent-to-use application filed on April 1, 2009. Applicant claimed a date of first use anywhere on December 14, 2009 and a date of first use in commerce on July 21, 2010.

Illumina, Inc. (“Opposer”) filed Notices of Opposition against the registration of Applicant’s ILLUMIPRO⁵ and ILLUMIPRO-10⁶ marks and Petitions to Cancel Applicant’s ILLUMIGENE⁷ and ILLUMIGENE MOLECULAR SIMPLIFIED and design marks.⁸ The oppositions were consolidated in an order dated November 19, 2010.⁹ The cancellation proceedings were consolidated with the opposition proceedings in an order dated December 6, 2011.¹⁰ The Board designated Opposition No. 91194218 as the “parent” case and thereafter all papers were filed in that opposition. All references in this opinion are to the TTABVUE record in Opposition No. 91194218 unless otherwise indicated.

As grounds for opposition and cancellation, Opposer alleged that Applicant’s marks were likely to cause confusion with “Opposer’s ILLUMI Family of Marks” under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d).¹¹ Opposer

⁵ Opposition No. 91194218.

⁶ Opposition No. 91194219.

⁷ Cancellation No. 92053482.

⁸ Cancellation No. 92053479.

⁹ 11 TTABVUE. Citations to the record in this opinion are to the TTABVUE docket entry number and the electronic page number where the document or testimony appears. Because the Board uses TTABVUE in reviewing evidence, the Board prefers that citations to material or testimony in the record that have not been designated confidential include the TTABVUE docket entry number and the TTABVUE page number. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

¹⁰ 17 TTABVUE.

¹¹ Opposer’s Amended Notice of Opposition ¶15 (12 TTABVUE 8). Opposer also alleged that Applicant’s marks falsely suggest a connection between Applicant and Opposer under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a). However, because Opposer did not pursue those claims at trial or in its brief, we consider them withdrawn. *Research in Motion Limited v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1189-90 (TTAB 2012); *Swiss*

alleged that the registered marks listed below comprise in part its ILLUMI Family of Marks:¹²

1. Registration No. 2471539 for the mark ILLUMINA (typed drawing form) for “developing, to the order and specification of others biological and/or chemical sensing systems which use random array technology to identify organic molecules, compounds and substances,” in Class 40;¹³

2. Registration No. 2632507 for the mark ILLUMINA (typed drawing form) for the goods and services listed below:¹⁴

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, in Class 1; and

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, in Class 42;

3. Registration No. 2756703 for the mark ILLUMINA (typed drawing form) for “scientific equipment and instruments, namely scanners, hybridization stations and

Watch International Inc. v. Federation of the Swiss Watch Industry, 101 USPQ2d 1731, 1734 n.4 (TTAB 2012).

¹² Opposer’s Amended Notice of Opposition ¶14 (12 TTABVUE 5-6).

¹³ Registered on July 24, 2001; renewed.

Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i) (October 2015).

¹⁴ Registered on October 8, 2002; renewed.

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,” in Class 9;¹⁵ and

4. Registration No. 4053668 for the mark ILLUMINADX (standard character form) for “clinical diagnostic reagents, reagent kits, and beads with attached biomolecules, comprised primarily of oligonucleotides and other nucleic acids, natural and modified nucleotides, buffers, labels, and substrates, for clinical diagnostic purposes,” in Class 5.¹⁶

In addition, Opposer pleaded common law use of the ILLUMI-formative marks listed below:

¹⁵ Registered on August 26, 2003; renewed.

¹⁶ Registered on November 8, 2011 based on an intent-to-use application (Serial No. 77982582) filed on May 28, 2009. Opposer claimed first use of this mark anywhere and first use of the mark in commerce on March 19, 2010.

In its Amended Notice of Opposition, Opposer identified the mark ILLUMINADX (Serial No. 77747038) for different goods and services than set forth in Registration No. 4053668 for the mark ILLUMINADX. Opposer abandoned Application Serial No. 77747038 because Opposer failed to file a Statement of Use. Opposer did not seek to amend its pleadings to add the ILLUMINADX mark identified in Registration No. 4053668 (Serial No. 77982582). However, Applicant did not object to Opposer’s introduction of that registration and, in fact, Applicant treated it as of record in its brief. *See* 104 TTABVUE 16, 17, 18, 20, and 21. In view thereof, we find that the likelihood of confusion claim with respect to Opposer’s mark ILLUMINADX as set forth in Registration No. 4053668 was tried by implied consent pursuant to Fed. R. Civ. P. 15(b) and the pleadings are so amended. See the discussion regarding whether the Opposer established a family of marks *infra*.

1. ILLUMICODE used in connection with DNA microarrays in use since at least as early as August 2002;¹⁷
2. ILLUMINA CONNECT used in connection with providing an online forum for users of Opposer's goods to share information regarding DNA and RNA sequencing for scientific and medical research and clinical diagnostics in use since at least as early as January 2007;¹⁸ and
3. ILLUMINOTES used in connection with newsletters providing information about Opposer's systems, assays and software, product updates, technical document updates, conference workshops, and webinars.¹⁹

I. Preliminary Issue

The parties over-designated testimony and evidence as confidential. For example, the entire testimony declaration of Vecheslav A. Elagin, Applicant's Executive Vice President of Research and Development was designated as confidential.²⁰ Likewise, the entire rebuttal testimony declaration of Mya Thomae, Vice President of Opposer's regulatory department, was designated as confidential.²¹ There was no testimony in either declaration that is confidential.

¹⁷ Opposer's Amended Notice of Opposition ¶6 (12 TTABVUE 6).

¹⁸ *Id.* at ¶7.

¹⁹ *Id.* at ¶8.

²⁰ 71 TTABVUE. The cross-examination testimony deposition of Dr. Elagin was not designated as confidential and the Elagin testimony declaration is an exhibit to that deposition. 88 TTABVUE 124-141.

²¹ 89 TTABVUE.

Federal Rule of Civil Procedure 26(c)(1)(G) protects confidential, trade secret, and commercially sensitive information by allowing a party to limit the access to trade secret or other confidential information or by permitting the information to be revealed only in a designated way. The Advisory Committee Notes to the 1970 Amendment explain that the Rule does not provide complete immunity against disclosure; rather, in each case, the need for privacy must be weighed against the need for disclosure. In rendering our decision, we will not be bound by the parties' designation. It is intended that the filings in Board proceedings be publicly available and the improper designation of materials as confidential thwarts that intention. It is more difficult to make findings of fact, apply the facts to the law, and write decisions that make sense when the facts shown by the evidence may not be discussed. The Board needs to be able to discuss the evidence of record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board's decisions. *See Warner-Lambert Co. v. Sports Solutions, Inc.*, 39 USPQ2d 1686, 1688 n.13 (TTAB 1996). Therefore, in this opinion, we will treat only testimony and evidence that is truly confidential or commercially sensitive as such.

II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application and registration files.

With its Amended Notice of Opposition, Opposer attached copies of its pleaded registrations for the mark ILLUMINA (Registration Nos. 2471539, 2632507, and 2756703) printed from the USPTO electronic database showing the current status of and title to the registrations pursuant to Trademark Rule 2.122(d)(1).

Also, “[t]he parties agreed that they could take the testimony of their own witnesses via declaration during their respective testimony periods, and that the adverse party would then have a period of time to take live cross-examination of any declarant.”²²

The parties introduced the following testimony and evidence:

A. Opposer’s testimony and evidence.

1. Notice of reliance on 78 exhibits including, *inter alia*, the following documents:²³

²² Opposer’s Brief, p. 7 n.1 (102 TTABVUE 15). We note that Trademark Rule 2.123(b) provides that “by written agreement,” the parties may stipulate that testimony may be submitted in the affidavit form.

²³ 57 TTABVUE. Opposer’s Exhibit Nos. 61-67 (58 TTABVUE 370-417 and 59 TTABVUE 3-97) are identified as documents produced by Applicant presumably in response to Opposer’s document requests. According to Trademark Rule 2.120(j)(3)(ii), “[a] party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e).” Because these documents are not admissible through a notice of reliance and were not properly introduced into evidence, we do not give them any consideration.

a. A copy of Registration No. 4053668 for the mark ILLUMINADX printed from the electronic database of the USPTO showing the current status of and title to the registration;²⁴

b. Applicant's responses to Opposer's first set of interrogatory Nos. 12, 16 and 21;²⁵

c. Copies of excerpts from websites and news articles and press releases posted on Internet websites;²⁶

d. Documents produced by Applicant responsive to Opposer's Interrogatory No. 21;²⁷ and

e. Excerpts from Applicant's website;²⁸

2(a). Testimony declaration of Naomi O'Grady, Opposer's Manager of Oncology Product Marketing, with attached exhibits;²⁹

2(b). Cross-examination testimony deposition of Naomi O'Grady with attached exhibits;³⁰

²⁴ 57 TTABVUE 23-27.

²⁵ 57 TTABVUE 29-36.

²⁶ 57 TTABVUE 38-368, 517-518 and 592-618. Because Opposer's Exhibit No. 67 (57 TTABVUE 514) is simply a letter, it is not a document that is admissible through a notice of reliance and, therefore, we do not give it any consideration.

²⁷ 57 TTABVUE 520-554.

²⁸ 57 TTABVUE 556-579.

²⁹ 60 TTABVUE and 62 TTABVUE. Exhibits that Opposer designated as confidential are posted at 61 TTABVUE.

³⁰ 83-84 TTABVUE. This testimony deposition was introduced by Applicant. Because cross-examination is part of the testimony of the witness, we listed the cross-examination transcript with Opposer's testimony declaration to associate the direct testimony with the

3. Testimony declaration of Gregory F. Heath, Ph.D., Opposer's Senior Vice President and formerly Opposer's General Manager of the Diagnostics Business Unit, with attached exhibits;³¹

4(a). Testimony declaration of Karen Possemato, Opposer's Chief of Staff responsible for communications, operations and projects for the offices of the CEO and the President, with attached exhibits;³²

4(b). Cross-examination testimony deposition of Karen Possemato with attached exhibits;³³

5. Testimony declaration of William Morrison, Opposer's in-house patent attorney, with attached exhibits;³⁴

6. Rebuttal testimony declaration of Mya Thomae, Vice President of Opposer's regulatory department;³⁵

7(a). Rebuttal testimony declaration of Naomi O'Grady, Opposer's Manager of Oncology Product Marketing, with attached exhibits;³⁶

cross-examination. We have identified and listed all of the cross-examination testimony depositions in this manner.

³¹ 64 TTABVUE and 65 TTABVUE

³² 66 TTABVUE.

³³ 85 TTABVUE.

³⁴ 68 TTABVUE.

³⁵ 89 TTABVUE.

³⁶ 91 TTABVUE.

7(b). Rebuttal cross-examination testimony deposition of Naomi O’Grady with attached exhibits;³⁷

8. Rebuttal notice of reliance on the following items:³⁸

- a. Excerpts from third-party websites;³⁹
- b. A brochure from the Centers of Disease Control and Prevention;⁴⁰
- c. Copies of research reports published in publications in general circulation among members of the relevant public;⁴¹
- d. Copy of the Code of Federal Regulations (CFR) Title 21, Volume 8, Revised as of April 1, 2014, Chapter 1 Food and Drug Administration Department of Health and Human Services Subchapter H – Medical Devices - Part 864 Hematology and Pathology Devices – Subpart E – Specimen Preparation Reagents, Sec. 864.4010 General purpose reagent.⁴²

³⁷ 97-98 TTABVUE.

³⁸ Opposer sought to introduce the statement of Alan Mertz, President of The American Clinical Laboratory Association, before the U.S. House of Representatives Energy and Commerce Committee Subcommittee on Health Hearing on 21st Century Cures: Examining the Regulation of Laboratory-Developed Tests. 93 TTABVUE 19-41. There is no provision in the Trademark Rules of Practice for the submission of this document through a notice of reliance. Therefore, we do not give it any consideration.

³⁹ 93 TTABVUE 9-12, 43-63, 118-138, 143-167.

⁴⁰ 93 TTABVUE 14-17.

⁴¹ 93 TTABVUE 65-117.

⁴² 93 TTABVUE 140-141.

B. Applicant's testimony and evidence.

1(a). Testimony declaration of Vecheslav A. Elagin, Ph.D., MBA, Applicant's Executive Vice President of Research and Development, with attached exhibits;⁴³

1(b). Cross-examination testimony deposition of Vecheslav A. Elagin with attached exhibits;⁴⁴

2(a). Testimony declaration of Kenneth J. Kozak, Opposer's Chief Technical Officer, with attached exhibits;⁴⁵

2(b). Cross-examination testimony deposition of Kenneth J. Kozak with attached exhibits;⁴⁶

3. Notice of reliance on the following items:⁴⁷

⁴³ 71 TTABVUE.

⁴⁴ 88 TTABVUE.

⁴⁵ 72-75 TTABVUE. Mr. Kozak's entire testimony declaration was designated confidential. However, with the exception of some advertising expenditures listed in paragraph No. 15, none of the other testimony is confidential, trade secret or commercially sensitive. Moreover, the Kozak declaration was attached as an exhibit to Mr. Kozak's cross-examination deposition transcript which was not designated confidential.

⁴⁶ 86 TTABVUE (nonconfidential) and 87 TTABVUE (confidential).

⁴⁷ Opposer is a publicly traded company. Possemato Testimony Dec. at 66 TTABVUE 12. Applicant sought to introduce Opposer's annual reports from 2003 through 2011 and copies of Form 10-K filings filed with the Securities and Exchange Commission ("SEC") but not from the records of the SEC. 76 TTABVUE 24-873. These are not documents that may be introduced into evidence through a notice of reliance. *See Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1603 (TTAB 201), *aff'd* 668 F.3d 1356, 101 USPQ2d 1713, 1718 (Fed. Cir. 2012); *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1929 (TTAB 2009); *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007). In view of the foregoing, the annual reports and SEC Form 10-K filings are not admissible through a notice of reliance and will be given no consideration. However, we will consider copies of those documents properly introduced through the testimony declaration of Karen Possemato. *See* Possemato Testimony Dec. at 66 TTABVUE 241-582.

- a. Opposer's supplemental responses to Applicant's first set of interrogatories;⁴⁸
 - b. Opposer's responses to Applicant's second set of interrogatories;⁴⁹
 - c. Copies of news articles posted on websites;⁵⁰
 - d. Excerpts from Opposer's website;⁵¹
 - e. Opposer's response to Applicant's interrogatory No. 13;⁵²
 - f. Copies of third-party registrations of "Illumi-formative" marks;⁵³
 - g. Copies of third-party registrations of "Lumi-formative" marks;⁵⁴
- and
- h. Copies of Applicant's registrations of "Tru-formative" marks and Opposer's registrations and applications for "Tru-formative" marks;⁵⁵

Also, Applicant sought to introduce two of Opposer's product brochures into evidence through the notice of reliance. 76 TTABVUE 914-938. Product brochures are not the type of documents that may be introduced through a notice of reliance. *See Hiraga v. Arena*, 90 USPQ2d 1102, 1104 (TTAB 2009); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1956-59 (TTAB 2008); *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1500 (TTAB 2005). In view of the foregoing, we do not consider the brochures.

⁴⁸ 76 TTABVUE 10-16.

⁴⁹ 76 TTABVUE 17-21 and 78 TTABVUE 3-22

⁵⁰ 76 TTABVUE 875-894 and 77 TTABVUE 238-245.

⁵¹ 76 TTABVUE 899-911.

⁵² 78 TTABVUE 24 (a customer list designated as confidential).

⁵³ 76 TTABVUE 939-1035.

⁵⁴ 77 TTABVUE 2-181.

⁵⁵ 77 TTABVUE 182-236.

4. Testimony declaration of Stephanie A. Ferguson, a paralegal in Applicant's counsel's law firm, attesting to the authenticity of the screen shots of the ILLUM, LUMI, and TRU formative marks;⁵⁶

5. Deposition of Dr. Stephen Young, Scientific Director of Infectious Disease as TriCore Reference Laboratories.⁵⁷

⁵⁶ 82 TTABVUE 2.

⁵⁷ 96 TTABVUE. Opposer lodged an objection to the deposition on the ground that it is "procedurally improper." 96 TTABVUE 6. In its brief, Opposer did not renew the objection to the deposition. Opposer simply made the following observation:

Dr. Young had not previously submitted any direct testimony. Meridian deposed him after its rebuttal trial testimony period had ended, and did so without leave from the Board or stipulation from Illumina.

102 TTABVUE 15 n.2. By failing to preserve the objection in its brief on the case, or in an appendix to the brief on the case or in a separate statement of objections filed with the brief on the case, a party may waive an objection that was seasonably raised at trial. *See also General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1592 n.7 (TTAB2011) (objection to testimony deemed waived because it was not maintained in brief *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential); *First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc.*, 77 USPQ2d 1334, 1340 n.14 (TTAB 2005) (objection made in deposition but not renewed in brief deemed waived), *rev'd on other grounds*, 476 F.3d 867, 81 USPQ2d 1375 (Fed. Cir. 2007). We are not going to guess as to what Opposer intended by the above-noted observation. If Opposer intended to renew its objection, it could have easily done so to remove any doubt (*e.g.*, "Opposer renews its objection to the Dr. Young's testimony deposition."). Because Opposer did not renew the objection to Dr. Young's testimony, Opposer waived any objection.

Applicant also sought to introduce an exchange of emails through a notice of reliance. 100 TTABVUE. E-mail correspondence is not a document that may be introduced into evidence through a notice of reliance because it does not constitute printed publications in general circulation and, therefore, we have not considered the emails. *See United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1047 (TTAB 2014).

III. *Standing*

Opposer has properly made its pleaded registrations of record, with evidence that its registrations are subsisting and owned by Opposer. Accordingly, Opposer has established its standing in this proceeding. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

IV. *Priority*

A. Whether Opposer proved that it had an Illumi-formative family of marks?

As indicated above, Opposer alleged that Applicant's marks were likely to cause confusion with "Opposer's ILLUMI Family of Marks." Opposer did not allege that there would be a likelihood of confusion with any of one of Opposer's pleaded marks that Opposer identified as comprising its "ILLUMI Family of Marks." Thus, Opposer has the burden of proving that it established its "ILLUMI Family of Marks" before Applicant began using its ILLUMIPRO and ILLUMIGENE marks. *Truescents LLC v. Ride Skin Care LLC*, 81 USPQ2d 1334, 1338 (TTAB 2006) (because opposer did not establish ownership of a family of marks, priority and likelihood of confusion is based on each of opposer's pleaded marks separately); *Hester Indus. Inc. Tyson Foods Inc.*, 2 USPQ2d 1645, 1647 (TTAB 1987) ("it is well settled that the mere ownership of a number of marks sharing a common feature (or even ownership of registrations thereof) is insufficient to establish a claim of ownership of a 'family' of marks characterized by the feature in the absence of competent evidence showing that prior

to the first use by the alleged interloper, the various marks said to constitute the ‘family,’ or at least a goodly number of them, were used and promoted together in such a manner as to create among purchasers an association of common ownership based upon the ‘family’ characteristic ...”).

Although Opposer introduced into evidence its pleaded registrations for the marks ILLUMINA and ILLUMINADX, as well as its common law marks, the evidence does not support finding that “the pattern of usage of the common element is sufficient to be indicative of the origin of the [ILLUMI] family.” *The Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1490 (TTAB 2007) citing *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). Thus, the requisite showing of a family of marks has not been made. The fact that Opposer has used several marks incorporating the prefix ILLUMI is not in itself sufficient to establish the existence of a family of marks. *See J & J Snack Foods*, 18 USPQ2d at 1891. As stated by the Federal Circuit, “There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods.” *Id.* Opposer failed to demonstrate that the marks asserted to compose the family have been used and advertised in promotional material or in everyday sales activities in such a manner as to create common exposure and thereafter recognition of common ownership based upon a feature common to each mark. *See Truescents LLC v. Ride Skin Care LLC*, 81 USPQ2d at

1337 (citing *American Standard, Inc. v. Scott & Fetzer Co.*, 200 USPQ 457, 461 (TTAB 1978)).

Opposer's evidence consists of examples of Opposer's ILLUMINA mark used as a house mark in connection with all of its products and services but not different ILLUMI-formative marks together. This material may suggest that the public has been exposed to Opposer's ILLUMINA mark as part of or in connection with Opposer's product marks. But Opposer failed to demonstrate that it advertises or promotes various ILLUMI-formative marks to the public in a way that creates exposure and recognition of common ownership thereof based upon the ILLUMI feature of each mark. *See Truescents LLC*, 81 USPQ2d at 1338.

Further, Opposer, in its brief, did not argue that it has a family of ILLUMI-formative marks. Opposer argued that "[t]he Board should deny [Applicant's] attempt to register marks confusingly similar to [Opposer's] famous ILLUMINA mark."⁵⁸

We find that Opposer has failed to prove that it has a family of ILLUMI-formative marks.

B. Whether likelihood of confusion based on the individual marks identified by Opposer were tried by implied consent?

Based on the testimony and evidence, as well as the fact that Applicant addressed Opposer's arguments directed toward the issue of likelihood of confusion with respect to each of its registered and common law marks without objection, we find this issue

⁵⁸ 102 TTABVUE 9.

was tried by the implied consent of the parties, and consider the pleadings to be amended with regard thereto. *See* Fed. R. Civ. P. 15(b)(2); **TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 507.03(b)** (June 2015).

C. Applicant's argument regarding priority.

Applicant argues that that it has priority in the field of clinical diagnosis because Opposer was prohibited from marketing in that field until at least as early as 2010.⁵⁹

[Applicant] does not dispute that Registration Nos. 2471539, 2632597, and 2756703 – all for the mark ILLUMINA – predate [Applicant's] *filing* dates in this case. However, ... these ILLUMINA registrations identify RUO [research use only] products and services meant for the scientific research mark, not the IVD [in-vitro diagnostic] products [Applicant] sells in the clinical diagnostic market. (Internal citation omitted). As a result, the ILLUMINA registrations do not confer priority on Opposer in the clinical diagnostic space which [Applicant] has historically occupied.⁶⁰

Applicant confuses the issue of priority – which party used its mark first – with the issue of whether the goods and services of the parties are related. Section 2(d) of the Trademark Act only requires prior use to establish priority, providing in relevant part:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... [c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name *previously used* in the United States by another and not abandoned, as to

⁵⁹ 104 TTABVUE 15.

⁶⁰ 104 TTABVUE 15-16.

be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

15 U.S.C. §1052(d) (emphasis added). The first party to use its mark in sale of goods or services is the senior user. *See United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 100, 39 S. Ct. 48 (1918) (“Undoubtedly, the general rule is that, as between conflicting claimants to the right to use the same mark, priority of appropriation determines the question.”); *In re Trade-Mark Cases*, 100 U.S. 82, 94, 1879 WL 16583 (1879) (“At common law the exclusive right to it grows out of the use of it, and not its mere adoption. ... It is simply founded on priority of appropriation.”); *Aktieselskabet af 21. November 2001 v. Fame Jeans, Inc.*, 77 USPQ2d 1861, 1864 (TTAB 2006), *later proceedings*, 525 F.3d 8, 86 USPQ2d 1527 (D.C. Cir. 2008) (“It is well settled that ‘[p]riority of trademark rights in the United States depends solely upon priority of use in the United States, not on priority of use anywhere in the world.’”); *National Chemsearch Corporation v. Chemtek Corporation*, 170 USPQ 110, 111 (TTAB 1971) (“It is however, well settled that as between conflicting claimants, the right to use the same mark is based on priority of appropriation.”).

D. Priority in the oppositions to Applicant’s ILLUMIPRO and ILLUMIPRO-10 marks.

1. Opposer’s pleaded registrations.

Because Opposer has properly made of record its pleaded registrations, and because Applicant has not filed a counterclaim to cancel any of Opposer’s pleaded

registrations, Section 2(d) priority is not an issue in the oppositions as to the marks and the goods and services covered by the pleaded registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

2. *Opposer's common law use.*

Because Applicant has submitted no evidence regarding its first use of its ILLUMIPRO and ILLUMIPRO-10 marks, the earliest dates on which it may rely are June 25, 2009 for ILLUMIPRO and July 7, 2009 for ILLUMIPRO-10, the filing dates of its applications. *See Orange Bang, Inc. v. Olé Mexican Foods, Inc.*, 116 USPQ2d 1102, 1115 (TTAB 2015); *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1429 (TTAB 2013). Therefore, in order to show that it has priority with respect to its common law marks, Opposer must rely on its common law rights, and show that it established such rights through prior use of a mark or trade name that has not been abandoned.

Karen Possemato, Opposer's Chief of Staff responsible for communications, operations and projects for the offices of the CEO and the President, testified that since at least as early as August 2002, Opposer has used the mark ILLUMICODE in connection with DNA microarrays and that at least as early as April 2006, Opposer has used the mark ILLUMINOTES in connection with newsletters featuring information in the fields of nucleic acid sequencing and genotyping, medical diagnostics, medical research, life sciences, biology, molecular pathology, molecular

diagnostics, laboratory medicine, biotechnology, and genetics.⁶¹ Applicant cross-examined Ms. Possemato and did not cast any doubt regarding her testimony about Opposer's common law use of ILLUMICODE and ILLUMINOTES. We find that Ms. Possemato's testimony is sufficient to establish Opposer's priority for ILLUMICODE and ILLUMINOTES. *See National Bank Book Co. v. Leather Crafted Products, Inc.*, 218 USPQ 826, 828 (TTAB 1993) (oral testimony may be sufficient to prove the first use of a party's mark when it is based on personal knowledge, it is clear and convincing, and it has not been contradicted); *Liquacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305, 316 (TTAB 1979) (oral testimony may be sufficient to establish both prior use and continuous use when the testimony is proffered by a witness with knowledge of the facts and the testimony is clear, convincing, consistent, and sufficiently circumstantial to convince the Board of its probative value); *GAF Corp. v. Anatox Analytical Services, Inc.*, 192 USPQ 576, 577 (TTAB 1976) (oral

⁶¹ Possemato Testimony Dec. at 66 TTABVUE 12. Ms. Possemato refers to Exhibit Nos. 214 and 215 to corroborate her testimony. Exhibit No. 214 (66 TTABVUE 212-219) is a "Data Sheet: SNP Genotyping" entitled "GoldenGate Indexing Assay increases Sample Throughput." The document has a 2010 copyright and a statement that says "Pub No. 370-2009-009 Current as of 29 July 2010." 66 TTABVUE 214. Thus, Exhibit No. 214 does not corroborate Ms. Possemato's testimony regarding the first use of the mark ILLUMICODE.

Exhibit No. 215 (66 TTABVUE 221-240) comprises excerpts from Opposer's website displaying the use of the mark ILLUMINOTES to identify an on-line newsletter. With the exception of the excerpt at 66 TTABVUE 239-240, the excerpts are dated in 2014. The excerpt at 66 TTABVUE 239-240 does not show the mark ILLUMINOTES used to identify an on-line newsletter. It identifies "Opposer's eCommerce site: "We are happy to announce that our eCommerce site is open for business. If you already have a login, place an order now and take advantage of this special offer." Thus, Exhibit No. 215 does not corroborate Ms. Possemato's testimony regarding the first use of ILLUMINOTES.

testimony may establish prior use when the testimony is clear, consistent, convincing, and uncontradicted).

There was no evidence or testimony regarding ILLUMINA CONNECT, therefore, Opposer failed to prove that it has priority with respect to that mark. We will give ILLUMINA CONNECT no further consideration in these proceedings.

E. The petitions to cancel Applicant's ILLUMIGENE and ILLUMIGENE MOLECULAR SIMPLIFIED and design registrations.

When both parties in a cancellation proceeding own registrations, as is the case in these proceedings, the petitioner – in these cases Opposer – must prove its priority. *Hornby v. Tjx Cos. Inc.*, 87 USPQ2d 1411, 1421 n.11 (TTAB 2008); *Brewski Beer Co. v. Brewski Bros., Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998).

Applicant asserted, in its brief, that November 17, 2008, the filing date for its ILLUMIGENE application (Registration No. 3868081) is its priority date.⁶² See *Brewski Beer*, 47 USPQ2d at 1284 (“petitioner or respondent may rely on its registration for the limited purpose of proving that its mark was in use as of the application filing date.”). The filing dates of the applications maturing into Opposer’s pleaded registrations are listed below:

1. Registration No. 2471539 for the mark ILLUMINA – June 15, 2000;
2. Registration No. 2632507 for the mark ILLUMINA – August 18, 2000;
3. Registration No. 2756703 for the mark ILLUMINA – August 18, 2000; and

⁶² 104 TTABVUE 15.

4. Registration No. 4053668 for the mark ILLUMINADX – May 28, 2009.

Based on the filing dates of its applications for registration, Opposer has priority for its ILLUMINA marks.

In determining Opposer's first use date for its ILLUMINADX mark, we note, that as indicated above, the filing date for Opposer's application for ILLUMINADX is May 28, 2009 which is subsequent to Applicant's priority date. In its application, the dates of first use claimed by Opposer are March 19, 2010. On cross-examination, Karen Possemato testified that Opposer began using ILLUMINADX "at some point" in 2008 or 2009.⁶³ If Opposer is seeking to prove a date of first use earlier than the date alleged in its application for registration (March 19, 2010), its proof of that earlier date must be "clear and convincing." *Hydro-Dynamics Inc. v. George Putnam & Co.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987) (dates of first use earlier than that alleged in the application is a change of position from one "considered to have been made against interest at the time of filing the application," and therefore requires enhanced proof); *Ilco Corp. v. Ideal Security Hardware Corp.*, 527 F.2d 1221, 188 USPQ 485, 488 (CCPA 1976). The testimony of Opposer's witness regarding

⁶³ Possemato Cross-Examination Dep. at 85 TTABVUE 91-94. *See also* the cross-examination testimony of Naomi O'Grady who testified that Opposer used ILLUMINADX after 2009.

- Q. And after 2009, [Opposer] used the Illumina Dx brand for its diagnostic products and services; right?
- A. The exact date is fuzzy to me, but yes, we had an Illumina Dx brand that we used.

Opposer's first use of the mark ILLUMINADX is not clear and convincing. Moreover, in view of the uncertainty of the witness and the lack of documentation, we find that Opposer's date of first use for the mark ILLUMINADX can be no earlier than December 31, 2009, the last day of the specified time period identified in the witnesses' testimony. *See EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 213 USPQ 597, 599n.5 (TTAB 1982) (documentary evidence showed first use in 1977, the month and day were unknown, therefore, the Board could not presume any date earlier than the last day of the proved period). *See also Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 911n.22 (TTAB 1985) (evidence established first use in 1968-1969, therefore December 31, 1969 is date of first use). Inasmuch as Opposer's testimony regarding its first use of ILLUMINADX is not "clear and convincing," Opposer failed to meet its burden of establishing a date of first use earlier than that claimed in its application for registration, or prior to Applicant's constructive date of first use for its registered marks.⁶⁴

Finally, because Opposer has established first use dates of 2002 for its ILLUMICODE mark and 2006 for its ILLUMINOTES mark, Opposer has established priority for those marks in the cancellation proceedings.

⁶⁴ Nevertheless, as noted above, the ILLUMINADX registration establishes Opposer's priority of use in the oppositions against Applicant's ILLUMIPRO and ILLUMIPRO-10 applications.

V. *The Parties*

A. *Opposer*

1. *Introduction*

[Opposer] is a global company that develops, manufactures, and markets genetic analysis tools and integrated systems for the analysis of genetic variation and function, and provides services related to the same. More specifically, [Opposer] develops and sells innovative array and sequencing-based solutions for DNA and RNA analysis which serve as tools for diseases research and diagnosis, drug development, and for the development of molecular tests in the clinic. [Opposer's] products and services serve life-sciences research, applied markets, and the molecular diagnosis market.⁶⁵

2. *Opposer's customers.*

Opposer sells its products to, *inter alia*, clinical diagnostic laboratories, where the laboratory medical director generally makes the purchasing decision for genetic, oncology and infectious disease products.⁶⁶ Opposer's customers are also laboratory directors in a molecular laboratory⁶⁷ and "prospective diagnostic development partners."⁶⁸ "The lab director is a key stakeholder in the decision-making process."⁶⁹

⁶⁵ Heath Testimony Dec. at 64 TTABVUE 3; Possemato Testimony Dec. at 66 TTABVUE 2.

⁶⁶ O'Grady Testimony Dec. at 60 TTABVUE 10. *See also* O'Grady Cross-Examination Dep. at 83 TTABVUE 43 and Opposer's response to Applicant's Interrogatory No. 44 at 76 TTABVUE 12 ("Opposer responds that it first offered for sale services under the ILLUMINA Mark that could have been ordered by or delivered to individuals employed in a clinical diagnostics lab of a hospital or reference laboratory at least as early as December 5, 2006.").

⁶⁷ O'Grady Cross-Examination Dep. at 83 TTABVUE 32, 56.

⁶⁸ O'Grady Cross-Examination Dep. at 83 TTABVUE 56, 70.

⁶⁹ O'Grady Cross-Examination Dep. at 83 TTABVUE 102.

Other stakeholders include “a medical director, hospital administration, including the president and purchasing agents.”⁷⁰

Opposer’s customers for its molecular diagnostic products and services include lab managers, molecular supervisors, purchasing department personnel, physicians (including infectious disease doctors and pathologists), medical geneticists, hospital administrators, genetic counselors, lab directors and lab technicians.⁷¹

In 2007, Opposer focused its sales efforts on the following non-exhaustive list of consumers for the launch of its BeadXpress product:

1. Researchers interested in focused analysis of markers of interest following a larger microarray discovery project;
2. Researchers interested in performing SNP genotyping analysis or a broad range of multiplex reactions;
3. Researchers interested in developing their own protein-based multiplex assays and/or genotyping assays; and
4. CLIA high complexity certified laboratories interested in developing laboratory-developed tests using RUO [research use only] products for multiplex assays.⁷²

⁷⁰ O’Grady Cross-Examination Dep. at 83 TTABVUE 102-103.

⁷¹ Heath Testimony Dec. at 64 TTABVUE 12.

⁷² O’Grady Cross-Examination Dep. at 83 TTABVUE 62-64. “Researchers’ means people interested in answering questions for the purpose of research, as opposed to diagnostics.” 83 TTABVUE 62.

According to Dr. Elagin, Applicant's Executive Vice President of Research and Development, "[t]hese RUO products are used by academic laboratories, medical centers for research purposes, government research entities, large pharmaceutical companies who do substantial research, and research laboratories, *not* the clinical diagnostic laboratories. In general, [Opposer] operated in the research market segment, similar to other companies like Life Technologies, Luminex, and the Life Science Division of Roche."⁷³

Thus, in 2007, when Opposer first began selling its BeadXpress product, they were sold to certified clinical laboratories ("CLIA") for their own laboratory developed tests ("LDT") for molecular diagnostics.⁷⁴ In its 2007 brochure advertising the VeraCode/BeadXpress technology,⁷⁵ Opposer pointed out that the technology could include "Molecular diagnostic assay development."⁷⁶ "In 2007, Children's Hospital of Philadelphia developed a test for hemoglobinopathies (inherited diseases in which a person has abnormal production or structure of the hemoglobin module, such as sickle cell anemia) using the BeadXpress system."⁷⁷ Also, in 2007, Opposer worked with the University of Maryland in connection with a \$5.6 million grant from the Bill and

⁷³ Elagin Testimony Dec. at 71 TTABVUE 11. We note that each of the companies referenced by Dr. Elagin also sell clinical diagnostic products. *See* the analysis of the similarity or dissimilarity of the nature of the goods and services *supra*.

⁷⁴ O'Grady Testimony Decl. ¶16 (60 TTABVUE 6).

⁷⁵ O'Grady Testimony Dec. at 60 TTABVUE 7 and 389-396.

⁷⁶ O'Grady Testimony Dec. at 60 TTABVUE at 391.

⁷⁷ O'Grady Testimony Dec. at 60 TTABVUE 7.

Melinda Gates Foundation “to assess emerging molecular diagnostic techniques as tools for epidemiological surveillance of infectious microbial disease.”⁷⁸ In other words, the University of Maryland School of Medicine used Opposer’s BeadXpress system “to detect microbial pathogens that contribute to diarrheal diseases (i.e., infectious diseases, including *C. difficile*).”⁷⁹ The preceding examples of Opposer’s sales activities are the types of activities that piqued the interest of Dr. Young, Scientific Director of Infectious Disease at TriCore Reference Laboratories, who was hoping that Opposer would develop a platform that Dr. Young would be able to use for diagnosing infectious diseases.⁸⁰

Opposer also promoted its BeadXpress product featuring the ILLUMINA house mark at the annual meeting of the Association of Molecular Pathology from 2007 through 2011⁸¹ and at the annual meeting of the American Association for Clinical Chemistry in 2006 and 2007-2008.⁸² The Association of Molecular Pathology is an organization in the field molecular and genomic laboratory medicine. Attendees of its annual meeting include pathologists, doctoral laboratory scientists, clinicians, and

⁷⁸ O’Grady Testimony Dec. at 60 TTABVUE 7-8.

⁷⁹ 91 TTABVUE 5.

⁸⁰ 96 TTABVUE 19-22.

⁸¹ O’Grady Testimony Decl. ¶¶11 and 13 (60 TTABVUE 5-6).

⁸² O’Grady Testimony Decl. ¶¶14-15 (60 TTABVUE 6).

other healthcare personnel, all of whom have an expertise in the fields of infectious diseases, genetic disorders, hematopathology, and solid tumors.⁸³

Opposer has conducted “corporate-sponsored workshops” featuring Opposer’s technology at the Association of Molecular Pathology annual meeting every year since 2008.⁸⁴ As noted above, Dr. Young encountered Opposer’s work by attending these meetings and conferences. Thus, even if we assume that Opposer’s sales were limited to research laboratories and that research laboratories include CLIA-certified laboratories, the decision makers in practical laboratories, such as Dr. Young’s infectious disease laboratory, encountered Opposer’s products and services at medical trade shows and conferences.

In 2009, Opposer advertised its BeadXpress product in *Cap Today*, a journal published by the College of American Pathologists, and *The Journal of Molecular Diagnostics*, a journal published by the Association for Molecular Pathology.⁸⁵ *Cap Today* is read by laboratory directors, managers and administrators, pathologists, hospital administrators, chief medical technologists, and “section managers/supervisors of chemistry, hematology, microbiology, immunology, blood bank, and cytology.”⁸⁶

⁸³ O’Grady Testimony Decl. ¶12 (60 TTABVUE 5).

⁸⁴ *Id.*

⁸⁵ O’Grady Testimony Decl. ¶10 (60 TTABVUE 4-5).

⁸⁶ O’Grady Testimony Decl. ¶10 (60 TTABVUE 4-5).

3. *Opposer's sales process.*

As noted above, Opposer's potential customer is "someone who is interested in a molecular approach and is interested in molecular etiology."⁸⁷ In other words, the customer thinks "that there is something to understand in the DNA or RNA."⁸⁸ Opposer's customers are laboratory directors in molecular laboratories who ask questions about Opposer's technology, such as:

1. their molecular or clinical questions;
2. whether the technology can identify whether a patient has a disease;
3. whether the technology can assess if the patient will respond to a drug;
4. what is the throughput in terms of samples per run;
5. what is the product workflow;
6. how is the reporting done;
7. how will the product be implemented into their laboratory;
8. how much space will the product need;
9. how many staff will be needed to operate the product; and
10. what other products are necessary to operate Opposer's primary

⁸⁷ Possemato Cross-Examination Dep. at 85 TTABVUE 73.

⁸⁸ Possemato Cross-Examination Dep. at 85 TTABVUE 73.

product.⁸⁹

“The right combination of instrument and consumables [other products used in a laboratory for use with Opposer’s products and for other purposes]⁹⁰ would be discussed with a marketing or sales representative as part of the conversation.”⁹¹ Marketing or sales representatives are assigned to each laboratory.⁹² The marketing or sales representatives are responsible for “forming a relationship and familiarity with the consumers.”⁹³ The marketing or sales representatives are knowledgeable about Opposer’s products, as well as the products of competitors. They answer customer questions about the products.⁹⁴

All of Opposer’s customers are trained by Opposer’s field application personnel.⁹⁵

Opposer’s products are expensive. They range in price from between \$30,000 to \$1,000,000.⁹⁶

⁸⁹ O’Grady Cross-Examination Dep. at 83 TTABVUE 32-34, 38-39, 117.

⁹⁰ O’Grady Cross-Examination Dep. at 83 TTABVUE 37.

⁹¹ O’Grady Cross-Examination Dep. at 83 TTABVUE 41.

⁹² O’Grady Cross-Examination Dep. at 83 TTABVUE 41.

⁹³ O’Grady Rebuttal Cross-Examination Dep. at 97 TTABVUE 87.

⁹⁴ O’Grady Rebuttal Cross-Examination Dep. at 97 TTABVUE 92.

⁹⁵ Possemato Cross-Examination Dep. at 85 TTABVUE 71.

⁹⁶ O’Grady Cross-Examination Dep. at 83 TTABVUE 24-26, 90, 105. *See also* Possemato Cross-Examination Dep. at 85 TTABVUE 54, 66.

B. Applicant

1. Introduction

Applicant has been in the clinical diagnostics field since its founding in 1977.⁹⁷

Within the broader category of infectious diseases, [Applicant's] clinical diagnostic products are focused in the microbiology space. [Applicant's] "molecular diagnostic" products test for and identify the microbial invader; [Applicant's] products do not focus on or have any relationship with the genetics of the *human* patient.⁹⁸

2. Applicant's customers

Applicant's customers are in the market for "ready-made" IVD tests.⁹⁹ Applicant distributes its products to hospitals and reference labs through its direct sales force.¹⁰⁰ The sales force interacts with microbiology technicians, lab managers, molecular supervisors, purchasing department personnel, infectious disease doctors and pathologists.¹⁰¹ "The actual consumers, then, of clinical diagnostic products in the microbiology space – the space that [Applicant] targets as its primary market for its ILLUMIGENE and ILLUMIPRO products – are typically the Clinical Directors of

⁹⁷ 72 TTABVUE 3; Declaration of Kenneth J. Kozak at 80 TTABVUE 3.

⁹⁸ Kozak Testimony Dec. at 72 TTABVUE 3; 80 TTABVUE 3.

⁹⁹ Elagin Testimony Dec. 71 TTABVUE 6.

¹⁰⁰ A "reference laboratory" is a "laboratory that receives a specimen from another, referring laboratory for testing and that actually performs the test." CMS Manual System, Pub. 100-4 Medicare Claims Processing, Department of Health & Human Services (February 6, 2004) (www.cms.gov). See also **MEDICAL DICTIONARY FOR THE HEALTH PROFESSIONS AND NURSING** (2012).

¹⁰¹ Applicant's response to Opposer's Interrogatory No. 12 (57 TTABVUE 31). See also 57 TTABVUE 521 and 528.

clinical diagnostic laboratories, who acquire such products often at the request of personnel in the laboratories' 'Infectious Disease' or 'Microbiology' departments or with the purpose to supply them to such departments."¹⁰²

"There are typically several specializations within a Clinical Diagnostic Laboratory, including for example Microbiology, Chemistry, Hematology, Special Chemistry, and/or others. Each department has a manager or supervisor."¹⁰³

¹⁰² 72 TTABVUE 4. *See also* Kozak Testimony Dec. at 72 TTABVUE 5 ("The ultimate decision-maker for buying [Applicant's] clinical diagnostic products – including [Applicant's] ILLUMIGENE products – is typically the head of a clinical diagnostic laboratory, i.e., the Clinical Director (sometimes with input or required consent or 'sign-off' from financial personnel such as a Purchasing Department, Materials Management department, or CFO or Director of Finance for the laboratory."); Elagin Cross-Examination Dep. at 88 TTABVUE 92 (Applicant's customers are "companies in the infectious disease area and then working with these customers in the virology, microbiology," fields."); 96 TTABVUE 12.

Dr. Elagin also testified that Applicant's products are purchased by clinical physicians or treating physicians. 71 TTABVUE 10 and 88 TTABVUE 83 and 85.

¹⁰³ Kozak Testimony Dec. at 72 TTABVUE 3. *See also* Kozak Cross-Examination Dep. at 86 TTABVUE 66 and Elagin Cross-Examination Dep. at 88 TTABVUE 101-102. "Clinical diagnostic laboratories encompass, by definition, every laboratory found within a hospital or a reference lab that can manage patient care." 86 TTABVUE 66-67 and 76-77 ("We sell into the clinical diagnostic lab focused on infectious disease microbiology."). Dr. Stephen Young, Scientific Director of Infectious Disease at TriCore Reference Laboratories, corroborated this organizational structure at TriCore Reference Laboratories.

TriCore is organized based on diagnostic disciplines. Basically, where the lab is automated in areas like chemistry and hematology, urinalysis, those are downstairs in an area that's described as automation. The rest of the lab is divided up by disciplines; Infectious Disease, Molecular Genetics, HLA or Human Genetics, and then Molecular Diagnostics and Toxicology.

96 TTABVUE 10.

Applicant does not market or sell to the research director in a hospital or reference laboratory.¹⁰⁴

Applicant has advertised and promoted its goods through direct sales contacts and presentations at professional conferences.¹⁰⁵ The professional conferences include those listed below:

1. Clinical Virology Symposium (April 2009 and April 2010);
2. American Society of Microbiology (May 2009 and May 2010);
3. Association of Molecular Pathology (November 2009 and November 2010);
4. Society of Healthcare Epidemiology of America (March 2010);
5. American Association of Clinical Chemistry (July 2010); and
6. College of American Pathologists (July 2010).¹⁰⁶

3. *Applicant's sales process*

The manager/supervisor of each department within a clinical diagnostics laboratory identifies the products that are needed by that department and gives the product description and supplier to a purchasing agent or department.¹⁰⁷ When there is more than one vendor for a specific product, the purchasing agent usually solicits

¹⁰⁴ Kozak Testimony Dec. at 72 TTABVUE 5 and Kozak Cross-Examination Dep. at 86 TTABVUE 74-75.

¹⁰⁵ Applicant's response to Opposer's Interrogatory No. 16 (57 TTABVUE 32-33).

¹⁰⁶ *Id.* See also Kozak Testimony Dec. at 72 TTABVUE 18-19.

¹⁰⁷ Kozak Testimony Dec. at 72 TTABVUE 3-4.

bids from multiple vendors and selects the best option based on a number of factors, including performance and price.¹⁰⁸

“[I]t typically requires multiple meetings and/or calls between [Applicant] and its customers to enter into a contract for [Applicant’s] clinical diagnostic products. [Applicant] and the relevant consumer will engage in significant negotiation over products, volumes, and prices. At all times, [Applicant’s] customers are fully aware of what types of products [Applicant] can offer and what types it does not offer, as well as the names of those products.”¹⁰⁹

* * *

“[D]uring these meetings and/or calls, the relevant consumer understands that she is interacting with [Applicant] to determine which of [Applicant’s] products, including without limitation the ILLUMIGENE product, are suitable for the consumer’s needs. ... In this context, it is the *company’s* brand that is foremost in the consumer’s mind – not the names of the products that the company offers to meet a particular need.”¹¹⁰

* * *

The purchasers of [Applicant’s] diagnostic products are not only very sophisticated, but they seek to answer a very detailed set of questions prior to purchasing. Lab Directors who make purchasing decisions examine in detail, among other things:

- the product’s diagnostic target
- the product’s intended use
- the product’s sensitivity

¹⁰⁸ Kozak Testimony Dec. at 72 TTABVUE 4.

¹⁰⁹ Kozak Testimony Dec. at 72 TTABVUE 13.

¹¹⁰ Kozak Testimony Dec. at 72 TTABVUE 13-14.

- the product's specificity
- the product's price
- whether the instruments to read the product cost money to purchase and/or run, and how much
- the sample type the product uses (e.g., throat swabs vs. nasal swabs)
- the type of media used for transfer of the sample or other component
- the available insurance reimbursement
- turnaround time of a result
- required education and training of the technical staff who will run the test
- whether the product will fit with the lab's current workflow.¹¹¹

Assuming the above-noted issues have been addressed to the satisfaction of the potential customer, "usually, they will do some type of testing on their own to assure that it does meet their work flows, and it is appropriate or a better replacement for their standard of care; then they usually make the recommendation to the purchasing people to say we want to buy this. In addition, [Applicant's] sales force goes into – at that point goes into the purchasing department and the purchasing agents and discusses the cost savings of using our product with them."¹¹²

¹¹¹ Kozak Testimony Dec. at 72 TTABVUE 14 and 83-84.

¹¹² Kozak Cross-Examination Dep. at 86 TTABVUE 84.

Applicant's ILLUMIGENE molecular diagnostic products are marketed between \$1,250 and \$3,000 per kit of 50 tests (\$25 to \$60 per test). Applicant's ILLUMIPRO instruments are included at no additional charge with the purchase of the consumer's first kit.¹¹³

VI. *Likelihood of Confusion*

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

A. *The fame of Opposer's ILLUMINA marks.*

This *du Pont* factor requires us to consider the fame of Opposer's marks. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Fame, if it exists, is determined at the time of trial. *See General Mills Inc. v. Fage Dairy Processing Indus. S.A.*, 100 USPQ2d 1584, 1595 n.13 (TTAB 2011).

¹¹³ Kozak Testimony Dec. at 72 TTABVUE 15.

Fame may be measured indirectly by the volume of sales and advertising expenditures for the goods and services identified by the marks at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments, and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305-1306 and 1309. Although raw numbers of product sales and advertising expenses sometimes may have sufficed to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or services). *Id.* at 63 USPQ2d at 1309.

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Coach Services, Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012), citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Opposer, in its brief, identified the evidence set forth below as demonstrating the fame of its ILLUMINA marks.¹¹⁴

¹¹⁴ 102 TTABVUE 31-32.

1. Opposer is a publicly-traded company (NASDAQ) with a market capitalization of around \$25 billion.¹¹⁵

2. Opposer has experienced sales growth from \$366.8 million in 2007 to well over \$1 billion in 2013.¹¹⁶ In this regard, because ILLUMINA is Opposer's house mark, it appears on all of Opposer's products and in connection with all of its services.¹¹⁷

3. Opposer has frequently been noted in news articles purportedly as an "industry leader."¹¹⁸ The articles listed below are illustrative.

a. In 2009, Forbes stated that Opposer was the fastest growing technology company in America, based on five-year annualized sales growth.¹¹⁹

¹¹⁵ Possemato Decl. ¶42 (66 TTABVUE 12). Ms. Possemato did not testify as to whether Opposer's customers were aware that Opposer was a publicly traded company with a market capitalization of over \$25 billion dollars or whether that is important to Opposer's customers.

¹¹⁶ Possemato Decl. ¶42 (66 TTABVUE 12) and declaration exhibit Nos. 216-221 comprising Opposer's annual reports from 2003 through 2009 (66 TTABVUE 241-390) and exhibit Nos. 222-228 comprising Opposer's SEC form 10-K filings from 2010 through 2013 (66 TTABVUE 391-582) that present Opposer's publicly reported financial results. Ms. Possemato did not testify as to Opposer's actual sales growth; she merely introduced Opposer's annual reports and SEC Form 10-K filings. Opposer presumably provided Opposer's counsel with the actual sales figures at some other time or counsel calculated the figures herself. In its brief, Applicant points out that Opposer derived almost half of its revenue from sales outside of the United States (104 TTABVUE 44); a point that Opposer did not contest in its reply brief. Nevertheless, even when we halve Opposer's revenue to account only for domestic sales, Opposer's revenues are substantial.

¹¹⁷ Possemato Decl. ¶11 (66 TTABVUE 4). *See also* Heath Testimony Dec. at 64 TTABVUE 12; Morrison Testimony Dec. at 68 TTABVUE 2; Possemato Cross-Examination Dep. at 85 TTABVUE 97-98, 110 ("Illumina is a master brand, and the branding strategy. The logo appears on all the products, and the Illumina name is in the first part of all the formal product names. So it's a monolithic branding strategy.").

¹¹⁸ Possemato Decl. ¶43 (66 TTABVUE 13) and Exhibit 229 (66 TTABVUE 583-611).

¹¹⁹ Possemato Decl. Exhibit 229 (*Forbes.com* (1-29-2009)) (66 TTABVUE 587). The article merely reported on the "25 Fastest-Growing Technology Stocks in America." It did not profile any of the companies; nor did it identify Opposer's field. On the other hand, in the *Forbes* 2010 list of fastest growing technology companies (66 TTABVUE 584-585), *Forbes*

b. Opposer ranked fourth on the Forbes 2010 ranking of the fastest growing technology companies in America.¹²⁰

c. *SignOnSanDiego.com* (November 16, 2011) reported that Opposer was on the Forbes top 25 list four times in the five-year period between 2006 and 2010.¹²¹ The article identified Opposer as a “leading global maker of genetic sequencing machines and other genetic testing products and services.” It also reported that “[t]he DNA mapping market has growing [sic] rapidly in recent years as the cost of the technology plunged and more scientists and doctors used genomics for research and patient care.”

d. *SeekingAlpha.com* (March 4, 2009) reported that sequencing the human genome is important and profitable and that that Opposer is dominating that market. According to the article, “Predictable consumable revenue, strong margins going forward, lack of a strong competitor means [Opposer] should be a sure bet in the short term. Longer term, [Opposer] looks promising too as long as it can acquire or produce a diagnostics business.”¹²²

(*forbes.com*) identified Opposer as being in the “analytical instruments” business whereas it identified Luminex, one of Opposer’s competitors (57 TTABVUE 40; O’Grady Testimony Dec. at 60 TTABVUE 3; O’Grady Cross-Examination Dep. at 83 TTABVUE 89, 133, and 166; Possemato Cross-Examination Dep. at 85 TTABVUE 93), as being in the “hardware, software and supplies for medical testing” business. (66 TTABVUE 584-585). This indicates, at least according to *Forbes*, that Opposer’s renown is as a manufacturer of analytical instruments.

¹²⁰ Possemato Decl. Exhibit 229 (66 TTABVUE 584-585).

¹²¹ Possemato Decl. Exhibit 229 (66 TTABVUE 583).

¹²² Possemato Decl. Exhibit 229 (66 TTABVUE 588).

e. *Forbes.com* (January 29, 2009) reported that Opposer is a company that “makes tools that scientists use to analyze the genes of humans, animals and plants.”¹²³

6. From 2008 through 2013, Illumina spent over \$8 million in advertising production cost, space, and fees; over \$6.8 million in direct marketing and electronic marketing; and over \$4.2 million in public relations including news releases and agency fees.¹²⁴ *Id.* Approximately X% of these marketing expenses were targeted to diagnostic customers.¹²⁵ *Id.*

While Opposer is a successful company in the field of genetic sequencing, the evidence does not support finding that Opposer’s ILLUMINA marks are famous. While the evidence shows that Opposer’s revenues and advertising expenditures are substantial, Opposer has offered no context for these figures. That is, there is no way to gauge the renown or consumer awareness of the marks vis-à-vis the competition or whether consumers are more cognizant of Opposer’s product marks than its

¹²³ Possemato Decl. Exhibit 229 (66 TTABVUE 589).

¹²⁴ Possemato Decl. ¶44. Although these figures were designated as confidential in the Possemato declaration, Opposer published them in its publicly available version of its brief while continuing to designate, as confidential, the percentage of these expenditures dedicated to diagnostic customers. Accordingly, we find that Opposer has withdrawn the confidential designation with respect to Opposer’s advertising figures.

As noted above, Opposer derived approximately half of its revenues from domestic sales. Likewise, the advertising figures submitted by Opposer do not distinguish between domestic and foreign advertising. While Opposer’s advertising figures are substantial, we are left to speculate as to how much Opposer spent advertising its products and services in the United States and what impact that advertising may have had on U.S. consumers.

¹²⁵ The percentage of advertising expenses dedicated to diagnostic customers was designated confidential.

ILLUMINA house mark. For example, there is no testimony or evidence regarding the extent to which relevant consumers have been exposed to Opposer's goods under its marks compared to sales of its competitors' goods, and thus it is not possible to determine whether Opposer's evidence of financial success reflects the fame of its ILLUMINA marks. The news articles introduced by Opposer, discuss Opposer as an attractive investment opportunity without any reference to the renown of the ILLUMINA marks or family of ILLUMINA branded products. The evidence shows that Opposer is an active and leading company in the genetic sequencing industry, not that its ILLUMINA mark is well known.

We find that the evidence and testimony of record is not sufficient to show that Opposer's ILLUMINA mark is famous. On the other hand, the evidence establishes that Opposer has a strong presence in the field of genetic sequencing.

B. The similarity or dissimilarity and nature of the goods and services.

In determining whether the goods and services are related, it is not necessary that the goods and services of the parties be similar or competitive in character to support a holding of likelihood of confusion; it is sufficient for such purposes that a party claiming damage establish that the goods and services are related in some manner and/or that conditions and activities surrounding marketing of these goods and services are such that they would or could be encountered by the same persons under circumstances that could, because of similarities of marks used with them, give rise to the mistaken belief that they originate from or are in some way associated with

the same producer. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1410 (TTAB 2010); *Schering Corporation v. Alza Corporation*, 207 USPQ 504, 507 (TTAB 1980); *Oxford Pendaflex Corporation v. Anixter Bros. Inc.*, 201 USPQ 851, 854 (TTAB 1978). The issue is not whether purchasers would confuse the parties' goods and/or services, but rather whether there is a likelihood of confusion as to the source of these goods and/or services. *In re Cook Medical Technologies LLC*, 105 USPQ2d 1377, 1380 (TTAB 2012); *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989); *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984).

In comparing and analyzing the goods and services, we must consider the goods and services as they are described in the applications and registrations. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"). *See also Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods").

We also do not read limitations into the identification of goods and services. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) (“There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration”). In this regard, for example, the fact that Applicant’s ILLUMIGENE diagnostic kits can be used only with the ILLUMIPRO readers and vice versa¹²⁶ plays no part in our analysis because that restriction or limitation as to Applicant’s goods is not reflected in its description of goods.

1. *The ILLUMIPRO and ILLUMIPRO-10 Oppositions.*

The description of goods in Applicant’s ILLUMPRO and ILLUMIPRO-10 applications reads as follows:

Diagnostic machine, namely, a stand alone closed heater and turbidity meter to be used for the amplification and detection of a closed tube molecular assay.

The act of detecting molecules requires amplification or making multiple copies of DNA.¹²⁷ “Closed tube” “means amplification will be conducted in a closed tube.”¹²⁸ “Molecular assays” are evaluations of substances at their molecular level, including

¹²⁶ Kozak Cross-Examination Dep. at 86 TTABVUE 43-46 and 142 (“Because our reader [ILLUMIPRO] and our kit [ILLUMIGENE] are married together. You cannot run one without the other. It is a completely closed system. No one else can get on it.”).

¹²⁷ O’Grady Cross-Examination Dep. at 83 TTABVUE 66.

¹²⁸ Elagin Cross-Examination Dep. at 88 TTABVUE 50.

DNA, RNA and chemical sequences.¹²⁹ Thus, Applicant's ILLUMIPRO marks will be used to identify diagnostic machines that detect microbial or viral bacteria or some other agent in a DNA sample.¹³⁰

Opposer introduced into evidence the following registrations:

1. Registration No. 2471539 for the mark ILLUMINA (typed drawing form) for "developing, to the order and specification of others biological and/or chemical sensing systems which use random array technology to identify organic molecules, compounds and substances";¹³¹ and

¹²⁹ "Molecular" is defined as "relating to molecules." A "molecule" is the smallest possible quantity of a di-, tri-, or polyatomic substance that retains the chemical properties of the substance." "Assays" are defined as "the quantitative or qualitative evaluation of a substance for impurities, toxicity, or other characteristics." **Stedman's Medical Dictionary** (stedmansonline.com). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including technical reference works. *In re 3Com Corp.*, 56 USPQ2d 1060, 1061n.3 (TTAB 2000) and *In re Astra Merck Inc.*, 50 USPQ2d 1216, 1219 (TTAB 1998). This includes online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006). "Molecular assays are assays that will work with DNA or RNA, and they will be for use to detect ... treatment of gastrointestinal, viral, urinary, so on and so forth." Elagin Cross-Examination Dep. at 88 TTABVUE 40.

¹³⁰ Elagin Cross-Examination Dep. at 88 TTABVUE 42-49.

¹³¹ "Array technology generally refers to a collection of microscopic regions of DNA attached to a solid surface. Each region contains a specific DNA sequence known as a probe. An array is used to determine whether a DNA sample contains the precise DNA sequence that corresponds to the probe on the region. For example, a sample from a human would be treated and then placed on the array. The array is then placed into a certain type of machine called a reader, which can determine whether a certain type of DNA sequence is present in the sample. This can indicate, for example, the presence of a disease, such as an infectious disease." Possemato Testimony Dec. at 66 TTABVUE 3. "Array technology means that you are doing multiple analyzing in the same test." Elagin Cross-Examination Dep. at 88 TTABVUE 78

2. Registration No. 4053668 for the mark ILLUMINADX (standard character form) is registered for “clinical diagnostic reagents, reagent kits, and beads with attached biomolecules, comprised primarily of oligonucleotides and other nucleic acids, natural and modified nucleotides, buffers, labels, and substrates, for clinical diagnostic purposes.”¹³²

Opposer also owns the mark ILLUMICODE for DNA microarrays.¹³³

Under the ILLUMINA mark in Registration No. 2471539, Opposer is developing systems that essentially do the same thing as Applicant’s ILLUMIPRO products (*i.e.*, detecting microbial, viral, or other disease causing agents) albeit using a different

¹³² This registration is only applicable in the opposition proceeding because Opposer failed to prove its priority vis-à-vis Applicant’s registrations involved in the cancellation proceedings. “Reagent” is defined as “any substance added to a solution or another substance to participate in a chemical reaction.” **STEDMAN’S MEDICAL DICTIONARY** (stedmansonline.com). “Reagents are the set of things that go into an assay or into a sample preparation.” Poseemato Cross-Examination Dep. at 85 TTABVUE 62-63.

¹³³ “Microarray technology allows a sample of the DNA of a clone of each gene in a whole genome to be laid out in order on the surface of a special chip, which is basically a small thin piece of glass that is treated in such a way that DNA molecules firmly stick to the surface. For any specific developmental stage of interest (e.g., the growth of root hairs in a plant or the production of a limb bud in an animal), the total RNA is extracted from cells of the organism, labeled with a fluorescent dye, and used to bathe the surfaces of the microarrays. As a result of specific base pairing, the RNAs present bind to the genes from which they were originally transcribed and produce fluorescent spots on the chip’s surface. Hence, the total set of genes that were transcribed during the biological function of interest can be determined.” Genomics, **ENCYCLOPAEDIA BRITANNICA** (2016) (*Britannica.com*). The Board may take judicial notice of information in encyclopedias. *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 n.61 (TTAB 2011); *Sprague Electric Co. v. Electrical Utilities Co.*, 209 USPQ 88, 95 n.3 (TTAB 1980) (standard reference works). According to Vecheslav Elagin, Applicant’s Executive Vice President for Research and Development, “‘Microarray’ means that a system can analyze several biological markers (proteins, DNA molecules, RNA molecules) from a single sample or multiple samples in a single format.” Elagin Testimony Dec. 71 TTABVUE 6.

technology.¹³⁴ See *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1267 (TTAB 2009) (VANTAGE TITAN for a medical magnetic resonance imaging diagnostic apparatus is likely to cause confusion with the mark TITAN for a medical diagnostic apparatus, namely, a medical ultrasound device because, *inter alia*, they may be used on the same patients to treat the same diseases by the same physicians). Likewise, Opposer's ILLUMINA brand DNA microarrays are used to analyze biological markers, including DNA molecules, and, thus, are used to do the same thing as the goods identified by Applicant's ILLUMIPRO marks.

Further, Opposer's ILLUMINADX reagents are used for clinical diagnostic purposes. Because reagents go into an assay or sample preparation, they theoretically could be used in Applicant's molecular assay.

In view of the foregoing, we find that Applicant's diagnostic machine is related to Opposer's "developing, to the order and specification of others biological and/or chemical sensing systems which use random array technology to identify organic molecules, compounds and substances," clinical diagnostic reagents and reagent kits, and DNA microarrays.

¹³⁴ O'Grady Rebuttal Testimony Dec. at 91 TTABVUE 4 and 14 ("To be clear, even though the technology may be different, both [Opposer's] products and [Applicant's] ILLUMIGENE and ILLUMIPRO products can be used to identify infectious disease by detecting genetic sequences that mark the particular disease.").

2. *The ILLUMIGENE cancellations.*

Applicant's ILLUMIGENE (standard character form) and ILLUMIGENE MOLECULAR SIMPLIFIED and design marks are both for the goods set forth below:

Diagnostic kits consisting of molecular assays for use in disease testing and treatment of gastrointestinal, viral, urinary, respiratory and infectious diseases.

"[T]he term 'molecular assays' in this context would be interpreted by one with skill in the field to mean an amplification/detection test for microbial, viral, or other disease-causing agents."¹³⁵

As noted above, Applicant explained that its ILLUMIGENE diagnostic kits can be used only with the ILLUMIPRO readers and vice versa.¹³⁶ While this fact has limited probative value because it is not reflected in any description of goods, it is something that we may consider in assessing the nature and purpose of Applicant's goods. The products work as follows:

[T]here will be a sampling device for C. difficle. You will take your stool sample, [] will be collected on a brush, placed into this device. The device has a specific buffer that we have designed and developed. The device has a filter. You squeeze it, drops come out the bottom. You then transfer that to reaction, you heat treat it, and then add it to the [ILLUMIPRO], a little plastic device that has our beads.

Group A strip, very similar. Doctors collect the swabs. Swab goes into the sampling device. Sampling device gets filtered through the filtration system, manually, very simply done. You do a 95 degree heat step, add that sample

¹³⁵ Elagin Testimony Dec. 71 TTABVUE 5.

¹³⁶ Kozak Cross-Examination Dep. at 86 TTABVUE 43-46 and 142.

to the [ILLUMIPRO] device, put it in the reader and read the results four minutes later.¹³⁷

Applicant advertises its ILLUMIGENE products as a “molecular diagnostic system.”¹³⁸ Molecular diagnostics includes looking at DNA and RNA sequences.¹³⁹ “The ILLUMIGENE product is [the] molecular-based detection.”¹⁴⁰ “Customers in the field of molecular diagnostics are testing for - - they’re looking for answers to questions that are answered by molecular biology.”¹⁴¹ The ILLUMIGENE and ILLUMIPRO products are “capable of detecting anything very simply that has a DNA base.”¹⁴²

According to Dr. Elagin, Applicant’s Vice President of Research and Development, Applicant’s products are used in a diagnostic laboratory, which “perform diagnostic tests (also referred to as ‘in vitro diagnostic’ or ‘IVD tests’) on samples taken from the human body, and used in a broad range of applications to aid the physician or

¹³⁷ Kozak Cross-Examination Dep. at 86 TTABVUE 43-44. Mr. Kozak used the term “Illumina” rather than ILLUMIPRO during his testimony. He was then asked, “Q. When you say put it in the reader, you are referring to the ILLUMIPRO? A. Yes.” 86 TTABVUE 44.

¹³⁸ 57 TTABVUE 557 and 560.

¹³⁹ O’Grady Cross-Examination Dep. at 83 TTABVUE 11-12.

¹⁴⁰ Kozak Cross-Examination Dep. at 86 TTABVUE 41-42.

¹⁴¹ O’Grady Cross-Examination Dep. at 83 TTABVUE 31. “Molecular biology” is defined as the “study of phenomena in terms of biology molecular (or chemical) interactions; traditionally, the focus of molecular biology is more specific than biochemistry in that it has an emphasis on chemical interactions involved in the replication of DNA, its ‘transcription’ into RNA, and its ‘translation’ into or expression in protein, in the chemical reactions connecting genotype and phenotype.” **STEDMAN’S MEDICAL DICTIONARY** (stedmansonline.com).

¹⁴² Kozak Cross-Examination Dep. at 86 TTABVUE 50.

caregiver in reaching decisions.”¹⁴³ ILLUMIGENE when used “in conjunction with the ILLUMIPRO data can be interpreted by the instrument to determine if a patient is positive or negative for a specific target.”¹⁴⁴

Applicant’s ILLUMIGENE and ILLUMIPRO products are DNA amplification assays.¹⁴⁵

The **illumigene** C. difficile DNA amplification assay, performed on the **illumipro-10**, is a qualitative in vitro diagnostic test for the direct detection of toxigenic C. difficile in human stool specimens from patients suspected of having Clostridium difficile-associated disease (CDAD).

The **illumigene** C. difficile assay utilizes loop-mediated isothermal DNA amplification (LAMP) technology to detect the pathogenicity locus (PaLoc) of toxigenic Clostridium difficile.¹⁴⁶

As noted above, Opposer introduced into evidence the following registrations:

1. Registration No. 2471539 for the mark ILLUMINA (typed drawing form) for “developing, to the order and specification of others biological and/or chemical sensing systems which use random array technology to identify organic molecules, compounds and substances”;

2. Registration No. 2632507 for the mark ILLUMINA (typed drawing form) is registered for the goods and services listed below:

¹⁴³ Elagin Testimony Dec. 71 TTABVUE 11.

¹⁴⁴ Kozak Cross-Examination Dep. at 86 TTABVUE 42.

¹⁴⁵ 57 TTABVUE 520-521, 528, 531.

¹⁴⁶ 57 TTABVUE 521.

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; and

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; and

3. Registration No. 2756703 for the mark ILLUMINA (typed drawing form) is registered for “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”;

Opposer also owns the mark ILLUMICODE for DNA microarrays.

Gregory F. Heath, Ph.D., Opposer’s Senior Vice President and formerly Opposer’s General Manager of the Diagnostics Business Unit, testified that Opposer’s products are used “to determine whether particular DNA sequences are present in a sample.”¹⁴⁷ “That DNA sequence, though, could be a microorganism that’s in the human sample.”¹⁴⁸

For example, an assay, such as [Opposer’s] GoldenGate genotyping assay, is used to process a DNA sample to attach specific portions of the DNA to VeraCode® beads. [Opposer’s] BeadXpress® reader is then used to analyze

¹⁴⁷ Heath Testimony Dec. at 64 TTABVUE 4.

¹⁴⁸ Possemato Cross-Examination Dep. at 85 TTABVUE 38.

the DNA samples attached to VeraCode® beads to determine whether specific, known DNA sequences are present in the sample of DNA.¹⁴⁹

Applicant's products do the same sort of thing (*i.e.*, detecting microbial, viral, or other disease causing agents) albeit through different technology.¹⁵⁰ *See In re Toshiba Med. Sys. Corp.*, 91 USPQ2d at 1267.

Dr. Stephen Young, Scientific Director of Infectious Disease at TriCore Reference Laboratories, testified that he goes to medical conferences, in part, "to interact with the vendors and find out what goods and services they have to offer so that you can be forward-thinking about how you're going to move your laboratory in terms of the diagnostic capacity of the lab."¹⁵¹

¹⁴⁹ Heath Testimony Dec. at 64 TTABVUE 4.

¹⁵⁰ O'Grady Rebuttal Testimony Dec. at 91 TTABVUE 4 and 15 ("To be clear, even though the technology may be different, both [Opposer's] products and [Applicant's] ILLUMIGENE and ILLUMIPRO products can be used to identify infectious disease by detecting genetic sequences that mark the particular disease."). In this regard, Naomi O'Grady Opposer's Manager of Oncology Product Marketing, testified that analyzing human genetics and detecting infectious diseases are related because "[b]oth involve detecting nucleic acids, and the same scientific methods are often used to detect human nucleic acids and the nucleic acids of a microorganism. In fact, the genetic blue print of both humans and microorganisms are made from the same building blocks – *i.e.*, DNA and/or RNA represented as strings of nucleic bases. This means the type of chemistry, tools, and techniques used to analyze human nucleic acids can and are often used to analyze the nucleic acids in a microbial organism such as the nucleic acids of infectious diseases." O'Grady Rebuttal Testimony Dec. at 91 TTABVUE 17.

¹⁵¹ 96 TTABVUE 20.

Dr. Young became aware of Opposer in or around 2007 and was anticipating that Opposer would develop a platform that Dr. Young would be able to use for diagnosing infectious diseases.¹⁵²

Q. Okay. You thought [Opposer] might actually be moving into something besides genetics even as far back as 2007?

A. Yes. I mean, I was interested in [Opposer's] sequencing platforms which were, basically, in their infancy, but I was familiar that they were developing platforms. At that point, the capacity of the platforms that were in development were beyond the scope of our laboratory. So you follow things that you think will eventually evolve and be available to you in terms of a platform.

Q. Okay. So as far back as 2007 you thought that [Opposer's] platforms and products might be something that would be relevant to you as an infectious disease -- someone in the infectious disease field; is that correct?

A. Yes.¹⁵³

* * *

Q. Do you have any thoughts on whether Next-Generation sequencing could be applicable to infectious disease?

A. Absolutely.

* * *

I absolutely believe Next-Generation sequencing will constitute an important component of an

¹⁵² 96 TTABVUE 19-22.

¹⁵³ 96 TTABVUE 22.

infectious disease, both diagnostic and prognostically.¹⁵⁴

* * *

Q. Going back to the time period we [Opposer's counsel and Applicant's counsel] both asked you about in 2007, part of it I could hear and part of it I couldn't. I want to make sure I understand exactly what your impressions were of [Opposer's] products and services in 2007. Did you say that you in 2007 hoped that the development program would take [Opposer] products in a direction where they could be relevant to your field?

* * *

A. Yes.

Q. And at that time, 2007, even the development programs were outside the scope of what you can use in your field. Did I get that right?

* * *

A. Yes, in the diagnostic laboratory.

Q. And you were hoping that eventually [Opposer] or other sequencing technology providers would move into something that might be useful in the diagnostic field?

* * *

Q. So do you understand my question, Dr. Young?

A. It was clear that it would certainly revolutionize human genetics and my hope was that products would be developed for infectious disease diagnostics.

¹⁵⁴ 96 TTABVUE 25.

Q. So it wasn't an impression you were getting from how those products were being marketed and presented, but rather your understanding of the evolution of technology, the revolution in human genetics, and then hoping for a possible continuing revolution that would carry it into diagnostics?

A. Yes.¹⁵⁵

* * *

Q. Back in 2007 when you said that you believed [Opposer's] technology could potentially revolutionize human genetics, would that include from a diagnostic standpoint?

A. Yes.¹⁵⁶

The following studies in professional publications showing “the natural progression from offering goods for use in research to offering goods for use in diagnostics” corroborate Dr. Young’s testimony.¹⁵⁷

1. Clinical Chemistry Review, “Microarray-Based Genomic DNA Profiling Technologies in Clinical Molecular Diagnostics” (2009).¹⁵⁸

¹⁵⁵ 96 TTABVUE 31-33.

¹⁵⁶ 96 TTABVUE 33.

¹⁵⁷ 57 TTABVUE 12 and 202-290. The relevance of the articles listed below in this note is not apparent. Opposer stated only generally that “the natural progression from offering goods for use in research to offering goods for use in diagnostics.”

1. Washington University School of Medicine (digitalcommons.com), “Diagnosis of Clostridium difficile infection: An ongoing conundrum for clinicians and for clinical laboratories” (January 1, 2013) at 57 TTABVUE 250-278; and

2. The New England Journal of Medicine, “Diverse Sources of C. difficile Infection Identified on Whole-Genome Sequencing” (September 26, 2013) at 57 TTABVUE 280-290.

Suffice it to say, we did not find any relevance to our proceedings in these articles.

¹⁵⁸ 57 TTABVUE 202-212. This report was submitted for review on October 24, 2008.

Background: Microarray-based genomic DNA profiling (MGDP) technologies are rapidly moving from translational research to clinical diagnostics and have revolutionized medical practices. Such technologies have shown great advantages in detecting genomic imbalances associated with genomic disorders and single-gene diseases.

* * *

Summary: MGDP technologies for molecular diagnostics are still at an early stage but are rapidly evolving. We are in a process of extensive clinical validation and utility evaluation of different array designs and technical platforms.

2. Clinical Chemistry Review, “Next-Generation Sequencing: From Basic Research to Diagnostics” (2009).¹⁵⁹

Content: ... Highlighted in this review are the impact of NGS on basic research, bioinformatics considerations, and translation of this technology into clinical diagnostics.

Summary: ... The various technologies that constitute this new paradigm continue to evolve, and further improvements in technology robustness and process streamlining will pave the part for translation into clinical diagnostics. ... This review describes NGS technologies, reviews their impact on basic research, and explores how they have translational potential to substantially impact molecular diagnostics.

Conclusions: ... Although considerable work lies ahead to implement NGS into clinical diagnostics, the potential applications are exciting and numerous.

¹⁵⁹ 57 TTABVUE 214-236. This report was submitted for review on October 7, 2008.

3. BMJ Open article (bmjopen.bmj.com), “A pilot study of rapid benchtop sequencing of *Staphylococcus aureus* and *Clostridium difficile* for outbreak detection and surveillance” (May 2, 2014).¹⁶⁰

Abstract

Objectives: To investigate the prospects of newly available benchtop sequencers to provide rapid whole-genome data in routine clinical practice. ...

Design: The authors used [Opposer’s] MiSeq benchtop sequencing to undertake case studies investigating potential outbreaks of methicillin-resistant *Staphylococcus aureus* (MRSA) and *Clostridium difficile*.

4. Washington University School of Medicine (digitalcommons.com), “Diagnosis of *Clostridium difficile* infection: An ongoing conundrum for clinicians and for clinical laboratories” (January 1, 2013).¹⁶¹

“Since the completion of the Human Genome Project in 2001, genetic sequencing had been moving into clinical diagnostic applications. One of the first goals was to enable more economic whole-gene sequencing so that whole-genome sequencing can realistically and practically be used for diagnostic applications.”¹⁶² “As sequencing technology has improved over the years, the cost of sequencing a human genome has decreased from \$3 billion to \$1,000.”¹⁶³ With this evolution in cost, Opposer moved into the molecular diagnostic market. Opposer introduced news articles, studies and

¹⁶⁰ 57 TTABVUE 238-248.

¹⁶¹ 57 TTABVUE 250-

¹⁶² Possemato Testimony Dec. at 66 TTABVUE 8.

¹⁶³ Possemato Testimony Dec. at 66 TTABVUE 7.

press releases in professional publications to show “Opposer’s expansion into and presence in the molecular diagnostics market.”¹⁶⁴ The most pertinent documents published prior to Applicant’s November 17, 2008 constructive date of first use for its ILLUMIGENE registration (Reg. No. 3868081) are listed below:

1. Genomeweb.com (May 15, 2006)¹⁶⁵

Decode, [Opposer] to Co-develop, Sell Molecular Diagnostics

Decode Genetics and [Opposer] plan to co-develop and commercialize DNA-based diagnostics in several major disease areas, the firms said today.

According to the firms, the partnership will use [Opposer’s] platform for high-multiplex SP-genotyping to develop diagnostics for gene variants that Decode has shown to be risk factors for various diseases.

Under terms of the agreement, [Opposer] will gain access to the disease-related biomarkers, which will be jointly validated as diagnostic panels. [Opposer] will market and sell these on its forthcoming BeadXpress platform, the partners said.

2. *Clinica: World Medical Device News* (Clinica.co.uk)(August 4, 2006)¹⁶⁶

¹⁶⁴ 57 TTABVUE 38-200. We recognize the hearsay problems inherent in such evidence. However, the stories are probative of the perceptions of the authors and of the content received by the readers. The news articles are probative to show that media covering industry events have reported on Opposer’s intent and attempts to develop and market its DNA sequencing technology for medical diagnostics.

¹⁶⁵ 57 TTABVUE 38. See also Possemato Testimony Dec. at 66 TTABVUE 5 (“[Opposer] and deCode used [Opposer’s] array technology to develop diagnostic tests for variant in genes linked to heart attack, type-2 diabetes, and breast cancer.”).

¹⁶⁶ 57 TTABVUE 40. Applicant objects to the admissibility of this document, *inter alia*, on the ground that it was published in a foreign publication without any evidence regarding U.S. readership. 104 TTABVUE 29. Since *In re Cell Therapeutics Inc.*, 67 USPQ2d 1795 (TTAB 2003), the Board has recognized that in cases involving highly sophisticated medical doctors

Lab diagnostics: competition heats up in bead-based technology

Two high-flying publicly traded competitors that use bead technology in their multiplex arrays revealed plans for enhancing their diagnostic portfolios at the annual scientific meeting of the American Association for Clinical Chemistry (AACC) in Chicago.

[Opposer] ... has been marketing the genotyping services of its bead array technologies since 1988. But with the acquisition of privately-held CyVera in April 2005, the San Diego-based company now has bead-based technology that offers opportunities for in vitro and molecular diagnostic development.

3. Genomeweb.com (March 21, 2007)¹⁶⁷

[Opposer] Launches BeadXpress Platform

and researchers, relevant consumers are not limited to receiving information from publications in general circulation restricted to the United States. *See also In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828 (Fed. Cir. 2007) (“Information originating on foreign websites or in foreign news publications that are accessible to the United States public may be relevant to discern United States consumer impression of a proposed mark.”); *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1050 (TTAB 2006) (under appropriate circumstances, web pages posted abroad may be considered probative evidence on how a term will be perceived); *In re Remacle*, 66 USPQ2d 1222, 1224 n.5 (TTAB 2002) (Board found that professionals in certain fields, such as medicine, engineering, computers and telecommunications would be likely to monitor developments in their fields without regard to national boundaries, and that the internet facilitates such distribution of knowledge, so evidence from an English language web site in Great Britain held admissible). The objection is overruled.

This article also reported that Luminex, a competitor of Opposer, has licensed its bead-based technology to more than 50 strategic partners and it is used in more than 34 FDA approved products, and that Luminex is developing its own assays to determine immune responses to pneumococcal vaccines which will be sold to reference labs late in 2006.

¹⁶⁷ 57 TTABVUE 45-46. Another article posted in this exhibit concerns the US Air Force extending a contract to develop an influenza genotyping system. Under the contract, “CBMX will develop a field-deployable system designed to identify all influenza strains, including H5N1 avian flu, and other respiratory pathogens. ... CBMX’s system can ‘determine when any other strain of influenza A is gaining an upper hand in a population, and can identify other infectious diseases that cause flu-like symptoms.’” 57 TTABVUE 48.

[Opposer] this week launched its BeadXpress system, the platform at the base of its molecular diagnostics strategy.

* * *

According to [Opposer], the BeadXpress system allows researchers to assay tens to hundreds of analytes in a single sample at one time. In addition to molecular diagnostics, [Opposer] anticipates the system will be used for biomarker research and validation, pharmaceutical development, industrial testing, and agricultural research.

“What this platform does is it enables us to move all the way down into lower and mid-multiplex ranges, which we really believe to be critical in the molecular diagnostics space,” said [Opposer’s CFO].

4. Genomeweb.com (November 28, 2007)¹⁶⁸

Gates Foundation Awards Md. Vaccine Center \$5.6M for Pathogen Dx; [Opposer], Ibis Tapped as Subcontractors

The Center for Vaccine Development at the University of Maryland’s School of Medicine said today that it has been awarded a \$5.6 million grant from the Bill and Melinda Gates Foundation to develop a diagnostic for diarrheal disease.

[Opposer] and Ibis Biosciences will serve as subcontractors on the grant and will provide genomics and pathogenic identification services, the university said.

Opposer introduced websites from ten companies that advertise their activities in the manufacture and distribution of both research and diagnostic products.¹⁶⁹ This evidence shows that there are companies in both the research and diagnostic fields.

The companies are listed below:

¹⁶⁸ 57 TTABVUE 50.

¹⁶⁹ 57 TTABVUE 292-349.

1. Becton, Dickinson and Company (bd.com);¹⁷⁰
2. Gen-Probe (gen-probe.com);¹⁷¹
3. Life-Technologies (lifetechnologies.com);¹⁷²
4. PerkinElmer (perkinelmer.com);¹⁷³
5. Qiagen (qiagen.com);¹⁷⁴
6. Roche (roche.com);¹⁷⁵
7. Agilent Technologies (agilent.com);¹⁷⁶
8. Beckman Coulter, Inc. (beckmancoulter.com);¹⁷⁷
9. Siemens Healthcare Diagnostics, Inc. (siemens.com);¹⁷⁸ and
10. Luminex Corporation (luminex.com).¹⁷⁹

¹⁷⁰ 57 TTABVUE 292-294.

¹⁷¹ 57 TTABVUE 296-299.

¹⁷² 57 TTABVUE 301.

¹⁷³ 57 TTABVUE 303-308.

¹⁷⁴ 57 TTABVUE 310-312.

¹⁷⁵ 57 TTABVUE 314-319.

¹⁷⁶ 57 TTABVUE 321-335. Agilent Technologies, a “provider of research microarrays used to analyze gene expression,” issued a press release (April 22, 2008) announcing that it was collaborating with Agendia BV, a “leader in gene expression analysis-based diagnostics,” to develop in-vitro diagnostic tests by combining the microarray technology of Aligent Technologies with the biomarker expertise of Agendia. 57 TTABVUE 331.

¹⁷⁷ 57 TTABVUE 337-340.

¹⁷⁸ 57 TTABVUE 342-344.

¹⁷⁹ 57 TTABVUE 346-349. In 2008, Luminex had a molecular diagnostic test for influenza. O’Grady Cross-Examination Dep. at 83 TTABVUE 138.

Becton, Dickinson and Company, Gen-Probe, Roche, Siemens Healthcare Diagnostics and Luminex advertise their involvement in both the fields of detecting infectious diseases and molecular analysis.

Through the Elagin declaration, Applicant points out the differences between Applicant's goods and Opposer's goods and services.¹⁸⁰ However, the issue before us is not whether consumers will confuse the goods and services but whether they will confuse the source of the goods and services. *In re Cook Medical Technologies LLC*, 105 USPQ2d at 1380; *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d at 1624.

Applicant contends that the description of goods and services in Opposer's pleaded registrations "specify that the goods and services will be used in scientific research, human genetic sequencing or genotyping, and specifically by using microarray assays."¹⁸¹ There are several problems with this argument. First, not all of Opposer's registrations are limited to research and the ILLUMICODE mark, based on common law use, is used for DNA microarrays *per se*, without limitation as to their application. Thus, for example, the "sensing systems" in Opposer's Registration No. 2471539 for the mark ILLUMINA for "developing, to the order and specification of others biological and/or chemical sensing systems which use random array technology to

¹⁸⁰ Elagin Testimony Dec. 71 TTABVUE 5-8.

¹⁸¹ Elagin Testimony Dec. 71 TTABVUE 10. Kenneth Kozak, Applicant's Chief Technical Officer, testified that in his 27 years in the business of selling medical devices, he has never seen one of Opposer's products in an infectious disease laboratory. 86 TTABVUE 125-126.

identify organic molecules, compounds and substances” could encompass the “diagnostic kits consisting of molecular assays” described in Applicant’s ILLUMIGENE registrations. As noted above, we must determine the relationship of the goods and services by their description of goods and services and not by the evidence of actual use. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 16 USPQ2d at 1787.

Second, according to Dr. Young’s testimony, he was anticipating Opposer’s development of a DNA sequencing platform that would be useful in his infectious disease laboratory, thus demonstrating a consumer perception of a connection between products used in research and in practical application. Dr. Young’s perception was corroborated by evidence of studies in professional publications showing “the natural progression from offering goods for use in research to offering goods for use in diagnostics,” including news articles, studies and press releases in professional publications to show “Opposer’s expansion into and presence in the molecular diagnostics market.”

Finally, Opposer introduced evidence of ten third-party companies in both the research and diagnostic fields, including Becton, Dickinson and Company, Gen-Probe, Roche, Siemens Healthcare Diagnostics and Luminex that promote their involvement in both the fields of detecting infectious diseases and molecular analysis further establishing a connection between research products and products in practice application.

In view of the foregoing, we find that Applicant's "diagnostic kits consisting of molecular assays for use in disease testing and treatment of gastrointestinal, viral, urinary, respiratory and infectious diseases" are related to Opposer's goods and services.

C. Established, likely-to-continue channels of trade.

The testimony and evidence show that laboratory directors and managers are primary targets for the parties' sales efforts. These laboratory directors and managers attend medical conferences that serve as a significant trade channel, where both parties participate and exhibit their goods and services. As discussed above, Dr. Steven Young testified that he became aware of Opposer's technology at one of these conferences. Thus, the same consumers encounter the marks and products and services of both parties. *See Block Drug Co., Inc. v. Den-Mat, Inc.*, 17 USPQ2d 1315, 1317 (TTAB 1989), *aff'd*, *Den-Mat Corp. v. Block Drug Co., Inc.*, 17 USPQ2d 1318 (Fed. Cir. 1990) ("Despite some slight differences in the methods of distribution, it cannot be denied that the same consumers, i.e. denture wearers, are reached by both parties in the promotion and sale of their goods."); *Quadrex Corp. v. Inficon Lyeboldy-Heraeus, Inc.*, 228 USPQ 300, 302 (TTAB 1985) ("It is only necessary that we find a relationship between these goods such that they would be likely to be encountered by the same persons under circumstances that could, because of the marks involved, give rise to a mistaken belief that they originate from, or are in some way associated with the same, albeit anonymous, producer."); *Jeanne-Marc Inc. v. Cluett, Peabody & Co.*,

221 USPQ 58, 61 (TTAB 1984) (“while [the goods of the parties] might not be encountered in the same stores, both parties’ goods might be encountered by the same purchasers.”).

In view of the foregoing, we find that the Applicant’s goods and Opposer’s goods and services move in some of the same channels of trade.

*D. The degree of consumer care.*¹⁸²

In determining the issue of likelihood of confusion, it is necessary to consider the circumstances surrounding their sale and offering for sale, insofar as these are made known to us by the evidence. Just based on the products involved in these proceedings, one would expect that all of the purchasers would exercise a high degree of care when making their purchasing decision. The record, as discussed above, supports this finding. *See Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1413 (TTAB 2010) (“opposer's heart monitors and applicant's computer system [monitoring for adverse drug effects] are purchased and licensed only after careful consideration by persons who are highly knowledgeable about the products.”). Thus, both Applicant’s products and Opposer’s products and services are purchased by consumers who use an extremely high degree of care when making their purchasing decisions.

¹⁸² The *du Pont* case refers to the degree of consumer care as “the conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.” 177 USPQ at 567.

E. The nature and extent of any actual confusion.

Despite the relatedness of the goods and services and similarity of the channels of trade, there have been no reported instances of confusion.¹⁸³ However, the absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a significant period of time in the same markets as those served by Opposer under its marks. *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*. 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d at 1660; *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. North American Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) (“the absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring”).

¹⁸³ Kozak Testimony Dec. at 72 TTABVUE 18; 76 TTABVUE 13; Kozak Cross-Examination Dep. at 86 TTABVUE 158-161.

The absence of any showing of actual confusion is of very little probative value here because Opposer has not been commercially active in the field of infectious disease diagnosis until only recently. Opposer's primary markets have been in the field of scientific and medical research. The extent that it has ventured into infectious disease diagnosis has been the result of sales to CLIA-certified laboratories,¹⁸⁴ whereas Applicant has been marketing to the directors of infectious disease laboratories.

F. The number and nature of similar marks in use in connection with similar goods and services.

Applicant introduced into evidence copies of third-party registrations for ILLUM-formative marks and LUM formative marks, accompanied by excerpts of webpages showing that the marks are in use. “[E]vidence of third-party use bears on the strength or weakness of an opposer’s mark. ... The weaker an opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and

¹⁸⁴ “CLIA is an acronym for Clinical Laboratory Improvement Amendments, a set of regulations implemented by the Centers of Medicare and Medicaid Services. 42 CFR § 493.1253(b)(2). When a laboratory develops a test system such as an LDT in-house without receiving FDA clearance or approval, CLIA prohibits the release of any test results prior to the laboratory establishing certain performance characteristics relating to analytical validity for the use of that test system in the laboratory’s own environment.” 104 TTABVUE 11. “If a test is providing a diagnostic answer, it must either be cleared by the FDA or it must be conducted in a CLIA-certified laboratory. The CLIA-certified laboratory may use equipment and consumables that are labeled for RUO [research use only], but such use does not somehow covert those components into diagnostic kits – far from it. Rather, the diagnostic product involved is the laboratory’s own LDT [laboratory designed/developed test] which is built from non-IVD components, and the process of building the LDT and using the LDT must be carefully controlled under CLIA regulations.” O’Grady Cross-Examination Dep. at 83 TTABVUE 140.

thereby invading what amounts to its comparatively narrower range of protection.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135-36 (Fed. Cir. 2015), quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). *See also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005) (“Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.”). “The purpose of a defendant introducing third party uses is to show that customers have become so conditioned by a plethora of such similar marks that customers ‘have been educated to distinguish between different [such] marks on the bases of minute distinctions.’” *Id.* at 1694.

Where the “record includes no evidence about *the extent of [third-party] uses ... [t]he probative value of this evidence is thus minimal.*” *Id.* at 1693, quoting *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1561 (Fed. Cir. 2001) (emphasis added in *Palm Bay Imps.*). However, if there is extensive evidence of third-party use and registrations, such evidence may be “powerful on its face,” even if the specific extent and impact of the usage has not been established. *Jack Wolfskin*, 116 USPQ2d at 1136; *Juice Generation*, 115 USPQ2d at 1674-75.

In addition, “[a] real evidentiary value of third party registrations per se is to show the sense in which ... a mark is used in ordinary parlance.” 2 McCarthy on Trademarks and Unfair Competition § 11:90 (4th ed. 2015) (emphasis

added). “Third party registrations are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Id.*; see *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917 [189 USPQ 693] (CCPA 1976) (even if “there is no evidence of actual use” of “third-party registrations,” such registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used”). Marks that are descriptive or highly suggestive are entitled to a narrower scope of protection, *i.e.*, are less likely to generate confusion over source identification, than their more fanciful counterparts. See, e.g., *Nat'l Data Corp. v. Computer Sys. Eng'g, Inc.*, 940 F.2d 676, at *2 (Fed. Cir. 1991) (unpublished); *Drackett Co. v. H. Kohnstamm & Co.*, 404 F.2d 1399, 1400 [160 USPQ 407] (CCPA 1969) (“The scope of protection afforded such highly suggestive marks is necessarily narrow and confusion is not likely to result from the use of two marks carrying the same suggestion as to the use of closely similar goods.”).

Id. at 1675.

The third-party marks are set forth in the tables below.

1. *ILLUM-formative marks*.¹⁸⁵

Mark	Reg. No.	Goods/Services
ILLUMABOND	3660170	Adhesives for use in industrial, electronic, medical and aerospace bonding applications

¹⁸⁵ 76 TTABVUE 939-1035. When two marks and two registration numbers appear in the same row, that means they are owned by the same entity.

We did not include Registration No. 3612773 for the mark CSA ILLUMINA and Registration No. 3612772 for the mark ILLUMINA because their description of goods was not related to goods or services in the medical field.

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Mark	Reg. No.	Goods/Services
ILLUMASK illuMask	4534705 4557547	Phototherapeutic light delivery apparatus for medical purposes.
ILLUMAVEIN	3924018	Medical instruments, namely apparatus for taking blood samples from animals
ILLUMIEN ILLUMIEN ILLUMIEN OPTIS	4258470 4577532 4577531	Computer displays and computer monitors and controllers therefor used in association with medical imaging apparatus during medical imaging of an individual Optical coherence tomography software for medical imaging; computer software for use in medical diagnosis, namely, for use in measurement and assessment of measured physiological variables
ILLUMINATIONS	4655976	Health care services, namely, wellness programs in the field of memory care for individuals facing Alzheimer's disease and other forms of dementia
IlluminOss IlluminOss MEDICAL	3951065 3955181	Medical devices and surgical instruments used for use in orthopedic and trauma surgical procedures

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Mark	Reg. No.	Goods/Services
ILLUMINATE THE CHANGE	3734384	DNA amplifiers; DNA synthesizers; DNA sequencers; DNA analyzers; automatic pipettes for laboratory experiments; automatic biological tissue processing units for pathology research; immunity test and evaluation devices for laboratory experiments; fiber optic instruments for surgical and diagnostic use; medical biogenic element analyzers; medical blood analyzers; diagnostic apparatus for testing and evaluating immunity for medical use; medical automatic pipettes; clinico-pathological and clinical chemical test preprocessors consisting of centrifuges, racks, dispensers, liquid volume monitors and pressure-sensor detectors, and labeling equipment for medical diagnostic purposes in the nature of patient specimen analysis, specimen separation and specimen aliquotting

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Mark	Reg. No.	Goods/Services
ILLUMENA	2237169	Powered injectors for injecting contrast media into the body of a human or animal to facilitate imaging body organs and by radiography, computed tomography, and the like; medical tubing for administration and drainage of fluids; containers, namely, syringes; medical apparatus, namely, contrast media power injector operator consoles, console and injector power head mounts, and accessories, namely, extension and interconnect cables, remote switches, ECG interfaces and pre-amplifiers; syringe pressure jackets and heaters, and bottle holders, all for use in connection with such contrast power injectors
ILLUMINOSTICS	4419422	Providing internet based data capture services that enable quality assessment and control, processing, analysis, and review of medical and research data; Scientific services, namely, compiling data for research purposes in the field of medical science and medical research; Providing quality assessment and quality control services in the field of medical science and medical research; Quality control for others in the field of medical and research data; Scientific research consulting in the field of analysis and review of medical data and medical research data.

The registration with a description of goods closest to Opposer's description of goods is Registration No. 3734384 for the mark ILLUMINATE THE CHANGE for *inter alia* DNA amplifiers, synthesizers, sequencers, and analyzers. However, this mark was registered under the provisions of Section 66a of the Trademark Act, 15

U.S.C. § 1141f(a), not use in commerce. Moreover, the webpage introduced purportedly to show use of the mark is the search result from the Hitachi Aloka Medical America, Inc. website for the term “illuminate the change.”¹⁸⁶ As displayed on the webpage, the term “Illuminate The Change” is not used as trademark to identify any goods. There is no evidence that this term is used as a mark in the United States.

It appears that the ILLUM-formative marks are using the ILLUM prefix as a derivative of the word “illuminate.” The word “illuminate” is defined, *inter alia*, as “to supply or brighten with light; light up,” “to make lucid or clear; throw light on (a subject),” and “to enlighten, as with knowledge.”¹⁸⁷ Thus, the ILLUM prefix has been adopted and used to engender the commercial impression of throwing light on a subject or making it easily understood.

2. LUMI-formative marks¹⁸⁸

Mark	Reg. No.	Goods/Services
CPS LUMINARY	3277930	Medical instruments, namely, bideflectable catheter with lumen

¹⁸⁶ 76 TTABVUE 998.

¹⁸⁷ *Dictionary.com* derived from the **RANDOM HOUSE DICTIONARY** (2016). Applicant notes that ILLUMINA is the Latin word for “enlighten.” 104 TTABVUE 21. The word “enlighten” is defined, as “to give intellectual or spiritual light to; instruct; impart knowledge to.” *Dictionary.com* derived from the **RANDOM HOUSE DICTIONARY** (2016). This is consistent with the definition of the word “illuminate” and the commercial impression engendered by the ILLUM prefix.

¹⁸⁸ 77 TTABVUE 2-181. We did not consider Registration No. 2891411 for the mark LUMENIS because it was cancelled effective May 8, 2015.

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Mark	Reg. No.	Goods/Services
E.LUMINEXX	3548273	Medical devices and apparatus, namely, stents, stent delivery systems, and parts and fittings therefor
LUMINEXX	2898765	
LUMENON MEDICA	3887972	Providing medical information in the fields of health care, public health, pharmaceuticals and biotechnology by electronic and non-electronic means
LUMEON & design	3894295	Medical devices, namely, vital signs monitors and colposcopes
LUMETRICS	3984557	Optical devices, namely, fiber-optic measurement instruments for measuring the dimensions of components of the human body for medical use
LUMIERE	4412254	Endoscopic equipment; Rigid and flexible medical endoscopes; Surgical retractors
LUMIE	4041094	Medical devices, namely, light units and light apparatus for use in the fields of light therapy and light supplementation, for treating seasonal affective disorders, mood disorders, jet lag problems, sleep disorders and other problems associated with the circadian cycle
LUMIN	3714156	Medical diagnostic testing, monitoring and reporting services
LUMINA HEALTHCARE	3979227	Oral hygiene products for medical use Dental implants Healthcare management services Dental laboratory services Dental services

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Mark	Reg. No.	Goods/Services
LUMINANCE	3441239	gloves for medical use, namely, examination gloves; medical gloves; and surgical gloves
LUMINANT	3254140	Medical apparatus, namely, a localizing ring for stereotactic procedures, namely to pinpoint the location of tumors or abscesses in the brain for biopsy, removal and radiation therapy
LUMINANT MR/CT LOCALIZER & design	3206725	
LUMINAQUEST TECHNOLOGIES	4522373	laboratory equipment, namely, multi function laser spectroanalysis diagnostic and quantitative device for use in chemical and molecular analysis for scientific, pharmacological, and medical research use
LUMINARY	3685524	Surgical implants, namely, disc spacers composed of human tissues Medical instruments for use in spinal surgery, namely, expandable disc space distractors, elevators, vertebral disc shavers, rasps, trial spacers, t-handle adapter, mallet, impactor, implant holder, spreaders
LUMINENZ	4080370	pharmaceutical preparations for the treatment of pervasive development disorders and dysautonomia pharmaceutical preparations for the treatment of pervasive development disorders and dysautonomia
LUMINJECT	3587323	Surgical, medical, dental and veterinary instruments and apparatus, namely, syringes and injection needles

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Mark	Reg. No.	Goods/Services
LUMINEX	2243135	software and computer hardware for use in medical diagnosis using multiemission ratiometric fluorophors
LUMINEX	3267571	Diagnostic reagents and micro spheres for clinical or medical use for conducting molecular analysis for healthcare, environmental, agricultural, diagnostic, and other applications Maintenance and repair services for laboratory instruments and parts therefor, and for biological and chemical test kits for use in the fields of life sciences, chemistry and medicine
LUMINOSKAN ASCENT	2203505	laboratory apparatus and instruments for medical and veterinary use, namely, luminometers
LUMINOCT	3703347	Chemical reagents for scientific and research use; chemical reagents and preparations for use in polymerase chain reaction analysis for scientific and research use and for use in medical diagnostic, clinical, and medical research laboratories; chemical reagents and preparations for use in the detection, amplification, analysis, quantification and labeling of nucleic acids for scientific and research use and for use in medical diagnostic, clinical, and medical research laboratories; fluorescent chemicals for scientific and research use and for use in medical diagnostic, clinical, and medical research laboratories
LUMIZYME	3843069	Pharmaceutical preparations for the treatment of lysosomal storage diseases

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Mark	Reg. No.	Goods/Services
LUMIX	3683241	Lasers for medical purposes for medical, surgical and dental use, all aforesaid items to be used on the human body in laser therapies carried out in medical centers and ambulatory care clinics
LUMIPROBE	4048811	Assays and reagents for use in genetic research; Assays for research purposes; Biochemical reagents commonly known as probes, for detecting and analyzing molecules in protein or nucleotide arrays; Chemical solutions and preparations consisting of pre-mixed reactants and reagents for scientific and research use in connection with amplification, analysis or labeling of nucleic acid; Diagnostic preparations for scientific or research use; Diagnostic reagents for clinical or medical laboratory use; Diagnostic reagents for scientific or research use; Fluorescent dye for scientific or research use; Genetic identity tests comprised of reagents; Nucleic acid isolation and purification kit consisting primarily of reagents and magnetic beads for scientific research purposes; Nucleic acid sequences and chemical reagents for other than medical and veterinary purposes; Reagent for chemical analyses; Reagent kits comprising generic DNA circle, DNA primers, polymerase and buffers for use in biotechnology fields; Reagents and substrates, namely, chemical compounds for use in patterning at nano scale or near nano scale; Reagents for research purposes; Reagents for scientific or medical research use

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Mark	Reg. No.	Goods/Services
LUMINOS	4072620	Electromedical, medical and surgical apparatus and devices for X-ray diagnostics and X-ray therapy as well as systems consisting of such apparatus and devices and parts thereof
LUMINOS AGILE	4072619	

Of these, there are five LUMI-formative marks used in connection with goods that are related to Opposer's DNA sequencing products and services:

1. Registration No. 4522373 for the mark LUMINAQUEST TECHNOLOGIES for "laboratory equipment, namely, multi function laser spectroanalysis diagnostic and quantitative device for use in chemical and molecular analysis for scientific, pharmacological, and medical research use";

2. Registration No. 3267571 for the mark LUMINEX for "diagnostic reagents and micro spheres for clinical or medical use for conducting molecular analysis for healthcare, environmental, agricultural, diagnostic, and other applications"; and

3. Registration No. 3703347 for the mark LUMINOCT for "chemical reagents and preparations for use in polymerase chain reaction analysis for scientific and research use and for use in medical diagnostic, clinical, and medical research laboratories; chemical reagents and preparations for use in the detection, amplification, analysis, quantification and labeling of nucleic acids for scientific and research use and for use in medical diagnostic, clinical, and medical research laboratories";

4. Registration No. 4048811 for the mark LUMIPROBE for "assays and reagents for use in genetic research, diagnostic reagents for clinical or medical laboratory use;

reagent kits comprising generic DNA circle, DNA primers, polymerase and buffers for use in biotechnology fields; reagents for research purposes; reagents for scientific or medical research use”; and

5. Registration Nos. 3531844 for the mark LUMIPULSE for “clinical laboratory analyzers for measuring, testing and analyzing, namely, immuneanalyzers, biochemical analyzers, chemical analyzers, gene analyzers, and body fluid analyzers all for clinical and industrial diagnostic testing” and “diagnostic reagents and preparations for medical use; test kits containing diagnostic reagents and preparations for medical use.”

According to Applicant, the use and registration of these marks “is relevant generally to the strength of Opposer’s marks and the widespread use of LUMI-formative marks in the relevant industry.”¹⁸⁹ Applicant does not explain the meaning of the LUMI prefix or the commercial impression that is supposed to be engendered thereby.¹⁹⁰ Presumably, the LUMI prefix is a shortened form of the word “luminous” which is defined in part as “clear; readily intelligible” and used in the marks to engender the commercial impression that the products make their subject readily understandable.¹⁹¹ However, these cases do not involve marks with a LUMI-prefix and none of the marks with the LUMI-prefix are as similar as Applicant’s

¹⁸⁹ 76 TTABVUE 6.

¹⁹⁰ In its brief, Applicant asserts, without any evidentiary support, that the LUMI prefix means light. 104 TTABVUE 49.

¹⁹¹ Dictionary.com derived from the **RANDOM HOUSE DICTIONARY** (2016).

ILLUMIGENE and ILLUMIPRO and Opposer's ILLUMINA marks. Thus, they fail to show that consumers have been educated to rely on minor distinctions to distinguish between marks such as Applicant's and Opposer's.

In analyzing the similarity or dissimilarity of the marks, we take into account that the ILLUMI-prefix and LUMI-prefix used in connection with medical devices suggests that their products cast light upon their subjects, making their subjects readily understandable or observable. Accordingly, while we find that the ILLUMI-prefix when used in connection medical devices may be suggestive, Opposer's ILLUMINA marks are not so weak that they should be given only a narrow scope of protection or a restricted exclusivity of use when used in connection with related goods because there is only one relevant mark with an ILLUMI-prefix [ILLUMINATE THE CHANGE] and the registration for that mark is not based on use in commerce and, as noted above, there is no evidence that it is actually in use as a mark.

G. The similarity of dissimilarity of the marks.

We now turn to the du Pont likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, "two marks may be found to be confusingly similar if there are sufficient similarities in terms of sound or visual appearance or connotation." *Kabushiki Kaisha Hattori Seiko v. Satellite Int'l, Ltd.*, 29 USPQ2d 1317, 1318 (TTAB 1991), *aff'd mem.*, 979 F.2d 216 (Fed. Cir. 1992) (citation omitted). *See also Eveready*

Battery Co. v. Green Planet Inc., 91 USPQ2d 1511, 1519 (TTAB 2009) (citing *Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”)).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012). *See also San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). As indicated above, the average customer is a laboratory director exercising a high degree of consumer care.

Applicant is seeking to register the marks ILLUMIPRO (standard characters) and ILLUMIPRO-10 (standard characters), and has registered the marks ILLUMIGENE (standard characters) and the mark ILLUMIGENE MOLECULAR SIMPLIFIED and design, shown below:



Opposer's marks are ILLUMINA (standard characters), ILLUMINADX (standard characters), and ILLUMICODE.

The dominant element of Applicant's ILLUMIGENE MOLECULAR SIMPLIFIED and design mark is the word ILLUMIGENE.¹⁹² We are aware that our analysis of the marks must be based on the marks in their entireties and not by dissecting them into their components. However, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The stylized letter "I" is analogous to a design in that consumers will not use it in calling for Applicant's products when it is combined with ILLUMIGENE. It merely emphasizes the first letter of the word ILLUMIGENE. In the case of marks consisting of words and a design, the words are normally given greater weight because they would be used by consumers to request the products. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)); *Joel Gott Wines, LLC*

¹⁹² Applicant concedes that the term ILLUMINGENE is the dominant element in the ILLUMIGENE MOLECULAR SIMPLIFIED and design mark. 104 TTABVUE 21 ("While arguably the word ILLUMIGENE is the dominant element of [Applicant's] composite mark, the other elements cannot be ignored in comparing the marks.").

v. Rehoboth Von Gott, Inc., 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)).

Further, the word ILLUMIGENE is more dominant than the term “Molecular Simplified” because it is presented in much larger type than “Molecular Simplified.” Also, “Molecular Simplified” has considerably less source-indicating significance because it merely informs informative consumers that the ILLUMIGENE products simplify the molecular analysis.

The marks ILLUMIPRO, ILLUMIPRO-10, ILLUMIGENE and ILLUMIGENE SIMPLIFIED MOLECULAR and design, ILLUMINA, ILLUMINADX, and ILLUMICODE are similar in appearance because they all share “Illumi” as the beginning of their marks.

Applicants displays its ILLUMINGENE mark as shown below:¹⁹³



The ILLUMPRO-10 mark is also displayed in the same manner, with the stylized letter “I” at the beginning, “ILLUMI” in dark blue, and “PRO-10” in a lighter blue.¹⁹⁴ In this display, the ILLUMI-prefix stands out, thus emphasizing that term within the mark. We may look to the trade dress to determine the commercial impression

¹⁹³ Kozak Testimony Dec. at 72 TTABVUE 126.

¹⁹⁴ Kozak Testimony Dec. at 72 TTABVUE 127. The ILLUMIPRO-10 mark could not be legibly reproduced.

engendered by the marks. *Citigroup Inc. v. Capital City Bank Group Inc.*, 98 USPQ2d at 1259 (“illustrations of the mark as actually used may assist the T.T.A.B. in visualizing other forms in which the mark might appear.”); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984) (trade dress may provide evidence of commercial impression). *See also American Rice, Inc. v. H.I.T. Corp.*, 231 USPQ 793, 797 (TTAB 1986) (“we may take into account whether the trade dress of packages or labels in the application file as specimens, or otherwise in evidence, may demonstrate that the trademark projects a confusingly similar commercial impression.”); *Northwestern Golf Co. v. Acushnet Co.*, 226 USPQ 240, 244 (TTAB 1985) (“Evidence of the context in which a particular mark is used on labels, packaging, etc., or in advertising is probative of the significance which the mark is likely to project to purchasers.”).

The marks also sound similar because they start with the sound I-LUM-I. Applicant’s marks are likely to be pronounced I-LUM-I (PRO or GENE) and Opposer’s marks are likely to be pronounced I-LUM-IN-A and I-LUM-I-CODE.¹⁹⁵

¹⁹⁵ The word “illuminate” is pronounced “ih-loo-muh-neyt.” *Dictionary.com* derived from the **RANDOM HOUSE DICTIONARY** (2016). We recognize that there is no correct pronunciation of a trademark that, like ILLUMIPRO, ILLUMIGENE, ILLUMINA, and ILLUMICODE, is a coined term, however, consumers would likely pronounce the marks as set forth in the body of this decision. *See United Global Media Grp. V. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1518 (TTAB 2009) (“it is certainly reasonable to pronounce SHICK in a very similar manner to SLICK.”). Even assuming argument that some purchasers will pronounce the marks differently, there will nevertheless be numerous purchasers who will pronounce them as described above. *See Kabushiki Kaisha Hattori Seiko v. Satellite International Ltd.*, 29 USPQ2d 1317, 1318 (TTAB 1991).

As noted in the previous section, the ILLUMI prefix engenders the commercial impression that the products of the parties make their subject readily understandable or observable, so the commercial impressions engendered by the marks are similar.

Applicant argues that because the ILLUMI prefix is “diluted,” “any similarities must be discounted somewhat, and the Board should focus instead on the *entirety* of the parties’ marks.”¹⁹⁶ Applicant contends that when considered in their entireties the marks of the parties are different.¹⁹⁷ With respect to the “dilution” of ILLUMI-formative marks, in the analysis of the third-party use and registrations, we noted that although the ILLUMI-formative marks were registered and used in connection with products and services in the medical field, none were as close to Opposer’s goods and services as Applicant’s products.

When we compare the marks, we are comparing them in their entireties. However, the analysis often properly involves more or less weight being given to a particular feature of a mark. *In re National Data Corp.*, 224 USPQ at 751. For example, in these cases, the ILLUMI-prefix dominates the marks in part because of its position as the first part of the marks. Upon encountering marks, consumers often focus on the first part of the marks. *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Fondée En 1772*, 73 USPQ2d at 1692 (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear

¹⁹⁶ 104 TTABVUE 20.

¹⁹⁷ *Id.*

on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word); *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”).

Further emphasizing the importance of the ILLUMI-prefix of Applicant’s marks are the descriptive and suggestive suffixes used by Applicant. While the ILLUMI-prefix suggests that the products are clarifying the diagnosis provided by the medical products and services, the word “gene” in Applicant’s ILLUMIGENE marks describes the subject being diagnosed and the word “pro” in Applicant’s ILLUMIPRO marks suggests that the products are for professionals. *See Sunbeam Corp. v. Conair Corp.*, 220 USPQ 748, 751 (TTAB 1983) (“It is quite clear (and applicant admits) that “pro,” standing by itself, is an accepted abbreviation of the word “professional.”). In this regard, Applicant asserts that the “DX” suffix of Opposer’s ILLUMINADX mark is an abbreviation for “diagnosis.”¹⁹⁸ Thus, the prefix lends more source-indicating significance.

When the marks are viewed in their entirety, we find the similarities of the marks outweigh their dissimilarities. The evidence of third-party use does not make the differences in the marks so significant as to be a basis for distinguishing them.

¹⁹⁸ 104 TTABVUE 21 citing *medilexicon.com/medicaldictionary.php?t=27123*.

H. Any other established fact probative of the effect of use.

This final factor accommodates the need for flexibility in assessing each unique set of facts. *In re Strategic Partners Inc.*, 102 USPQ2d 1397, 1399 (TTAB 2012).

Applicant introduced into evidence TRU-formative marks registered and used by both Opposer and Applicant to show that if there is no likelihood of confusion between these marks, which coexist peacefully in the marketplace, then there is no likelihood of confusion with the ILLUMI-marks at issue in these proceedings.¹⁹⁹

1. Applicant's TRU-formative marks.

Mark	Reg. No.	Goods/Services
TRU BLOCK Applicant disclaimed the exclusive right to use the word "Block."	3877361	Biological reagents to block heterphilic antibodies in immunoassays
TRU EBV-G	3468630	Diagnostic test kits containing transfer pipettes, pouched device comprising a plastic holder and test strip, a pouched conjugate tube comprising lyophilized conjugate bead, sample diluent, positive control, negative control, and running buffer, for qualitative diagnosis for Epstein-Barr Virus for use in medical or clinical laboratories

¹⁹⁹ 76 TTABVUE 6 and 77 TTABVUE 182-236.

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Mark	Reg. No.	Goods/Services
TRU EBV-M	3468631	Diagnostic test kits containing transfer pipettes, pouched device comprising a plastic holder and test strip, a pouched conjugate tube comprising lyophilized conjugate bead, sample diluent, positive control, negative control, and running buffer, for the detection of the Epstein-Barr Virus for use in medical and clinical laboratories
TRU FLU Applicant disclaimed the exclusive right to use the word "Flu."	3407185	Diagnostic tests for qualitative diagnosis in the medical or clinical laboratory for the detection of Influenza A and Influenza B viral nucleoprotein antigens in human nasal wash, nasopharyngeal aspirate, throat swab, and nasal and nasopharyngeal swab samples
TRU HSV 1 and 2 IGG ²⁰⁰ Applicant disclaimed the exclusive right to use the term "1 and 2 IGG."	4277182	Diagnostic tests for qualitative diagnosis in the medical or clinical laboratory for the detection of anti-Herpes simplex-1 IgG antibodies and anti-Herpes simplex-2 IgG antibodies
TRU LEGIONELLA ²⁰¹ Applicant disclaimed the exclusive right to use the word "Legionella."	4255343	Diagnostic tests for qualitative diagnosis in the medical or clinical laboratory for the detection of legionella bacterium

²⁰⁰ Opposer's constructive first use date is March 1, 2012.

²⁰¹ Opposer had a filing date of February 24, 2012 and claimed first use dates of September 29, 2011

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Mark	Reg. No.	Goods/Services
TRU RSV Applicant disclaimed the exclusive right to use the term "RSV."	3407186	Diagnostic tests for qualitative diagnosis in the medical or clinical laboratory for the detection of Respiratory Syncytial Virus antigens in human nasal wash, nasopharyngeal aspirate, throat swab, and nasal and nasopharyngeal swab samples

2. *Opposer's TRU-formative marks.*

Mark	Reg. No.	Goods/Services
TRUSEQ ²⁰²	4064847	Reagents and reagent kits comprising nucleic acids, naturally occurring or modified nucleotides, enzymes, labels, and buffers, all for the purpose of preparing, detecting, sequencing, and analyzing nucleic acids and other biological molecules, samples of biological molecules, genes, genomes, nucleotide sequence variants and modifications, regulation, transcription, and expression in the fields of scientific, diagnostic and clinical research
TRUGENOME ²⁰³	4752641	DNA screening for medical purposes; Genetic analysis and reporting services for medical purposes; Nucleic acid sequencing and analysis services for medical purposes

²⁰² Opposer's constructive first use date is the application filing date of July 23, 2010.

²⁰³ Opposer's constructive first use date is October 21, 2013.

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Mark	Reg. No.	Goods/Services
TRUSIGHT ²⁰⁴	4498222	<p>Reagents, enzymes, and nucleotides for scientific or medical research use; Reagents, enzymes, and nucleotides for nucleic acid sequencing other than for medical and veterinary purposes</p> <p>Reagents, enzymes, and nucleotides for nucleic acid sequencing for medical purposes</p> <p>Genetic analysis and reporting services for scientific and research purposes; Nucleic acid sequencing and analysis services for scientific and research purposes</p> <p>DNA screening for medical purposes; Genetic analysis and reporting services for medical purposes; Nucleic acid sequencing and analysis services for medical purposes</p>

With the exception of TRU BLOCK, all of Applicant’s TRU-formative marks are registered for diagnostic kits similar to those in the ILLUMIGENE description of goods. Likewise, Opposer’s TRU-formative marks are registered for goods and services similar to its ILLUMINA description of goods and services. The TRU-prefix is suggestive that the products of the parties will provide accurate results. The term “seq” in Opposer’s mark TRUSEQ is an abbreviation for sequencing as in DNA sequencing and the word “genome” means “a complete set of chromosomes derived from one parent, the haploid number of a gamete.”²⁰⁵ There have been no reported

²⁰⁴ Opposer claimed first use dates of December 2012.

²⁰⁵ **STEDMAN’S MEDICAL DICTIONARY** (stedmansonline.com).

instances of confusion.²⁰⁶ Applicant contends that the coexistence of the TRU-formative marks owned and used by the parties without any evidence of confusion is evidence that the ILLUMI-formative marks owned by the parties for essentially the same goods and services can coexist without confusion.

The parties have already demonstrated they can do business under marks sharing the same prefix with descriptive suffixes without confusion occurring, in part because consumers in the relevant field are conditioned to seeing product names which share similar prefixes. Kozak Dec. ¶ 47-48 [72 TTABVUE 16-17]. Either the markets are not as closely related as Opposer asserts or the consumers are sophisticated enough to differentiate the products based on the suffixes; or, as [Applicant] has demonstrated, both. This analogous evidence of the parties' coexistence is highly probative of whether there is a likelihood of confusion in this case, and this factor overwhelmingly favors [Applicant].²⁰⁷

Opposer responds that the facts underlying the use and registration of the TRU-formative marks and the ILLUMI-formative marks are not analogous because "TRU is a descriptive term that describes the accuracy of a test. ... In contrast, ILLUMI is a coined, distinctive term, and ILLUMINA is a [Opposer's] famous house mark that it uses with its entire line of goods and services."²⁰⁸

These arguments are not persuasive. First, all of Applicant's TRU-formative marks are registered on the principal register without a disclaimer of the term "Tru" and

²⁰⁶ Kozak Testimony Dec. at 72 TTABVUE 18.

²⁰⁷ 104 TTABVUE 55-56. There is no evidence regarding the extent to which either party used its TRU-formative marks.

²⁰⁸ 105 TTABVUE 26.

without a claim of acquired distinctiveness. With respect to the registrations with disclaimers, the term “Tru” was not treated as merely descriptive. Thus, for purposes of assessing the strength of Applicant’s TRU-formative marks, the term “Tru” must be considered to be, at worst, suggestive. Second, while Opposer’s mark may be considered a coined term, as noted above, we find based on the extensive third-party use and registration that the ILLUMI-prefix is suggestive and engenders the commercial impression that the products of the parties their products make their subject readily understandable or observable.

Third, the record does not support Opposer’s claim that its mark is famous.

We find that the Applicant’s evidence of Opposer’s adoption and use of Opposer’s TRU-formative marks with constructive notice of Applicant’s previously-registered and used TRU-formative marks merits consideration. As the Court of Customs and Patent Appeals observed in *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151 (CCPA 1978), where an applicant took a contrary position before a Trademark Examining Attorney than it was taking in the opposition,

[T]hat a party earlier indicated a contrary opinion respecting the conclusion in a similar proceeding involving similar marks and goods is a fact, and that fact may be received in evidence as merely illuminative of shade and tone in the total picture confronting the decision maker. To that limited extent, a party's earlier contrary opinion may be considered relevant and competent. Under no circumstances, may a party's opinion, earlier or current, relieve the decision maker of the burden of reaching his own ultimate conclusion on the entire record.

Id. at 154. We consider Opposer’s use and registration of its TRU-formative marks to be relevant because it illustrates Opposer’s opinion as the similarity or dissimilarity of the goods and services and similarity or dissimilarity as to established, likely-to-continue channels of trade with respect to similar goods and services. However, while Opposer’s prior inconsistent actions may properly be considered as “illuminative of shade and tone in the total picture” confronting the Board, they do not alter the Board’s obligation to reach its own conclusion on the record before us. *Cf. Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978) (prior contrary opinion by a party is admissible but not binding). *See also Domino's Pizza Inc. v. Little Caesar Enterprises Inc.*, 7 USPQ2d 1359, 1365 (TTAB 1988) (“the fact that opposer once indicated a different opinion that it now maintains would simply be one fact to be considered, together with all of the other facts of record (which, in our opinion, would far outweigh this one “fact”), in our determination of this case.”).

I. Balancing the factors.

We have considered of all of the evidence of record and all of the arguments of the parties (including evidence and arguments not specifically discussed in this opinion) as it pertains to the relevant *du Pont* likelihood of confusion factors. The evidence as a whole leads us to conclude that a likelihood of confusion exists. Although the high degree of care when selecting the goods and services of the parties weighs in

Applicant's favor, the marks are similar, the goods and services are related and they move in the same channels of trade. Opposer's marks are not famous, but they need not be famous to be protected. Moreover, there is no sufficient basis for finding that Opposer's ILLUMI marks are weak or diluted in the marketplace due to third-party use of similar marks on similar goods or services. There may be no evidence of actual confusion, but neither is there any evidence that there has been a significant opportunity for actual confusion to have occurred in the marketplace. The apparently inconsistent position Opposer has taken with respect to the parties' TRU-formative marks does not, in our judgment, outweigh these considerations.

For the reasons discussed, we find that a likelihood of confusion exists between Applicant's ILLUMIPRO and ILLUMIPRO-10 marks for a "diagnostic machine, namely, a stand alone closed heater and turbidity meter to be used for the amplification and detection of a closed tube molecular assay" and Opposer's marks ILLUMINA for "developing, to the order and specification of others biological and/or chemical sensing systems which use random array technology to identify organic molecules, compounds and substances,"²⁰⁹ ILLUMINADX for "clinical diagnostic reagents, reagent kits, and beads with attached biomolecules, comprised primarily of oligonucleotides and other nucleic acids, natural and modified nucleotides, buffers,

²⁰⁹ Registration No. 2471539.

labels, and substrates, for clinical diagnostic purposes,”²¹⁰ and ILLUMICODE for DNA microarrays.

We find that a likelihood of confusion exists between Applicant’s ILLUMIGENE and ILLUMIGENE MOLECULAR SIMPLIFIED and design for “diagnostic kits consisting of molecular assays for use in disease testing and treatment of gastrointestinal, viral, urinary, respiratory and infectious diseases” and Opposer’s ILLUMINA marks for “developing, to the order and specification of others biological and/or chemical sensing systems which use random array technology to identify organic molecules, compounds and substances,”²¹¹ “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,”²¹² and ILLUMICODE for DNA microarrays.

We have considered all of Applicant's arguments to the contrary, including any arguments not specifically discussed in this opinion, but we are not persuaded thereby. To the extent that any doubts might exist as to the correctness of this conclusion, we resolve such doubts, as we must, in favor of registrant.

²¹⁰ Registration No. 4053668.

²¹¹ Registration No. 2471539.

²¹² Registration No. 2756703.

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Decision: The oppositions are sustained and the cancellations are granted.