

ESTTA Tracking number: **ESTTA34732**

Filing date: **06/02/2005**

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

| | |
|-------------------------------|---|
| Proceeding | 78058107 |
| Applicant | BAUSCH & LOMB INCORPORATED |
| Correspondence Address | BAUSCH & LOMB INCORPORATED ONE BAUSCH & LOMB PLACE ROCHESTER, NY 14604-2701 |
| Submission | Resubmitting documents in ex parte appeal originally filed via express mail on 2/8/05 -Applicant's Notice of Resolution of Proceedings. |
| Attachments | Notice of Resolution.pdf (11 pages) |
| Filer's Name | Deborah A. Wing |
| Filer's e-mail | deborah.wing@kattenlaw.com |
| Signature | /daw/ |
| Date | 06/02/2005 |

February 8, 2005

Via Express Mail

Box TTAB -NO FEE
Assistant Commissioner for Trademarks
P. O. Box 1451
Alexandria, Virginia 22313-1451

Re: BAUSCH & LOMB MILLENNIUM
Application Serial No. 78/058,107

Dear Sir or Madam:

Enclosed are an original and two copies of Applicant, Bausch & Lomb Inc.'s, Notice of Resolution of Proceedings in the above-captioned matter.

Thank you for your consideration in this matter.

Sincerely,



Lisa K. Shebar

LKS:mp/50258642
Enclosure

cc: Jon O. Webster, Esq. (with enclosure)

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

In re:)
Application Serial No.: 78/058,107)
Applicant: BAUSCH & LOMB INCORPORATED)
Filed: April 12, 2001)
Mark: BAUSCH & LOMB MILLENNIUM)

NOTICE OF RESOLUTION OF PROCEEDINGS

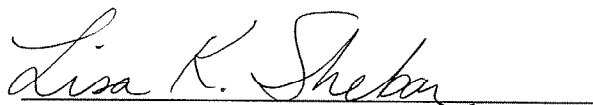
In compliance with the Board's Order dated May 28, 2003 (the "Order"), in the above-captioned *ex parte* appeal (the "Appeal"), Applicant, BAUSCH & LOMB INCORPORATED, hereby informs the Board of a final resolution in Cancellation No. 92041798, styled Bausch & Lomb Incorporated v. Biolase Technology (the "Cancellation Proceeding"). Pursuant to the Order, the Appeal was, and has remained, suspended pending a final resolution in the Cancellation Proceeding, which has now occurred by dismissal of the Cancellation Proceeding pursuant to the Board's Order dated February 1, 2005, a copy of which is attached hereto as Exhibit A.

In addition, the Consent to Use and Register, a copy of which is attached hereto as Exhibit B, by and between Applicant and Biolase Technology, Inc. ("Registrant"), owner of U.S. Registration No. 2,219,279 for the mark MILLENNIUM ("Registrant's Mark"), grants Registrant's express consent to the issuance of a U.S. registration of Applicant's mark, BAUSCH & LOMB MILLENNIUM ("Applicant's Mark"). Because Registrant's Mark was cited by the Trademark Examining Attorney as a Section 2(d) bar to registration of Applicant's Mark, and such registration refusal is the sole basis for the Appeal, the Consent to Use and Register should

now enable a registration to issue for Applicant's Mark, rendering the Appeal moot. Accordingly, Applicant respectfully requests dismissal of the Appeal and the issuance of such registration for Applicant's Mark.

Dated: February 8, 2005

Respectfully submitted,

A handwritten signature in cursive script that reads "Lisa K. Shebar". The signature is written in black ink and is positioned above a solid horizontal line.

Lisa K. Shebar
Attorney for Petitioner
Katten Muchin Zavis Rosenman
525 West Monroe Street
Chicago, Illinois 60661
(312) 902-5200

EXHIBIT A
(TTAB Order dated 2/1/05)

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Ricks

Mailed: February 1, 2005

Cancellation No. 92041798

Bausch & Lomb Incorporated

v.

BIOLASE TECHNOLOGY, INC.

On January 3, 2005, parties' filed a stipulated withdrawal of the petition to cancel and counterclaim with prejudice. In view thereof, the petition to cancel and counterclaim are hereby dismissed with prejudice.

***By the Trademark Trial
and Appeal Board***

EXHIBIT B
(Consent to Use and Register)

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

In re:)
Application Serial No.: 78/058,107)
Applicant: BAUSCH & LOMB INCORPORATED)
Filed: April 12, 2001)
Mark: BAUSCH & LOMB MILLENNIUM)

CONSENT TO USE AND REGISTER

Biolase Technology, Inc. ("Biolase"), confirms that it is the owner of U.S. Registration No. 2,219,279 for the mark MILLENNIUM for cutting devices for medical use, namely, laser and other electromagnetic energy activated cutting devices used with liquids for cutting and/or ablating hard and soft tissues, in International Class 10 ("Biolase's Registration"). Bausch & Lomb Incorporated ("B&L") has applied for registration of the mark BAUSCH & LOMB MILLENNIUM for microsurgical instruments used in ophthalmic procedures to remove cataracts, in International Class 10, as set forth in Application Serial No. 78/058,107 ("B&L's Application"). It is understood that B&L's Application has been refused registration under Section 2(d) of the Trademark Act based on a likelihood of confusion with Biolase's Registration.

Biolase hereby consents to the use and registration of the mark BAUSCH & LOMB MILLENNIUM by B&L for those goods set forth in B&L's Application, subject to the terms of an agreement ("the Agreement") entered into by the parties which, *inter alia*, provides that Biolase will not use or register any mark

containing the term "MILLENNIUM" on any goods or services within the ophthalmic or eye-care fields, and that B&L will not use or register any mark containing the term "MILLENNIUM" on any goods or services within the dental field, including, but not limited to, the specialty categories of endodontology, general dentistry, head and neck surgery, implantology, oral surgery, oral and maxillofacial surgery, orthodontics, periodontology, pedodontics, prosthodontics, and restorative dentistry (collectively, "the Dental Field").

B&L is familiar with Biolase's use of the mark MILLENNIUM in the marketplace, and Biolase understands how B&L intends to use the mark BAUSCH & LOMB MILLENNIUM. The parties believe that no likelihood of confusion will exist from the contemporaneous use in commerce of the mark MILLENNIUM by Biolase and the mark BAUSCH & LOMB MILLENNIUM by B&L for the respective goods and services, as per the above-mentioned Agreement, for the following reasons, among others:

(1) In accordance with the agreed restriction in channels of trade, Biolase will not seek to use or register any mark containing the term "MILLENNIUM" in the field for which B&L has applied for registration of the mark BAUSCH & LOMB MILLENNIUM, that is, the ophthalmic field;

(2) In accordance with the agreed restrictions in channels of trade, B&L's use and registration of the mark BAUSCH & LOMB MILLENNIUM will not overlap with use and the continuation of registration of the mark MILLENNIUM by Biolase (although nothing contained herein or in the Agreement shall be construed

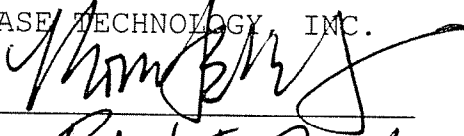
to limit B&L's ability to exercise its rights in the mark BAUSCH & LOMB MILLENNIUM in the ophthalmic and eye-care fields);

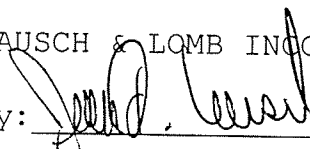
(3) The parties agree to take further action as necessary to avoid potential likelihood of confusion, and agree to execute and file with the U.S. Patent and Trademark Office any and all documents which may be necessary or proper to effectuate the terms of this consent;

(4) In the event of actual confusion, each party agrees to inform the other party and to cooperate fully to correct such confusion and to avoid future confusion.

Accordingly, for the reasons set forth above, the parties believe that no likelihood of confusion will exist from the contemporaneous use and registration of their respective marks. Biolase hereby consents to B&L's registration of the mark BAUSCH & LOMB MILLENNIUM for the goods specified in B&L's Application, namely, microsurgical instruments used in ophthalmic procedures to remove cataracts.

Respectfully submitted,

BIOLASE TECHNOLOGY, INC.
By: 
Name: Robert E. Grant
Title: President + CEO
Date: Nov. 23, 2004

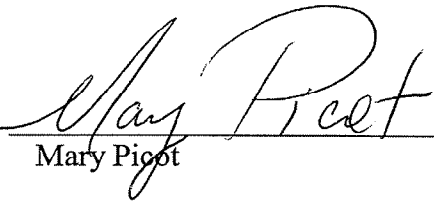
BAUSCH & LOMB INCORPORATED
By: 
Name: JEAN F. GEISEL
Title: SECRETARY
Date: AUGUST 19, 2004

"Express Mail" mailing label number: EU 666991700 US

Date of Deposit: February 8, 2005

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Box TTAB – NO FEE, Assistant Commissioner for Trademarks, P. O. Box 1451, Alexandria, VA 22313-1451.

Date: February 8, 2005

By: 
Mary Pirot



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