

ESTTA Tracking number: **ESTTA15328**

Filing date: **09/17/2004**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Varian, Inc.
Granted to Date of previous extension	09/19/2004
Address	Varian, Inc. 3120 Hansen Way, M/S D-102 Palo Alto, CA 94304 UNITED STATES

Correspondence information	Roy S. Gordet Law Office of Roy S. Gordet 98 Battery Street, Suite 601 San Francisco, CA 94111 UNITED STATES roy@gordetlaw.com Phone:(415) 627-0300
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Applicant Information

Application No	78269823	Publication date	03/23/2004
Opposition Filing Date	09/17/2004	Opposition Period Ends	09/19/2004
Applicant	Ventana Medical Systems, Inc.		

Goods/Services Affected by Opposition

Class 001. First Use: 19991200 First Use In Commerce: 19991200

All goods and services in the class are opposed, namely: diagnostic and prognostic reagents for laboratory, scientific or research use sold alone or in kits comprised of reagents and immunodiagnostics

Attachments	NotOppVENTANA823.pdf (5 pages)
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Signature	/rsgordet/
Name	Roy S. Gordet
Date	09/17/2004

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

Varian, Inc.)	
)	
Opposer)	
)	Opposition No.
v.)	
)	
Ventana Medical Sciences, Inc.)	
)	
Applicant)	

In re Mark : VENTANA (Plus Design)
Applicant : Ventana Medical Systems, Inc.
Serial No. : 78269823
Filing Date : July 2, 2003
Date of Publication : March 23, 2004

NOTICE OF OPPOSITION

Varian, Inc., a corporation of Delaware, whose mailing address is 1320 Hansen Way, M/S D-102, Palo Alto, CA 94304 (hereinafter “Opposer”), believes it will be damaged by registration of the mark shown in Application Serial No. 78269823, and hereby opposes the same.

As grounds for the opposition it is alleged that:

1. Opposer is a public corporation headquartered in Palo Alto, California principally engaged in distributing products around the world in diverse aspects of the life sciences industries.

2. Opposer, or Opposer’s predecessor in interest, has been using the mark “VARIAN” for various laboratory and scientific instruments since at least as early as 1959.

3. Opposer is also the owner of the corporate identifier consisting of the term VARIAN plus an accompanying design as appears in Appendix 1 (the “Varian Corporate Identifier”). The Varian Corporate Identifier is used on building signage, letterhead, brochures, packaging, and at

the Opposer's web site. Opposer has used the Varian Corporate Identifier in connection with the business of Opposer since at least as early as March 1999.

4. As evidenced by the publication of the mark VENTANA (Plus Design), Application Serial No. 78269823 published on March 23, 2004 in the *Official Gazette*, Applicant seeks to register the mark VENTANA (Plus Design) for "diagnostic and prognostic reagents for laboratory, scientific or research use sold alone or in kits comprised of reagents and immunodiagnosics." The application for the mark VENTANA (Plus Design) was filed on July 2, 2003 and the alleged date of first use of the mark in commerce is December, 1999, both dates being long after Opposer's predecessor in interest first use of the mark VARIAN, which was in December, 1959.

5. On information and belief, Applicant has not used the mark VENTANA (PLUS DESIGN) in the United States prior to December 1999, the alleged date of first use stated in Applicant's application.

6. On information and belief, Applicant had no cognizable common law trademark rights in the mark VENTANA (Plus Design) in the United States as of December, 1959, the date of first use in the United States of the mark VARIAN by Applicant's predecessor in interest.

7. Applicant has filed counterclaims in a lawsuit captioned Varian, Inc. v. Ventana Medical Systems, Inc., Case No. C03 03918 JF, now pending in the United States District Court for the Northern District of California. In one of those counterclaims, Applicant has alleged that there is a likelihood of confusion between Opposer's Varian Corporate Identifier as appears in Appendix 1 and Applicant's mark as appears in the Drawing Page of this present Application Serial No. 78269823 (referred to in Applicant's counterclaims as the "Ventana Composite Mark" According to Applicant, as stated in Applicant's counterclaims, "Varian's use of the [Varian

Corporate Identifier] in connection with goods and services is likely to cause confusion, deception and mistake among customers as to the source, association or affiliation of these goods and services.” (Paragraph 49, page 7 of “Answer and Counterclaims” filed by Ventana Medical Systems, Inc. in the United States District Court for the Northern District of California, Case No. C03 03918 JF)

8. Thus, according to Applicant herein, based on the similarity of the mark of this present Application Serial No. 78269823 and Opposer’s Varian Corporate Identifier, consumers of products and services offered by the respective parties will be confused or deceived.

9. Furthermore, if Application Serial No. 78269823 were to issue as a registration, Applicant would acquire a presumption of exclusive use, and, as evidenced by Applicant’s aggressive conduct in both threatening and then alleging in a Federal District Court claims for trademark infringement against Opposer, it appears likely that Applicant would use such a registration, if it ever issued to Applicant, against Opposer, even though Applicant would not be justified in doing so.

WHEREFORE, registration of Application Serial No. 78269823 for the mark VENTANA (Plus Design) would be damaging to Opposer, and based on Applicant’s prior rights, registration should be denied.

Opposer submits herewith the requisite filing fee in the amount of \$300. This document is being submitted in duplicate.

Respectfully submitted,
/rsgordet/
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Attorney for Opposer,
Varian, Inc.

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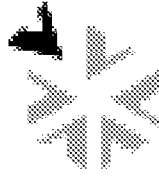
CERTIFICATE OF ESTTA FILING

I certify that this document is being forwarded by the Electronic System for Trademark Trials and Appeals, U.S. Trademark Office on September 17, 2004.

Dated: September 17, 2004

/rsgordet/
Roy S. Gordet

APPENDIX 1



VARIAN