

ESTTA Tracking number: **ESTTA72296**

Filing date: **03/22/2006**

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 parties oppose registration of the indicated application.

Opposers Information

Name	Laboratory Corporation of America Holdings
Granted to Date of previous extension	03/22/2006
Address	430 South Spring Street Burlington, NC 27215 UNITED STATES

Name	Dianon Systems, Inc.
Granted to Date of previous extension	03/22/2006
Address	200 Watson Boulevard Stratford, CT 06615 UNITED STATES

Attorney information	James A. Thomas Parker, Poe, Adams & Bernstein 150 Fayetteville Street Mall, Suite 1400 PO Box 389 Raleigh, NC 27602 UNITED STATES trademarks@parkerpoe.com Phone:919-828-0564
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Applicant Information

Application No	76632923	Publication date	11/22/2005
Opposition Filing Date	03/22/2006	Opposition Period Ends	03/22/2006
Applicant	Schumann Cytology Laboratories, Inc. 44 Beech Hill Road Trumbull, CT 06611 UNITED STATES		

Goods/Services Affected by Opposition

Class 016. First Use: 2005/02/14 First Use In Commerce: 2005/02/14 All goods and services in the class are opposed, namely: PRINTED MEDICAL INSTRUCTIONAL MATERIAL REGARDING DETECTION AND TREATMENT OF URINARY DISEASES SUCH AS HEMATURIA
Class 044. First Use: 1993/12/31 First Use In Commerce: 1993/12/31 All goods and services in the class are opposed, namely: MEDICAL SERVICES FOR DETECTING AND TREATING URINARY DISEASES, NAMELY, HEMATURIA

Related	Laboratory Corporation of America Holdings and Dianon Systems, Inc. v. G.
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Proceedings	Berry Schumann, M.D. and Schumann Cytology Laboratories, Inc. (United States District Court for the Middle District of North Carolina) (Civil Case No. 1:05CV00995)
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Attachments	MICROCYTE Opposition.pdf (8 pages)
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Signature	/James A. Thomas/
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Name	James A. Thomas
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Date	03/22/2006
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial Number: 76/632,923

Published: November 22, 2005

LABORATORY CORPORATION OF AMERICA HOLDINGS and DIANON SYSTEMS, INC.,)	
Opposers,)	
v.)	Opposition No. _____
SCHUMANN CYTOLOGY LABORATORIES, INC.,)	
Applicant.)	

NOTICE OF OPPOSITION

Laboratory Corporation of America Holdings (“LabCorp”), a corporation organized and existing under the laws of Delaware and having a principal place of business at 430 South Spring Street, Burlington, North Carolina, 27215, and Dianon Systems, Inc. (“Dianon”), a corporation organized and existing under the laws of Delaware and having a principal place of business at 200 Watson Boulevard, Stratford, Connecticut, 06615 (collectively, “Opposers”), believing that they will be damaged by registration of the mark shown in application Serial No. 76/632,923 in International Classes 16 and 44, hereby oppose such registration. This opposition is based on 15 U.S.C. § 1063(a), and the grounds for the opposition are set forth below.

PARTIES

1. LabCorp, one of the world’s largest clinical laboratories, is a pioneer in genomic testing and the commercialization of new diagnostic technologies. LabCorp operates a nationwide network of 31 primary testing locations and more than 1,100 patient service centers.

Through its service network, LabCorp offers an extensive testing portfolio, including leading testing technologies, to the medical field.

2. Dianon, a wholly-owned subsidiary of LabCorp, provides anatomic pathology, cytogenetic, and molecular genetic services for essentially all types of cancer, as well as for many inherited and acquired genetic diseases. Dianon was acquired by LabCorp on or about January 17, 2003.

3. Upon information and belief, Schumann Cytology Laboratories, Inc. (hereinafter "SCL" or "Applicant") is a Connecticut corporation having a principal place of business in Trumbull, Connecticut. Upon information and belief, SCL is in the business of providing medical and diagnostic testing and reporting services and instructional material and medical literature relating to medical and diagnostic testing and reporting services.

ACTIVITIES AND RIGHTS OF OPPOSERS

4. At least as early as 1992, Dianon selected and adopted the designation MICROCYTE. Moreover, since at least as early as August 19, 1993, Dianon has used continuously the designation MICROCYTE in connection with, among other things, medical and diagnostic testing services and medical and diagnostic test reporting services. Additionally, Dianon has used continuously the MICROCYTE II and MICROCYTEPLUS marks in connection with, among other things, medical and diagnostic testing services and medical and diagnostic test reporting services since at least as early as January 5, 1996 and January 2005, respectively.

5. Effective January 17, 2003, Dianon assigned to its parent LabCorp all right, title, and interest in and to the MICROCYTE and MICROCYTE II marks. In return, Dianon has been authorized by LabCorp to use these MICROCYTE marks and the MICROCYTEPLUS mark. Therefore, all use of the MICROCYTE marks by Dianon since January 17, 2003 inures to the

benefit of LabCorp.

6. By such use, Dianon (prior to January 17, 2003) and LabCorp (subsequent to January 17, 2003) was and is the owner of common law rights, including the goodwill related thereto, in the MICROCYTE, MICROCYTE II, and MICROCYTEPLUS designations (collectively the "MICROCYTE marks") as service marks under the laws of the United States and otherwise.

7. On July 29, 2005, LabCorp filed an application in the U.S. Patent and Trademark Office for a service mark registration for the mark MICROCYTE in connection with medical and diagnostic testing services and medical and diagnostic test reporting services (Application Serial No. 78/681,511). Also on July 29, 2005, LabCorp filed applications in the U.S. Patent and Trademark Office for service mark registrations for the mark MICROCYTE II in connection with medical and diagnostic testing services and medical and diagnostic test reporting services (Application Serial No. 78/681,592) and for MICROCYTEPLUS in connection with medical and diagnostic testing services and medical and diagnostic test reporting services (Application Serial No. 78/681,671).

8. Through the adoption and longstanding, prominent, and exclusive use of the designations MICROCYTE, MICROCYTE II, and MICROCYTEPLUS by LabCorp and, as predecessor-in-title and currently a licensee, by Dianon, these distinctive designations have acquired special and particular significance and valuable goodwill as identifying Opposers and their business, so that when physicians, medical care providers, and members of the public see the MICROCYTE marks, they automatically think of Opposers.

9. Opposers' use of the MICROCYTE marks is in commerce and has been valid and continuous since at least as early as the dates of first use set forth above. The MICROCYTE marks are valid, distinctive, famous, and well-known. Opposers have spent substantial amounts

of time, money, and effort in developing, testing, and marketing products under the MICROCYTE marks, and the MICROCYTE marks are symbolic of extensive goodwill and consumer recognition.

10. Consequently, through such usage and recognition, Opposers have acquired and still possess, in addition to certain statutory rights, common-law rights in the marks MICROCYTE, MICROCYTE II, and MICROCYTEPLUS and the associated goodwill, which rights extend, without limitation, to the exclusive right to use the MICROCYTE marks nationwide.

ACTIVITIES AND RIGHTS OF APPLICANT

11. From approximately January 1, 1993 until approximately September 14, 2001, Dr. G. Berry Schumann was employed by Dianon in Stratford, Connecticut as the medical director of cytopathology and cytotechnology. Thereafter, he continued in his employment by Dianon as a staff pathologist until approximately April 4, 2005. Dr. Schumann also is the President of the Applicant, SCL.

12. On or about October 12, 1993, SCL and Dianon entered into a Technical Services Agreement (the "Agreement") wherein SCL granted to Dianon an exclusive, non-transferable license during the term of the Agreement, to certain technical expertise, knowledge, know-how, improvements, information, and data relating to testing services for microhematuria, renal, and lower urinary tract injury disorders and diseases.

13. Dianon selected the designation MICROCYTE for use in connection with these testing services. It did so in order to parallel the names of other testing services offered by Dianon that ended in the letters "cyte." Dianon selected, adopted, and used the MICROCYTE mark before October 12, 1993, the date that Dianon and SCL entered into the Agreement.

14. At no time, either in connection with the Agreement or otherwise, has Dianon or

Labcorp authorized Applicant to use the MICROCYTE mark, or any derivative or colorable variation thereof, as a trade or service mark in connection with medical and diagnostic testing and reporting services, or in connection with instructional material or medical literature relating to medical and diagnostic testing and reporting services or otherwise, nor has Applicant acquired any rights to, or proprietary interest in, the MICROCYTE marks through any other means.

15. Despite having no rights to, or proprietary interest in, the MICROCYTE marks, Applicant filed, on March 4, 2005, an application with the U.S. Patent and Trademark Office (Application Serial No. 76/632,923) for a service and trademark registration for MICROCYTE, which application is the subject of this proceeding. Applicant seeks to register the MICROCYTE mark for “printed medical instructional material regarding detection and treatment of urinary diseases such as hematuria” in International Class 16 and for “medical services for detecting and treating urinary diseases, namely, hematuria” in International Class 44 (hereinafter “Applicant’s Goods and Services”), as evidenced by publication of Applicant’s purported Mark in the *Official Gazette* dated November 22, 2005.

GROUND FOR OPPOSITION

16. During all times relevant, Opposers owned, and Opposer LabCorp still owns, the mark MICROCYTE. Applicant has no rights to, or proprietary interest in, the mark MICROCYTE and has no rights in said mark senior to Opposers’ interests in the MICROCYTE marks.

17. Moreover, as set forth in more detail below, the mark Applicant seeks to register so closely resembles the MICROCYTE marks that it is likely, when used in connection with Applicant’s Goods and Services, to cause confusion, to cause a mistake, or to deceive. Registration of Applicant’s proposed mark is therefore barred under 15 U.S.C. § 1052(d).

18. The mark that Applicant seeks to register, MICROCYTE, is identical to the

MICROCYTE mark of Opposer LabCorp and nearly identical to the MICROCYTE II and MICROCYTEPLUS marks.

19. Further, upon information and belief, Applicant is claiming rights in and control over Opposer LabCorp's MICROCYTE mark in connection with the provision of medical and diagnostic testing and reporting services that are the same or similar to the testing and reporting services offered by Opposers under the MICROCYTE marks. Also upon information and belief, Applicant is using Opposer LabCorp's MICROCYTE mark in connection with instructional material and medical literature relating to medical and diagnostic testing and reporting services that are the same or similar to the testing and reporting services offered by Opposers under the MICROCYTE marks. Indeed, upon information and belief, it is Dianon's first use of the mark that Applicant claims as its own first use in the subject application. Accordingly, Applicant's use of the MICROCYTE mark pertains to goods and services that are identical to or overlap substantially with those of Opposers.

20. Further, on information and belief, Applicant's Goods and Services are marketed to the same potential purchasers as the goods and services marketed by Opposers. Additionally, upon information and belief, Applicant's Goods and Services are distributed through the same channels of distribution and ultimately are purchased and used by the same persons as those of Opposers.

21. Consequently, if Applicant were permitted to register to use the MICROCYTE mark for Applicant's Goods and Services, confusion, mistake, and/or deception among physicians, medical care providers, and members of the general public would result with respect to the true source, origin, nature, characteristics, and qualities of Applicant's goods, services, and commercial activities.

22. For instance, physicians, medical care providers, and members of the general

public who are familiar with Opposers' goods and services sold under the MICROCYTE marks would believe that Applicant's Goods and Services are, contrary to fact, associated with, endorsed by, related to, or actually the goods and services of Opposers. Any fault or defect in Applicant's Goods and Services would reflect upon and seriously injure Opposers' reputation. Moreover, physicians, medical care providers, and members of the general public who are familiar with the MICROCYTE marks used by Opposers would confuse the same with Applicant's mark and might purchase Applicant's Goods and Services in the mistaken belief that they are purchasing the goods and/or services of Opposers. This confusion would adversely impact Opposers' revenue and income. In addition, upon information and belief, the substantial confusion that would result from Applicant's registration of Opposer LabCorp's mark would create the potential for misdiagnosis, thereby resulting in a health or safety risk for the patient involved.

23. If registration of Opposer LabCorp's mark by the Applicant were granted, Applicant would be placed in a position to harass and cause annoyance to the public as the registration would give the Applicant *prima facie* exclusive rights to said mark and all confusingly similar marks, thereby causing damage and injury to Opposers.

24. Thus, as a result of the identical and near identical appearance of Applicant's purported mark in comparison to the MICROCYTE, MICROCYTE II and MICROCYTEPLUS marks used by Opposers, the identical or substantially overlapping nature of the goods and services of Applicant and Opposers, and the fact that such goods and services are sold in common channels of commerce and directed to the same classes of customers, registration of the MICROCYTE mark by Applicant would cause damage and injury to Opposers.

25. Further, Applicant has made claims to Opposers that it owns the MICROCYTE mark being used by Opposers and that Opposers have no rights or interests in such mark.

Opposers contend, however, that Applicant has no such rights in the MICROCYTE mark and that Applicant's assertions to the contrary are untrue.

26. Therefore, if Applicant is permitted to register the MICROCYTE mark, Opposer LabCorp would be deprived of its ownership of its MICROCYTE marks and thereby Opposers would be further damaged and suffer further injury.

WHEREFORE, Opposers pray that said Application Serial No. 76/632,923 be rejected and that registration of Applicant's proposed mark be refused and denied.

This Notice of Opposition is herewith submitted together with the filing fee in the amount of \$1200.00.

Respectfully submitted this 22nd day of March, 2006.

PARKER, POE, ADAMS & BERNSTEIN L.L.P.

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