

ESTTA Tracking number: **ESTTA974024**

Filing date: **05/15/2019**

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	Caris MPI, Inc.
Granted to Date of previous extension	05/15/2019
Address	750 West John Carpenter Freeway Suite 800 Irving, TX 75039 UNITED STATES

Attorney information	Tiffani D. Otey Womble Bond Dickinson (US) LLP 300 N. Greene Street Suite 1900 Greensboro, NC 27401 UNITED STATES kristin.webb@wbd-us.com, jack.hicks@wbd-us.com, tiffani.otey@wbd-us.com, tmdocketing@wbd-us.com, stephen.shaw@wbd-us.com 336-721-3629
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Applicant Information

Application No	87399262	Publication date	01/15/2019
Opposition Filing Date	05/15/2019	Opposition Period Ends	05/15/2019
International Registration No.	NONE	International Registration Date	NONE
Applicant	4D PHARMA RESEARCH LIMITED Life Sciences Innovation Building Cornhill Road Aberdeen, AB252ZS UNITED KINGDOM		

Goods/Services Affected by Opposition

Class 042. First Use: 2018/08/09 First Use In Commerce: 2018/08/09
All goods and services in the class are opposed, namely: Scientific research and development; microbiology research and development involving biotherapeutics

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
The mark is merely descriptive	Trademark Act Section 2(e)(1)
No use of mark in commerce before application or amendment to allege use was filed	Trademark Act Sections 1(a) and (c)

No bona fide intent to use mark in commerce for identified goods or services	Trademark Act Section 1(b)
The mark is not inherently distinctive and has not acquired distinctiveness	Trademark Act Sections 1, 2 and 45; and Section 2(f)
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)
Other	Void ab initio for failure to file valid statement of use, 15 USC 1051(d).

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	87732684	Application Date	12/22/2017
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	MICDX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 044. First use: First Use: 0 First Use In Commerce: 0 Genomic and molecular medical testing services for diagnostic or treatment purposes in the field of cancer; diagnostic services, namely, medical diagnostic testing for cancer and other diseases and disorders; providing collected and analyzed medical information in the field of genetic and treatment information for cancer and other diseases and disorders for diagnostic and treatment purposes; providing medical data and information to healthcare professionals		

Related Proceedings	Opposition No. 91244814
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Attachments	Notice of Opposition.pdf(35846 bytes)
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Signature	/Tiffani D. Otey/
Name	Tiffani D. Otey
Date	05/15/2019

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

**In the Matter of Application Serial No. 87/399,262
Published for Opposition on January 15, 2019
Mark: MICRODX**

CARIS MPI, INC.,)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
4D PHARMA RESEARCH LIMITED,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer Caris MPI, Inc., a Delaware corporation having its principal place of business at 750 W. John Carpenter Freeway, Suite 800, Irving, TX 75039 (“Opposer”), respectfully submits this Notice of Opposition on the basis that Opposer will be damaged by registration of the mark MICRODX that is the subject of U.S. App. Ser. No. 87/399,262, published in the Official Gazette on January 15, 2019, for “Scientific research and development; microbiology research and development into live biotherapeutics,” in International Class 42, and Opposer hereby opposes the same. As grounds for the opposition, it is alleged that:

1. Opposer is a leading provider of precision medicine and personalized medical information to help patients with cancer and other complex diseases. Opposer, through patented and proprietary service offerings, provides physicians and other clinicians with actionable treatment options and advanced diagnostics, including profiling analytics, genomic testing, and molecular medical testing, for the diagnosis or treatment of cancer and other diseases and

disorders. In connection with providing its analytic and diagnostic services including as described herein, Opposer is developing and intends to launch a companion diagnostic test and/or testing service in the United States under the trademark “MICDx.”

2. Upon information and belief, applicant 4d Pharma Research Limited (“Applicant”) is a private limited liability company organized under the laws of the United Kingdom, having a principal place of business at Life Sciences Innovation Building, Cornhill Road, Aberdeen, UK AB252ZS.

3. On April 5, 2017, Applicant filed its application for registration of the MicroDx trademark (the “MicroDx Mark”), pursuant to 15 U.S.C. § 1051(b), U.S. App. Ser. No. 87/399,262, for “Scientific research and development; microbiology research and development into live biotherapeutics” in International Class 42 (the “MicroDx Application”).

4. On December 22, 2017, Opposer filed an application for registration of the MICDx trademark (the “MICDx Mark”) under the “intent-to-use” provisions of 15 U.S.C. § 1051(b), U.S. App. Ser. No. 87/732,684 (the “MICDx Application”), for “Genomic and molecular medical testing services for diagnostic or treatment purposes in the field of cancer; diagnostic services, namely, medical diagnostic testing for cancer and other diseases and disorders; providing collected and analyzed medical information in the field of genetic and treatment information for cancer and other diseases and disorders for diagnostic and treatment purposes; providing medical data and information to healthcare professionals,” in International Class 44.

5. In connection with and at the time of the filing of Opposer’s MICDx Application, Opposer had and continues to have a bona fide intention to use the MICDx Mark in commerce in

connection with the goods and services set forth in the MICDx Application, and Opposer's MICDx Application met all necessary statutory requirements applicable at the time of filing.

6. On May 2, 2018, the United States Patent and Trademark Office issued a Notice of Publication in the case of Opposer's MICDx Application, stating that "The [MICDx Mark] appears to be entitled to registration."

7. On May 22, 2018, Opposer's MICDx Mark was published for opposition in the Official Gazette.

8. On June 20, 2018, an Extension of Time to Oppose for a period of ninety (90) days was filed as to Opposer's MICDx Application by a third party entity, 4D Pharma, Plc., which period of time was subsequently extended an additional sixty (60) days.

9. On November 18, 2018, 4D Pharma, Plc. and Applicant jointly filed a Notice of Opposition against Opposer's MICDx Application, claiming that Applicant and 4D Pharma, Plc. were in privity of contract and claiming a right to oppose registration of Opposer's MICDx Mark on the grounds of priority and likelihood of confusion pursuant to 15 U.S.C. § 1052(d), arising from the MicroDx Application, which is now the subject of the instant opposition proceeding.

10. Any judgment that may be issued as a result of Applicant's Notice of Opposition of Opposer's MICDx Application will be contingent upon the MicroDx Application maturing to registration.

11. On January 15, 2019, Applicant's MicroDx Application was published for opposition in the Official Gazette.

12. On February 13, 2019, Opposer timely filed a 90-day Request for an Extension of Time to Oppose the Application, which was granted, extending the time for Opposer to file a

Notice of Opposition as to the MicroDx Application to May 15, 2019. This Notice of Opposition is timely filed by Opposer on the basis of same.

13. Upon information and belief, Opposer's constructive date of first use and priority date of December 22, 2017 pursuant to 15 U.S.C. §1057(c) for the purposes of this opposition is prior to any valid filing date or date of constructive use of Applicant of the MicroDx mark as alleged herein, on any application that may properly mature to registration, including any foreign priority date which may be claimed by Applicant in connection with Applicant's MicroDx Application as alleged herein, and upon information and belief is prior to any date that Applicant can otherwise validly claim to rely on for the purposes of priority.

GROUND I – MICRODX MARK IS MERELY DESCRIPTIVE (15 U.S.C. § 1052(E))

14. Opposer repeats and re-alleges each and every allegation above as if fully set forth herein.

15. Registration of Applicant's MicroDx Mark must be refused on the basis that the MicroDx Mark is merely descriptive of the "microbiology diagnostic" services asserted to be provided by Applicant in connection with the MicroDx Mark.

16. Applicant's MicroDx mark consists of two constituent parts: "micro" and "dx." The first constituent part, "micro," merely describes the microbiology aspects of Applicant's services, which involve the use of "microbiology" to develop "biotherapeutics." Biotherapeutics in the context of Applicant's MicroDx Mark is the use of viruses and bacteria to develop biological treatments. Microbiology is the study of microorganisms, including viruses and bacteria. The second constituent part of Applicant's MicroDx Mark is "dx," which is merely common medical or pharmaceutical shorthand for "diagnosis" or "diagnostic."

17. Applicant's MicroDx Mark is not inherently distinctive, but rather is only merely descriptive of the microbiology-based diagnostics on which use of the MicroDx Mark is expected.

18. Applicant's MicroDx Mark is not entitled to registration on the basis that the MicroDx Mark is merely descriptive of the services for which registration is sought, and registration of the merely descriptive designation "MicroDx" is in violation of 15 U.S.C. § 1052(e) and will cause damage and harm to Opposer as alleged herein..

GROUND II – INVALID STATEMENT OF USE (15 U.S.C. § 1051(D))

19. The MicroDx Application is defective and cannot provide a basis for, or proceed to issuance of, any registration in the name of Applicant, because Applicant was not using the MicroDX Mark in commerce at the time that Applicant's Statement of Use and Specimen was filed, and because the time to file a satisfactory Statement of Use and Specimen has now expired.

20. On November 14, 2018, Applicant filed a Statement of Use pursuant to 15 U.S.C. § 1(d), notwithstanding the fact that upon information and belief, Applicant was not then using the MicroDx Mark in commerce with all of the services identified in the MicroDx Application.

21. On November 14, 2018, in connection with Applicant's Statement of Use, Applicant also submitted a Specimen which Applicant claims shows advertising of the MicroDx Mark in connection with use in commerce of the services identified in the MicroDx Application. The Specimen filed by Applicant in connection with the Statement of Use does not show use of the MicroDx Mark in commerce, but only recites that the MicroDx Mark is used with Applicant's "in house" activities and/or in connection with research and development of Applicant's own drugs or treatments. The Specimen recites implementation of certain technology in connection with "clinical trials," but does not show that any such trials in the United States

have commenced, that any MicroDx-branded services, as applied for, have been rendered in connection with such trials, or that any MicroDx-branded services, as applied for, have been rendered in commerce to others in the United States.

22. Upon information and belief, any services rendered by Applicant under the MicroDx Mark have been rendered in Applicant's facilities or locations in the United Kingdom, and not in connection with United States commerce.

23. Upon information and belief, any services rendered by Applicant under the MicroDx Mark are used by Applicant "in house" or in connection with the use or development of Applicant's own drugs or treatments, have been rendered primarily for the benefit of Applicant and/or Applicant's own operations in the United Kingdom, not to others in connection with United States commerce.

24. Upon information and belief, the only clinical trial of Applicant which would involve the potential rendering of services under the MicroDx Mark in the United States had not yet commenced at the time the Specimen was submitted or the Statement of Use was filed.

25. Upon information and belief, Applicant's clinical trial for which the MicroDx Mark is asserted to be used in commerce has not yet resulted in the use of the MicroDx Mark in commerce, or alternatively the conduct of any clinical trial did not result in the use of the MicroDx Mark in commerce until at least the time that the clinical trial began on January 10, 2019.

26. Applicant's time to submit a Statement of Use containing a truthful and accurate claim of use and to submit a specimen showing use of the MicroDx Mark in commerce in connection with the rendering of all of the applied-for services has expired and was not extended by Applicant.

GROUND III – APPLICANT LACKS BONA FIDE INTENT TO USE MICRODX MARK ON SERVICES RENDERED IN COMMERCE TO OTHERS (15 U.S.C. § 1052(E))

27. Opposer repeats and re-alleges each and every allegation above as if fully set forth herein.

28. Upon information and belief, the services asserted to be provided by Applicant in connection with application for registration of the MicroDx Mark are not services used in commerce or that can be intended for use in commerce for the purposes of establishing a right to registration under 15 U.S.C. § 1051(a)-(b) or § 1126(d)-(e) because, upon information and belief, the research and development services claimed by Applicant are not primarily for the benefit of someone other than the Applicant.

29. Applicant is the Sponsor and the Responsible Party for a clinical trial to be conducted in the United States, NIH Identifier NCT03637803, and any provisions of the services identified in the MicroDx Application by Applicant in connection with the MicroDx Mark are limited to the collection and analysis of “Faecal and urine samples . . . for microbiota and metabolomics using the MicroDx platform” and such services are primarily for the benefit of Applicant.

30. Because Applicant’s services contemplated in connection with the MicroDx mark are rendered internally for Applicant and its affiliates, and not primarily for the benefit of someone other than Applicant, Applicant lacks the necessary bona fide intent to use the MicroDx Mark on services in commerce that would give rise to any registrable rights.

GROUND IV – FRAUDULENT REGISTRATION (15 U.S.C. § 1064(3))

31. Opposer repeats and re-alleges each and every allegation above as if fully set forth herein.

32. On November 14, 2018, an individual identifying themselves as Adrian Murray, the Intellectual Property Director of Applicant, filed with the United States Patent and Trademark Office a Statement of Use under Section 1(d) of the Lanham Act, asserting under that the MicroDx Mark “is in use in commerce on or in connection with all of the goods/services” set forth in the MicroDx Application, and that the MicroDx mark was “used in commerce at least as early as 08/09/2018, and is now in use in such commerce.” In the same Statement of Use, Adrian Murray further declared that “all statements made of his/her own knowledge are true” and acknowledged that “willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom[.]”

33. Upon information and belief, the clinical trial involving Applicant’s research and development services in the United States, NIH Identifier NCT03637803, for which Applicant claims use in commerce of the MicroDx Mark in connection with all of the services identified in the MicroDx Application, did not begin until at least as early as the actual start date of the clinical trial on January 10, 2019.

34. Upon information and belief, as of at least January 10, 2019, Applicant had not yet rendered any of the services identified in the MicroDx Application, and specifically Applicant had not yet conducted any collection or analysis of “Faecal and urine samples . . . for microbiota and metabolomics using the MicroDx platform” in the United States, either in connection with the initial clinical trial or otherwise.

35. At the time of the November 14, 2018 statements set forth herein, upon information and belief, Applicant and Adrian Murray as the authorized agent for Applicant, knew that the clinical trial involving Applicant’s research and development services in the United

States had not yet commenced, and that Applicant had not yet used the MicroDx Mark in the United States in connection with rendering any of the applied-for services in commerce, either in connection with the initial clinical trial or otherwise.

36. Upon information and belief, the November 14, 2018 statement by Adrian Murray on behalf of Applicant was false and was then known to be false, and such statement was intended by Applicant to deceive and did deceive the United States Patent and Trademark Office as to a material issue affecting the registrability of the MicroDx Mark.

37. The examining attorney would not have allowed the MicroDx Application to proceed to allowance and publication but for the foregoing fraud by Applicant as recited herein.

38. Applicant's MicroDx Application must be refused on the basis of the foregoing fraud upon the United States Patent and Trademark Office in connection with Applicant's prosecution of the MicroDx Application

39. Applicant cannot cure its fraud committed in the prosecution of the MicroDx Application as alleged herein, including by amending or adding a new or different basis on which to allege use, when the mark was not actually being used with all of the applied-for services at the time of the signing of the statement alleging use.

40. Opposer will be damaged if Applicant's material misstatement of fact, namely the false statement that Applicant's MicroDx Mark was in use in commerce on all services identified in the MicroDx Application as of August 9, 2018, which Applicant knew to be false as of November 14, 2018, and which was intended to and has caused the United States Patent and Trademark Office to allow registration of the MicroDx Mark but for this opposition, leads the Patent and Trademark Office to issue a U.S. Trademark Registration for the MicroDx Mark as a result of the MicroDx Application.

GROUND V – RESTRICTION (15 U.S.C. § 1068) (IN THE ALTERNATIVE)

41. Opposer repeats and re-alleges each and every allegation above as if fully set forth herein.

42. By the application herein opposed, Applicant seeks to register the MicroDx Mark for “Scientific research and development; microbiology research and development into live biotherapeutics,” in International Class 42. Solely for the purposes of Opposer’s claim to relief pursuant to 15 U.S.C. § 1068, Applicant has asserted, and it is therefore hypothetically alleged, that Applicant’s use of the MicroDx Mark for the applied-for services is likely to cause confusion, mistake, or to deceive the consuming public and cause corresponding injury to Opposer, as a result of the indefiniteness of the services identified in Applicant’s MicroDx Application.

43. Upon information and belief, the services identified in Applicant’s MicroDx Application are indefinite and overbroad, and do not identify Applicant’s services in a way that is specific, definite, clear, accurate, or concise.

44. Upon information and belief, the current identification of Applicant’s services in the MicroDx Application is indefinite in that the current identification may include goods or services in more than one class, and further fails to provide adequate public notice as to the specific services claimed by Applicant in connection with the MicroDx Application.

45. In light of the foregoing and solely for the purposes of Opposer’s claim for relief pursuant to 15 U.S.C. § 1068, and unless the identification of services in the MicroDx Application is restricted as set forth herein, such services may be hypothetically considered to be closely related to the goods and services for which Opposer has applied for registration of the MICDx Mark.

46. Pursuant to 15 U.S.C. § 18, the identification of services in the MicroDx Application should properly be restricted as follows: “~~Scientific~~ Pharmaceutical research and development services in the field of microbiology, namely the identification of microbiome characteristics for the development of live biotherapeutics; microbiology research and development, namely the identification of microbiome characteristics for the development of ~~into~~ live biotherapeutics,” and upon the entry of such restriction, there will be no likelihood of confusion between the MicroDx Application and Opposer’s MICDx Application.

47. Alternatively, upon information and belief, Applicant’s identification of services in the MicroDx Application fails to provide adequate notice to third parties as to the nature of the services for which the MicroDx Mark is sought to be registered, and Applicant is not entitled to receive a filing date pursuant to the MicroDx Application under 37 C.F.R. §2.21(a)(4).

48. Opposer will be damaged by the registration sought by Applicant because such registration will give color and exclusive statutory right to Applicant in violation and derogation of Opposer’s corresponding rights to use and to obtain registration of the MICDx Mark.

49. Opposer will be further damaged by the registration sought by Applicant for the MicroDx Mark in that permitting such registration would grant Applicant the right to pursue exclusive use of the MicroDx Mark to the derogation of Opposer’s MICDx Mark, including through a claim of priority to which Applicant is not entitled, and on the basis of a claim of likelihood of confusion which would be obviated if any registration of Applicant’s MicroDx mark is properly restricted to the narrow set of services on which Applicant can use the MicroDx Mark.

WHEREFORE, for the foregoing reasons and for such other reasons as the Board determines are appropriate, Opposer respectfully prays that this Opposition be sustained, that

registration of the MicroDx Mark be denied to Applicant on its U.S. Application Serial No. 87/399,262, and that the Board grants all further relief favorable to Opposer that is necessary and just in these circumstances. The Commissioner is hereby authorized to charge the \$400 filing fee required under 37 C.F.R. §2.6(a)(17), and to charge any additional fees which may be required, or to credit any overpayment, to the undersigned's Deposit Account No. 50-0517.

This 15th day of May, 2019.

Respectfully submitted,

/Stephen F. Shaw/

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Attorneys for Caris MPI, Inc.

CERTIFICATE OF MAILING

I do hereby certify that on May 15, 2019, I filed via electronic means (ESTTA) this

NOTICE OF OPPOSITION with the:

U.S. Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

/Kristin S. Webb/

Kristin S. Webb