

ESTTA Tracking number: **ESTTA1058692**

Filing date: **05/29/2020**

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	Softek Illuminate, Inc.		
Entity	Corporation	Citizenship	Kansas
Address	7299 W. 98th Terrace #130 Overland Park, KS 66212 UNITED STATES		

Attorney information	Robert Reynolds Conroy Baran, LLC 1316 St. Louis Ave Kansas City, MO 64101 UNITED STATES rreynolds@conroybaran.com, rbaran@conroybaran.com no phone number provided		
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Applicant Information

Application No	88732936	Publication date	04/28/2020
Opposition Filing Date	05/29/2020	Opposition Period Ends	05/28/2020
Applicant	Merck Sharp & Dohme Corp. One Merck Drive Whitehouse Station, NJ 08889 UNITED STATES		

Goods/Services Affected by Opposition


Class 044. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Providing medical information, namely, clinical study results to doctors and patients
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3608560	Application Date	09/04/2008
Registration Date	04/21/2009	Foreign Priority Date	NONE
Word Mark	ILLUMINATE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2008/04/01 First Use In Commerce: 2008/04/01 Computer software for managing patient medical information; computer software for indexing, searching, displaying, and managing electronic health records and electronic medical records; computer software for indexing, searching, displaying, and managing radiology images, radiology examinations, radiology reports, radiology data, and patient data

U.S. Registration No.	6023126	Application Date	08/29/2019
Registration Date	03/31/2020	Foreign Priority Date	NONE
Word Mark	ILLUMINATE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2011/01/01 First Use In Commerce: 2011/01/01 Downloadable and recorded computer software for managing patient medical information, specifically software for generating automatic follow-up notices for primary care physicians regarding radiological findings; computer software for tracking pre-screened patient data and patient diagnoses Class 035. First use: First Use: 2011/01/01 First Use In Commerce: 2011/01/01 Business consulting services provided to the healthcare industry, namely, the collection, reporting, and analysis, both real-time and post-completion, of productivity, efficiency, and completeness in the provision of healthcare services		

Attachments	77562892#TMSN.png(bytes) 88598373#TMSN.png(bytes) Opposition Pleading Illuminate Merck.pdf(1253957 bytes)
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Signature	/Robert Reynolds/
Name	Robert Reynolds
Date	05/29/2020

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

In the Matter of Application
Serial No. 88/732,936
Published on April 28, 2020

Softek Illuminate, Inc.)	
)	
Opposer)	Opposition No. _____
)	
v.)	
)	
Merck Sharp & Dohme Corp.)	
)	
Applicant)	

TRADEMARK TRIAL AND APPEAL BOARD
Commissioner for Trademarks
PO Box. 1451
Alexandria, Virginia 22312-1451

NOTICE OF OPPOSITION

Opposer Softek Illuminate, Inc., (“**Opposer**”) with an address of 7299 W. 98th Terrace, #130, Overland Park, KS 66212, a Kansas corporation, believes that it will be damaged by the registration of the stylized mark ILLUMINATE, Serial No. 88/732,936 (“**Applicant’s Mark**”) which is owned by Merck Sharp & Dohme Corp., with an address of One Merck Drive, Whitehouse Station, New Jersey, 08889, a New Jersey corporation (“**Applicant**”) and hereby opposes the same.

1. Opposer began using its ILLUMINATE brand in February of 2009. Applicant filed U.S. Application Serial No. 88/732,936 for Applicant’s Mark on December 19, 2019, claiming a *bona fide* intent to use Applicant’s Mark in connection with “Providing medical information, namely, clinical study results to doctors and patients” in Class 044. Upon information and belief, Applicant has not yet begun use of Applicant’s Mark and thus Opposer has priority over Applicant’s Mark.

2. Opposer is the owner and user of the following U.S. registrations (“**Opposer’s Marks**”):
 - a. Registration No. 3,608,560 registered on April 21, 2009, and renewed April 20, 2019, for the standard character mark “ILLUMINATE” covering “computer software for managing patient medical information; computer software for indexing, searching, displaying, and managing electronic health records and electronic medical records; computer software for indexing, searching, displaying, and managing radiology images, radiology examinations, radiology reports, radiology data, and patient data” in Class 009. This mark’s registration is attached as Exhibit A and incorporated herein by reference and made of record pursuant to Trademark Rule 2.122(d).
 - b. Registration No. 6,023,126 registered on March 31, 2020, for the standard character mark “ILLUMINATE” covering “downloadable and recorded computer software for managing patient medical information, specifically software for generating automatic follow-up notices for primary care physicians regarding radiological findings; computer software for tracking pre-screened patient data and patient diagnoses” in Class 009 and “business consulting services provided to the healthcare industry, namely, the collection, reporting, and analysis, both real-time and post-completion, of productivity, efficiency, and completeness in the provision of healthcare services” in Class 035. This mark’s registration is attached as Exhibit B and incorporated herein by reference and made of record pursuant to Trademark Rule 2.122(d).
3. Each of the above-mentioned registrations is valid. Registration No. 3,608,560 is incontestable.
4. Opposer has made significant investments to advertise and promote Opposer’s Services in interstate commerce in connection with the Marks and has established extensive goodwill in the Marks.
5. Applicant’s mark is similar in sight and overall commercial appearance to Opposer’s Marks. The literal element and pronunciation of Applicant’s Mark is identical to Opposer’s Marks. Applicant’s Mark will travel in the same channels of commerce as Opposer’s Marks and covers very similar services.

6. Applicant's Mark so closely resembles Opposer's previously used and registered ILLUMINATE marks that its use, in connection with the services previously mentioned, is likely to cause confusion, or to cause mistake or deceive, in violation of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d).
7. Opposer will be damaged by the registration of Applicant's Mark for the services listed in Application Serial No. 88/732,936 as a result of the confusion, mistake, and deception listed in Paragraph 6 above.

WHEREFORE, Opposer Softek Illuminate, Inc. prays that this opposition be sustained and registration on Application Serial No. 88/732,936 be refused.

Respectfully submitted

Softek Illuminate, Inc.

By: /s/ Robert C. Reynolds
Robert C. Reynolds

Attorney for Opposer
Conroy Baran, LLC
1316 St. Louis Ave.
Second Floor
Kansas City, MO 64112

Date: May 29, 2020

Exhibit A

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ILLUMINATE

Word Mark ILLUMINATE

Goods and Services IC 009. US 021 023 026 036 038. G & S: Computer software for managing patient medical information; computer software for indexing, searching, displaying, and managing electronic health records and electronic medical records; computer software for indexing, searching, displaying, and managing radiology images, radiology examinations, radiology reports, radiology data, and patient data. FIRST USE: 20080401. FIRST USE IN COMMERCE: 20080401

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number **77562892**

Filing Date September 4, 2008

Current Basis 1A

Original Filing Basis 1A

Published for Opposition February 3, 2009

Registration Number 3608560

Registration Date April 21, 2009

Owner (REGISTRANT) Softek Solutions, Inc. CORPORATION KANSAS Suite 100 Prairie Village KANSAS 66207
(LAST LISTED OWNER) SOFTEK ILLUMINATE, INC. CORPORATION KANSAS SUITE 130 7299 W. 98TH TERRACE OVERLAND PARK KANSAS 66212

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Robert Reynolds

Type of Mark TRADEMARK

Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20190420.
Renewal 1ST RENEWAL 20190420
Live/Dead Indicator LIVE

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Exhibit B

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M:

Word Mark ILLUMINATE
Goods and Services IC 009. US 021 023 026 036 038. G & S: Downloadable and recorded computer software for managing patient medical information, specifically software for generating automatic follow-up notices for primary care physicians regarding radiological findings; computer software for tracking pre-screened patient data and patient diagnoses. FIRST USE: 20110101. FIRST USE IN COMMERCE: 20110101

IC 035. US 100 101 102. G & S: Business consulting services provided to the healthcare industry, namely, the collection, reporting, and analysis, both real-time and post-completion, of productivity, efficiency, and completeness in the provision of healthcare services. FIRST USE: 20110101. FIRST USE IN COMMERCE: 20110101

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 88598373

Filing Date August 29, 2019

Current Basis 1A

Original Filing Basis 1A

Published for Opposition January 14, 2020

Registration Number 6023126

Registration Date March 31, 2020

Owner (REGISTRANT) Softek Illuminate, Inc. CORPORATION KANSAS 10012 W. 50th Terr. Merriam KANSAS 66203

Attorney of Record Robert Reynolds

Prior Registrations 3608560

Type of Mark TRADEMARK. SERVICE MARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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