

ESTTA Tracking number: **ESTTA1075416**

Filing date: **08/17/2020**

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	Lucigen Corporation
Granted to Date of previous extension	08/16/2020
Address	2905 PARMENTER STREET MIDDLETON, WI 53562 UNITED STATES
Attorney information	SARAH J. SCHNEIDER SHERIDAN ROSS P.C. 1560 BROADWAY, SUITE 1200 DENVER, CO 80202 UNITED STATES Primary Email: <a href="mailto:sschneider@sheridanross.com">sschneider@sheridanross.com</a> Secondary Email(s): <a href="mailto:cbryce@sheridanross.com">cbryce@sheridanross.com</a> 3038639700
Docket Number	10234LC-1

**Applicant Information**

Application No.	88239945	Publication date	02/18/2020
Opposition Filing Date	08/17/2020	Opposition Period Ends	08/16/2020
Applicant	Illumina, Inc. 5200 ILLUMINA WAY SAN DIEGO, CA 92122 UNITED STATES		

**Goods/Services Affected by Opposition**

<p>Class 001. First Use: 2014/01/15 First Use In Commerce: 2014/01/15 All goods and services in the class are opposed, namely: Reagents, assays, enzymes, chemical preparations all for scientific and research use; biological specimens in the nature of human tissue or human body fluid, animal tissue or animal body fluid for scientific and research use; cultures of microorganisms, plant tissue and nucleotides for scientific and research use, notfor medical or veterinary purposes; reagents kits comprised primarily of nucleotides, reagents, enzyme substrates, buffers, chemical preparations, biological preparations in the nature of human tissue or human body fluid, animal tissue or animal body fluid, cultures of microorganisms, plant tissue and also comprised of enzymes for scientific and research use, not for medical or veterinary purposes; nucleotides for medical research; chemical buffer solutions used in analytical chemistry; all of the foregoing related to clinical, genetic and specialized tests related to scientific and clinical diagnostic equipment</p>
<p>Class 005. First Use: 2014/01/15 First Use In Commerce: 2014/01/15 All goods and services in the class are opposed, namely: Reagents for medical and veterinary use,</p>

clinical medical diagnostic reagents, medical diagnostic assays for medical and diagnostic purposes for testing genetic material; enzymes for medical and veterinary use, nucleotides for medical and veterinary use, buffers for medical and veterinary diagnostic use for testing genetic material, chemical reagents for medical and veterinary use, and biological preparations in the nature of human tissue cultures for medical and veterinary use, human body fluids for medical and veterinary use, animal tissue cultures for medical and veterinary use, and animal body fluids for medical and veterinary use, cultures of microorganisms for medical or veterinary use, and plant tissue for medical and veterinary use in the fields of medical diagnostics, veterinary diagnostics, clinical and diagnostic laboratory medicine, veterinary medicine, and genetics; all of the foregoing related to clinical, genetic and specialized tests related to scientific and clinical diagnostic equipment

Class 009. First Use: 2014/01/15 First Use In Commerce: 2014/01/15

Opposed goods and services in the class: scientific apparatus and instruments, namely, nucleic acid sequencers for laboratory use in the fields of medical diagnostics, veterinary diagnostics, medical research, veterinary research, diagnostics, clinical research, drug development, drug development research, medical laboratory research, veterinary science and research, life sciences, biology, microbiology, biotechnology, agriculture, forensics, food safety, metagenomics, and genetics

Class 010. First Use: 2014/01/15 First Use In Commerce: 2014/01/15

Opposed goods and services in the class: scientific apparatus and instruments, namely, nucleic acid sequencers for use in medical and veterinary diagnosis and in medical and veterinary treatment

## Grounds for Opposition

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

U.S. Registration No.	4197857	Application Date	01/10/2012
Registration Date	08/28/2012	Foreign Priority Date	NONE
Word Mark	NXSEQ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 2011/11/15 First Use In Commerce: 2011/11/15 Assays and reagents for use in genetic research; Biochemical reagents commonly known as probes, for detecting and analyzing molecules in protein or nucleotide arrays; Chemical reagents for non-medical purposes; Nucleic acid sequences and chemical reagents for other than medical and veterinary purposes; Reagents for research purposes; Reagents for scientific or medical research use		

Attachments	Notice of Opposition.pdf(114919 bytes ) Exhibit 1.pdf(636299 bytes )
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Signature	/Caroline E. Bryce/
Name	Caroline E. Bryce
Date	08/17/2020

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

In the Matter of Service Mark Application Serial No. 88239945  
Filed on December 21, 2018  
For the mark "NEXTSEQ"  
Published in the *Official Gazette* on February 18, 2020

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Lucigen Corporation,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. _____
	)	
Illumina, Inc.	)	
	)	
Applicant.	)	

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**NOTICE OF OPPOSITION**

Opposer Lucigen Corporation, a corporation organized under the laws of the state of Wisconsin, with its principal place of business at 2905 Parmenter Street, Middleton, Wisconsin 53562 ("Opposer") believes that it will be damaged by the registration of U.S. Trademark Application Serial No. 88239945 for the goods identified herein and hereby opposes the same. As grounds for the opposition, Opposer, by and through its undersigned counsel, alleges the following:

1. Applicant Illumina, Inc. ("Applicant") filed Application No. 88239945 for "NEXTSEQ" (Applicant's Mark), on December 21, 2018, for goods in Classes 1, 5, 9, and 10 based on a claimed first use and first use in commerce date of January 15, 2014.
2. Application No. 88239945 published for opposition on February 18, 2020.
3. On March 18, 2020, Opposer filed a Request for a 90-day Extension of Time to File a Notice of Opposition which was granted until June 17, 2020.

4. On June 15, 2020, Opposer filed a Request for a 60-day Extension of Time to File a Notice of Opposition with the consent of Applicant which was granted until August 16, 2020.

5. Pursuant to 37 C.F.R. § 2.196, because August 16, 2020, falls on a Sunday, the Notice of Opposition is timely when filed on August 17, 2020.

6. Opposer's filing of this Notice of Opposition is timely pursuant to 37 C.F.R. § 2.101, as it is being filed by the August 17, 2020, deadline.

7. Opposer objects to the registration of Application No. 88239945 with respect to the goods, "reagents, assays, enzymes, chemical preparations all for scientific and research use; biological specimens in the nature of human tissue or human body fluid, animal tissue or animal body fluid for scientific and research use; cultures of microorganisms, plant tissue and nucleotides for scientific and research use, not for medical or veterinary purposes; reagents kits comprised primarily of nucleotides, reagents, enzyme substrates, buffers, chemical preparations, biological preparations in the nature of human tissue or human body fluid, animal tissue or animal body fluid, cultures of microorganisms, plant tissue and also comprised of enzymes for scientific and research use, not for medical or veterinary purposes; nucleotides for medical research; chemical buffer solutions used in analytical chemistry; all of the foregoing related to clinical, genetic and specialized tests related to scientific and clinical diagnostic equipment" in Class 1, "reagents for medical and veterinary use, clinical medical diagnostic reagents, medical diagnostic assays for medical and diagnostic purposes for testing genetic material; enzymes for medical and veterinary use, nucleotides for medical and veterinary use, buffers for medical and veterinary diagnostic use for testing genetic material, chemical reagents for medical and veterinary use, and biological preparations in the nature of human tissue cultures for medical and veterinary use, human body fluids for medical and veterinary use, animal tissue cultures for medical and veterinary use, and

animal body fluids for medical and veterinary use, cultures of microorganisms for medical or veterinary use, and plant tissue for medical and veterinary use in the fields of medical diagnostics, veterinary diagnostics, clinical and diagnostic laboratory medicine, veterinary medicine, and genetics; all of the foregoing related to clinical, genetic and specialized tests related to scientific and clinical diagnostic equipment” in Class 5, and “scientific apparatus and instruments, namely, nucleic acid sequencers for laboratory use in the fields of medical diagnostics, veterinary diagnostics, medical research, veterinary research, diagnostics, clinical research, drug development, drug development research, medical laboratory research, veterinary science and research, life sciences, biology, microbiology, biotechnology, agriculture, forensics, food safety, metagenomics, and genetics” in Class 9, and “scientific apparatus and instruments, namely, nucleic acid sequencers for use in medical and veterinary diagnosis and in medical and veterinary treatment” in Class 10 (collectively “Applicant’s Goods”).

8. Opposer is the owner of incontestable U.S. Trademark Registration No. 4197857 for “NXSEQ” filed on January 10, 2012, registered on August 28, 2012, with a claimed first use and first use in commerce date of at least as early as November 15, 2011, for “assays and reagents for use in genetic research; biochemical reagents commonly known as probes, for detecting and analyzing molecules in protein or nucleotide arrays; chemical reagents for non-medical purposes; nucleic acid sequences and chemical reagents for other than medical and veterinary purposes; reagents for research purposes; reagents for scientific or medical research use” in Class 1.

9. Opposer is the owner of common law trademark rights in the United States for the mark “NXSEQ” first used in commerce at least as early as November 15, 2011, for “assays and reagents for use in genetic research; biochemical reagents commonly known as probes, for detecting and analyzing molecules in protein or nucleotide arrays; chemical reagents for non-

medical purposes; nucleic acid sequences and chemical reagents for other than medical and veterinary purposes; reagents for research purposes; reagents for scientific or medical research use”.

(Registration Certificate and TSDR status report attached at Exhibit 1; Opposer’s U.S. registration and common law rights and the marks contained therein identified in Paragraphs 8 - 9 are collectively referred to herein as “Opposer’s NXSEQ Mark”.)

10. Opposer adopted and has continuously used the “NXSEQ” Trademark in commerce since at least as early as November 15, 2011, in the United States.

11. Opposer has used and is currently using Opposer’s NXSEQ Mark in commerce in the United States in connection with “assays and reagents for use in genetic research; biochemical reagents commonly known as probes, for detecting and analyzing molecules in protein or nucleotide arrays; chemical reagents for non-medical purposes; nucleic acid sequences and chemical reagents for other than medical and veterinary purposes; reagents for research purposes; reagents for scientific or medical research use”.

12. Opposer has standing to oppose Application No. 88239945 based on Opposer’s ownership of Opposer’s NXSEQ Mark.

13. On May 29, 2013, Applicant and Opposer entered into an agreement (the “2013 Agreement”) wherein Opposer consented to Applicant’s use and registration of NEXSEQ in connection with “Scientific and clinical diagnostic instruments, namely, nucleic acid sequencers, imaging devices, namely, electronic imaging apparatus for detecting images and optical signals, and for processing images and optical signals into data, for use in sequencing” in Class 9.

14. Under the 2013 Agreement, Opposer further consented to Applicant's use of NEXTSEQ in connection with "clinical, genetic and specialized tests associated with NEXTSEQ scientific and clinical diagnostic instruments".

15. Opposer contends Applicant's Goods exceed the scope of the 2013 Agreement.

16. Opposer's NXSEQ Mark has priority over the Applicant's Mark as Opposer's NXSEQ Mark was used, filed, and registered prior to the filing of Application No. 88239945 and prior to Applicant's actual use in commerce in the United States of Applicant's Mark.

17. Opposer's NXSEQ Mark is inherently distinctive.

18. Opposer has devoted substantial time, money, and effort in establishing and maintaining a high standard of quality of the goods provided under Opposer's NXSEQ Mark.

19. By virtue of the success of the goods branded with Opposer's NXSEQ Mark in the United States and the advertising and promotion by Opposer of Opposer's NXSEQ Mark, Opposer's NXSEQ Mark has become a valuable asset of Opposer, serving as a symbol of origin, identifying Opposer as the source of such goods, and of the goodwill which is associated with such goods.

20. Applicant's Goods are identical or highly related to the goods offered by Opposer in connection with Opposer's NXSEQ Mark.

21. Applicant's Mark NEXTSEQ is similar in sound, appearance, connotation and commercial impression to Opposer's NXSEQ Mark.

22. Applicant's use of the NEXTSEQ mark in connection with Applicant's Goods is likely to cause confusion, mistake or deception in the minds of consumers because consumers mistakenly believe that Applicant's goods are associated with Opposer.

23. Applicant's Mark is likely to cause confusion, mistake or deception in the minds of consumers as to the source or origin of Applicant's Goods.

24. Consumers are likely to mistakenly believe that Applicant's Goods are sponsored by, authorized by, endorsed, affiliated with or otherwise associated with Opposer because Applicant's Mark is confusingly similar to Opposer's NXSEQ Mark.

25. Applicant's use of the NEXTSEQ mark in connection with Applicant's Goods is without Opposer's consent or authorization.

26. Opposer will be damaged by the registration of Applicant's Mark and registration should be refused under 15 U.S.C. 1052(d) because Opposer has priority of use and confusion is likely to occur.

WHEREFORE, Opposer respectfully requests that registration of the specified goods of U.S. Service Mark Application Serial No. 88239945 be refused, and that this Opposition be sustained in favor of Opposer.

Respectfully submitted,

Date: August 17, 2020

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Attorneys for Opposer



# United States of America

United States Patent and Trademark Office

# NxSeq

**Reg. No. 4,197,857**

LUCIGEN CORPORATION (WISCONSIN CORPORATION)  
2120 W. GREENVIEW DRIVE  
MIDDLETON, WI 53562

**Registered Aug. 28, 2012**

**Int. Cl.: 1**

FOR: ASSAYS AND REAGENTS FOR USE IN GENETIC RESEARCH; BIOCHEMICAL REAGENTS COMMONLY KNOWN AS PROBES, FOR DETECTING AND ANALYZING MOLECULES IN PROTEIN OR NUCLEOTIDE ARRAYS; CHEMICAL REAGENTS FOR NON-MEDICAL PURPOSES; NUCLEIC ACID SEQUENCES AND CHEMICAL REAGENTS FOR OTHER THAN MEDICAL AND VETERINARY PURPOSES; REAGENTS FOR RESEARCH PURPOSES; REAGENTS FOR SCIENTIFIC OR MEDICAL RESEARCH USE, IN CLASS 1 (U.S. CLS. 1, 5, 6, 10, 26 AND 46).

**TRADEMARK**

**PRINCIPAL REGISTER**

FIRST USE 11-15-2011; IN COMMERCE 11-15-2011.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 85-513,197, FILED 1-10-2012.

MAYUR VAGHANI, EXAMINING ATTORNEY



*David J. Kyfos*

Director of the United States Patent and Trademark Office

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**Mark:** NXSEQ

# NxSeq

**US Serial Number:** 85513197

**Application Filing Date:** Jan. 10, 2012

**US Registration Number:** 4197857

**Registration Date:** Aug. 28, 2012

**Filed as TEAS Plus:** Yes

**Currently TEAS Plus:** Yes

**Register:** Principal

**Mark Type:** Trademark

**TM5 Common Status Descriptor:**



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

**Status:** A Sections 8 and 15 combined declaration has been accepted and acknowledged.

**Status Date:** Sep. 05, 2018

**Publication Date:** Jun. 12, 2012

## Mark Information

**Mark Literal Elements:** NXSEQ

**Standard Character Claim:** Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

**Mark Drawing Type:** 4 - STANDARD CHARACTER MARK

## Goods and Services

**Note:**

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (..) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

**For:** Assays and reagents for use in genetic research; Biochemical reagents commonly known as probes, for detecting and analyzing molecules in protein or nucleotide arrays; Chemical reagents for non-medical purposes; Nucleic acid sequences and chemical reagents for other than medical and veterinary purposes; Reagents for research purposes; Reagents for scientific or medical research use

**International Class(es):** 001 - Primary Class

**U.S Class(es):** 001, 005, 006, 010, 026, 046

**Class Status:** ACTIVE

**Basis:** 1(a)

**First Use:** Nov. 15, 2011

**Use in Commerce:** Nov. 15, 2011

## Basis Information (Case Level)

**Filed Use:** Yes

**Currently Use:** Yes

**Filed ITU:** No

**Currently ITU:** No

**Filed 44D:** No

**Currently 44E:** No

**Filed 44E:** No

**Currently 66A:** No

**Filed 66A:** No

**Currently No Basis:** No

**Filed No Basis:** No

## Current Owner(s) Information

**Owner Name:** Lucigen Corporation  
**Owner Address:** 2905 Parmenter Street  
 Middleton, WISCONSIN UNITED STATES 53562  
**Legal Entity Type:** CORPORATION  
**State or Country Where Organized:** WISCONSIN

## Attorney/Correspondence Information

### Attorney of Record - None Correspondent

**Correspondent Name/Address:** Lucigen Corporation  
 2905 PARMENTER STREET  
 MIDDLETON, WISCONSIN UNITED STATES 53562

**Phone:** 6088319011

**Fax:** 608-831-9012

### Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Sep. 05, 2018	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Sep. 05, 2018	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	66607
Sep. 05, 2018	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	66607
Aug. 27, 2018	TEAS SECTION 8 & 15 RECEIVED	
Aug. 27, 2018	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Aug. 28, 2017	COURTESY REMINDER - SEC. 8 (6-YR) E-MAILED	
Oct. 23, 2012	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	88888
Oct. 23, 2012	TEAS CHANGE OF OWNER ADDRESS RECEIVED	
Oct. 19, 2012	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Aug. 28, 2012	REGISTERED-PRINCIPAL REGISTER	
Jun. 12, 2012	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jun. 12, 2012	PUBLISHED FOR OPPOSITION	
May 23, 2012	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
May 04, 2012	LAW OFFICE PUBLICATION REVIEW COMPLETED	70138
May 03, 2012	ASSIGNED TO LIE	70138
Apr. 16, 2012	APPROVED FOR PUB - PRINCIPAL REGISTER	
Apr. 16, 2012	ASSIGNED TO EXAMINER	85327
Jan. 14, 2012	NOTICE OF PSEUDO MARK MAILED	
Jan. 13, 2012	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jan. 13, 2012	NEW APPLICATION ENTERED IN TRAM	

## TM Staff and Location Information

### TM Staff Information - None File Location

**Current Location:** TMEG LAW OFFICE 102

**Date in Location:** Sep. 05, 2018