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Filing date: **06/02/2022**

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

Proceeding no.	91274662
Party	Defendant mAgilEnt LLC
Correspondence address	JOHANN FANDL MAGILENT LLC 1101 HERITAGE HILLS WAY WAKE FOREST, NC 27587 UNITED STATES Primary email: john.fandl@magilent.com Secondary email(s): notifications@trademarkengine.com, johnfandl@gmail.com 919-720-2171
Submission	Answer
Filer's name	Johann Fandl
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Signature	/Johann Fandl/
Date	06/02/2022
Attachments	Opposition No 91274662 - mAgilEnt Answer to Amended Notice of Opposition.pdf(385577 bytes )

Trademark Trial and Appeal Board Electronic Filing System: <https://estta.uspto.gov>

ESTTA Tracking number: ESTTA

Answer Date: 06/01/2022

Opposition No. 91274662

Application Serial No(s). 90480492

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

Proceeding	91274662
Party	Defendant mAgilEnt LLC
Correspondence Address	mAgilEnt LLC 1101 HERITAGE HILLS WAY WAKE FOREST, NC 27587 UNITED STATES
Submission	Answer to Amended Opposition
Filer's Name	Johann Fandl
Filer's e-mail	john.fandl@mAgilEnt.com
Signature	/JohannFandl/
Date	06/01/2022
Attachments	Opposition No 91274662 - mAgilEnt Answer to Amended Notice of Opposition.pdf

Opposition No. 91274662

Agilent Technologies, Inc.

Opposer,

v.

Mark:

mAgilEnt LLC

**MAGILENT**

Applicant.

### **ANSWER TO AMENDED NOTICE OF OPPOSITION**

The following is the Answer of Applicant mAgilEnt LLC ("Applicant"), owner of Federal Trademark Application Serial No. 90480492 for the mark MAGILENT (hereinafter "Applicant's Mark"), to the Amended Notice of Opposition filed on

May 26, 2022 by Agilent Technologies Inc. (hereinafter "Opposer"), and assigned Opposition No. 91274662.

1. Admitted.

2. Admitted.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 3 of the Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 4 of the Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

5. Applicant acknowledges “design and development of software *for use by analytical laboratories*” as explicitly documented in Opposer’s Class 042 filing. The software focus on “analytical laboratories” is very specific (not “expansive”), and is disjoint with Applicant’s current Class 042 filing related to the mAgilEnt mark. Due to Opposer’s mischaracterization of its “design and development of software” as “expansive”, in the context of both Opposer’s Class 042 filing and Opposer’s commercial offerings (see paragraph 7), Applicant must deny.

6. Admitted.

7. Since the main Product page of Opposer’s public web site below reveals no evidence of “consulting services, technical support services, and the design and development of software”, any such offerings are considered by consumers to be incidental and ancillary in nature to Opposer’s main business. Hence, the claims of “significant investment” and “substantial goodwill and consumer recognition” in connection with these services are without merit. Denied.

The screenshot shows the Agilent website's 'Products' page. The header includes the Agilent logo, navigation links for 'PRODUCTS', 'APPLICATIONS & INDUSTRIES', 'TRAINING & EVENTS', 'SERVICES', 'SUPPORT & RESOURCES', and 'ORDER CENTER'. A search bar is located in the top right corner. The main content area is titled 'Products' and displays a grid of product categories organized by letter:

- A**: Atomic Spectroscopy, Automated Electrophoresis, Automated Liquid Handling, Autostainer Link Solution for IHC, Autostainer Plus for IHC
- B**: Biomolecules, Conjugation, Synthesis & Purification, Biopharma HPLC Analysis
- C**: Capillary Electrophoresis & CE/MS, Cell Analysis, Certified Pre-Owned Instruments, CGH & CGH+SNP Microarray Platform, Chemical Standards, Clinical Flow Cytometry, Clinical Mass Spectrometry, Clinical Microplate Instrumentation, Community Design (Microarrays)
- D**: Companion Diagnostics, CRISPR/Cas9
- F**: FISH Probes
- G**: Gas Chromatography, Gas Chromatography/Mass Spectrometry (GC/MS), Gas Purification & Gas Management, GC Columns, GC Syringes and Replacement Needles, Gene Expression Microarray Platform, GPC/SEC Columns & Standards
- H**: Hematoxylin & Eosin
- I**: Immunohistochemistry
- L**: Lab Supplies, Labeling Systems, Liquid Chromatography, Liquid Chromatography/Mass Spectrometry (LC/MS)
- M**: Mass Spectrometry (MS), Methylation & ChIP on Chip Microarray Platform - Discontinued, Microarray Scanners Platform, Microplate Instrumentation, Microplates, miRNA Microarray Platform, Molecular Spectroscopy, Multiple Affinity Removal System (MARS), Mutagenesis & Cloning
- N**: Next Generation Sequencing
- P**: Polymerase Chain Reaction (PCR)
- R**: Real-Time PCR (qPCR), Research Flow Cytometry
- S**: Sample Preparation, Small Molecule Columns, Software & Informatics, Special Staining, Specific Proteins, SurePrint Oligonucleotide Library Synthesis
- T**: Thin Layer Chromatography
- V**: Vacuum Technologies, Vials, Caps, and Vial Inserts
- Protein Expression**: PT Link for Pre-Treatment

8. Admitted.

9. Admitted.

10. Applicant is without knowledge or information sufficient to form a belief as to the

truth of allegations contained in paragraph 10 of the Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

11. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 11 of the Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

12. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 12 of the Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

13. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 13 of the Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

14. Applicant is without knowledge or information sufficient to form a belief as to the truth of the “valuable goodwill” assertions contained in paragraph 14 of the Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

15. Admitted.

16. Denied. FURTHERMORE, Applicant sets forth the following in support of its position:

Per the [Filing of 90480492 on 1-21-2021](#) and documented in the screenshot below, applicant filing was NOT “seeking registration of the mark MAGILENT”. Applicant filed for registration of the mark mAgilEnt and the literal element mAgilEnt.

## Trademark/Service Mark Application, Principal Register

Serial Number: 90480492  
Filing Date: 01/21/2021

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	90480492
MARK INFORMATION	
*MARK	mAgilEnt
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	mAgilEnt
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	mAgilEnt LLC
*MAILING ADDRESS	1101 Heritage Hills Way
*CITY	Wake Forest
*STATE (Required for U.S. applicants)	North Carolina
*COUNTRY/REGION/JURISDICTION/U.S. TERRITORY	United States
*ZIP/POSTAL CODE (Required for U.S. and certain international addresses)	27587

17. Admitted.

18. Admitted.

19. Denied.

FURTHERMORE, Applicant sets forth the following in support of its position:

Applicant acknowledges receipt of a litigious demand via email to withdraw the application, as well as a litigious demand to change the company name mAgilEnt, LLC.

Applicant was not offered any opportunity to *amend* the application, hence Applicant must deny.

20. Admitted.

21. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 21 of the Notice of Opposition, specifically regarding the timing of "... use of its AGILENT Marks in connection with the Agilent Goods and Services". Since Applicant can neither admit nor deny the paragraph as written, Applicant must

deny.

22. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 22 of the Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

23. As noted in paragraphs 1 to 22 above, Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in specifically enumerated paragraphs of the Notice of Opposition. Since Applicant can neither admit nor deny those specifically enumerated paragraphs as written, Applicant must deny.

24. Denied.

FURTHERMORE, Applicant sets forth the following in support of its position:

24a. Applicant's mark is unique and distinctive:

Applicant's mark (mAgilEnt) is a mnemonic that expresses the company mission statement: "Making Agile Enterprises", as represented in the commercial logo and as acknowledged by USPTO via assigning the PSEUDO MARK "MAKING AGILE ENTERPRISE".

Additionally, the first 4 letters of Applicant's mark (Magi) carry additional meaning: Magi is the term we use for our consultants, and how we market their experience to customers.

By contrast, Opposer's mark is generic, i.e. its parts do not represent a mnemonic or denote any additional meaning.

24b. Applicants' mark and Opposer's mark are different in spelling.

24c. The *first* letter of Applicant's mark is specifically different from Opposer's mark.

24d. The different first letter is critical due to its dramatic effect on internet search results. Consumers entering the letters **magi** and consumers

entering the letters **agil** receive *dramatically different and non-overlapping results* from internet search engines. This is significant because internet search results would be the primary avenue of any possible potential consumer confusion between Applicant's mark and Opposer's mark, and the goods and services associated with each.

24e. The different first letter is also critical due to its dramatic effect on human word recognition and interpretation.

The field of psycholinguistics proves that letter order is determinative in the human ability to differentiate 2 similar words, even when the words are only shown for a fraction of a second. For example, in English an *S suffix* is easily ignored by the human brain (as it is ignored by internet search engines), while 2 words with a different *starting* letter are very rarely, if ever, confused with each other.

So, if, for example, Applicant's mark were "AGILENTS", Opposer would have a claim re: that mark being "confusingly similar" to Opposer's mark.

With a different first letter, however, Applicant's mAgilEnt mark is singular and distinctive by design, and clearly dissimilar to Opposer's mark.

24f. Applicant's mark and Opposer's mark are different in appearance.

24g. Applicant's mark and Opposer's mark create different commercial impressions.

25. Denied.

FURTHERMORE, Applicant sets forth the following in support of its position:



As noted in paragraphs 5 and 7 above, Applicant's documented services are disjoint with Opposer's services in both the actual services provided and the target market.

26. Denied.

FURTHERMORE, Applicant sets forth the following in support of its position:

26a. Applicant's Class 042 services are *business-oriented* and *data-oriented*, with a focus on "...migration of legacy *business data* and design and development of custom computer software for *business process improvement...*". Conversely, Opposer's enumerated Class 042 services are all *scientific / technical* in nature, and do not reference the term "business" at all. Additionally, Applicant's "design and development of software" services are specifically "for use by analytical laboratories".

Consequently, due to the lack of overlap between Applicant's and Opposer's services, Opposer's claim that Applicant's mark is "...likely to cause confusion, mistake, or deception that Applicant's Services are those of Agilent, or are otherwise endorsed, sponsored, or approved by Agilent" is without merit.

26b. Applicant's mark and Applicant's services are specifically aligned with each other to differentiate and avoid confusion with the services of any other company, including those of Opposer.

27. Denied.

FURTHERMORE, Applicant sets forth the following in support of its position:

27a. Applicant's services and Opposer's services are not marketed through the same

channels of trade.

27b. Applicant's mark is singular and avoids contextual association with any other company, including that of Opposer.

27c. Applicant's mark and Opposer's mark are not likely to cause confusion, mistake or deception to purchasers as to the source of either Applicant's or Opposer's goods or services.

28. Denied.

FURTHERMORE, Applicant sets forth the following in support of its position:

Opposer trivializes and mischaracterizes the critical impact of the first letter difference, per paragraphs 24d and 24e above.

29. Denied.

FURTHERMORE, Applicant sets forth the following in support of its position:

29a. "AGILE" is used in commerce by third parties as part of numerous trademarks for science and technology services not owned by Opposer.

29b. "AGILE" is a common phrase in relation to providing science and technology services.

29c. "ENT" is used in commerce (as an abbreviated term referring to "Enterprise") by third parties as part of numerous trademarks for science and technology services not owned by Opposer.

29d. "ENT" (as an abbreviated term referring to "Enterprise") is a common phrase in relation to providing science and technology services to mid-sized to large companies.

30. Denied.

FURTHERMORE, Applicant sets forth the following in support of its position:

USPTO published Applicant's trademark application (U.S. Serial No. 90480492) in the Official Gazette on Oct 26, 2021, as part of its mission to promote "industrial and technological progress in the United States and strengthen the national economy".

Reversing that rightful (and appreciated) decision based on Opposer's unsubstantiated claims of harm would in no way further this critically important mission.

WHEREFORE, Applicant prays that the Trademark Trial and Appeal Board deny the Opposition and permit registration of Applicant's proposed mark in Application Serial Number 90480492 in the United States Patent and Trademark Office.

Opposition No. 91274662: ANSWER to Amended Notice of Opposition

Dated this 1st day of June, 2022

A handwritten signature in black ink, appearing to read "Johann Fandl". The signature is written in a cursive style with a large initial 'J' and 'F'.

Johann Fandl  
mAgilEnt LLC  
1101 HERITAGE HILLS WAY  
WAKE FOREST, NC 27587  
UNITED STATES  
TEL: 919-720-2171

Applicant

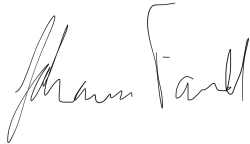
**CERTIFICATE OF SERVICE**

I hereby certify that a true and accurate copy of ANSWER TO NOTICE OF OPPOSITION has been served on the following by delivering said copy on June 1, 2022 via email to the Opposer emails listed in the Notice of Opposition:

Primary email: [doCKET@hollandhart.com](mailto:doCKET@hollandhart.com)

Secondary email(s): [AGarcia@hollandhart.com](mailto:AGarcia@hollandhart.com), [JAKent@hollandhart.com](mailto:JAKent@hollandhart.com),  
[TMEnf-Agilent@hollandhart.com](mailto:TMEnf-Agilent@hollandhart.com)

Dated this 1st day of June, 2022



Johann Fandl  
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Applicant