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Filing date: **01/08/2024**

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	Biocartis NV
Granted to date of previous extension	01/07/2024
Address	GENERAAL DE WITTELAAN 11 B3 MECHELEN, 2800 BELGIUM

Attorney information	CLIFFORD D. HYRA FRESH IP PLC 11710 PLAZA AMERICA DRIVE SUITE 2000 RESTON, VA 20190 UNITED STATES Primary email: cliff@freship.com Secondary email(s): docketing@freship.com, Michael@freship.com, micah@freship.com, Regina@freship.com 8669133499
Docket no.	HDCPA-O003US

### Applicant information

Application no.	90450945	Publication date	07/11/2023
Opposition filing date	01/08/2024	Opposition period ends	01/07/2024
Applicant	Bio-Diagnostics Limited UPTON INDUSTRIAL ESTATE RECTORY ROAD, UPTON-UPON-SEVERN WORCESTERSHIRE, WR80LX UNITED KINGDOM		

### Goods/services affected by opposition

Class 005. First Use: None First Use In Commerce: None All goods and services in the class are opposed, namely: Medical diagnostic reagents; medical diagnostic reagents and assays for testing of body fluids
Class 010. First Use: None First Use In Commerce: None All goods and services in the class are opposed, namely: Surgical and medical apparatus and instruments, namely, for detection, diagnosis, monitoring, screening and confirmation of diseases, toxins, pathogens, analytes, immunity, antibodies, and autoantibodies in food; surgical and medical test kits for detection, diagnosis, monitoring, screening and confirmation of diseases, toxins, pathogens, analytes, immunity, antibodies, and autoantibodies in food consisting primarily of medical apparatus and instruments, sample preparation devices, devices for obtaining bodily fluids, sample tubes and vials, probes, buffers, swabs, assays, reagents, diluents, blocking agents, plastic bags for transmitting medical specimens, printed mailing labels, and usage instructions; medical diagnostic test kits consisting primarily of medical apparatus and instruments, namely, sample preparation devices, devices

for obtaining bodily fluids, sample tubes and vials, probes, buffers, swabs, assays, reagents, diluents, blocking agents, plastic bags for transmitting medical specimens, printed mailing labels, and usage instructions; medical diagnostic tests for the detection, diagnosis, monitoring, screening and confirmation of diseases, toxins, pathogens, analytes, immunity, antibodies, and autoantibodies in food; testing apparatus for sale in kit form for medical diagnostic purposes consisting primarily of medical apparatus and instruments, sample preparation devices, devices for obtaining bodily fluids, sample tubes and vials, probes, buffers, swabs, assays, reagents, diluents, blocking agents, plastic bags for transmitting medical specimens, printed mailing labels, and usage instructions

## 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.	4665252	Application date	10/09/2013
Register	Principal		
Registration date	01/06/2015	Foreign priority date	NONE
Word mark	BIOCARTIS		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 005. First use: First Use: None First Use In Commerce: None Diagnostic preparations for medical purposes</p> <p>Class 010. First use: First Use: None First Use In Commerce: None Medical apparatus and instruments, namely, electrochemical sensors and scales for preparation and measurement of biological analyte concentrations in fluids for medical diagnostic purposes; medical apparatus and instruments, namely, electrochemical sensors and scales for medical analysis and diagnosis of biological analyte concentrations in fluids; medical apparatus and instruments, namely, electrochemical sensors and scales for preparation and measurement of analytes in biological samples for medical diagnostic purposes</p> <p>Class 042. First use: First Use: None First Use In Commerce: None Scientific and technological services, namely, research and design in the fields of biology, bacteriology, chemistry and medicine; industrial analysis and re-search services in the fields of biology, bacteriology, chemistry and medicine; scientific research in the fields of biology, bacteriology, chemistry and medicine</p> <p>Class 044. First use: First Use: None First Use In Commerce: None Medical services; medical analysis services, namely, medical testing for diagnostic or treatment purposes; performing diagnosis of diseases in the field of medicine</p>		

Attachments	Notice of Opposition - Biocard.pdf(85586 bytes )
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Signature	/Micah Gunn/
Name	Micah Gunn
Date	01/08/2024

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

Biocartis NV	)	
	)	
Opposer,	)	Opposition No.: _____
	)	Ser. Nos.: 90450945
v.	)	
	)	
Bio-Diagnostics Limited	)	
	)	
Applicant.	)	

NOTICE OF OPPOSITION

Biocartis NV, a company organized under the laws of Belgium, having its principal place of business at Generaal De Wittelaan 11 B3, Mechelen BELGIUM 2800 (“Biocartis” and “Opposer”), hereby opposes registration of the following application owned, according to the records of the U.S. Patent and Trademark Office, by Bio-Diagnostics Limited, a company organized under the laws of the United Kingdom and having its principal place of business at Upton Industrial Estate, Rectory Road, Upton-Upon-Severn, Worcestershire UNITED KINGDOM WR80LX (“Applicant”).

Opposer would be damaged by registration of Applicant's Mark and hereby opposes the same on the following grounds:

1. Based on information and belief, Applicant, Bio-Diagnostics Limited., is a United Kingdom limited company (ltd.) having a mailing address of Upton Industrial Estate, Rectory Road, Upton-Upon-Severn, Worcestershire UNITED KINGDOM WR80LX.

2. On Jan. 6, 2021, Applicant filed Trademark Application Serial No. 90450945 for the mark BIOCARD (the “Application”), which was published in the Official Gazette on Jul. 11, 2023, for the following goods and services:

“Medical diagnostic reagents; medical diagnostic reagents and assays for testing of body fluids” in International Class 05, and

“Surgical and medical apparatus and instruments, namely, for detection, diagnosis, monitoring, screening and confirmation of diseases, toxins, pathogens, analytes, immunity, antibodies, and autoantibodies in food; surgical and medical test kits for detection, diagnosis, monitoring, screening and confirmation of diseases, toxins, pathogens, analytes, immunity, antibodies, and autoantibodies in food consisting primarily of medical apparatus and instruments, sample preparation devices, devices for obtaining bodily fluids, sample tubes and vials, probes, buffers, swabs, assays, reagents, diluents, blocking agents, plastic bags for transmitting medical specimens, printed mailing labels, and usage instructions; medical diagnostic test kits consisting primarily of medical apparatus and instruments, namely, sample preparation devices, devices for obtaining bodily fluids, sample tubes and vials, probes, buffers, swabs, assays, reagents, diluents, blocking agents, plastic bags for transmitting medical specimens, printed mailing labels, and usage instructions; medical diagnostic tests for the detection, diagnosis, monitoring, screening and confirmation of diseases, toxins, pathogens, analytes, immunity, antibodies, and autoantibodies in food; testing apparatus for sale in kit form for medical diagnostic purposes consisting primarily of medical apparatus and instruments, sample preparation devices, devices for obtaining bodily fluids, sample tubes and vials, probes, buffers, swabs, assays, reagents,

diluents, blocking agents, plastic bags for transmitting medical specimens, printed mailing labels, and usage instructions”, in International Class 10, (“Applicant’s Goods and Services”).

3. Opposer, Biocartis, is the owner of US Trademark Registration No. 4665252, registered on the Principal Register of the U.S. Patent and Trademark Office, filed under section 66A on Oct. 09, 2013, published for opposition on Oct. 21, 2014, and registered Jan. 06, 2015, for the following goods and services (the “BIOCARTIS Mark” and the “BIOCARTIS Registration”):

“Diagnostic preparations for medical purposes,” in International Class 05, and

“Medical apparatus and instruments, namely, electrochemical sensors and scales for preparation and measurement of biological analyte concentrations in fluids for medical diagnostic purposes; medical apparatus and instruments, namely, electrochemical sensors and scales for medical analysis and diagnosis of biological analyte concentrations in fluids; medical apparatus and instruments, namely, electrochemical sensors and scales for preparation and measurement of analytes in biological samples for medical diagnostic purposes,” in International Class 10, and

“Scientific and technological services, namely, research and design in the fields of biology, bacteriology, chemistry and medicine; industrial analysis and research services in the fields of biology, bacteriology, chemistry and medicine; scientific research in the fields of biology, bacteriology, chemistry and medicine” in International Class 42, and “Medical services; medical analysis services, namely, medical testing for diagnostic or treatment purposes; performing diagnosis of diseases in the field of medicine” in International Class 44, (hereinafter referred to collectively as the “BIOCARTIS Goods and Services”).

4. Delaration of continued use of Opposer's BIOCARTIS Registration under section 71 was filed December 9, 2020, indicated continued use of the BIOCARTIS Mark in the United States for all listed goods and services, and was accepted June 22, 2021

5. A trademark application for Applicant's Mark was filed on the basis of 44(d) and 44(e) on Jan. 06, 2021, and contained a priority claim of Jul. 08, 2020.

6. The filing date of Opposer's Registration precedes the claimed priority date of the Application by over six years.

7. Opposer's trademark rights in the BIOCARTIS Mark are superior in time to Applicant's rights in Applicant's Mark.

8. Applicant's Mark so resembles the BIOCARTIS Mark in terms of appearance, sound, connotation and commercial impression as to be likely, when applied to Applicant's goods, to cause confusion and mistake and to deceive.

9. Applicant's goods and services overlap with Opposer's goods and services marketed and sold under its BIOCARTIS Mark. Therefore, if Applicant's Mark is allowed to register, a likelihood of confusion will be created for consumers of these goods and services, such as medical goods and services and those related thereto.

10. Applicant's targeted customer base for the goods and services identified in the Application overlaps with Opposer's customer base.

11. As Applicant's goods description contains no restrictions or limitations as to Applicant's channels of trade, Opposer assumes that Applicant's Mark will be used in all accepted channels of trade. Therefore, in addition to overlapping customer bases, Applicant's intended channels of trade for its goods and services overlap with the channels of trade used by

Opposer in marketing, selling, or otherwise distributing its goods and services under its BIOCARTIS Mark.

12. Applicant's Mark is confusingly similar to the Opposer's Mark so that registration of Applicant's Mark would be inconsistent with and damaging to Opposer. Persons familiar with Opposer's BIOCARTIS Mark would likely perceive Applicant's products as associated or affiliated with or sponsored by Opposer. Such confusion would inevitably result in damage to Opposer.

13. Any defect, objection to or fault found with Applicant's goods marketed under Applicant's Mark would necessarily reflect on and seriously injure the reputation that Opposer has established for its goods and services.

14. Registration of Applicant's Mark would give Applicant *prima facie* evidence of the validity and ownership of Applicant's Mark and of Applicant's exclusive right to use Applicant's Mark, all to the detriment of Opposer.

WHEREFORE, Opposer prays that Applicant's Mark be refused registration and that this Opposition be sustained.

This Notice of Opposition is being filed by the undersigned attorneys at law, duly authorized to represent Opposer in this proceeding, pursuant to Trademark Rule 2.111(b).

RESPECTFULLY SUBMITTED

FRESH IP PLC

/Micah Gunn/

Micah Gunn

Clifford D. Hyra

11710 Plaza America Drive, Suite 2000

Reston, Virginia 20190  
(866) 913-3499  
micah@freship.com  
cliff@freship.com

ATTORNEYS FOR OPPOSER  
Biocartis NV

January 8, 2024