



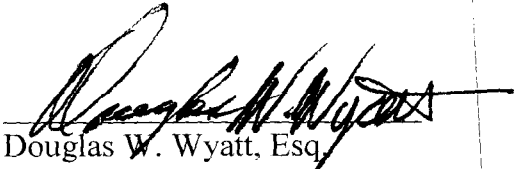


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

GENE LINK, INC.	)	
	)	
	)	
Petitioner	)	
	)	
v.	)	Cancellation No. 30,200
	)	
GENELINK, INC.	)	
	)	
	)	
Respondent	)	
	)	
	)	

**CERTIFICATE OF SERVICE**

I hereby certify that on this 26th day of December, 2002, a true and correct copy of the foregoing REPLY BRIEF OF PETITIONER GENE LINK, INC. IN SUPPORT OF ITS PETITION TO CANCEL RESPONDENT'S TRADEMARK REGISTRATION FOR GENELINK is being served upon the attorney for Applicant via first class mail addressed to: John Lezdey, esq., 4625 East Bay Drive, Suite 302, Clearwater, Florida, 33764.

  
Douglas W. Wyatt, Esq.



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February 23, 2000 before the five (5) year period anniversary of February 13, 2001.

Thus the Respondent's claim at page 2, line 2 of its answering brief that its mark is incontestable appears to be, at best, misguided in view of the fact that 37 CFR Section 2.167 requires that the Section (e) of a Section 15 affidavit state that there is no proceeding pending in the PTO not finally disposed of as follows:

**"§ 2.167 Affidavit or declaration under section 15.**

The affidavit or declaration in accordance with § 2.20 provided by section 15 of the Act for acquiring incontestability for a mark registered on the Principal Register or a mark registered under the act of 1881 or 1905 and published under section 12(c) of the Act (§ 2.153) must:

(e) Specify that there is no proceeding involving said rights pending in the Patent and Trademark Office or in a court and not finally disposed of;"

Petitioner attempted to locate the Trademark Registration file to examine the Section 15 affidavit and was informed by phone by the PTO executives, Ms. Shirley Hansen and Ms. Tracy Alexander that the file was not available for inspection.

**RESPONDENT ALTERED CLAIM FOR DIFFERENT SERVICES  
THAN SET OUT IN THE REGISTRATION**

In the second paragraph of its Reply Brief, Respondent attempts to alter the description of its services set out in its registration by claiming services were for

". . . a service to the consumer for the collection of DNA from corpses, patients, and relatives for purposes of identification and storage for future reference. The identification was especially for use in identifying corpses in a disaster such as a plane crash and to identify inheritable diseases."

This is in contrast to the actual services as described in the Genelink's registration No. 1,956,014 reads as follows:

FOR: DNA TESTING AND STORAGE OF DNA MATERIAL FOR MEDICAL DIAGNOSTICS AND IDENTITY TESTING, IN CLASS 42 (U.S. CLS. 100 AND 101)."

Dr. Javed's testimony on cross examination about his GENE LINK products is as follows:

"Q. Typically, what would this custom oligo product be used for by the university that ordered it?

A. Genetic research, identity, DNA analysis, DNA identity, forensics, any use, any of those uses."

(Javed Deposition Transcript dated June 13, 2001 hereafter Javed II, p. 96)

It is well established that the nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration. (*See, e.g., In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993); et al. Thus the Respondent's statement that its services for collection of DNA from corpses or a plane crash and identifying disease for future reference are clearly not the same.

As discussed below, Petitioner's goods and services are substantively the same as declared in Registration 1,956,014. Petitioner and Respondent's services are for DNA testing for medical diagnostics. Both can be used for identity testing and kept in



storage by the customer. Neither Petitioner nor Respondent stores the DNA at its own facilities. (Javed II, p.123)

PETITIONER CLEARLY USED TRADEMARK GENE LINK IN TRADITIONAL, COMMON LAW USAGE OF A TRADEMARK FOR GOODS AND SERVICES

Respondent's Brief at page 3, line 3 infers that the Petitioner promoted its name only as noted in Petitioner's exhibit 39. This flies in the face of the Petitioner's exhibits and Dr. Javed's testimony referred to in Petitioner's main brief. Dr. Javed testified that all products sold were sold in packages or containers with the GENE LINK trademark thereon. Respondent also refers to Petitioner's exhibit 133 to support its position (Javed I, p. 21). There is no Petitioner's exhibit 133 in the trial transcript.

Petitioner's use of GENE LINK as a Trademark and part of a Trade Style does not detract from the Trademark usage under well established case law.

Petitioner's use of service mark GENE LINK commenced in late 1993 which Petitioner has pointed out on page 5 of Petitioner's main brief. Petitioner sold products and services under the Trademark GENE LINK in 1994 well before Respondent's alleged first use in November 1994 and its first business operation in February, 1995 (10KSB PX55).

At page 3, line 12, Respondent implies Petitioner's principal, Dr. Javed, testified that Petitioner did not begin offering services until 1999-2000. Dr. Javed's answer clearly states there was no service for DNA sequencing before this but not that

different services were not sold. This quote is taken out of context and relates only to DNA sequencing services as pointed out in detail below. Petitioner offered and delivered extensive services in the preparation and sale of custom made DNA as a service to customers.

PETITIONER'S EXHIBITS AND TRIAL TESTIMONY ARE REplete WITH  
EVIDENCE OF CUSTOM SERVICES OFFERED BY PETITIONER

Petitioner offers the services of providing customers with customized DNA bases in accordance with each customer's requirements. For example, in Exhibit 11, a copy of which is attached hereto as Exhibit A for convenient reference, which shows examples of customized services provided to Rutgers University in April '94. In this document a customer order form is shown wherein the customer fills in oligo sequences for this custom made product and service.

Dr. Javed's testimony describes this service as follows: (Javed I, p. 28).

"A. Gene Link, New York, then fills an order. If it is a custom order, it synthesizes those pieces of DNA and then ships it directly to the investigators or the researcher or to the shipped information provided in the purchase order of those institutions."

Exhibit 17 dated July 30, 1994 shows custom made products for a Dr. Fitchmun of San Diego.

Exhibit 22 shows the services of providing custom DNA products sold to University of Nebraska on 10/26/94.

Exhibit 23 shows an invoice to Dr. Yuannan Xia of Lincoln, Nebraska on 11/1/94 for service of providing custom DNA products.

Exhibit 24 shows a purchase order to Cyanimide dated 11/22/94, a blanket order for "synthesis service usage". In addition Dr. Javed further testified to these services (Javed I, p. 30).

**PETITIONER CLEARLY USED MARK GENE LINK AS A TRADEMARK  
AND SERVICE MARK FROM THE VERY BEGINNING**

Dr. Javed described the products sold under these invoices of record as follows (Javed I, p.21).

"Q. And what were these products. can you tell..? You would have to look up those serial numbers?

A. From the invoice numbers I cannot tell specifically which of the product, but 95 percent of our product are DNA bases. oligo synthesis, small stretches of DNA, probes and gene detection systems.

Q. These, again, were sold with your trademark Gene Link on the package?

A. Yes."

Petitioner's use of the GENE LINK mark is as a traditional Trademark and Service Mark. As to the services rendered prior to 1999, Dr. Javed described the DNA testing services for the sale to Rutgers as follows (Javed I, p. 28)

"A. Gene Link, New York, then fills an order. If it is a custom order, it synthesizes those pieces of DNA and then ships it directly to the investigators or the researcher or to the shipped information provided in the purchase order of those institutions."

Similarly, this usage is shown in Exhibits 30, 31, 32, 33, 34 and 35.

Exhibit 36 shows an advertisement for GENE LINK with logo.

Accordingly, Petitioner's use of the mark GENE LINK was both as a Trademark for products and for sale of custom ordered services and products.

A TRADE NAME MAY FUNCTION AS A TRADEMARK OR A SERVICE MARK IN ADDITION TO IDENTIFYING A BUSINESS

A trade name or commercial name may function as a trademark or service mark in addition to identifying a business or vocation. *See In re Walker Process Equipment Inc.* 233 F.2d 329, 332, 110 USPQ 41, 43 (CCPA 1956), *aff'g* 102 USPQ 443 (Comm'r Pats. 1954). Here the Court held:

“[T]he question of whether a corporate name, which is also a trade name, has been used as a trademark must be decided on the circumstances of each particular case.”

The general rule is that whether a trade name or a portion thereof also performs the function of a trademark depends upon the manner of its use and the probable impact of such use upon customers.

"*In re Lytle Engineering & Mfg. Co.*, 125 USPQ 308, (TTAB 1960), the Court held that

"LYTLE' is applied to the container for applicant's goods in a style of lettering distinctly different from the other portion of the trade name and is of such nature and prominence that it creates a separate and independent impression."



# PACKING LIST

## GENE LINK, INC

401 Clairmont Ave.  
THORNWOOD  
NY 10594  
Tel: (914) 769-1192  
Fax: (914) 769-1193  
Federal Tax ID Number 13-3747700

## NO. 94993

SHIP DATE April 18, 1994  
Invoice No. 94993  
Customer PO Q212037  
Customer Number 08855MD1

### INVOICE ADDRESS

08854RSU  
Disbursement Control  
Invoice Processing  
PO BOX 1089  
Rutgers State University  
Piscataway, NJ 08854

### SHIP TO ADDRESS

08855MD1  
Dr. Monica Driscoll  
Rm# 314, CABM Bldg.  
679 Hoes Lane  
Rutgers State University  
Piscataway, NJ 08855  
(908) 235-5214  
Fax: (908) 235-4880

ITEM	QUANTITY	DESCRIPTION
1	29	rhS-11; custom oligo 200 nmol scale, mixed bases, one Inosine site
2	28	LG-5; custom oligo 200 nmol scale
3	25	rhS-12; custom oligo 200 nmol scale, mixed bases, one Inosine site
4	25	rhS-13; custom oligo 200 nmol scale, mixed bases, one Inosine site

GENE LINK, INC,  
401 Clairmont Ave.  
Thornwood, NY 10594

# INVOICE

**GENE LINK, INC**

401 Clairmont Ave.  
 THORNWOOD  
 NY 10594  
 Tel: (914) 769-1192  
 Fax: (914) 769-1193  
 Federal Tax ID Number 13-3747700

**NO. 94993**

INVOICE DATE      April 18, 94  
 SHIP DATE        April 18, 1994  
 Invoice No.        94993  
 Customer PO       R753766  
 Customer Number   08855MD1

<b>BILL TO</b>	<b>SHIP TO</b>
----------------	----------------

08854RSU  
 Disbursement Control  
 Invoice Processing  
 PO BOX 1089  
 Rutgers State University  
 Piscataway, NJ 08854

08855MD1  
 Dr. Monica Driscoll  
 Rm# 314, CABM Bldg.  
 679 Hoes Lane  
 Rutgers State University  
 Piscataway, NJ 08855  
 (908) 235-5214  
 Fax: (908) 235-4880

ITEM	UNITS	DESCRIPTION	UNIT PRICE	DISCOUNT	NET PRICE
			\$	PRICE \$	\$
1	28	rhS-11; custom oligo 200 nmol scale (29 mer)	3.75/base	2.65	74.20
	1	one Inosine site	25.00		25.00
2	28	LG-5; custom oligo 200 nmol scale	3.75/base	2.65	74.20
3	24	rhS-12; custom oligo 200 nmol scale (25 mer)	3.75/base	2.65	63.60
	1	one Inosine site	25.00		25.00
4	24	rhS-11; custom oligo 200 nmol scale (25 mer)	3.75/base	2.65	63.60
	1	one Inosine site	25.00		25.00
		Shipping and Handling; Priority Fed. Ex.			15.50
<b>TOTAL DUE</b>					<b>366.10</b>
<b>TERMS NET 30 DAYS</b>					

**REMIT PAYMENT TO:**

Gene Link, Inc.  
 401 Clairmont Ave.  
 Thornwood  
 NY 10594



**Gene Link** 1002  
 February 21, 2001  
**MW-38**  
 5' ACCCTGTGACTTGAGCOTCGATTTT 3'  
 1410.0 ug O.D. 48.0 24mer

**Gene Link** 40-2004-10  
**Genemer™ Fragile X CGG**  
 Components  
 Primer GLFX1C: 40-2004-01  
 Primer GLFX1F: 40-2004-02  
 10 nmoles For Research Use Only

**Gene Link** 40-3202-01  
**GeneProber™ GLFXDig1**  
 Fragile X (FMR1) gene CGG repeat spanning region specific oligonucleotide labeled probe  
 10 nmoles For Research Use Only

**Gene Link** 40-3103-00  
**Genemer™ Fragile X PCR kit**  
 Fragile X (FMR1) gene CGG repeat region amplification kit  
 Components A, B and C  
 100 Reactions

**Gene Link**  
**Chemiluminescent Gene Detection System**  
 10 X Detection Buffer  
 80 ml For research use only  
 27-5005-00 For 0014

**Gene Link** 40-2001-10  
**Genemer™ Sickle Cell**  
 Components  
 Primer SC5: 40-2001-01  
 Primer SC2: 40-2001-02  
 10 nmoles each

**Gene Link** 40-2002-10  
**Genemer™ Rh D**  
 Components  
 Primer 1: 40-2002-01  
 Primer 2: 40-2002-02  
 10 nmoles each

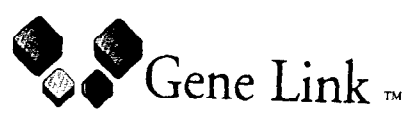
**Gene Link** 40-2020-10  
**Genemer™ SRY**  
 Components  
 Primer SRY 1: 40-2020-01  
 Primer SRY 2: 40-2020-02  
 10 nmoles

**Gene Link**  
 M13/pUC (-20)  
 Forward primer 17mer  
 5'-GTAAAACGACGGCCAGT-3'  
 mw: 5225 17mer  
 28-3000-03 24 ug

**Gene Link**  
**SP6 Universal 18mer Primer**  
 5'-ATTTAGGTGACACTATAG-3'  
 25µg ~4.5 nmols  
 28-3000-17

**Gene Link**  
**Random Nonamers**  
 5'-NNNNNNNNN-3'  
 mw: 2,719 ~40 nmols  
 28-4000-08 180µg

*Hundreds of Products with similar labels*



Toll Free: 1-800-GENE LINK (1-800-436-3546); Fax: 1-888-GENE LINK (1-888-436-3546)  
 Tel: (914) 769-1192; Fax (914) 769-1193. email: orders@genelink.com http://www.genelink.com