



12-27-2002

U.S. Patent & TMOfc/TM Mail RoptDt. #73

UNITED STATES PATENT AND TRADEMARK
OFFICE

Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: December 9, 2002

Registration No. 2426144

Cancellation No. 92041248

Millipore Corporation

v.

Eppendorf AG

David Toren
Brown & Wood LLP
One World Trade Center; 54th Floor
New York, NY 10048-0557

Helen Johnson, Legal Assistant

A petition, copy of which is attached, has been filed to cancel the above-identified registration.

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that became effective October 9, 1998. See Notice of Final Rulemaking published in the *Official Gazette* on September 29, 1998 at 1214 TMOG 145. Slight corrections to the rules, resulting in a correction notice, were published in the *Official Gazette* on October 20, 1998 at 1215 TMOG 64. A copy of the recent amendments to the Trademark Rules, as well as the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), is available at <http://www.uspto.gov>.

In the registration here involved, respondent has designated David Toren of Brown & Wood LLP as its U. S. representative on whom may be served notices affecting this mark.

If the respondent desires to be represented by counsel in this proceeding, a power of attorney to that effect may be filed, or respondent's chosen counsel may simply make an appearance pursuant to Patent and Trademark Rule 2.17. Respondent's copy of communications from the Board will be sent to respondent's domestic representative until counsel is appointed or makes an appearance in behalf of respondent. See Trademark Rule 2.119(d).

ANSWER IS DUE FORTY DAYS after the mailing date hereof. (See Patent and Trademark Rule 1.7 for expiration date falling on Saturday, Sunday, or a holiday.)

Discovery and testimony dates are set as indicated below. In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Discovery period to open: **December 29, 2002**
Discovery period to close: **June 27, 2003**

Testimony period for party in position of plaintiff to close: **September 25, 2003** (opening thirty days prior thereto)

Testimony period for party in position of defendant to close: **November 24, 2003**
(opening thirty days prior thereto)

Rebuttal testimony period to close: **January 08, 2004** (opening fifteen days prior thereto)

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NOTE: This proceeding is subject to the pilot project on telephone disposition of interlocutory matters. See the Official Gazette notice titled "*Pilot Project on Telephone Disposition of Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board*," 1213 TMOG 151 (August 18, 1998). A hard copy of the notice announcing the pilot project is available for a fee from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402 (Telephone (202) 512-1800). The notice is also available at

<http://www.uspto.gov>. Any interlocutory matter proposed for discussion or resolution during a Board approved phone conference may be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks, or during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

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

-----X
MILLIPORE CORPORATION,)
Petitioner,)
v.)
EPPENDORF-NETHELER-HINZ GMBH,)
Respondent.)
-----X

08-30-2002
U.S. Patent & TMO/TM Mail Rcpt Dt. #26

Cancellation No.

CERTIFICATE OF MAILING
I hereby certify that this correspondence is being deposited with the United States Postal Service, with sufficient postage as First Class Mail in an envelope addressed to Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.
on 8/27/02 Date Signature Stacy D. McGarry
STACY D. MCGARRY
Typed or printed name of person signing certificate

PETITION FOR CANCELLATION

Millipore Corporation, a Massachusetts Corporation, having its principal place of business at 80 Ashby Road, Bedford, Massachusetts 01730, hereby petitions for the cancellation of United States Trademark Registration No. 2,426,144, registered February 6, 2001 to Respondent, EPPENDORF-NETHELER-HINZ GMBH, of Barkhausenweg 1, D-22339 Hamburg, Germany, for the goods of "Reaction tubes, namely, microcentrifuge tubes for laboratory use," in Class 9. Petitioner believes it will be damaged if such registration remains on the Principal Register.

As grounds for cancellation it is alleged that:

1. Respondent has obtained a registration on the Principal Register with the United States Trademark Registration No. 2,426,144 for the goods of "Reaction tubes, namely, microcentrifuge tubes for laboratory use," in Class 9. This registration has not been cancelled.

2. Petitioner has been and is using goods having the design as shown in Respondent's registration since at least as early as 1991.

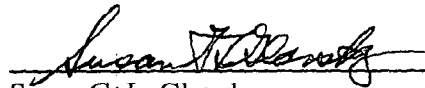
3. The design of Respondent's mark is functional. That is, the mark consists of the design of the identified goods that serves a utilitarian purpose.

4. Respondent's mark is generic. That is, the relevant purchasing public understands the mark primarily as the common or class identifier for the goods or services and not as an identifier of source.

5. The registration as issued to the Respondent places Respondent in a position to harass and cause annoyance to Petitioner and its customers, to the damage of the Petitioner. Such registration would inhibit Petitioner in its use of the design in its goods which would manifest damage upon Petitioner.

WHEREFORE, PETITIONER respectfully requests that Registration No. 2,426,144 of EPPENDORF-NETHELER-HINZ GMBH be cancelled from the Trademark Register.

Respectfully submitted,



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Attorneys for Petitioner

Dated: August 27, 2002

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08-30-2002

U.S. Patent & TMO/TM Mail Rpt Dt. #26

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on 8/27/02 Date
Stacy D. McGarry Signature
STACY D. MCGARRY
Typed or printed name of person signing certificate

August 27, 2002

BOX TTAB
FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

RE: Millipore Corporation v. Eppendorf-Netheler-Hinz GmbH
Petition to Cancel U.S. Trademark Registration No. 2,426,144
Our File Number: 0046.0125-001

Dear Sirs:

Enclosed for filing is a Petition for Cancellation the above-referenced registration, in duplicate, with Certificate of Mailing.

A check in the amount of \$300.00 (one class) is enclosed to cover the filing fee associated herewith. Please charge any additional amount due to our Deposit Account No. 08-0380. A copy of this letter is enclosed for accounting purposes.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By John L. Dupre
Susan G. L. Glovsky
Susan G. L. Glovsky
Attorney for Petitioner

SGLG/sdm
Enclosure

::ODMA\MHODMA\Manage;336130;1

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APPEAL BOARD
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