

ESTTA Tracking number: **ESTTA1101919**

Filing date: **12/15/2020**

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

Petition for Cancellation

Notice is hereby given that the following party has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	Meso Scale Diagnostics, LLC.		
Entity	Limited Liability Company	Citizenship	Delaware
Address	1601 RESEARCH BLVD. ROCKVILLE, MD 20850 UNITED STATES		

Correspondence information	KEITH A. WELTSCH SCULLY, SCOTT, MURPHY & PRESSER, P.C. 400 GARDEN CITY PLAZA, STE 300 GARDEN CITY, NY 11530 UNITED STATES Primary Email: intprop@ssmp.com Secondary Email(s): intprop@ssmp.com 516-742-4343		
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Registration Subject to Cancellation

Registration No.	6076021	Registration date	06/09/2020
Registrant	TAAG Genetics Corp 15300 VALLEY VIEW AVENUE 15300 VALLEY VIEW AVENUE LA MIRADA, CA 90638 UNITED STATES		

Goods/Services Subject to Cancellation

Class 001. First Use: 2019/10/01 First Use In Commerce: 2020/01/01 All goods and services in the class are subject to cancellation, namely: Reagent kits comprising generic DNA circle, DNA primers, polymerase and buffers for use in biotechnology fields
Class 010. First Use: 2019/10/01 First Use In Commerce: 2020/01/01 All goods and services in the class are subject to cancellation, namely: Diagnostic kits consisting primarily of probes, buffers and reagents for use in microbial testing

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
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Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	6091262	Application Date	11/07/2016
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Registration Date	06/30/2020	Foreign Priority Date	NONE
Word Mark	N-PLEX		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 001. First use: First Use: 2020/05/15 First Use In Commerce: 2020/05/15 Biological assays and kits, namely, self-assembled arrays for simultaneous, multiple detection of biological analytes and for use in the fields of biological and diagnostic testing for industrial, scientific and/or research use</p> <p>Class 005. First use: First Use: 2020/05/15 First Use In Commerce: 2020/05/15 Biological assays and kits, namely, self-assembled arrays for simultaneous, multiple detection of biological analytes and for use in the fields of biological and diagnostic testing for medical and/orveterinary use</p> <p>Class 009. First use: First Use: 2020/05/15 First Use In Commerce: 2020/05/15 Multi-well plates that can be used in chemical or biological analysis using electrochemiluminescence for scientific, laboratory or medical research use</p> <p>Class 042. First use: First Use: 2020/04/17 First Use In Commerce: 2020/04/17 Research and development in the fields of assays, selection, screening, testing, imaging and diagnostics using electrochemiluminescence</p>		

Attachments	Petition for Cancellation attachment.pdf(125209 bytes)
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Signature	/Keith A. Weltsch/
Name	Keith A. Weltsch
Date	12/15/2020

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

In the matter of U.S. Registration No. 6,076,021
Registered on June 9, 2020
For the Mark nPLEX

	X	
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Meso Scale Diagnostics, LLC.,	:	
	:	
Petitioner	:	
	:	Cancellation No.
v.	:	
	:	
TAAG Genetics Corp	:	
:	:	
	:	
Respondent.	:	
	X	

PETITION FOR CANCELLATION

Meso Scale Diagnostics, LLC., (“Petitioner”) a limited liability company organized under the laws of Delaware, believes that it will be damaged by the continued use and registration of the mark nPLEX registered under U.S. Reg. No. 6,076,021, and hereby petitions to cancel the same.

As grounds therefore it is alleged that:

1. TAAG Genetics Corp (“Respondent”), a California Corporation, obtained a registration for the mark nPLEX (“Respondent’s Mark”) covered by U.S. Reg. 6,076,021 for use with “Reagent kits comprising generic DNA circle, DNA primers, polymerase and buffers for use in biotechnology fields” in Class 1 and “Diagnostic kits consisting primarily of probes, buffers and reagents for use in microbial testing” in International Class 10 (collectively referred to “Respondent’s Goods”) on June 9, 2020.

2. Respondent filed an intent to use trademark application for Respondent’s Mark with the USPTO on March 29, 2019.

3. Respondent filed a Statement of Use with the USPTO associated with Respondent's Mark on April 16, 2020, asserting that it first used Respondent's Mark in commerce on January 1, 2020.

4. Petitioner is a company that primarily manufactures, markets and distributes a variety of biological assays and kits, as well as associated instruments, all primarily used to detect the presence of biological analytes in a variety of different fields.

5. Petitioner offers such assays and/or kits, in part, under a series of marks containing the wording "PLEX," preceded by a single letter and a dash. The registered marks that Petitioner owns that are used in conjunction with such assays and/or kits include the marks S-PLEX, U-PLEX, V-PLEX, T-PLEX, N-PLEX and R-PLEX (collectively referred to as "Petitioner's PLEX Marks").

6. Notably, Petitioner's registered trademark, N-PLEX ("Petitioner's N-PLEX Mark"), was registered under U.S. Reg. No. 6,091,262 for use with "Biological assays and kits, namely, self-assembled arrays for simultaneous, multiple detection of biological analytes and for use in the fields of biological and diagnostic testing for industrial, scientific and/or research use" in International Class 1, "Biological assays and kits, namely, self-assembled arrays for simultaneous, multiple detection of biological analytes and for use in the fields of biological and diagnostic testing for medical and/or veterinary use" in International Class 5, "Multi-well plates that can be used in chemical or biological analysis using electrochemiluminescence for scientific, laboratory or medical research use" in International Class 9 and "Research and development in the fields of assays, selection, screening, testing, imaging and diagnostics using electrochemiluminescence" in International Class 42 (collectively referred to as "Petitioner's Goods and Services").

7. Petitioner filed an intent-to-use application for Petitioner's N-PLEX application with the USPTO on November 7, 2016.

8. Petitioner obtained a U.S. trademark registration for Petitioner's N-PLEX mark on June 30, 2020 under U.S. Reg. No. 6,091,262.

9. Petitioner filed an application for the mark ULTRA N-PLEX under U.S. Serial No. 88/834,095 ("Petitioner's '095 Application") on March 13, 2020.

10. Petitioner's '095 Application has been rejected by the USPTO based on an alleged likelihood of confusion with Respondent's Mark.

11. Petitioner will be damaged, in part, if Petitioner's '095 Application is not able to proceed to registration based on confusion with Respondent's Mark, which was improperly registered based on its near identity to Petitioner's N-PLEX Mark.

12. Petitioner's filing date for Petitioner's N-PLEX Mark is earlier than both the filing date and the asserted date of first use in commerce for Respondent's Mark.

13. Petitioner is entitled to rely on its filing date for its intent to use application for Petitioner's N-PLEX Mark as its effective date of first use for priority purposes.

14. Petitioner's effective date of first use for Petitioner's N-PLEX Mark is earlier than both the filing date and the asserted date of first use in commerce for Respondent's Mark.

15. The registration for Petitioner's N-PLEX Mark is valid and subsisting.

16. Petitioner's N-PLEX Mark is inherently distinctive as applied to Petitioner's Goods and Services.

17. Petitioner's N-PLEX Mark is recognized by the general consuming public of the United States as a designation of source for Petitioner's Goods and Services.

18. By virtue of Petitioner's continuous use in commerce of Petitioner's N-PLEX Mark, Petitioner's Goods and Services have become favorably known to the relevant trade and public under Petitioner's N-PLEX Mark.

19. Respondent's Goods are related, and in some instances essentially identical, to Petitioner's Goods and Services that are sold or offered with Petitioner's N-PLEX Mark.

20. In the registration that is the subject of the instant Petition, there are no restrictions on trade channels, so it must be presumed that the goods identified in the registration will travel through all trade channels appropriate for goods of that type.

21. On information and belief, Respondent's Goods and Petitioner's Goods and Services are intended to be marketed through overlapping channels of trade and are intended to be sold to overlapping classes of purchasers.

22. Respondent's Mark is confusingly similar to Petitioner's N-PLEX Mark, because the marks are, at a minimum, highly similar, if not identical, visually, aurally and phonetically.

23. Respondent's Mark, as applied to Respondent's Goods, so resembles Petitioner's N-PLEX Mark, that it is likely to cause confusion, mistake and/or deception.

24. Any defect, objection to, or fault found with Respondent's Goods under Respondent's Mark would necessarily reflect on and seriously injure the reputation that Petitioner has established for Petitioner's Goods and Services.

25. In view of the above allegations, Respondent is not entitled to continue registration of Respondent's Mark because the same is likely to cause confusion with Petitioner's N-PLEX Mark.

26. Petitioner hereby requests that the required \$800 fee to cancel U.S. Reg. No. 6,076,021 proscribed under 37 C.F.R. §2.6 be withdrawn from Deposit Account No. 19-1013.

WHEREFORE, Petitioner respectfully prays that U.S. Reg. No. Registration No. 6,076,021 be canceled in its entirety.

Petitioner hereby appoints the following attorneys, to whom all correspondence should be addressed, to prosecute this Cancellation and transact all business in the Patent and Trademark

Office connected therewith:

Please address all correspondence to:

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Respectfully submitted,
Meso Scale Diagnostics, LLC.

Dated: December 15, 2020

By: Keith A. Weltsch
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