

ESTTA Tracking number: **ESTTA885398**

Filing date: **03/23/2018**

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	Quest Diagnostics Investments LLC
Granted to Date of previous extension	03/25/2018
Address	2711 Centerville Road, Suite 400 Wilmington, DE 19808 UNITED STATES

Attorney information	Shima S. Roy Baker & McKenzie LLP 300 E. Randolph Street, Suite 5000 Chicago, IL 60601 UNITED STATES Email: chisusptomail@bakermckenzie.com, david.davis@bakermckenzie.com, shima.roy@bakermckenzie.com Phone: 312-861-8005
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Applicant Information

Application No	79195950	Publication date	09/26/2017
Opposition Filing Date	03/23/2018	Opposition Period Ends	03/25/2018
International Registration No.	1318529	International Registration Date	07/13/2016
Applicant	PATHOQUEST 11 R WATT BIOPARK BATIMENT B F-75013 PARIS FRANCE		

Goods/Services Affected by Opposition

<p>Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Computers; computer systems, namely, software for compiling scientific and biological data and electronic databases recorded on computer media in the field of laboratory analysis and diagnostics; computer systems, namely, software for analyzing scientific and biological data and electronic databases recorded on computer media for scientific and biological use; computer systems comprised of computer hardware and peripherals and software for collecting, storing, analysis and reporting of biological information, and follow-up projects and monitoring of samples, workflows and laboratory data; chemical and biological analysis software; software for collecting, storing, analyzing, monitoring, and reporting and electronic databases recorded on computer media, all of the foregoing dedicated to the fields of diagnostics and metagenomics; software for detecting and analyzing of pathogens in a biological sample and electronic databases referencing publicly available collections of genomic information on bacteria and viruses recorded on computer media; laboratory apparatus and instruments for the detection of pathogens in a biological sample</p>
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Class 042. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Scientific testing services, namely, for testing and analysis in the field of DNA analysis; medical testing services in the field of pharmaceutical testing; microbiological testing services, namely, providing microbiological sample testing for others in the fields of medicine and research related thereto; computer-aided testing services, namely, genetic testing for research purposes; collection and analysis of blood for scientific purposes; preparation of biological samples to be analyzed in a laboratory; conducting analysis and products testing in the biological, pharmaceutical and bio-pharmaceutical fields; analysis and evaluation of the toxicity and safety of biological and pharmaceutical products, and their components; conducting analyses and tests by metagenomics; arranging and conducting of scientific and technical reports; advisory services relating to laboratory tests; scientific and medical laboratory services; services of laboratory for the preparation, detection, quantification and analysis of biological materials, for genotyping, for diagnostic tests and for the sequencing of biological molecules, genomes and metagenomes; laboratory services for DNA analysis; biological, bacteriological, medical and pharmacological research services; design, development and updating of software and databases dedicated to the fields of diagnostics and metagenomics; research and development in the field of genome research and genetic expression; biotechnology research and development


Class 044. First Use: 0 First Use In Commerce: 0


All goods and services in the class are opposed, namely: Medical diagnostic services, namely, testing and analysis in the field of disease diagnosis; collection and analyses of human blood for medical purposes; preparing and processing biological samples for medical and pharmaceutical use intended for analysis in laboratories, namely, disease diagnostics; medical analysis in the nature of medical testing for diagnosis; medical analysis in the nature of medical testing of biological molecules, genomes and metagenomes for diagnosing of pathogens and infectious diseases; medical and health services relating to DNA, genetics and genetic testing, namely, genetic counseling and genetic testing for medical purposes; DNA analysis services for medical purposes; preparation and compilation of medical reports; medical testing services relating to disease diagnosis and treatment; medical analysis services for the diagnosis and treatment of persons; carrying out disease diagnoses; medical testing for the diagnosis and treatment of persons

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	2365337	Application Date	09/23/1996
Registration Date	07/04/2000	Foreign Priority Date	NONE
Word Mark	QUEST		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1997/02/14 First Use In Commerce: 1997/02/14 providing clinical testing information services for the diagnosis, monitoring and treatment of disease		

U.S. Registration No.	3850293	Application Date	07/25/2001
Registration Date	09/21/2010	Foreign Priority Date	NONE
Word Mark	QUEST		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 005. First use: First Use: 1997/02/14 First Use In Commerce: 1997/02/14 Diagnostic reagents and assays for the treatment, monitoring, and diagnosis of disease, namely, infectious disease, allergies, microbial disease, pregnancy-related disease, bacterial disease, heart disease, viral disease, histological disease, genetic disease, blood-related disease, fungal disease, adrenal disease, cancer, liver disease, autoimmune disease, growth disorder, and diabetes; diagnostic reagents and assays for clinical and medical laboratory use; diagnostic reagents and assays for the treatment, monitoring, and diagnosis of disease; diagnostic reagents for clinical and medical laboratory use; diagnostic kits consisting primarily of diagnostic assays, specimenholders, diagnostic preparation agents, and specimen preparation agents for the treatment, monitoring, and diagnosis of disease; diagnostic kits consisting primarily of diagnostic assays, specimen holders, diagnostic preparation agents, and specimen preparation agents for clinical and medical use</p> <p>Class 035. First use: First Use: 1997/02/14 First Use In Commerce: 1997/02/14 Registration services, namely, database for tracking patient information for diagnostic testing; product demonstration services in the field of medical diagnostic testing; computerized database management of diagnostic testing and results; computerized database management of medical, hospital, insurance and billing records; and providing information regarding hospital billing records</p> <p>Class 039. First use: First Use: 1997/02/14 First Use In Commerce: 1997/02/14 computer services, namely, electronic storage and retrieval of messages and data in the fields of diagnostic testing and preparations for the treatment, monitoring and diagnosis of disease; computer services, namely, electronic storage and retrieval of biological specimens and diagnostic assays</p>		

U.S. Registration No.	2365335	Application Date	09/23/1996
Registration Date	07/04/2000	Foreign Priority Date	NONE
Word Mark	QUEST DIAGNOSTICS		

Design Mark	QUEST DIAGNOSTICS
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1997/02/14 First Use In Commerce: 1997/02/14 providing clinical testing information services for the diagnosis monitoring and treatment of disease

U.S. Registration No.	2356304	Application Date	11/07/1996
Registration Date	06/06/2000	Foreign Priority Date	NONE

Word Mark	QUEST DIAGNOSTICS
Design Mark	
Description of Mark	The mark consists of the letter "Q" within a sunburst design, all inside an ellipse and combined with the terms "QUEST DIAGNOSTICS".
Goods/Services	Class 042. First use: First Use: 1997/02/14 First Use In Commerce: 1997/02/14 clinical testing information services for the diagnosis, monitoring and treatment of disease

U.S. Registration No.	3107154	Application Date	07/02/2001
Registration Date	06/20/2006	Foreign Priority Date	NONE

Word Mark	QUEST DIAGNOSTICS
Design Mark	QUEST DIAGNOSTICS
Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 1997/02/14 First Use In Commerce: 1997/02/14 Printed reports featuring laboratory, clinical and diagnostic testing and results; printed information, namely, reports, pamphlets, brochures and leaflets featuring diagnostic testing and health information; printed information, namely, reports, pamphlets, brochures and leaflets providing information on medical, hospital, insurance, and billing records; and instruction sheets regarding medical testing

	<p>procedures and testing results</p> <p>Class 035. First use: First Use: 1997/02/14 First Use In Commerce: 1997/02/14 Computerized database management for tracking patient information for diagnostic testing; referral services in the fields of medical, health and clinical care; product demonstration services in the field of medical diagnostic testing; computerized data base management of diagnostic testing and results; computerized data base management of medical, hospital, insurance and billing records; and providing information regarding hospital billing records</p> <p>Class 039. First use: First Use: 1997/02/14 First Use In Commerce: 1997/02/14 Computer services, namely, electronic storage and retrieval of messages and data in the fields of diagnostic testing and preparations for the treatment, monitoring or diagnosis of disease; computer services, namely, electronic storage and retrieval of biological specimens and diagnostic assays</p> <p>Class 042. First use: First Use: 1997/02/14 First Use In Commerce: 1997/02/14 Medical and testing information services, namely, providing information regarding diagnostic testing results, testing procedures, disease conditions and disease prevention; providing information regarding medical and hospital records; and medical and scientific consultation services</p>
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U.S. Registration No.	3018131	Application Date	04/10/1999
Registration Date	11/22/2005	Foreign Priority Date	NONE
Word Mark	QUESTNET		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 036. First use: First Use: 1998/10/30 First Use In Commerce: 1998/10/30 CLINICAL DIAGNOSTIC LABORATORY BILL PAYMENT SERVICES OFFERED TO MANAGED CARE ORGANIZATIONS, HOSPITALS, EMPLOYERS, AND OTHER INSTITUTIONAL HEALTHCARE PROVIDERS</p> <p>Class 042. First use: First Use: 1998/10/30 First Use In Commerce: 1998/10/30 providing on-line clinical and trial laboratory data and information to managed-care organizations, hospitals, employers and other institutional healthcare providers; processing requests for diagnostic laboratory tests, performing diagnostic laboratory tests, and reporting diagnostic laboratory test results, all performed for managed care organizations, hospitals, employers, and other institutional healthcare providers; and providing quality assurance services for others relating to the foregoing services</p>		

U.S. Registration No.	3651796	Application Date	07/03/2007
Registration Date	07/07/2009	Foreign Priority Date	NONE
Word Mark	QUESTCARES		

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