

Applicant: Illumina Inc.  
Mark: MISEQ  
Serial No.: 88/491251  
Our Ref.: ILLINCT.566T2

The following is submitted in response to the Office Action issued on September 21, 2019 in connection with the mark MISEQ (“Applicant’s Mark”).

**I. IDENTIFICATION OF GOODS**

In the Office Action, the Examining Attorney requested amendments to the identification of goods. Accordingly, Illumina Inc. (“Applicant”) has amended the identification of goods as suggested by the Examining Attorney and in accordance with the U.S. Patent and Trademark Office’s Acceptable Identification of Goods and Services Manual as follows:

Class 1: **Biological** agents, reagents, assays, enzymes, nucleotides, buffers, chemical preparations, and biological preparations for **use in science and scientific research**; diagnostic reagents and preparations, other than for medical or veterinary use; kits containing reagents and a protocol for use thereof for **scientific and research** purposes; **biological** agents, reagents, assays, enzymes, nucleotides, buffers, chemical preparations, and biological preparations for scientific and research use in the fields of nucleic acid sequencing, genotyping, diagnostics, diagnostic research, clinical research, drug development, pharmaceuticals, laboratory research, scientific research, medical research, life sciences, biology, microbiology and metagenomics, biotechnology, agriculture, forensics, food safety, genetic testing, and genetics, not for medical or veterinary purposes; kits comprising nucleotides, reagents, enzyme substrates, buffers, chemical preparations, or biological preparations for scientific and research use including in the fields of nucleic acid sequencing, genotyping, diagnostics, diagnostic research, clinical research, drug development, pharmaceuticals, laboratory research, scientific research, medical research, life sciences, biology, microbiology and metagenomics, biotechnology, agriculture, forensics, food safety, genetic testing, and genetics, not for medical or veterinary purposes

***Comments Regarding Class 1 Goods:***

*kits comprising nucleotides, reagents, enzyme substrates, buffers, chemical preparations, or biological preparations for scientific and research use including in the fields of nucleic acid sequencing, genotyping, diagnostics, diagnostic research, clinical research, drug development, pharmaceuticals, laboratory research, scientific research, medical research, life sciences, biology, microbiology and metagenomics, biotechnology, agriculture, forensics, food safety, genetic testing, and genetics, not for medical or veterinary purposes*

The Examining Attorney originally requested additional information regarding the specific types of “kits” covered by the above language in Class 1, on the concern that the kits could

encompass Class 5. However, Applicant notes that the above wording already limits the kits to those for “scientific and research use” and also specifically states “not for medical or veterinary purposes” as shown in the underlined language above, and also includes the fields of use of the goods namely: “nucleic acid sequencing, genotyping, diagnostics, diagnostic research, clinical research, drug development, pharmaceuticals, laboratory research, scientific research, medical research, life sciences, biology, microbiology and metagenomics, biotechnology, agriculture, forensics, food safety, genetic testing, and genetics.” Additionally, the wording indicates what the kits are comprised of, namely: nucleotides, reagents, etc. This wording provides a clear description of the goods and their purpose, and removes the possibility that the kits would be belong in Class 5.

Applicant points the Examining Attorney to several of the goods listed in the ID manual which are comparable to those filed for herein:

[001-1119] Reagent kits comprising generic DNA circle, DNA primers, polymerase and buffers for use in biotechnology fields

[001-1159] Kit comprising regeneration solution, serum samples and sensor chips for scientific use

[001-705] reagents for scientific and research use

[001-1727] nucleotides for scientific and research use

[001-400] enzyme substrates

[001-1856] Chemical preparations for scientific purposes, other than for medical or veterinary use

[001-2098] Biological preparations for use in industry and science

Class 5: **Biological** agents, reagents, assays, enzymes, nucleotides, buffers, chemical preparations, and biological preparations for medical and veterinary use; diagnostic reagents and preparations for medical and veterinary use, **namely, for use in medical diagnostics**; kits containing reagents and a protocol for use thereof for medical purposes; kits comprised of nucleotides, reagents, enzyme substrates, buffers, chemical preparations, biological preparations for medical genetic testing and medical diagnostic purposes; agents, reagents, assays, enzymes, nucleotides, buffers, chemical preparations, and biological preparations for medical and veterinary use in the fields of medical diagnostics, clinical diagnostics, veterinary diagnostics, medical forensics, laboratory medicine, veterinary medicine, genetic testing, and genetics

***Comments Regarding Class 5 Goods:***

*Biological agents, reagents, assays, enzymes, nucleotides, buffers, chemical preparations, and biological preparations for medical and veterinary use*

The Examining Attorney requested the addition for the following language: “namely for use in the treatment of disease.” Applicant has already clarified that the biological agents, reagents, assays, enzymes, etc., are for medical and veterinary use and thus, no further clarification should be necessary.

Applicant points the Examining Attorney to several of the goods listed in the ID manual for Class 5 which are comparable to those filed for herein. Also applicant notes that the same goods were acceptable in Class 1 when designated as for “scientific and research purposes” and therefore, these goods should be acceptable in Class 5 when designated as for “medical and veterinary use.”

[005-788] Diagnostic agents, preparations and substances for medical purposes

[005-1786] Cellular function activating agents for medical purposes

[005-644] reagents for medical use

[005-1209] enzymes for medical purposes

[005-1700] enzymes for veterinary purposes

Applicant respectfully references the following recently issued trademark registrations, which contain similar language in Class 5.

Mark	Relevant Goods in Class 5	Reg. No. / Reg. Date
ENPC	Diagnostic preparations <b>for medical and veterinary use</b> ;	6011047 March 17, 2020
DTECT-ALL	Diagnostic preparations <b>for medical and veterinary use</b> ;	6010862 March 17, 2020
NEW D INNOVATION	bacterial preparations <b>for medical and veterinary use</b> ;	6005186 March 10, 2020
TERRAGENE	Bacteriological preparations <b>for medical and veterinary use</b>	5988027 February 18, 2020
EDIGENETX	Diagnostic preparations <b>for medical and veterinary use</b>	5981393 February 11, 2020
NOVAGRAY	diagnostic reagents <b>for medical and veterinary use</b>	5831539 August 13, 2019

Class 9: Laboratory devices for detecting genetic sequences; diagnostic apparatus for the detection of pathogens for laboratory or research use; scientific apparatus and instruments for use in genetic analysis; apparatus for DNA and RNA testing for research **and scientific** purposes; apparatus and instruments for testing gases, liquids, or solids **in the fields of nucleic acid sequencing, genotyping, medical diagnostics, veterinary diagnostics, clinical diagnostics,**

medical research, veterinary research, diagnostics, clinical research, drug development, pharmaceuticals, medical laboratory research, veterinary science and research, life sciences, biology, microbiology, biotechnology, agriculture, forensics, food safety, metagenomics, genetic testing, and genetics; DNA chips; ~~measuring and weighing apparatus and instruments; observation instruments;~~ data processing apparatus; computers; **computer** monitors; computer hardware; **downloadable and recorded** computer software for **sequencing and analysis of data in the field of DNA and RNA testing, genotyping, diagnostic research, and biotechnology;** **downloadable and recorded** computer software for use in **data analysis** in the fields of nucleic acid sequencing, genotyping, medical diagnostics, veterinary diagnostics, clinical diagnostics, medical research, veterinary research, diagnostic research, clinical research, drug development, drug development research, medical laboratory research, veterinary science and research, life sciences, biology, microbiology, biotechnology, agriculture, forensics, food safety, metagenomics, genetic testing and genetics; Scientific and research apparatus and instruments **namely,** nucleic acid sequencers **and** sequencing reagent cartridges and trays; ~~test sample preparation equipment, and laboratory equipment for laboratory use including in the fields of nucleic acid sequencing, genotyping, medical diagnostics, veterinary diagnostics, clinical diagnostics, medical research, veterinary research, diagnostics, clinical research, drug development, pharmaceuticals, medical laboratory research, veterinary science and research, life sciences, biology, microbiology, biotechnology, agriculture, forensics, food safety, metagenomics, genetic testing, and genetics;~~ micro processors; data processors; next-generation sequencing (NGS) bioinformatics data processor; cards with integrated circuits; computer chips; encoded electronic chip cards containing programming used for DNA sequencing

**Comments Regarding Class 9 Goods:**

1. “Scientific apparatus and instruments for use in genetic analysis” in Class 9

The Examining Attorney requested that Applicant provide more detail for the above-referenced goods. Applicant respectfully disagrees that further clarification is required because Applicant has already specified the intended use of the goods, namely for genetic analysis.

Applicant points the Examining Attorney to several of the goods listed in the ID manual which are comparable to those filed for herein:

- [009-3776] Laboratory devices for detecting genetic sequences
- [009-2570] air analysis apparatus

Applicant respectfully references the following recently registered trademark applications, which contain similar language in Class 9.

Mark	Relevant Goods in Class 9	Reg. No. / Reg. Date
PERSONAL GENOMICS	scientific instruments for genetic analysis	5748212 May 14, 2019

Mark	Relevant Goods in Class 9	Reg. No. / Reg. Date
OES	Scientific instruments for genetic analysis	5483913 June 5, 2018
MINISEQ	scientific instruments for use in genetic analysis	5296991 September 26, 2017
MISEQ FGX	scientific instruments for use in genetic analysis	5324062 October 31, 2017
HISEQ X	scientific instruments for use in genetic analysis	4705120 March 17, 2015

2. *“Apparatus for DNA and RNA testing for research and scientific purpose”* in Class 9

The Examining Attorney requested that the Applicant indicate the nature of the specific goods. Applicant respectfully disagrees that further clarification is required because Applicant has already specified the intended use of the goods, namely for DNA and RNA testing for research and scientific purposes.

Applicant points the Examining Attorney to several of the goods listed in the ID manual which are comparable to those filed for herein. The goods listed below are virtually identical in scope as “DNA and RNA testing” provides the same level of description as the phrases “detecting genetic sequences” and “DNA analysis” which are deemed acceptable:

[009-3776] Laboratory devices for detecting genetic sequences

[009-4779] Medical laboratory research instruments for DNA analysis

Class 10: Medical diagnostic apparatus and instruments for use in genetic analysis; medical diagnostic apparatus and instruments for the analysis of body fluids; apparatus for blood analysis; apparatus for DNA and RNA testing for medical purposes; medical and veterinary apparatus and instruments, **namely for use in medical diagnostics for detecting genetic abnormalities and disease**; analytical apparatus for medical purposes, **namely apparatus that test and sequence genetic material for use in medical diagnostics**; testing apparatus for medical purposes, **for testing genetic material for use in medical diagnostics**; medical diagnostic apparatus and instruments for use in preparing blood, bodily fluid and human biological samples for further testing and for the detection and identification of pathogen nucleic acids in blood, bodily fluids and biological samples; clinical and medical apparatus and instruments, including, nucleic acid sequencers; clinical and medical apparatus and instruments, **namely**, nucleic acid sequencers, nucleic acid analyzers, sample and library preparation devices **for medical diagnosis, testing, and treatment purposes** including in the fields of nucleic acid sequencing, genotyping, medical diagnostics, veterinary diagnostics, clinical diagnostics, ~~medical research, veterinary research,~~ diagnostics, ~~clinical research~~, drug development, pharmaceuticals, ~~medical laboratory~~

~~research, veterinary science and research~~, life sciences, biology, microbiology, biotechnology, agriculture, forensics, food safety, metagenomics, genetic testing, and genetics

## II. CONCLUSION

Applicant submits that it has responded to all outstanding issues raised in the Office Action. Applicant respectfully requests that the Examining Attorney pass the application to publication. Should the Examining Attorney have any questions, the Examining Attorney is encouraged to contact the undersigned.

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