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

Proceeding	91223528
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Date	02/04/2016
Attachments	Amended Answer to Clariant Opposition - Final.pdf(120301 bytes)

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

CLARIANT CORPORATION,

Opposer,

v.

MULTISORB TECHNOLOGIES, INC.,

Applicant.

Opposition No. 91223528
Application No. 86/569,259

Mark: DESIPAX

**APPLICANT’S FIRST AMENDED ANSWER TO OPPOSER’S NOTICE OF
OPPOSITION**

Pursuant to the Board’s Order (at Dkt. No. 12 TTABVUE 5) filed on January 20, 2016, Applicant Multisorb Technologies, Inc. (“Applicant” or “Multisorb”) submits its first amended answer to Opposer Clariant Corporation’s (“Opposer”) Notice of Opposition (“Opposition”) against Applicant’s Trademark Application Serial No. 86/569,259 for the mark DESIPAX and specifically admits, denies, and alleges as follows:

1. Applicant admits the allegations in paragraph 1 of the Opposition.
2. Applicant admits the allegations in paragraph 2 of the Opposition.
3. Applicant admits all of the allegations in paragraph 3 of the Opposition, except for the allegation that the Opposition was timely filed, which is a legal conclusion and does not require an Answer. To the extent that further answer is necessary, Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of this and therefore denies it.
4. Applicant admits that the United States Patent and Trademark Office records regarding U.S. Trademark Registration No. 1,369,682 reflects the current owner of record as Clariant, and Applicant admits that the goods listed in U.S. Trademark Registration No.

1,369,682 are “PREPACKAGED DESICCANTS FOR USE IN CLOSED PACKAGES FOR MACHINE PARTS, ELECTRONIC COMPONENTS, SURGICAL INSTRUMENTS AND SUPPLIES, TOOLS, PHARMACEUTICALS, FOOD AND FILM.” Applicant admits that U.S. Trademark Registration No. 1369682 is registered on the Principle Register. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the claim of ownership made in paragraph 4 of the Opposition and therefore denies such allegation.

5. Paragraph 5 of the Opposition states legal conclusions of the Opposer, to which no answer is required. To the extent that further answer is necessary, Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations of paragraph 5 and therefore denies such allegations.

6. Paragraph 6 of the Opposition states legal conclusions of the Opposer, to which no answer is required. To the extent that further answer is necessary, Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations of paragraph 6 and therefore denies such allegations.

7. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations in paragraph 7 of the Opposition and therefore denies such allegations.

8. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations in paragraph 8 of the Opposition and therefore denies such allegations.

9. Paragraph 9 of the Opposition states legal conclusions of the Opposer, to which no answer is required. To the extent that further answer is necessary, Applicant lacks sufficient

knowledge or information to form a belief as to the truth or falsity of the allegations of paragraph 9 and therefore denies such allegations.

10. Paragraph 10 of the Opposition states legal conclusions of the Opposer, to which no answer is required. To the extent that further answer is necessary, Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations of paragraph 10 and therefore denies such allegations.

11. Paragraph 11 of the Opposition states legal conclusions of the Opposer, to which no answer is required. To the extent that further response is necessary, Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations of paragraph 11 and therefore denies such allegations.

COUNT I
LIKILHOOD OF CONFUSION

12. Applicant repeats and realleges each and every answer stated in Paragraphs 1-11 above as if fully set forth herein.

13. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations of paragraph 13 of the Opposition and therefore denies such allegations.

14. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations of paragraph 14 of the Opposition and therefore denies such allegations.

15. Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations of paragraph 15 of the Opposition and therefore denies such allegations.

16. Applicant denies the allegations set forth in paragraph 16 of the Opposition.

17. Paragraph 17 of the Opposition states legal conclusions of the Opposer, to which no answer is required. To the extent that further answer is necessary, Applicant lacks sufficient knowledge or information to form a belief as to the truth or falsity of the allegations of paragraph 17 and therefore denies such allegations.

COUNT II
LIKILHOOD OF DILUTION

18. Applicant repeats and realleges each and every answer stated in Paragraphs 1-17 above as if fully set forth herein.

19. Applicant denies the allegations set forth in paragraph 19 of the Opposition. Additionally, Paragraph 19 of the Opposition states legal conclusions of the Opposer, to which no answer is required.

20. Applicant denies the allegations set forth in paragraph 20 of the Opposition. Additionally, Paragraph 20 of the Opposition states legal conclusions of the Opposer, to which no answer is required.

21. Applicant denies the allegations set forth in paragraph 21 of the Opposition. Additionally, Paragraph 21 of the Opposition states legal conclusions of the Opposer, to which no answer is required.

22. Applicant denies the allegations set forth in paragraph 22 of the Opposition. Additionally, Paragraph 22 of the Opposition states legal conclusions of the Opposer, to which no answer is required.

AMENDED COUNTERCLAIM TO CANCEL REGISTRATION

23. Applicant repeats and realleges each and every allegation set forth in the foregoing paragraphs as if fully set forth herein.

24. Applicant hereby seeks cancellation of U.S. Trademark Registration No. 1,369,682 (“DESI PAK”) for all the goods listed therein, as to which Opposer claims actual use, namely, “PREPACKAGED DESICCANTS FOR USE IN CLOSED PACKAGES FOR MACHINE PARTS, ELECTRONIC COMPONENTS, SURGICAL INSTRUMENTS AND SUPPLIES, TOOLS, PHARMACEUTICALS, FOOD AND FILM,” all in International Class 001.

First Ground—Abandonment

25. Upon information and belief, Opposer failed to use the DESI PAK mark in commerce for at least three consecutive years, with an intention not to resume use, during the period of 2005 through 2013.

26. Applicant’s information and believe is based upon Applicant’s communications with Opposer prior to Applicant filing a response and counterclaim. In those communications, Applicant told Opposer that it would voluntarily withdraw its application for the DESIPAX mark if Opposer could demonstrate continuous use of its DESI PAK mark for at least the last ten years.

27. Opposer submitted marketing material to Applicant in the form of screenshots from the Internet Archive (Wayback Machine) website, but no proof of sales were provided, despite Applicant’s request that at least some minimal evidence of actual sales in commerce of Opposer’s DESI PAK mark be provided. Opposer did not and has not provided additional information or evidence of actual use of the DESI PAK mark in interstate commerce.

28. Specifically, on October 1, 2015, counsel for Clariant submitted screenshots of webpages from the website Internetarchive.com, known also as the “Wayback Machine”. The Internet Archive is an online “library” that takes snapshots of individual pages of a website of a particular moment in time. The dates of the webpages provided were March 19, 2005; April 28, 2006; October 27, 2007; December 4, 2008; May 9, 2009; April 12, 2010; April 24, 2011; April 12, 2012; August 3, 2013; July 1, 2014. They also submitted two product information sheets found on Clariant’s website, one from the Wayback Machine from 2013, the other a print screen from Clariant’s current website (as of October 2015).

29. None of the above listed documents is evidence of any actual sale of a product bearing the DESI PAK trademark in the US or anywhere else. Neither do the documents show a website from which the product could be purchased (a requirement for a website to demonstrate use in commerce specifically required in TMEP 904(3)(i).) Instead, the documents only list a phone number and email address to call for more information or samples. At best the websites are advertising or promotional material, and not evidence of use on product. Because the website screenshots and product information sheets provided to Applicant by Opposer do not show any use of the mark in commerce, Opposer formed a belief that Applicant was not using the mark.

30. On October 2, 2015, counsel for Applicant informed counsel for Opposer that Applicant would need additional information and actual proof of sales in order for Opposer to withdraw its application. Opposer never provided the additional requested evidence.

31. Opposer has also relied upon “declarations of continued use” under section 8 (filed in 1991, 2005, and 2015) and a declaration under section 15 (filed in 1991) as evidence of continued use. Applicant does not dispute that Opposer filed declarations on these dates. The evidence provided by these declarations alleges continuous use from 1985 to 1991 (via the

section 15 declaration), but only two instances of use from 1991 to 2015 because the most recent declarations under Section 8 only allege use as of the dates of the declarations (2005 and 2015), and not continuous use between 1991 and 2015. As such, Applicant does not agree that these declarations of use allege, let alone demonstrate, continuous use of the mark in commerce over a period of time that would eliminate the possibility that Opposer ceased using the mark for at least three years between 1991 and 2005 or between 2005 and 2015. The declarations do not change.

32. Based upon Opposer's failure to provide Applicant with proof of continuous use of its DESI PAK mark in commerce sufficient to eliminate the possibility of abandonment, it is Applicant's opinion and belief that Opposer ceased using the DESI PAK mark, with an intention not to resume use, for at least one three-year period between 2005 and 2015.

33. Opposer has therefore abandoned the DESI PAK mark by discontinuing use of the mark for each of the goods listed therein, with an intention not to resume use, and accordingly, Registration No. 1,369,682 should be cancelled.

WHEREFORE, Applicant requests that Registration No. 1,369,682, be cancelled, the Opposition be dismissed and that Serial No. 86/569,259 be allowed to register.

Respectfully submitted this 4th day of February 2016.



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CERTIFICATE OF SERVICE

I hereby certify that on this 4th day of February 2016, the foregoing Applicant's First Amended Answer to Opposer's Notice of Opposition was served upon Opposer's attorney of record by sending via email, per the parties' agreement, as follows:

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