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

Proceeding	92052388
Party	Plaintiff Pac-Dent International, Inc.
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Submission	Opposition/Response to Motion
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Date	06/14/2010
Attachments	opposition to motion suspend 388 cancellation.pdf (3 pages)(91825 bytes)

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

PAC-DENT INTERNATIONAL, INC, Petitioner, v. SULZER MIXPAC AG, Registrant.	Cancellation No. 92052388

OPPOSITION TO MOTION TO SUSPEND

Petitioner Pac-Dent International, Inc. ("Petitioner") submits this Memorandum of Law in Opposition to the Motion filed by Registrant Sulzer Mixpac AG ("Registrant"), to suspend the instant cancellation based on a civil action currently pending between the parties ("the Civil Action"). For the reasons discussed below, it is respectfully submitted that Registrant's Motion should be denied.

The Civil Action and the instant Cancellation address different issues, and therefore, it is not necessary to suspend the instant Cancellation.

In particular, as Registrant correctly points out, the Civil Action will determine whether Petitioner's product "is confusingly similar to, and infringes" the mark covered by the Registration which is the subject of the instant Cancellation ("Registrant's Mark"). The instant Cancellation does **not** address whether Petitioner's product is confusing similar to or infringes Registrant's Mark. Rather, the instant Cancellation addresses whether Registrant's Mark is entitled to registration in the first instance - *i.e.*, whether it should have been denied registration on a number of grounds, including without limitation, use of a defective specimen of use, lack of

secondary meaning, functionality, *etc*. Indeed, the Board is not authorized to determine issues of infringement and can **only** determine issues of registrability. *See*, *e.g.*, Gary D. Krugman, *Trademark Trial and Appeal Board Practice and Procedure*, § 3:4 (2009-2010) ("The only issue before the TTAB [in a cancellation] is the entitlement of the defendant to maintain its registration.").

Based on the foregoing, it is respectfully submitted that Registrant's Motion to Suspend be denied in all respects.

Respectfully submitted,

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Dated: New York, New York
June 14, 2010

By: _____
Philip H. Gottfried
Holly Pekowsky

CERTIFICATE OF SERVICE

The undersigned hereby certifies that she is one of the attorneys for Petitioner in the above-captioned Cancellation proceeding and that on the date which appears below, she caused a copy of the foregoing Opposition to Motion To Suspend to be served on Registrant by Federal Express, postage pre-paid, as follows:

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Dated: New York, New York
June 14, 2010