

ESTTA Tracking number: **ESTTA559037**

Filing date: **09/12/2013**

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 requests to cancel indicated registration.

Petitioner Information

Name	Multisorb Technologies, Inc.		
Entity	Corporation	Citizenship	New York
Address	325 Harlem Road Buffalo, NY 14224 UNITED STATES		

Attorney information	Kimberly I. Shimomura Harter Secrest & Emery LLP 1600 Bausch & Lomb Place Rochester, NY 14604 UNITED STATES kshimomura@hselaw.com Phone:585-231-1382		
----------------------	---	--	--

Registration Subject to Cancellation

Registration No	3859182	Registration date	10/12/2010
International Registration No.	NONE	International Registration Date	NONE
Registrant	CLARIANT INTERNATIONAL AG ROTHAUSSTRASSE 61 4132 MUTTENZ, SWITZERLAND		

Goods/Services Subject to Cancellation

Class 020. All goods and services in the class are cancelled, namely: Packaging containers of plastic
--

Grounds for Cancellation

The mark is merely descriptive	Trademark Act section 2(e)(1)
--------------------------------	-------------------------------

Related Proceedings	91212441
---------------------	----------

Attachments	Petition to Cancel to File.PDF(511353 bytes)
-------------	---

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Kimberly I. Shimomura/
Name	Kimberly I. Shimomura
Date	09/12/2013

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

MULTISORB TECHNOLOGIES, INC.,

PETITIONER,

v.

CLARIANT INTERNATIONAL AG,

REGISTRANT.

PETITION TO CANCEL

REGISTRATION NO. 3859182

CANCELLATION NO.:

Multisorb Technologies, Inc. (“Multisorb”), by its attorneys Harter Secrest & Emery LLP, as and for its Petition to Cancel against Clariant International AG (“Clariant”) regarding United States Trademark Registration No. 3859182 (the “Registration”), alleges as follows:

PARTIES

1. Multisorb is a New York corporation with its principal place of business at 325 Harlem Road, Buffalo, New York 14224.
2. Upon information and belief, Clariant is corporation organized under the laws of Switzerland, with a place of business at Rothausstrasse 61, 4132 Muttenz, Switzerland.

BACKGROUND

3. Multisorb develops, manufactures, and sells a full range of sorbent products, including plastic packaging containers that contain sorbents. These containers are used to extend the stability and shelf life of various goods and are used commonly in the food, beverage, and pharmaceutical industries. In addition, Multisorb develops, manufactures, and sells other sorbent products in a variety of forms (sachets, packets, canisters, etc.) for use in preventing oxidization in a variety of applications, including, but not limited to food, beverage, and pharmaceutical

applications.

4. Like Multisorb, Clariant develops, manufactures, and sells sorbent products in the form of packaging containers for use in the food, beverage, and pharmaceutical industries.

Clariant also produces sorbent packaging inserts in a variety of forms (including, packets) for use in a variety of industries.

5. Multisorb and Clariant directly compete in the sorbent products industry. Both companies offer sorbents in container form, as well as in the form of packets, sachets, and canisters to be inserted in packaging for use in a wide variety of industries.

6. On October 12, 2010, the USPTO issued Registration No. 3859182 for the mark OXY-GUARD for “packaging containers of plastic” in International Class 020 (“Registrant’s Goods”). A copy of the USPTO’s record of the Registration is attached as Exhibit A.

7. The Registration originally issued to Sud-Chemie AG. An assignment of Sud-Chemie AG’s entire interest in the Registration to Sud-Chemie IP GMBH & Co. KG was recorded with the USPTO on June 19, 2012. An assignment of Sud-Chemie IP GMBH & CO. KG’s entire interest in the Registration to Clariant International AG was recorded with the USPTO on March 21, 2013. A copy of the USPTO record of these assignments is attached as Exhibit B.

STANDING

8. Standing to assert a descriptiveness claim is shown by the petitioner having an interest in using the descriptive term in its business.

9. A competitor has a present or prospective right to use the term at issue descriptively in its business and therefore is presumed to have standing to petition to cancel on descriptiveness grounds.

10. As a competitor in the sorbent industry, Multisorb has a present and prospective

right to use the mark at issue to describe its products in the course of its business.

11. Therefore, Multisorb has standing to seek to cancel the Registration.

GROUND: DESCRIPTIVENESS

12. Clariant owns the Registration, which is for the mark OXY-GUARD for “packaging containers of plastic.”

13. Clariant actually uses the mark OXY-GUARD with a specific type of packaging: packaging that guards against the entry of oxygen.

14. Attached are the following exhibits showing how Clariant uses the mark OXY-GUARD in connection with packaging:

- a. Exhibit C - Clariant’s website showing its OXY-GUARD plastic barrier bottles, which are described as “bottles [that] effectively block oxygen ingress by a factor of 100 compared to regular bottles...”; and
- b. Exhibit D - Clariant’s Product Sheet for its OXY-GUARD plastic barrier bottles, which Clariant describes the bottles as providing “barrier protection from oxygen.”

15. OXY-GUARD, when used for “packaging containers of plastic,” merely describes Registrant’s Goods.

16. The qualities, features, functions, purpose, and use of Registrant’s Goods are to guard against oxygen reaching the product stored inside the packaging.

17. OXY-GUARD is merely descriptive of Registrant’s Goods because it describes the qualities, features, functions, purpose, and use of such goods.

18. Because OXY-GUARD is merely descriptive of Registrant’s Goods, the Registration should be cancelled under Lanham Act § 2(e)(1); 15 U.S.C. § 1052(e)(1).

WHEREFORE, Multisorb respectfully requests that its Petition to Cancel the

Registration be sustained and that the Registration be cancelled.

September 12, 2013

HARTER SECRET & EMERY LLP

By: /s/ Kimberly I. Shimomura
Kimberly I. Shimomura, Esq.
*Attorneys for Petitioner Multisorb
Technologies, Inc.*
1600 Bausch & Lomb Place
Rochester, New York 14604
Tel: (585) 232-6500
Kshimomura@hselaw.com

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing **PETITION TO CANCEL** was sent via U.S. Mail, First Class Postage Prepaid to Counsel for Applicant Katrin Lewertoff, Esq., and Michael A. Grow, Esq., Arent Fox LLP, 1675 Broadway, New York, New York 10019-5820 on September 12, 2013.

/s/ Kimberly I. Shimomura
Kimberly I. Shimomura

Exhibit A



United States Patent and Trademark Office

Home | Site Index | Search | FAQ | Glossary | Guides | Contacts | eBusiness | eBiz alerts | News | Help

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Wed Sep 11 03:20:34 EDT 2013

[TESS HOME](#)
[NEW USER](#)
[STRUCTURED](#)
[FREE FORM](#)
[BROWSE DICT](#)
[SEARCH OG](#)
[BOTTOM](#)
[HELP](#)
[PREV LIST](#)
[CURR LIST](#)

[NEXT LIST](#)
[FIRST DOC](#)
[PREV DOC](#)
[NEXT DOC](#)
[LAST DOC](#)

[Logout](#) Please logout when you are done to release system resources allocated for you.

[Start](#) List At: _____ OR [Jump](#) to record: **Record 2 out of 5**

[TSDR](#)
[ASSIGN STATUS](#)
[LEGAL STATUS](#)
 (Use the "Back" button of the Internet Browser to return to TESS)

OXY-GUARD

Word Mark OXY-GUARD
Goods and Services IC 020. US 002 013 022 025 032 050. G & S: Packaging containers of plastic
Standard Characters Claimed
Mark Drawing Code (4) STANDARD CHARACTER MARK
Trademark Search Facility Classification Code NOTATION-SYMBOLS Notation Symbols such as Non-Latin characters,punctuation and mathematical signs,zodiac signs,prescription marks
Serial Number 77823729
Filing Date September 10, 2009
Current Basis 44E
Original Filing Basis 44D
Published for Opposition July 27, 2010
Registration Number 3859182
Registration Date October 12, 2010

Owner (REGISTRANT) Süd-Chemie AG CORPORATION FED REP GERMANY Lenbachplatz 6 D-80333 München FED REP GERMANY

(LAST LISTED OWNER) CLARIANT INTERNATIONAL AG CORPORATION SWITZERLAND ROTH AUSSTRASSE 61 4132 MUTTENZ SWITZERLAND

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Katrin Lewertoff and Michael A. Grow

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

TESS HOME	NEW USER	STRUCTURED	FREE FORM	BROWSE DICT	SEARCH OG	TOP	HELP	PREV LIST	CURR LIST
NEXT LIST	FIRST DOC	PREV DOC	NEXT DOC	LAST DOC					

[|.HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)

Exhibit B



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)Assignments on the Web > Trademark Query**Trademark Assignment Abstract of Title****Total Assignments: 2**Serial #: 77823729

Filing Dt: 09/10/2009

Reg #: 3859182

Reg. Dt: 10/12/2010

Registrant: Süd-Chemie AG

Mark: OXY-GUARD

Assignment: 1Reel/Frame: 4803/0758

Recorded: 06/19/2012

Pages: 3

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: SUED-CHEMIE AG

Exec Dt: 06/13/2012

Entity Type: CORPORATION

Citizenship: GERMANY

Assignee: SUED-CHEMIE IP GMBH & CO. KG

LENBACHPLATZ 6

80333 MUENCHEN, GERMANY

Entity Type: LIMITED PARTNERSHIP

Citizenship: GERMANY

Correspondent: KATRIN LEWERTOFF AND MICHAEL A. GROW

ARENT FOX LLP

1675 BROADWAY

NEW YORK, NY 10019

Domestic rep: KATRIN LEWERTOFF

ARENT FOX LLP

1675 BROADWAY

NEW YORK, NY 10019

Assignment: 2Reel/Frame: 4987/0596

Recorded: 03/21/2013

Pages: 3

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: SUED-CHEMIE IP GMBH & CO. KG

Exec Dt: 03/12/2013

Entity Type: LIMITED PARTNERSHIP

Citizenship: GERMANY

Assignee: CLARIANT INTERNATIONAL AG

ROTHAUSSTRASSE 61

4132 MUTTENZ, SWITZERLAND

Entity Type: CORPORATION

Citizenship: SWITZERLAND

Correspondent: KATRIN LEWERTOFF AND MICHAEL A. GROW

ARENT FOX LLP

1675 BROADWAY

NEW YORK, NY 10019

Domestic rep: KATRIN LEWERTOFF

ARENT FOX LLP

1675 BROADWAY

NEW YORK, NY 10019

Search Results as of: 09/11/2013 05:35 PM

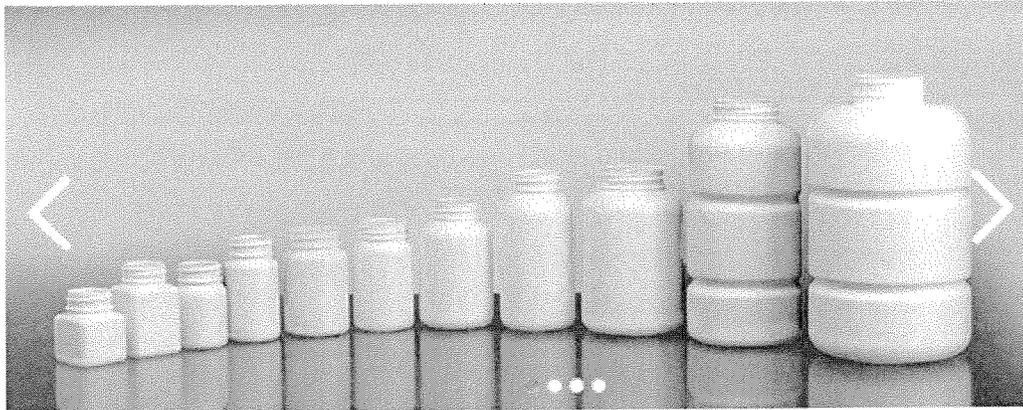
If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.3.4
Web interface last modified: Jul 8, 2013 v.2.3.4| [.HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)

Exhibit C



- PRODUCTS
- INDUSTRY SOLUTIONS
- INNOVATION
- NEWS & EVENTS
- LOCATIONS
- CONTACT US
- ABOUT US

OXY-GUARD® BARRIER BOTTLES



DOWNLOAD CENTER

- > Product Profile 
- > Product Catalog 

Clariant specializes in protective packaging technologies, including multi-layer extrusion blow molded pharmaceutical containers.

In order to inhibit the oxidation of sensitive drugs, our barrier bottles are engineered with six layers, one of which includes Ethylene Vinyl Alcohol (EVOH). Oxy-Guard® bottles effectively block oxygen ingress by a factor of 100 compared to regular bottles and also provide an excellent barrier against moisture. The six-layer structure can also incorporate a UV barrier, as well as customer-specific resins and design characteristics.

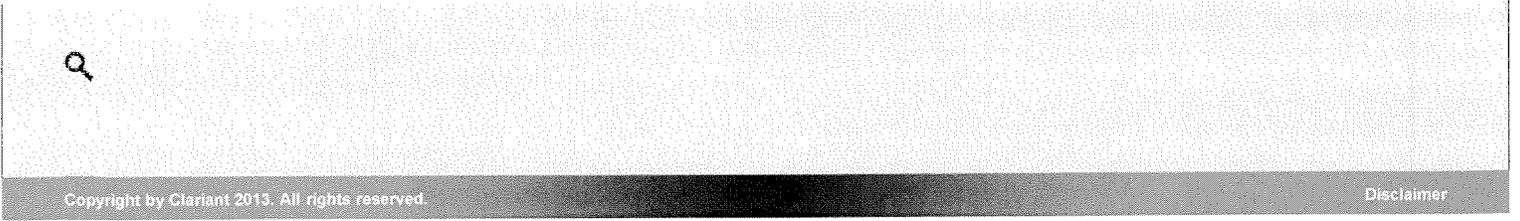
Clariant works with customers to customize performance parameters, materials and bottle design.

For a complete solution, Oxy-Guard bottles can be used in conjunction with PharmaKeep® oxygen absorbers which absorb the oxygen contained in the container headspace after drug filling and the small amount of oxygen that may still permeate into the container during shelf life.

OUR PROMISE

We create added value by appreciating the needs of our customers - with competitive and innovative solutions. The needs of our employees - by adhering to our company values. The needs of our shareholders - with above-average returns. And the needs of our environment - by acting sustainably.

Oxy-Guard Barrier Bottles provide barrier against moisture degradation



Copyright by Clariant 2013. All rights reserved.

Disclaimer

Exhibit D

Product Sheet

OXY-GUARD® BARRIER BOTTLES

CLARIANT

PHARMACEUTICAL
CONTAINERS WITH
ULTRA OXYGEN
PROTECTION



Purpose

Oxy-Guard® barrier bottles provide barrier protection in pharmaceutical applications to inhibit oxidation and enhance shelf life of drug products.

What are they?

Oxy-Guard bottles are extrusion blow-molded 6-layer pharmaceutical containers offering several times the barrier protection from oxygen than standard polyethylene bottles of similar size.

Why use them?

Oxidation – besides moisture – is one of the major pathways for degradation of pharmaceuticals during production, isolation processes and storage. In pharmaceutical formulations, oxidation of proteins and active pharmaceutical substances can present significant stability problems affecting efficacy and shelf life and causing other undesirable side effects. When evaluating drug properties during formulation, the need to address susceptibility to oxidation can extend development time and costs. Time-to-market can be shortened by addressing oxidative stability with appropriate drug packaging instead of in the drug formulation itself. Furthermore, chemical agents that would otherwise be out of the running due to their susceptibility to oxidation could be considered.

Oxy-Guard bottles effectively block oxygen ingress by a factor of 100 compared to regular bottles and also provide an excellent barrier against moisture. A full range of standard sizes are available. As all Oxy-Guard bottle neck finishes are SP 400, any pharmaceutical screw cap produced according to this standard can be used. The 6-layer structure can also incorporate a UV barrier, as well as customer-specific resins and design characteristics. Clariant can work with customers to customize performance parameters, materials and bottle design.

For a complete solution, Oxy-Guard bottles can be used in conjunction with PharmaKeep® oxygen scavengers, which absorb the oxygen contained in the container headspace after drug filling and the small amount of oxygen that may still permeate into the container during shelf life.

CLARIANT INTERNATIONAL LTD
Healthcare Packaging
– BL Medical Specialties

Europe
Phone: +33 1 41 76 20 00
healthpack.eu@clariant.com

Americas
Phone: +1 909 825 1793
healthpack@clariant.com

Australia
Phone: +61 247 321 421
healthpack.au@clariant.com

Asia
Phone: +86 (0) 21 6218 9556, 6218 4480
healthpack.as@clariant.com

India
Phone: +91 22 2207 5133
healthpack.in@clariant.com

HEALTHPACK.CLARIANT.COM

COPYRIGHT ©
CLARIANT INTERNATIONAL LTD 2013

Available Configurations

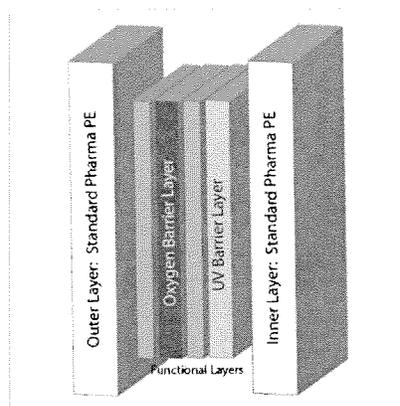
With both standard and customized configurations available, bottles sizes range from 40 ml to 750 ml.

Key Advantages

- Oxy-Guard Bottles protect pharmaceutical products from oxidation
- Oxygen ingress is blocked by a factor of 100 compared to regular polyethylene bottles.
- With PharmaKeep® oxygen scavengers, a complete oxygen protection package is available.



Oxy-Guard® Barrier Bottles are available in several sizes and configurations and feature a standard SP 400 neck.



The 6-layer bottle structure offers barrier against oxygen and moisture as well as tailor-made features such as UV protection and incorporation of specified resins.

This information corresponds to the present state of our knowledge and is intended as a general description of our products and their possible applications. Clariant makes no warranties, express or implied, as to the information's accuracy, adequacy, sufficiency or freedom from defect and assumes no liability in connection with any use of this information. Any user of this product is responsible for determining the suitability of Clariant's products for its particular application. * Nothing included in this information waives any of Clariant's General Terms and Conditions of Sale, which control unless it agrees otherwise in writing. Any existing intellectual/industrial property rights must be observed. Due to possible changes in our products and applicable national and international regulations and laws, the status of our products could change. Material Safety Data Sheets providing safety precautions, that should be observed when handling or storing Clariant products, are available upon request and are provided in compliance with applicable law. You should obtain and review the applicable Material Safety Data Sheet information before handling any of these products. For additional information, please contact Clariant.

* For sales to customers located within the United States and Canada the following applies in addition: NO EXPRESS OR IMPLIED WARRANTY IS MADE OF THE MERCHANTABILITY, SUITABILITY, FITNESS FOR A PARTICULAR PURPOSE OR OTHERWISE OF ANY PRODUCT OR SERVICE.



Clariant International Ltd