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

Proceeding	92061895
Party	Defendant Prolmmune Limited
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

5350-16

PROOVE BIOSCIENCES, INC.)	
)	
Petitioner,)	
)	Cancellation No. 92061895
v.)	Registration No. 3,250,168
)	Mark: PROVE
PROIMMUNE LIMITED)	
)	
)	
Registrant.)	

ANSWER TO AMENDED PETITION FOR CANCELLATION

Registrant, ProImmune Limited, hereby answers the Amended Petition for Cancellation in the following manner:

1. Registrant is without knowledge or information sufficient to form a belief as to the truth of any of the allegations in Paragraph 1 of the Amended Petition for Cancellation, and therefore, denies all of the allegations in Paragraph 1.
2. Admitted.
3. Registrant denies that Petitioner is currently and will continue to be damaged by Registration No. 3,250,168. Registrant admits that Petitioner has petitioned to cancel Registration No. 3,250,168.
4. Registrant admits that a copy of a Notice of Docketing dated September 24, 2015 in the United States Court of Appeals for the Federal Circuit for Application Serial No. 86/085,515 is attached as Exhibit A to the Amended Petition for Cancellation. Registrant is without knowledge or information sufficient to form a belief as to the truth of any of the remaining allegations in Paragraph 4 of the Amended Petition for

Cancellation, and therefore, denies all of the remaining allegations in Paragraph 4.

FIRST GROUNDS FOR CANCELLATION - GENERICNESS

5. Registrant admits that Registration No. 3,250,168 includes services in International Class 42 for “Scientific and technical research and design services in the field of biomedical sciences.” Registrant admits that “Petitioner maintains that Registrant has abandoned and has not used the mark PROVE for the services in International Class 042.” Registrant denies the remaining allegations in Paragraph 5 of the Amended Petition for Cancellation.

6. Registrant denies that the word “prove” is a common term that the relevant purchasing public understands primarily as describing the genus of services in International Class 42 for “scientific and technical research and design services in the field of biomedical sciences.” Registrant is without knowledge or information sufficient to form a belief as to the truth of any of the remaining allegations in Paragraph 6 of the Amended Petition for Cancellation, and therefore, denies all of the remaining allegations in Paragraph 6. To “prove” means to demonstrate that something is true. Registrant’s Class 42 services, which are in the nature of custom synthesis for others of the products it supplies for measuring immune responses, do not do that. The term “prove” is therefore not a generic description of Registrant’s Class 42 services.

7. Registrant is without knowledge or information sufficient to form a belief as to the truth of any of the allegations in Paragraph 7 of the Amended Petition for Cancellation, and therefore, denies all of the allegations in Paragraph 7.

8. Registrant is without knowledge or information sufficient to form a belief as to the truth of any of allegations in Paragraph 8 of the Amended Petition for Cancellation, and therefore, denies all of the allegations in Paragraph 8.

9. Registrant is without knowledge or information sufficient to form a belief as to the truth of any of the allegations in Paragraph 9 of the Amended Petition for Cancellation, and therefore, denies all of the allegations in Paragraph 9.

10. Registrant admits that it has made prior trademark use of the term “prove” for its International Class 42 services “scientific and technical research and design services in the field of biomedical sciences.” Registrant denies the remaining allegations in Paragraph 10 of the Amended Petition for Cancellation.

SECOND GROUNDS FOR CANCELLATION - ABANDONMENT

11. Registrant admits that a copy of the specimen filed in connection with both International Classes 1 and 42 with the June 7, 2013 Combined Declaration of Use and Incontestability under Sections 8 & 15, demonstrating use in commerce by Registrant with respect to its goods and services in both International Classes 1 and 42 respectively in Registration No. 3,250,168, is attached to the Amended Petition for Cancellation. Registrant admits that the specimen reflects the use of the PROVE mark by registrant with MHC Class 1 pentamers or libraries based on those pentamers. Registrant admits that the pentamers and pentamer libraries are protein products classifiable in International Class 1. Registrant denies the remaining allegations in Paragraph 11 of the Amended Petition for Cancellation. Registrant uses the PROVE mark (also displayed as ProVE) for the custom made products that it supplies for

measuring immune responses and also for the custom synthesis of those products for others.

12. Registrant admits that a partial history of its www.proimmune.com website is available on the Internet Archive at URL:

http://web.archive.org/web/20060501000000*/https://www.proimmune.com. Registrant is without knowledge or information sufficient to form a belief as to the truth of any of the remaining allegations in Paragraph 12 of the Amended Petition for Cancellation, and therefore, denies all of the remaining allegations in Paragraph 12.

13. Registrant denies the allegation that the first appearance of use of the PROVE mark for the MHC Class 1 Pentamer proteins or libraries as products classifiable in International Class 1 first appeared on the Registrant's website update dated September 16, 2005. Applicant denies that attached as Exhibit D to the Amended Petition for Cancellation is a print-out of the URL:

<http://web.archive.org/web/20050916150746/http://www.proimmune.com/>. Rather, Exhibit D displays the URL:

[https://web.archive.org/web/20050901091636/http://www.proimmune.com/p_overview.h](https://web.archive.org/web/20050901091636/http://www.proimmune.com/p_overview.htm)
tm (which is a print-out of Registrant's archived web page:

http://www.proimmune.com/p_overview.htm from September 1, 2005). Exhibit D appears to cut off the right hand side of the page found at that URL.

14. Registrant admits that a review of the entire archive of the Registrant's website between March 24, 2003 and February 3, 2015 shows consistent use of the PROVE mark for the MHC Class 1 Pentamer proteins or libraries as products classifiable in International Class 1. Registrant denies the remaining allegations of

Paragraph 14 of the Amended Petition for Cancellation. Registrant's website between at least as early as September 2005 to the present date also shows use of the PROVE mark for its Class 42 services, including scientific and technical research and design services in the field of biomedical sciences in the nature of custom synthesis of products that it supplies for measuring immune responses.

15. Registrant admits that Registration No. 3,250,168 became registered on June 12, 2007 and that it has used the word mark PROVE for MHC Class 1 Pentamer proteins or libraries as products classifiable in International Class 1. Registrant denies all the remaining allegations of Paragraph 15 of the Amended Petition for Cancellation. Registrant's website evidence, including Exhibit C to the Amended Petition for Cancellation, shows that Registrant has used the PROVE mark for Class 42 services including scientific and technical research and design services in the field of biomedical sciences in the nature of custom synthesis of products that it supplies for measuring immune responses. In addition, the undersigned has already explained to Petitioner's counsel, Mr. Patrick Delaney, on July 2, 2015, the PROVE trademark has been used and is being used in the United States in connection with its International Class 42 services.

16. Registrant admits that it has used the word mark PROVE for MHC Class 1 Pentamer proteins or libraries as products classifiable in International Class 1. Registrant denies all the remaining allegations of paragraph 16 of the Amended Petition for Cancellation.

THIRD GROUNDS FOR CANCELLATION - FRAUD

17. Admitted.

18. Registrant admits that in a Combined Declaration of Use and Incontestability under Sections 8 and 15 filed on June 7, 2013, Mr. Eisenhart swore that Registrant was, as of June 7, 2013, using the PROVE trademark "...in commerce on or in connection with all goods and/or services identified..." including those in International Class 042, and that the PROVE trademark "...has been in continuous use in commerce for five (5) consecutive years after the date of registration [June 12, 2007] ..." including with respect to those in International Class 042. Registrant denies the remaining allegations in Paragraph 18 of the Amended Petition for Cancellation.

19. Registrant admits that in support of its June 07, 2013 Combined Declaration of Use and Incontestability, Registrant attached a specimen of use (Exhibit C) consisting of a webpage for, *inter alia*, Registrant's "PROVE MHC Class I Pentamer Libraries" a diagnostic preparation product associated with International Class 001. Registrant denies the remaining allegations in Paragraph 19 of the Amended Petition for Cancellation. The specimen attached was also associated with Registrant's Class 42 services, scientific and technical research and design services in the field of biomedical sciences, which are in the nature of custom synthesis of the products it supplies for measuring immune responses. Further, the specimen attached was technically in support of Registrant's Declaration of Use, since a specimen is not required to comply with the requirements of a Declaration of Incontestability.

20. Denied. Petitioner's own attachment C to the Amended Petition for Cancellation shows that Registrant was using the PROVE trademark in commerce in association with scientific and technical research and design services in the field of

biomedical sciences in the nature of custom synthesis of the products it supplies for measuring immune responses.

21. Denied.

22. Denied. As of June 7, 2013, the webpage (Exhibit C to the Amended Petition for Cancellation) which Registrant submitted with its Combined Declaration of Use and Incontestability was currently being used at that time by Registrant to advertise scientific and technical research and design services in the field of biomedical sciences, in the nature of custom synthesis of the products it supplies for measuring immune responses.

23. Denied.

24. Denied.

25. Denied.

26. Admitted that the U.S. Patent and Trademark Office (USPTO) relied upon Mr. Eisenhart's statements and Registrant's specimen in allowing the continued registration of the PROVE mark. Registrant denies the remaining allegations in Paragraph 26 of the Amended Petition for Cancellation. In particular, Registrant denies that Mr. Eisenhart's statements were false and that the specimen was false.

27. Admitted that the USPTO allowed Registration No. 3,250,168 to remain valid. Denied that Registrant made false statements and denied that Registrant submitted a false specimen. Registrant objects to answering any statements of law. Registrant is without sufficient knowledge or information to form a belief as to the truth of what actions the USPTO would or would not do in a given situation.

FURTHER ANSWER

28. As a result of Registrant's long period of use of the mark PROVE in connection with "Human and animal diagnostic preparations for scientific research purposes and biochemical substances for scientific research purposes" and "Scientific and technical research and design services in the field of biomedical sciences," it has developed and currently possesses significant and valuable goodwill in the mark PROVE as applied to these goods and services.

29. Registrant is entitled to use and continue to use its PROVE trademark in the US, and Registrant is entitled to maintain its registration for the PROVE trademark because it is the senior party.

30. Petitioner's Amended Petition for Cancellation is defective and fails to state a claim against Registrant upon which relief can be granted. In particular, Petitioner's pleadings of genericness fail to clearly allege how the mark PROVE could be understood by the relevant public primarily to refer to the services "scientific and technical research and design services in the field of biomedical sciences." In addition, the Amended Petition for Cancellation at page 1 indicates that Petitioner "alleges on knowledge, information and belief" the allegations set forth thereafter in support of the Amended Petition. To the extent that Petitioner's pleadings of fraud are made on information and belief, they are insufficient. Further, the allegedly false statements/specimen identified in paragraphs 18-25 of the Amended Petition for Cancellation are not false, as Exhibit C clearly shows use of the mark PROVE in connection with scientific and technical research and design services in the field of

biomedical sciences in the nature of custom synthesis for others of the products it supplies for measuring immune responses.

31. Registrant's Trademark No. 3,250,168, as being registered, is inherently distinctive.

32. Registrant asserts that its mark is not generic.

33. Registrant reserves the right to add affirmative defenses as its further investigation or discovery so leads.

WHEREFORE, Respondent requests that the Amended Petition for Cancellation be denied.

Respectfully submitted,

PROIMMUNE LIMITED

By: /Sheryl De Luca/

Sheryl De Luca

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing “ANSWER TO AMENDED PETITION FOR CANCELLATION” was served on counsel for Petitioner, Patrick R. Delaney, Ditthavong & Steiner, P.C., 44 Canal Center Plaza Suite 322, Alexandria, VA 22314, by email (by prior agreement of the parties) at the email addresses docket@dcpatent.com and pdelaney@dcpatent.com this 7th day of December 2015.

By: /Sheryl De Luca/
Sheryl De Luca