

ESTTA Tracking number: **ESTTA759766**

Filing date: **07/21/2016**

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

| | |
|------------------------|---|
| Proceeding | 92061895 |
| Party | Plaintiff Proove Biosciences, Inc. |
| Correspondence Address | PATRICK R DELANEY DITTHAVONG & STEINER PC 44 CANAL CENTER PLZ STE 322 ALEXANDRIA, VA 22314 UNITED STATES pdelaney@dcpatent.com,docket@dcpatent.com |
| Submission | Withdrawal of Petition to Cancel |
| Filer's Name | Patrick R. Delaney |
| Filer's e-mail | pdelaney@dcpatent.com,docket@dcpatent.com |
| Signature | /s/ |
| Date | 07/21/2016 |
| Attachments | MOTION.pdf(107284 bytes) |

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

L1040US00

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

MOTION FOR WITHDRAWAL WITHOUT PREJUDICE

Pursuant to 37 CFR §2.114, Petitioner, Proove Biosciences, Inc. (hereinafter “Petitioner” or “Proove”), by its undersigned counsel, hereby motions for withdrawal of their petition in the above-captioned cancellation proceeding. Although Registrant, ProImmune Limited (hereinafter “Registrant” or “ProImmune”) has filed an answer, Petitioner respectfully requests that withdrawal from this cancellation proceeding be granted without prejudice. Counsel for ProImmune was notified by email on July 1, 2016, of Petitioner’s intent to pursue this motion without prejudice but they have not indicated whether ProImmune will oppose.

I. FACTUAL AND PROCEDURAL HISTORY

1. On July 20, 2015, Proove, by counsel, filed a petition for cancellation of Registration No. 3,250,168 for Registrant’s word mark, PROVE, on the three separate grounds of Genericness, Abandonment and Fraud (ESTTA Tracking No. ESTTA684536). All three of the grounds advanced in by Proove in the July 20, 2015 petition for cancellation are based on 15 U.S.C. §1064(3).

2. On September 1, 2015, ProImmune, by counsel, filed an answer (ESTTA Tracking No. ESTTA692886) to Proove's petition of July 20, 2015.

3. At a discovery conference held October 7, 2015 and attended by a Board professional, the Board required that Petitioner add clarifications to select parts of the Petition and that the Registrant add clarifications to select parts of the Answer.

4. On November 6, 2015, Proove filed an amended petition for cancellation of Registration No. 3,250,168 for Registrant's word mark, PROVE, on the same three separate grounds of Genericness, Abandonment and Fraud (ESTTA Tracking No. ESTTA707229).

5. On December 7, 2016, ProImmune, by counsel, filed an answer (ESTTA Tracking No. ESTTA712889) to Proove's amended petition of November 6, 2016.

6. On February 12, 2016, this cancellation proceeding was suspended for settlement negotiation purposes but the parties have not been able to reach an agreement.

II. LEGAL STANDARD

15 U.S.C. §1064 provides “[a] petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged...by the registration of a mark on the principal register...”. 15 U.S.C. §1064(3) further specifies such a petition may be filed “[a]t any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently...” (*emphasis added*).

Furthermore, Proove's petition and amended petition, filed and answered, should not give rise to an affirmative defense based on res judicata or collateral estoppel with regard to the

grounds of Genericness, Abandonment and/or Fraud in a future proceeding before the Honorable Trademark Trial and Appeal Board (hereinafter, the “Board”) or in a federal court. “The Board has held that the equitable defenses of laches and estoppel are not available against claims of fraud and abandonment because there exists a broader interest — a ‘public policy’ interest — in addition to a private interest in removing from the register those registrations procured or maintained by fraud and those registrations for marks that have been abandoned.” *Tbc Corp. v. Grand Prix Ltd.*, 12 U.S.P.Q.2d 1311, 1313, 1989 WL 274376 (T.T.A.B.1989). This principle has also been recognized in trademark cancellation proceedings before the federal courts brought under 15 U.S.C. §1065. See *Marshak v. Treadwell*, 240 F.3d 184, 192 (3rd Cir. 2001).

III. CONCLUSION

WHEREFORE, Petitioner requests that its motion for withdrawal of the above-mentioned petition for cancellation be granted without prejudice.

DATED: July 21, 2015

Respectfully submitted,

PROOVE BIOSCIENCES, INC.

/s/ Patrick R. Delaney

Patrick R. Delaney, Esq.
DITTHAVONG & STEINER, P.C.
44 Canal Center Plaza, Suite 322
Alexandria, Virginia 22314
Telephone: (703) 519-9951
Email: pdelaney@dcpatent.com
Attorneys for Petitioner

CERTIFICATE OF SERVICE

I certify that on July 21, 2016, the foregoing MOTION FOR WITHDRAWAL WITHOUT PREJUDICE was filed electronically and serviced by email, according to prior agreement, to the general email address for Nixon & Vanderhye, P.C. at nixonptomail@nixonvan.com and to Ms. Sheryl De Luca at sld@nixonvan.com the Attorney of Record for the owner of the Registration:

Sheryl De Luca
NIXON & VANDERHYE, P.C.
901 N. Glebe Road, 11th Floor
Arlington, VA 22203

Attorneys for Registrant
PROIMMUNE, LTD.

/s/ Patrick R. Delaney
Patrick R. Delaney