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

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| Proceeding | 92061895 |
| Party | Defendant<br>ProImmune Limited |
| Correspondence Address | PROIMMUNE LIMITED<br>MAGDALEN CENTRE, OXFORD SCIENCE PARK<br>OXFORD, OX4 4GA<br>UNITED KINGDOM |
| Submission | Answer |
| Filer's Name | Sheryl De Luca |
| Filer's e-mail | nixonptomail@nixonvan.com, sld@nixonvan.com |
| Signature | /Sheryl De Luca/ |
| Date | 09/01/2015 |
| Attachments | Answer to Petition for Cancellation.pdf(1600060 bytes ) |

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

5350-16

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

**ANSWER TO PETITION FOR CANCELLATION**

Registrant, ProImmune Limited, hereby answers the 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 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 June 15, 2015 decision on appeal in Application No. 86/085,516 is attached to the 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 Petition for Cancellation, and therefore, denies all of the remaining allegations in Paragraph 4.

5. Registrant is without knowledge or information sufficient to form a belief as to the truth of any of the allegations in Paragraph 5 of the Petition for Cancellation, and therefore, denies all of the allegations in Paragraph 5.

6. Registrant is without knowledge or information sufficient to form a belief as to the truth of any of the allegations in Paragraph 6 of the Petition for Cancellation, and therefore, denies all of the allegations in Paragraph 6.

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 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 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 Petition for Cancellation, and therefore, denies all of the allegations in Paragraph 9.

10. Registrant admits that it has made prior use of the term "prove." Registrant denies the remaining allegations in Paragraph 10 of the Petition for Cancellation.

11. Registrant admits that a copy of the specimen filed in connection with both International Classes 001 and 042 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 001 and 042 respectively in the Registration, is attached to the Petition for Cancellation.

Registrant denies the remaining allegations in Paragraph 11 of the Petition for Cancellation.

SECOND GROUNDS FOR CANCELLATION - ABANDONMENT

12. Registrant admits that in a Combined Declaration of Use and Incontestability under Sections 8 and 15 filed on June 7, 2013, Registrant claimed the mark PROVE had been continuously used in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and was still in use in commerce on or in connection in both International Classes 001 and 042 in the Registration. Registrant denies the remaining allegations in Paragraph 12 of the Petition for Cancellation.

13. Registrant admits that the June 7, 2013 Combined Declaration, of record in the Registration's file history, was filed with two copies of a single specimen for the respective goods and services in both International Classes 001 and 042 in the Registration. Registrant admits that a copy of the June 7, 2013 Combined Declaration is attached at Exhibit C. Registrant denies the remaining allegations in Paragraph 13 of the Petition for Cancellation.

14. Denied. The USPTO issued a Notice of Acceptance and Acknowledgement of §§ 8 & 15 Declaration mailed June 24, 2013, which indicated that, with respect to International Classes 001 and 042, the combined declaration of use and incontestability filed in connection with the 3,250,168 registration identified meets the requirements of Sections 8 and 15 of the Trademark Act, 15 U.S.C. §1058 and 1065. The combined declaration is accepted and acknowledged. The registration remains in force.

15. Denied. As already explained to Petitioner's counsel, Mr. Patrick Delaney, on July 2, 2015 by the undersigned, (upon his inquiry to counsel for Registrant for a voluntary modification of Registration No. 3,250,168), the PROVE trademark has been used and is being used in the United States in connection with its International Class 042 services.

16. Denied. As already explained to Petitioner's counsel, Mr. Patrick Delaney, on July 2, 2015 by the undersigned, (upon his inquiry to counsel for Registrant for a voluntary modification of Registration No. 3,250,168), the PROVE trademark has been used and is being used in the United States in connection with its International Class 042 services.

17. Admitted that Registrant operates a website at https://www.proimmune.com/ecommerce/index.php that promotes the sale of select specific goods. Registrant also offers services on its website.

18. Denied.

19. Denied.

THIRD GROUNDS FOR CANCELLATION - FRAUD

20. Admitted.

21. Admitted that Mr. Eisenhart declared 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 [in the Combined Declaration]..." 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 21 of the Petition for Cancellation.

22. Admitted 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 1 Pentamer Libraries" a diagnostic preparation product associated with International Class 001." Registrant denies the remaining allegations in Paragraph 22 of the Petition for Cancellation.

23. Denied.

24. Denied.

25. Denied.

26. Denied.

27. Denied.

28. Denied.

29. 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 28 of the Petition for Cancellation. In particular, Registrant denies that Mr. Eisenhart's statements were false and that the specimen was false.

30. 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 AND AFFIRMATIVE DEFENSES

31. 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.

32. 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.

33. Petitioner's 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 allege that the mark PROVE refers to the class, genus or category of goods and/or services on or in connection with which it is used and that PROVE is understood by the relevant public primarily to refer to that genus (category or class) of goods or services. In addition, Petitioner's pleadings of fraud made on information and belief are insufficient.

34. Petitioner is barred from relief by the doctrine of Unclean Hands in that, on information and belief, Petitioner has been aware of the fact that the PROVE trademark has been used in the United States for a number of years, has never been abandoned,

and there is no intent to abandon the trademark. Petitioner's Petition for Cancellation is merely intended to try to improperly force Registrant to resolve this matter on terms that are contrary to Registrant's rights.

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

36. Registrant asserts that its mark is not generic.

37. Registrant reserves the right to add, to amend, and to withdraw its affirmative defenses as its further investigation or discovery so leads.

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

Respectfully submitted,

**PROIMMUNE LIMITED**

By: Sheryl De Luca

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## CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing "ANSWER TO 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 first-class mail this 1ST day of September 2015.

Sheryl De Luca

Sheryl De Luca