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01-09-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #:

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

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INTERNATIONAL NUTRITION COMPANY,	:	
	:	
Opposer,	:	Opposition No. 91152660
	:	
v.	:	
	:	
HORPHAG RESEARCH, LTD.,	:	
	:	
Applicant.	:	

MOTION OF OPPOSER TO SUSPEND OPPOSITION PROCEEDING

Opposer, International Nutrition Company ("Opposer" or "INC"), hereby moves this Honorable Board for an Order suspending this opposition pending resolution of Cancellation No. 26,569 ("the Cancellation), now pending between the parties.

RELEVANT FACTS

Applicant Horphag Research, Ltd. ("Horphag") has filed application Ser. No. 75/826,851 to register the mark PYCNO for skin care creams, topical antioxidant cosmetics and dietary supplements, which INC has opposed. Applicant, or its predecessor, also has obtained, and is the record owner of, U.S. Reg. No. 1,769,633 for the mark PYCNOGENOL for dietary and nutritional supplements, which INC has petitioned to cancel on the ground that the registration was procured fraudulently. The cancellation proceeding now is pending.

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INC asserts in its Notice of Opposition that it has an interest in using and registering the mark PYCNOGENOL in the United States in connection with the sale of its nutritional and other antioxidant products (Notice of Opp., para. 4). INC also asserts that Horphag or its predecessor fraudulently obtained Reg. No. 1,769,633 for the PYCNOGENOL mark (Notice of Opp. Para. 10), as it does in the Petition to Cancel (Petition to Canc. Para. 10) (attached hereto as Ex. A). The cancellation proceeding is referred to in the Notice of Opposition (Notice of Opp. Para. 10). The mark Horphag seeks to register, PYCNO, is a colorable variation of and confusingly similar to the PYCNOGENOL mark for which it fraudulently procured a registration. Indeed, Horphag answered an interrogatory served by INC in this proceeding as follows:

Interrogatory No. 1

Identify the person who coined the term PYCNO and state the date the term was coined.

Response to Interrogatory No. 1

The term PYCNO, derives from the Greek language and was coined internally in 1998 by Applicant as a short-hand reference to PYCNOGENOL.

The facts and legal issues relating to both proceedings obviously are intertwined, and the witnesses and evidence will, in many cases, be the same.

Discovery in this opposition is set to close on March 16, 2003. Discovery in the cancellation proceeding is now closed, following a stay of discovery spanning a year, pending a determination by the Board of a Summary Judgment Motion brought by Horphag. The motion was denied. The Board in the cancellation proceeding still is considering discovery disputes between the parties.

ARGUMENT

IT IS APPROPRIATE TO SUSPEND THIS OPPOSITION PROCEEDING PENDING THE OUTCOME OF THE CANCELLATION PROCEEDING.

The Board, in its discretion, may suspend final determination in one proceeding pending the outcome of another Board proceeding. TMEP § 510.02(a). Suspension will ordinarily be ordered if the final determination of the other proceeding will have a bearing on the issues before the Board. Whopper - Burger, Inc. v. Burger King Corp., 171 U.S.P.Q. 805 (T.T.A.B. 1971).

In its answer to the Notice of Opposition, Horphag asserted ownership of the PYCNOGENOL mark, and has claimed that PYCNO is an abbreviated version of PYCNOGENOL. Whether or not Horphag owns valid rights in the PYCNOGENOL mark has a clear bearing on the final determination in both the opposition and cancellation

proceedings. Indeed, it is the only issue before the Board in the cancellation proceeding. As the outcome of the cancellation proceeding will have a bearing on the issues before the Board in this opposition proceeding, INC's motion to stay this opposition proceeding pending a determination in the cancellation proceeding should be granted.

CONCLUSION

Based on the forgoing, it is respectfully requested that the Board issue an Order suspending Opposition No. 91152660 pending the outcome of Cancellation No. 26,569.

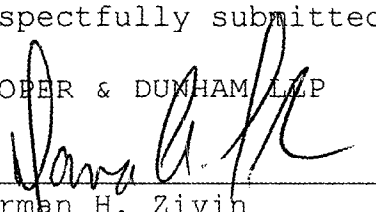
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1/6/03

Respectfully submitted,

COOPER & DUNHAM LLP

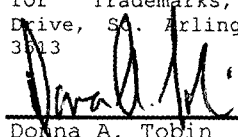
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I hereby certify that this paper is being deposited with the U.S. Postal Service as first class mail addressed to: Asst. Commissioner for Trademarks, 2900 Crystal Drive, Sd. Arlington, V.A. 22202-3813



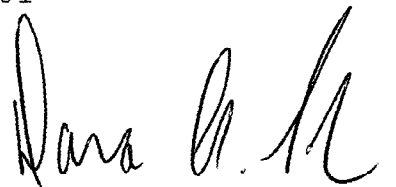
1/6/03
Date

Donna A. Tobin

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing MOTION OF OPPOSER TO SUSPEND was served by First Class Mail, postage prepaid, this 6th day of January 2003 on counsel for Applicant, addressed as follows:

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01-09-2003

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #70

Dkt. 48200-A

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

In the Matter of

Registration No. : 1,769,633
Issued : May 11, 1993
Mark : PYCNOGENOL

-----X
INTERNATIONAL NUTRITION COMPANY, :
Petitioner, :
v. : Cancellation No.
HORPHAG RESEARCH LTD., :
Registrant. :
-----X

PETITION FOR CANCELLATION

INTERNATIONAL NUTRITION COMPANY, a Liechtenstein company having a place of business at Josef Rheinbergerstrasse 6, Vaduz, Liechtenstein (Petitioner" or "INC"), believes that it is being and will continue to be damaged by continued registration of the mark shown in the above-identified registration of HORPHAG RESEARCH LTD., a British company, having an alleged place of business at Maison Allaire, Smith Street, Peter's Port, Guernsey, Channel Islands ("Registrant"), and hereby petitions to cancel the registration.

As grounds for the petition, Petitioner states as follows:

1. Petitioner INC is a marketer and distributor of nutritional products throughout the world, including the United States.

2. The trademark PYCNOGENOL was coined by Dr. Jack Masquelier in 1979 and was adopted by him for use as a trademark for nutritional and other products. Dr. Masquelier and companies controlled by him have granted their rights in the trademark PYCNOGENOL to Petitioner INC and related entities.

3. Petitioner INC is the owner of registrations for the trademark PYCNOGENOL for nutritional products in many countries outside the United States, including at least Austria, France, Germany, Liechtenstein, Monaco and Portugal.

4. Petitioner INC has an interest in using and registering the mark PYCNOGENOL in the United States in connection with the sale of its nutritional products.

5. Registrant is a marketer and distributor of nutritional products throughout the world, including the United States, in competition with Petitioner.

6. Registrant or its predecessor was a broker or agent on commission for Centre D'Experimentation Pharmaceutique ("C.E.P."), pursuant to agreements dated July 12, 1971 and April 28, 1982. C.E.P. is a French company which was controlled by Dr. Masquelier and his colleagues.

7. C.E.P. was the first and principal supplier of products under the PYCNOGENOL trademark to customers in the United States.

8. Dr. Masquelier instructed Registrant or its predecessor at least in writing not to seek trademark registrations for the mark PYCNOGENOL.

9. In defiance of Dr. Masquelier's instructions, Registrant or its predecessor applied to register the mark PYCNOGENOL in the United States without informing or obtaining authorization from Dr. Masquelier.

10. Registrant or its predecessor obtained and Registrant is the owner of record of Reg. No. 1,769,644 for the mark PYCNOGENOL for dietary and nutritional supplements.

FIRST CLAIM FOR RELIEF

11. Petitioner hereby realleges and incorporates by reference paragraphs 1 through 10 of the Petition.

12. Registrant or its predecessor obtained a registration for the mark PYCNOGENOL in the Patent and Trademark Office by the following material false and/or fraudulent declarations or representations:

(a) Registrant's predecessor claimed, in the application for registration, sworn to on December 15, 1989, that it was the

owner of the mark when it knew that Dr. Masquelier or a company controlled by Dr. Masquelier was the owner of the mark;

(b) Registrant's predecessor relied in the application for registration on a date of first use of the mark on December 22, 1987, which use actually was a shipment made by Dr. Masquelier's company C.E.P., for which Registrant's predecessor served as an agent or broker;

(c) Registrant's predecessor alleged in the application for registration that it manufactured the goods bearing the mark when it knew that the goods were manufactured by a company, Les Derives Resiniques et Terpeniques S.A. ("D.R.T."), under license by Dr. Masquelier's company C.E.P., for which Registrant's predecessor served as an agent or broker; and

(d) Registrant's predecessor submitted a declaration, sworn to on February 4, 1992, amending the date of first use of the mark to an earlier date of July 27, 1987, which use actually was a shipment made by Dr. Masquelier's company C.E.P., for which Registrant's predecessor served as an agent or broker.

13. The false and/or fraudulent statements were made willfully and knowingly with the intent and purpose of deceiving the Patent and Trademark Office Attorney so that a registration would be granted to Registrant or its predecessor.

14. Registration No. 1,769,633 for the mark PYCNOGENOL was procured by Registrant or its predecessor by false and/or

fraudulent declarations and/or representations and/or by false means.

15. Registration No. 1,769,633 should be canceled as provided by Section 14 of the Lanham Act, 15 U.S.C. §1064.

16. The maintenance of Reg. No. 1,769,633 on the Principal Register is causing damage to Petitioner INC and is interfering with its lawful business activities.

SECOND CLAIM FOR RELIEF

17. Petitioner hereby realleges and incorporates by reference paragraphs 1 through 16 of this Petition.

18. Austria, France, Germany, Liechtenstein, Monaco, Portugal and the United States all are members of the International Convention for Protection of Industrial Property, also known as the Paris Convention.

19. The Paris Convention is self-executing and is part of the law of the United States, as provided by Section 44 of the Lanham Act, 15 U.S.C. §1126.

20. Registrant or its predecessor, as an agent of the proprietor of the mark in one of the countries party to the Paris

Convention, and lacking the proprietor's authorization, applied in its own name for registration of the mark PYCNOGENOL.

21. Registrant or its predecessor's conduct in applying for registration of the mark PYCNOGENOL was in violation of Article 6 septies of the Paris Convention, as amended at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967.

22. Registration No. 1,769,633 should be canceled as it was obtained in contravention of the Paris Convention.

23. The maintenance of Reg. No. 1,769,633 on the Principal Register is causing damage to Petitioner INC as the rightful proprietor of the mark.

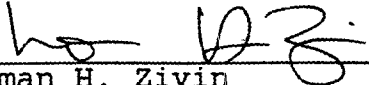
WHEREFORE, Petitioner prays that the Petition be sustained and that Registration No. 1,769,633 for the mark PYCNOGENOL be canceled.

Respectfully submitted,

COOPER & DUNHAM LLP

Dated: 8/4, 1997

By


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