

TTAB

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

ChemNavigator.com, Inc., assignee of
Arena Pharmaceuticals, Inc.

Opposition No. 91152665

10-08-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #75

Opposer,

Serial Nos. 76/033489 and 76/033477
Marks: CHEMNAVIGATOR and
CHEMISTRYNAVIGATOR

v.

Elsevier Science, Inc.,

Applicant.

Box TTAB No Fee
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

ANSWER TO OPPOSITION

Applicant Elsevier Science, Inc., a Delaware corporation, located and doing business at 655 Avenue of the Americas, New York, New York 10010 ("Applicant") hereby provides its timely answer to the Trademark Opposition filed by ChemNavigator.com, Inc. ("Opposer") on either June 19, 2002 or August 27, 2002 (the "Opposition"). Applicant respectfully disputes the allegations in the Opposition and hereby denies each and every allegation contained therein except to the extent expressly admitted below. As a result, Applicant submits that the Opposition should be denied in every respect and that Applicant's marks at issue, CHEMNAVIGATOR (Serial No.

76/033489) and CHEMISTRYNAVIGATOR (Serial No. 76/033477) should proceed to registration.

THE CHEMNAVIGATOR APPLICATION

1. Applicant admits that it filed an application on April 25, 2000 seeking registration for its CHEMNAVIGATOR mark ultimately for the following services: (a) computerized database management in International Class 35; (b) providing educational information in the field of science via the Internet in International Class 41; and (c) providing non-downloadable computer software for use in accessing and searching databases in the field of science via a global computer network, and information in the fields of science and scientific research in International Class 42. Applicant denies all other inferences, allegations and claims as to this paragraph.

2. Applicant admits that its CHEMNAVIGATOR mark was published for opposition on May 21, 2002.

3. Applicant is without knowledge or information sufficient to either admit or deny that Opposer's Opposition was timely filed since the Opposition was not recognized by the Trademark Office until August 28, 2002. Therefore, the allegations contained in this paragraph are deemed denied.

THE CHEMISTRYNAVIGATOR APPLICATION

4. Applicant admits that it filed an application on April 25, 2000 seeking registration for its CHEMISTRYNAVIGATOR mark ultimately for the following services: (a) computerized database management in International Class 35; and (b) providing non-downloadable computer software for use in accessing and searching databases in the field of science via a global computer network, and information in the

fields of science and scientific research in International Class 42. Applicant denies all other inferences, allegations and claims as to this paragraph.

5. Applicant admits that its CHEMISTRYNAVIGATOR mark was published for opposition on June 18, 2002.

6. Applicant is without knowledge or information sufficient to either admit or deny that Opposer's Opposition was timely filed since the Opposition was not recognized by the Trademark Office until August 28, 2002. Therefore, the allegations contained in this paragraph are deemed denied.

OPPOSER'S STANDING

7. Applicant is without knowledge or information sufficient to either admit or deny the allegations contained in this paragraph. Therefore, the allegations contained herein are deemed denied.

8. Applicant is without knowledge or information sufficient to either admit or deny the allegations contained in this paragraph. Therefore, the allegations contained herein are deemed denied.

9. Applicant is without knowledge or information sufficient to either admit or deny the allegations contained in this paragraph. Therefore, the allegations contained herein are deemed denied.

10. Upon information and belief, Applicant denies the allegations contained in this paragraph.

11. Upon information and belief, Applicant denies the allegations contained in this paragraph.

12. Upon information and belief, Applicant denies the allegations contained in this paragraph.

13. Upon information and belief, Applicant denies the allegations contained in this paragraph.

GROUND FOR OPPOSITION

14. Applicant is without knowledge or information sufficient to either admit or deny the allegations contained in this paragraph. Therefore, the allegations contained herein are deemed denied.

15. Applicant admits that its applications for both marks were based on its intent to use the marks in interstate commerce, and that as of April 30, 2002, Applicant had not yet used the marks in interstate commerce. Applicant is without knowledge or information sufficient to either admit or deny the remaining allegations contained in this paragraph and therefore these remaining allegations are deemed denied.

16. Upon information and belief, Applicant denies the allegations contained in this paragraph.

17. Upon information and belief, Applicant denies the allegations contained in this paragraph.

18. Upon information and belief, Applicant denies the allegations contained in this paragraph.

19. Upon information and belief, Applicant denies the allegations contained in this paragraph.

20. Applicant admits that it was aware of a CHEMNAVIGATOR mark owned by Arena Pharmaceuticals, Inc. as a result of the search performed by Applicant prior to

filing its registrations. Applicant denies that it filed its applications in bad faith, however, as both Applicant and the Trademark Office concluded that the Arena Pharmaceuticals, Inc. CHEMNAVIGATOR mark and Applicant's marks were sufficiently dissimilar so as to prevent potential confusion and to allow registration of Applicant's marks. Applicant further denies all other inferences, allegations and claims as to this paragraph.

21. Applicant denies the allegations contained in this paragraph.

22. Applicant admits that it was aware of a CHEMNAVIGATOR mark owned by Arena Pharmaceuticals, Inc. as a result of the search performed by Applicant prior to filing its registrations. Applicant denies all other inferences, allegations and claims as to this paragraph.

23. Applicant denies the allegations contained in this paragraph.

24. Applicant denies the allegations contained in this paragraph.

25. Applicant lacks the information to admit or deny the allegations contained in this paragraph. Therefore, the allegations contained herein are deemed denied.

26. Applicant lacks the information to admit or deny the allegations contained in this paragraph. Therefore, the allegations contained herein are deemed denied.

27. Applicant denies the allegations contained in this paragraph.

PROCEDURAL MATTERS

28. This paragraph requires no response from Applicant except to state that Applicant also hereby gives notice under Rule 1.272 of the patent and Trademark Office and Rule 2.122(b) of the Trademark Rules of the Practice (37 C.F.R. §§ 1.272 and 2.122(b)) that in any hearing and on any appeal of the opposition proceeding it will rely

on any existing trademark and copyright registrations, common law trademark rights, and pending applications.

29. Applicant lacks the information to admit or deny the allegations contained in this paragraph. Therefore, the allegations contained herein are deemed denied.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

The Opposition fails to state a claim against Applicant upon which relief can be granted.


SECOND AFFIRMATIVE DEFENSE

Opposer lacks standing to oppose registration of Applicant's marks.

WHEREFORE, Elsevier Science, Inc. prays that this opposition be denied in its entirety and that its marks CHEMNAVIGATOR and CHEMISTRYNAVIGATOR be allowed to register.

Dated: October 7, 2002

Lipstein, Jaffe & Lawson, LLP



Grace Lawson
Attorneys for Elsevier Science, Inc.

Lipstein, Jaffe & Lawson, LLP
1900 M Street, NW
Suite 700
Washington, DC 20005

CERTIFICATE OF SERVICE

I, Grace W. Lawson, hereby certify that copies of the foregoing submission on behalf of Elsevier Science, Inc., dated October 7, 2002, were served on the following parties via First Class Mail:

ATTORNEYS FOR CHEMNAVIGATOR.COM, INC.

Gregory P. Goonan

D. Whitlow Bivens

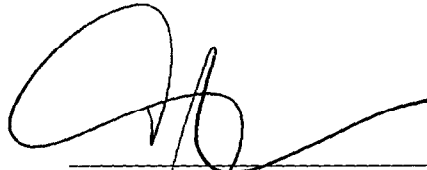
Musick, Peeler & Garrett LLP

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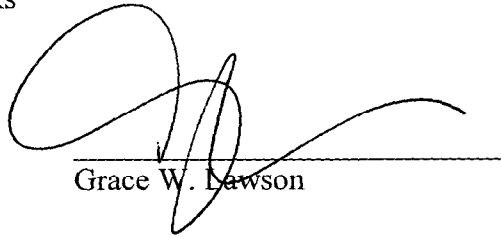
Grace W. Lawson

CERTIFICATE OF MAILING

I hereby certify that this Answer to Opposition is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to:

Box TTAB No Fee
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

On: October 7, 2002



Grace W. Lawson



LIPSTEIN, JAFFE & LAWSON L.L.P.

TTAB



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Sender's E-mail: glawson@ljllaw.com

October 7, 2002

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02 OCT 24 AM 9:52
TRADEMARK DIVISION
U.S. PATENT & TRADEMARK OFFICE

Dear Sir or Madam:

On behalf of Applicant Elsevier Science, Inc., submitted herewith is the Answer To Opposition in the above referenced matter, a Certificate of Service indicating that the Answer To Opposition has been served on all parties, and a Certificate of Mailing indicating that the filing of this Answer is timely.

Please stamp one copy of the enclosed documents to indicate receipt and return the stamped copy to the undersigned in the enclosed self-addressed, stamped envelope.

Thank you for your assistance.

Sincerely,

Grace W. Lawson

Counsel for Elsevier Science, Inc.

Enclosure