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Filing date: **08/08/2014**

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

Proceeding	91211414
Party	Defendant Purepharma ApS
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Date	08/08/2014
Attachments	Applicant's Proposed Amended Answer.pdf(57769 bytes )

Registration Subject to the filing

Registration No	2639990	Registration date	10/22/2002
Registrant	Purapharm International (H.K.) Limited 1 Connaught Place Central, HONG KONG		
Grounds for filing	The registered mark has been abandoned.		
	The registration was obtained fraudulently.		

Goods/Services Subject to the filing

<p>Class 005. First Use: 1999/02/23 First Use In Commerce: 2001/07/26 All goods and services in the class are requested, namely: Health food for medically restricted diets; food supplements, namely, herbal extract in the form of capsule tablet, powder and granule; food supplements, namely, vitamins, vitamin preparations, minerals, enzymes, and enzymes preparations; dietary and nutritional supplements; nutritional supplements, namely, drink mixes in powder form; dietetic food preparations, dietetic beverages, dietetic substances, and food preparations all for medically restricted diets; digestives for pharmaceutical purposes; appetite suppressants; pharmaceutical preparations and substances for appetite control and weight management; analgesics; sedatives; tranquilizers; sunburn ointments and sunburn preparations for medical use; pharmaceutical preparations for skin care; medicated mud for skin care, medicated skin care mud for baths; medicated mouth washes; medicines for dental purposes; Chinese medicines, for use with human biological systems, namely, Chinese medicines for the respiratory system, gastrointestinal system, endocrine system, cardiovascular system, nervous system, musculoskeletal system, urinary system, integumentary system and reproductive system; balmsfor medical purposes for the treatment of muscle pain, veterinary nutritional supplements for pets and livestock and medicated preparations for pet and livestock</p>
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Purapharm International (H.K.) Limited	)	
	)	
Opposer	)	
	)	
	)	
v.	)	Opposition No.: 91211414
	)	
Purepharma ApS	)	
	)	
Applicant	)	

**PUREPHARMA APS AMENDED ANSWER AND COUNTERCLAIM FOR  
CANCELLATION AND/OR RESTRICTION OF REGISTRATION NO. 2,639,990**

1. Answering Paragraph 1 of the Notice of Opposition, Applicant lacks sufficient knowledge or information to form a belief as to the truth of the allegations contained therein, and therefore denies each and every allegation contained in Paragraph 1, leaving Opposer to its strict proof at trial.

2. Applicant admits the allegations of Paragraph 2.

3. Answering Paragraph 3 of the Notice of Opposition, Applicant admits that the description of goods for Serial Number 79124353 set forth in Paragraph 3 correctly reflects the information in the USPTO records for the application as filed. Applicant denies each and every remaining allegation of Paragraph 3, instead affirmatively averring that effective October 30, 2012, it was granted International Registration Number 1145576, for the mark that is the subject of this opposition; said International Registration was based on a national application filed in Denmark on May 1, 2012, which basic application formed the basis of a priority claim under the

Paris Convention; application 1145576 for International Registration included the United States as an initial designation for extension of protection, from which an application ultimately was transmitted to the USPTO on or about January 31, 2013 and created as Serial Number 79124353.

4. Answering Paragraph 4 of the Notice of Opposition, Applicant admits that during the course of examination of Application Serial Number 79124353, it entered in the application a disclaimer of exclusive rights in "pharma." Applicant denies each and every remaining allegation of Paragraph 4.

5. Answering Paragraph 5 of the Notice of Opposition, Applicant admits that the description of goods for Serial Number 79124353 set forth in Paragraph 5 correctly reflects the information in the USPTO records for the goods in the application as amended. Applicant denies each and every remaining allegation of Paragraph 5.

6. Answering Paragraph 6 of the Notice of Opposition, Applicant lacks sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 6, and therefore denies each and every allegation contained therein, leaving Opposer to its strict proof at trial.

7. Answering Paragraph 7 of the Notice of Opposition, Applicant admits that attached to the Notice of Opposition is a document identified as Exhibit 1 that purports to be a print out of an excerpt from the USPTO trademark TSDR database for Registration No. 2639990. As to the remaining allegations in Paragraph 7, Applicant lacks sufficient knowledge or information to form a belief as to the truth of the allegations contained therein, and therefore

denies each and every remaining allegation contained in Paragraph 7, leaving Opposer to its strict proof at trial.

8. Answering Paragraph 8 of the Notice of Opposition, Applicant hereby repeats and incorporates herein each and every one of its respective responses to the preceding Paragraphs 1 through 7.

9. Answering Paragraph 9 of the Notice of Opposition, Applicant lacks sufficient knowledge or information to form a belief as to the truth of the allegations contained therein, and therefore denies each and every allegation contained in Paragraph 9, leaving Opposer to its strict proof at trial.

10. Answering Paragraph 10 of the Notice of Opposition, Applicant denies each and every allegation contained in Paragraph 10 and demands that Opposer provide specific proof thereof.

11. Answering Paragraph 11 of the Notice of Opposition, Applicant denies each and every allegation contained in Paragraph 11 and demands that Opposer provide specific proof thereof.

12. Answering Paragraph 12 of the Notice of Opposition, Applicant hereby repeats and incorporates herein each and every one of its respective responses to the preceding Paragraphs 1 through 7.

13. Answering Paragraph 13 of the Notice of Opposition, Applicant lacks sufficient knowledge or information to form a belief as to the truth of the allegations contained therein, and

therefore denies each and every allegation contained in Paragraph 13, leaving Opposer to its strict proof at trial.

14. Answering Paragraph 14 of the Notice of Opposition, Applicant denies each and every allegation contained in Paragraph 14 and demands that Opposer provide specific proof thereof.

15. Answering Paragraph 15 of the Notice of Opposition, Applicant denies each and every allegation contained in Paragraph 15 and demands that Opposer provide specific proof thereof.

#### AFFIRMATIVE DEFENSE

16. No damage or injury has resulted, will result, or is likely to result to Opposer from registration of Applicant's mark due to, among other factors, the weakness of the component terms in the marks, the differences between the marks, the distinct and different trade channels, promotional channels, and customer bases of the respective parties and their products, and the significant differences in the overall nature and essential characteristics, uses, and purposes of the parties' respective products.

#### COUNTERCLAIM FOR CANCELLATION

17. Applicant repeats and re-avers paragraphs 1-16 above as if fully set forth herein.

#### CLAIM I: CANCELLATION ON THE GROUNDS OF FRAUD

18. Applicant counterclaims for cancellation for Opposer's Registration No. 2639990 on the ground of fraud.

19. On September 21, 1998, Opposer filed its application that evolved into pleaded Registration No. 2639990.

20. The application that evolved into pleaded Registration No. 2639990 was based on intention to use.

21. On June 14, 2002, Opposer filed a Statement of Use declaring that the mark was then in use on all the goods listed in the application in commerce.

22. This statement was false.

23. On June 14, 2002, and up to and including the issuance of the registration on October 22, 2002, Opposer was not using the mark in commerce on any of the goods listed in the application.

24. Alternatively, on June 14, 2002 and up to and including the issuance of the registration on October 22, 2002, Opposer was not using in commerce the mark on all of the goods listed in the application.

25. On October 17, 2008, Opposer filed a Combined Section 8 and 15 affidavit in Registration No. 2639990.

26. In the Section 15 affidavit, Opposer declared that the mark PURAPHARM had been used in commerce continuously for the five years preceding the filing of the affidavit on all goods listed in the registration.

27. This statement was false.

28. At the time Opposer filed the Section 8 and 15 affidavit, the mark PURAPHARM had not been used in commerce continuously on any of the goods listed in the registration.

29. Alternatively, on October 17, 2008, Opposer was not on that date using the mark in commerce, and had not continuously used the mark in commerce for the five years preceding that date, on all of the goods listed in the registration.

30. On July 27, 2012, Opposer filed a Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of Registration of a Mark under Sections 8 & 9 of the Lanham Act.

31. In its Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of Registration of a Mark under Sections 8 & 9 of the Lanham Act, Opposer alleged that the mark PURAPHARM was then in use in commerce on all of the goods listed in the registration.

32. This statement was false.

33. On July 27, 2012, Opposer was not using the mark in commerce on all of the goods listed in the application.

34. As result of the false and fraudulent statements, the USPTO issued Registration No. 2,639,990, maintained it, conferred the benefits of incontestability, and renewed the registration.

35. Opposer made each of these false statements with the knowledge that they were false, with the intent to deceive the United States Patent and Trademark Office. Further, these

statements were material. But for the false statements, Opposer would not have received the benefit of an issued U.S registration in 2002, or its maintenance, or the benefits of incontestability in 2008, or a renewal of the registration 2012.

36. Opposer is therefore guilty of fraud.

CLAIM II: CANCELLATION ON THE GROUNDS OF NONUSE AND  
ABANDONMENT

37. Applicant repeats and re-alleges the allegations of paragraphs 1-36 of the Answer as if fully set forth herein.

38. Opposer is not using the mark and has not used the mark on any of the goods listed in the registration except “food supplements, namely herbal extracts in the form of capsule tablet, powder and granule;” “dietary and nutritional supplements” and “Chinese medicines, for use with human biological systems, namely, Chinese medicines for the respiratory system, gastrointestinal system, endocrine system, cardiovascular system, nervous system, musculoskeletal system, urinary system, integumentary system and reproductive system.” (hereafter “paragraph 38 goods”)

39. Opposer has not used its mark on any of the goods listed in its registration (except on the paragraph 38 goods) for the past three years.

40. Opposer has no intention to resume use of the mark on any of the goods listed in its registration except on the “paragraph 38 goods”.



41. Accordingly, as Opposer has abandoned and not used the mark as to all but the paragraph 38 goods, Opposer is not entitled to the registration which should be limited to the goods set forth in paragraph 38 of this Answer.

CLAIM III: RESTRICTION BASED ON SECTION 18 OF THE  
LANHAM ACT

42. Applicant repeats and re-alleges the allegations of paragraphs 1-41 of the Answer as if fully set forth herein.

43. All of Opposer's goods materially differ and are far narrower than identified in the registration. Specifically all of Opposer's goods are Chinese herbal remedies sold to consumers or Chinese medicines sold directly to Chinese medical practitioners.

44. Further, all of Opposer's goods are sold through channels of trade to consumers differing materially from Applicant. Specifically, Opposer's goods are sold either exclusively to practitioners of Chinese medicine who dispense the products or to persons seeking Chinese herbal remedies; whereas Applicant's goods are not. Applicant's goods are **athletic recovery and performance enhancers** not in the nature of Chinese herbal remedies and medicines.

45. To the extent that Opposer's registration is not cancelled, in whole or in part, Applicant respectfully requests that the Board amend it so that it reads: "**Chinese herbal food supplement remedies, namely** herbal extracts in the form of capsule tablet, powder and granule and dietary and nutritional supplements; and **Chinese medicines sold exclusively to Chinese medical practitioners namely** Chinese medicines, for use with human biological systems, namely, Chinese medicines for the respiratory system, gastrointestinal system, endocrine system,

cardiovascular system, nervous system, musculoskeletal system, urinary system, integumentary system and reproductive system;”

46. Applicant respectfully requests that its application be amended to: “**Athletic recovery and performance enhancers not in the nature of Chinese herbal remedies and medicines** namely food supplements for medical purposes; food supplements not for medical purposes, made from plants and weed extracts, for human consumption, for the purpose of nutritionally supplementing a normal diet; dietetic substances not for medical purposes, made from plants and weed extracts, for physiological purposes, namely, nutritional supplements; biopathic products and dietary supplements for medical purposes, including those based on active components and extracts of marine animals, plants, marine plants, herbs, fruits and vegetables, namely, nutritional supplements; foodstuffs and health supplements not for medical purposes, mainly consisting of extracts and active components from fruits, vegetables, marine plants, marine animals, fish, shellfish and dried herbs, namely, nutritional supplements.

47. Applicant respectfully submits that (i) entry of the proposed restriction to the goods or services in its opponent's registration and Applicant's application will avoid a finding of likelihood of confusion and (ii) the Opposer and Applicant are not using their marks on those goods or services that will be effectively excluded from the application and registration if the proposed restrictions are entered.

48. The continued registration of Registration No. 2639990 on the Principal Register would be inconsistent with Applicant's rights under common law and would be damaging to Applicant.

49. All fees owed are believed paid.

WHEREFORE, Applicant prays that Opposer's registration be cancelled in whole or in part, that it be restricted under Section 18, that this opposition be dismissed with prejudice, that Applicant's application proceed to registration, and for such other and further relief as may be deemed appropriate.

Respectfully submitted,

Date: August 8, 2014

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Attorneys for Purepharma, APS

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on August 8, 2014 a true and accurate copy of the foregoing:

**APPLICANT’S MOTION FOR LEAVE TO AMEND THE ANSWER TO OPPOSITION,  
EXHIBIT A, AND AMENDED ANSWER AND COUNTERCLAIM**

was served by agreement of the parties on Opposer by emailing a copy of the same to Melissa S. Rizzo, Attorney for Opposer, at melissa.rizzo@arlaw.com and [trademarks@arlaw.com](mailto:trademarks@arlaw.com).

/Carla Calcagno/