

ESTTA Tracking number: **ESTTA562701**

Filing date: **10/02/2013**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	AstraZeneca AB
Granted to Date of previous extension	10/02/2013
Address	Vastra Malarehamnen 9 SÅrdertÅrje, SE-15185 SWEDEN

Attorney information	WM CHARLES SAUNDERS ASTRAZENECA PHARMACEUTICALS LP 1800 CONCORD PIKE, FOP3-318 WILMINGTON, DE 19850-5437 UNITED STATES trademarks@astrazeneca.com,chuck.saunders@astrazeneca.com,paula.wright@astrazeneca.com Phone:302.885.4268
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Applicant Information

Application No	79128403	Publication date	06/04/2013
Opposition Filing Date	10/02/2013	Opposition Period Ends	10/02/2013
International Registration No.	1155780	International Registration Date	12/20/2012
Applicant	PROBIOTICAL SPA Via Mattei, 3 I-28100 NOVARA (NO) ITALY		

Goods/Services Affected by Opposition

Class 005. All goods and services in the class are opposed, namely: Pharmaceutical preparations, namely pharmaceutical preparations containing lactic acid bacteria; sanitary preparations for medical purposes; dietetic substances adapted for medical use, namely dietetic substances adapted for medical purposes containing lactic acid bacteria; food supplements; dietary supplements; nutritional supplements; vitamin supplements; food supplements adapted for medical use containing lactic acid bacteria

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2160791	Application Date	12/18/1995
Registration Date	05/26/1998	Foreign Priority Date	NONE
Word Mark	ATACAND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 1997/12/22 First Use In Commerce: 1997/12/22 pharmaceutical preparations for the treatment of cardiovascular diseases		

U.S. Registration No.	2485478	Application Date	03/03/1997
Registration Date	09/04/2001	Foreign Priority Date	NONE
Word Mark	ATACAND HCT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 2000/09/04 First Use In Commerce: 2000/09/04 pharmaceutical preparations for the treatment of cardio-vascular diseases		

U.S. Registration No.	2485478	Application Date	03/03/1997
Registration Date	09/04/2001	Foreign Priority Date	NONE
Word Mark	ATACAND HCT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 005. First use: First Use: 2000/09/04 First Use In Commerce: 2000/09/04 pharmaceutical preparations for the treatment of cardio-vascular diseases		

Attachments	Notice of Opposition_ACTICAND_79128403.pdf(222411 bytes) ATACAND_US Reg_2160791_TSDR.pdf(14393 bytes) ATACAND HCT_US Reg_2485478_TSDR.pdf(20900 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/wcs/
Name	WM CHARLES SAUNDERS
Date	10/02/2013

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

In the Matter of Application Serial No. 79/128,403
Published in the *Official Gazette* of June 4, 2013

AstraZeneca AB,	:	
Opposer,	:	
	:	Opposition No.: _____
v.	:	
	:	
	:	
Probiotical S.p.a.,	:	
Applicant.	:	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

AstraZeneca AB, a company organized under the laws of Sweden, with a place of business located at Vastra Malarehamnen 9, Sodertalje, Sweden, SE-15185 (hereinafter “Opposer”), believes that it will be damaged by registration of the alleged trademark “ACTICAND”, as shown in Application Serial No. 79/128,403, and hereby opposes same.

As grounds for opposition, it is alleged that:

1. Probiotical S.p.a., an Italian joint stock company (hereinafter “Applicant”) has filed an application in the United States Patent and Trademark Office, Serial No. 79/128,403, filed December 20, 2012, for registration of the word “ACTICAND” as a trademark on the Principal Register in respect of “Pharmaceutical preparations, namely pharmaceutical preparations containing lactic acid bacteria; sanitary preparations for medical purposes; dietetic substances adapted for medical use, namely dietetic substances adapted for medical purposes containing lactic acid bacteria; food supplements; dietary supplements; nutritional supplements; vitamin supplements; food supplements adapted for medical use containing lactic acid bacteria” (Int’l Class 5), on the basis of Section 66(a) (Madrid Protocol) of the

Trademark Act, 15 U.S.C. § 1141 .

2. Upon information and belief, Applicant did not use its alleged trademark “ACTICAND” anywhere in the United States, or in commerce, prior to its aforementioned application filing date.

3. Upon information and belief, Applicant is not using its alleged trademark “ACTICAND” anywhere in the United States, or in commerce, for any of the goods set forth in the opposed application.

4. Opposer is a leading worldwide producer and distributor of high-quality pharmaceutical products.

5. Opposer has registered the trademark “ATACAND” on the Principal Register of the United States Patent and Trademark Office, Reg. No. 2,160,791, dated May 26, 1998, in respect of “pharmaceutical preparations for the treatment of cardiovascular diseases.” (Int’l. Cl. 5). Said registration is valid, subsisting and incontestable, and Opposer hereby gives notice, in accordance with Trademark Rule 2.122(d)(2), that it will rely on said registration as evidence on its behalf in this proceeding. Attached to this Notice of Opposition is a status copy of said registration from the “TSDR” database of the United States Patent and Trademark Office, which shows that Opposer is the owner of record of the registration.

6. Opposer has registered the trademark “ATACAND HCT” on the Principal Register of the United States Patent and Trademark Office, Reg. No. 2,485,478, dated September 4, 2001, in respect of pharmaceutical preparations for the treatment of cardiovascular diseases.” (Int’l. Cl. 5). Said registration is valid, subsisting and incontestable, and Opposer hereby gives notice, in accordance with Trademark Rule 2.122(d)(2), that it will rely on said registration as evidence on its behalf in this proceeding. Attached to this Notice of Opposition is a status copy of said registration from the “TSDR” database of the United States Patent and Trademark Office, which shows that Opposer is the owner of the record of the registration.

7. Opposer has used the trademarks “ATACAND” and “ATACAND HCT” in commerce

for pharmaceutical preparations since prior to the filing date of the application to register “ACTICAND”, and since prior to any use of said mark by Applicant, and Opposer’s use of its aforementioned trademarks has been nationwide, substantial and continuous until the present date.

8. There is no issue of priority since the filing date of Applicant’s “ACTICAND” trademark application, and the date of first use of said mark (if any) and the earliest priority date claimed by Applicant (if any) is subsequent to the filing date of Opposer’s “ATACAND” and “ATACAND HCT” trademark registrations and to the dates of first use of Opposer’s pleaded trademarks.

9. There is no issue of priority if an Applicant’s mark is likely to cause confusion, mistake and/or deception with regard to a mark *registered* in the Patent and Trademark Office by an Opposer.

10. Opposer’s pleaded trademarks possess a high degree of inherent and acquired distinctiveness and represent extremely valuable assets and symbols of the goodwill of its business by identifying goods which have their source of origin exclusively with Opposer, and by distinguishing such goods from those of others.

11. Applicant’s alleged trademark “ACTICAND” is confusingly similar to Opposer’s pleaded trademarks in sound, appearance and/or commercial impression.

12. The respective goods of the Opposer and the Applicant are related and would travel through the same channels of trade for sale to and/or use by the same general class of purchasers and/or end users.

13. Under the “doctrine of greater care”, Applicant had a duty to adopt a trademark for its aforementioned products which is clearly distinguishable from Opposer’s trademarks for related pharmaceutical products.

14. Under the “doctrine of greater care”, Applicant’s alleged trademark “ACTICAND” is likely to cause pre-purchase and/or post-purchase confusion, mistake and/or deception with respect to

Opposer's aforementioned trademarks.

15. As a result of the distinctive nature of Opposer's aforementioned trademarks and the extensive sales and advertising in commerce of goods bearing said trademarks, Opposer's marks became famous prior to the filing date of Applicant's alleged mark "ACTICAND" and prior to any use of said mark by Applicant.

16. Famous trademarks such as Opposer's aforementioned marks will be accorded a wide scope of protection by the Trademark Trial and Appeal Board, and by the courts.

17. Registration of Applicant's alleged mark is likely to lessen the capacity of Opposer's aforementioned marks to identify and distinguish Opposer's aforementioned goods.

18. Registration of Applicant's alleged mark is likely to cause dilution of the distinctive quality of Opposer's aforementioned marks.

19. Applicant's alleged trademark is calculated or likely to cause confusion, mistake and/or deception of purchasers as to the respective marks of Opposer and Applicant, and also as to the source of origin or sponsorship of the goods for which such marks are used, or are intended to be used.

20. Applicant's alleged trademark is calculated or likely to cause irreparable loss, injury and damage to Opposer's business and to the goodwill thereto appertaining as symbolized and recognized by its aforementioned trademarks.

21. Applicant's alleged trademark is a colorable imitation or misappropriation of Opposer's pleaded trademarks, and will enable Applicant to reap where it has not sown by trading on the goodwill of Opposer's business as symbolized and recognized by its aforementioned trademarks.

22. Applicant adopted its alleged trademark "ACTICAND" and applied to register said mark with constructive notice of Opposer's aforementioned registered trademarks, pursuant to Section 22 of the U.S. Trademark Act.

23. Upon information and belief, Applicant adopted its alleged trademark "ACTICAND"

and applied to register said mark with actual prior notice of Opposer's aforementioned registered trademarks.

24. Applicant adopted its alleged trademark "ACTICAND" and applied to register said mark without the approval, authorization or acquiescence of Opposer.

IN CONCLUSION, Opposer, by its undersigned attorneys, prays that its opposition to Application Serial No. 79/128,403 be sustained and that the Trademark Trial and Appeal Board grant any and all further relief to Opposer that the Board finds to be necessary and just in the circumstances.

The official filing fee of \$300.00 should be charged to Deposit Account No. 504541, as should any other fee(s) required to be paid in connection with this proceeding.

Respectfully submitted,

ASTRAZENECA AB

Dated: October 2, 2013

By: 

Wm. Charles Saunders, Esq.

AstraZeneca Pharmaceuticals LP
1800 Concord Pike
Wilmington, DE 19850
Tel. No.: (302) 885-4268
Fax No.: (302) 886-2459
E-Mail: trademarks@astrazeneca.com

Attorney for Opposer

**CERTIFICATE OF
SERVICE**

I hereby certify that on this 2nd day of October 2013, a true and complete copy of the foregoing Notice of Opposition has been served upon the Applicant's correspondent via Overnight Courier:

GUIDO MORADEI
Via Sanvito, 43
I-21100 VARESE
ITALY

Dated: October 2, 2013

By: 
Wm. Charles Saunders

Generated on: This page was generated by TSDR on 2013-10-02 12:31:45 EDT

Mark: ATACAND

US Serial Number: 75033908 **Application Filing Date:** Dec. 18, 1995
US Registration Number: 2160791 **Registration Date:** May 26, 1998
Register: Principal
Mark Type: Trademark
Status: The registration has been renewed.
Status Date: Jun. 06, 2008
Publication Date: Oct. 01, 1996 **Notice of Allowance Date:** Dec. 24, 1996

Mark Information

Mark Literal Elements: ATACAND
Standard Character Claim: No
Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *..* identify additional (new) wording in the goods/services.

For: pharmaceutical preparations for the treatment of cardiovascular diseases

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: Dec. 22, 1997

Use in Commerce: Dec. 22, 1997

Basis Information (Case Level)

Filed Use: No	Currently Use: Yes	Amended Use: No
Filed ITU: Yes	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: AstraZeneca AB
Owner Address: Vastra Malarehamnen 9
SODERTALJE
SWEDEN
Legal Entity Type: CORPORATION **State or Country Where Organized:** SWEDEN

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Wm. Charles Saunders **Docket Number:** ATACAND
Attorney Primary Email: trademarks@astrazeneca.com **Attorney Email:** Yes

Address: _____

Authorized:

Correspondent

Correspondent Name/Address: Wm. Charles Saunders
AstraZeneca Pharmaceuticals LP
OW2
1800 Concord Pike
Wilmington, DELAWARE 19850
UNITED STATES

Phone: 3028854268

Fax: 3028868221

Correspondent e-mail: trademarks@astrazeneca.com

Correspondent e-mail Authorized: Yes

Domestic Representative

Domestic Representative Name: Wm. Charles Saunders

Phone: 3028854268

Fax: 3028868221

Domestic Representative e-mail: trademarks@astrazeneca.com

Domestic Representative e-mail Authorized: Yes

Prosecution History

Date	Description	Proceeding Number
Jun. 06, 2008	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	76533
Jun. 06, 2008	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Jun. 06, 2008	ASSIGNED TO PARALEGAL	76533
May 15, 2008	TEAS SECTION 8 & 9 RECEIVED	
Aug. 16, 2007	CASE FILE IN TICRS	
Jul. 23, 2007	ATTORNEY REVOKED AND/OR APPOINTED	
Jul. 23, 2007	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Jun. 24, 2004	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
May 18, 2004	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
May 18, 2004	TEAS SECTION 8 & 15 RECEIVED	
Feb. 10, 2003	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Aug. 23, 2002	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
May 26, 1998	REGISTERED-PRINCIPAL REGISTER	
Mar. 11, 1998	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Mar. 11, 1998	ASSIGNED TO EXAMINER	73363
Mar. 06, 1998	STATEMENT OF USE PROCESSING COMPLETE	
Jan. 20, 1998	USE AMENDMENT FILED	
Jan. 16, 1998	EXTENSION 2 GRANTED	
Dec. 04, 1997	EXTENSION 2 FILED	
Jul. 09, 1997	EXTENSION 1 GRANTED	
Jun. 16, 1997	EXTENSION 1 FILED	
Dec. 24, 1996	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Oct. 01, 1996	PUBLISHED FOR OPPOSITION	
Aug. 30, 1996	NOTICE OF PUBLICATION	
Jul. 25, 1996	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jun. 26, 1996	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Jun. 11, 1996	NON-FINAL ACTION MAILED	
May 31, 1996	ASSIGNED TO EXAMINER	72618

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: May 26, 2008

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: POST REGISTRATION

Date in Location: Jun. 06, 2008

Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Registrant: ASTRA AKTIEBOLAG

Assignment 1 of 1

Conveyance: CHANGE OF NAME

Reel/Frame: [2191/0437](#)

Pages: 12

Date Recorded: Aug. 14, 2000

Supporting Documents: [assignment-tm-2191-0437.pdf](#)

Assignor

Name: [ASTRA AB \(ASTRA AKTIEBOLAG\)](#)

Execution Date: Jan. 03, 2000

Legal Entity Type: SWEDEN CORPORATION

State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [ASTRAZENECA AB](#)

Legal Entity Type: SWEDEN CORPORATION

State or Country Where Organized: No Place Where Organized Found

Address: 151 85 SODERTALJE
SWEDEN

Correspondent

Correspondent Name: GRAHAM, CAMPAIGN P.C.

Correspondent Address: H. JOHN CAMPAIGN
SUITE 1300
36 WEST 44TH STREET
NEW YORK, NY 10036-8178

Domestic Representative - Not Found

Generated on: This page was generated by TSDR on 2013-10-02 12:33:19 EDT

Mark: ATACAND HCT

ATACAND HCT

US Serial Number: 75250934 Application Filing Date: Mar. 03, 1997
US Registration Number: 2485478 Registration Date: Sep. 04, 2001
Register: Principal
Mark Type: Trademark
Status: The registration has been renewed.
Status Date: Aug. 13, 2011
Publication Date: Nov. 18, 1997 Notice of Allowance Date: Feb. 10, 1998

Mark Information

Mark Literal Elements: ATACAND HCT
Standard Character Claim: No
Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)
Disclaimer: "HCT"

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *..* identify additional (new) wording in the goods/services.

For: pharmaceutical preparations for the treatment of cardio-vascular diseases

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: Sep. 04, 2000

Use in Commerce: Sep. 04, 2000

Basis Information (Case Level)

Filed Use: No	Currently Use: Yes	Amended Use: No
Filed ITU: Yes	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: ASTRAZENECA AB
Owner Address: VASTRA MALAREHAMNEN 9
S-151 85 SODERTALJE
SWEDEN
Legal Entity Type: CORPORATION State or Country Where Organized: SWEDEN

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Travis P. Boozar Docket Number: A02167/US
Attorney Primary Email Address: trademarks@astrazeneca.com Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Travis P. Boozar
ASTRAZENECA PHARMACEUTICALS LP

1800 CONCORD PIKE
Mailstop: FOP3-414
WILMINGTON, DELAWARE 19850-5437
UNITED STATES

Phone: 302.885.5242

Fax: 302.383.4918

Correspondent e-mail: trademarks@astrazeneca.com

Correspondent e-mail Yes
Authorized:

Domestic Representative

Domestic Representative Name: Wm. Charles Saunders

Phone: 3028854268

Fax: 3028868221

Domestic Representative e-mail: trademarks@astrazeneca.com

Domestic Representative e-mail Yes
Authorized:

Prosecution History

Date	Description	Proceeding Number
Aug. 13, 2011	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	67723
Aug. 13, 2011	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	67723
Aug. 11, 2011	TEAS SECTION 8 & 9 RECEIVED	
Sep. 19, 2007	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	67723
Sep. 12, 2007	ASSIGNED TO PARALEGAL	67723
Aug. 29, 2007	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Aug. 29, 2007	TEAS SECTION 8 & 15 RECEIVED	
Jul. 23, 2007	ATTORNEY REVOKED AND/OR APPOINTED	
Jul. 23, 2007	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Feb. 05, 2007	CASE FILE IN TICRS	
Sep. 26, 2002	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Aug. 23, 2002	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Sep. 04, 2001	REGISTERED-PRINCIPAL REGISTER	
May 02, 2001	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
May 01, 2001	ASSIGNED TO EXAMINER	72505
Mar. 02, 2001	STATEMENT OF USE PROCESSING COMPLETE	
Jan. 24, 2001	USE AMENDMENT FILED	
Sep. 10, 2000	EXTENSION 5 GRANTED	
Jul. 10, 2000	EXTENSION 5 FILED	
Feb. 09, 2000	EXTENSION 4 GRANTED	
Dec. 14, 1999	EXTENSION 4 FILED	
Jul. 02, 1999	EXTENSION 3 GRANTED	
Jun. 07, 1999	EXTENSION 3 FILED	
Jan. 07, 1999	EXTENSION 2 GRANTED	
Dec. 14, 1998	EXTENSION 2 FILED	
Jul. 23, 1998	EXTENSION 1 GRANTED	
Jul. 06, 1998	EXTENSION 1 FILED	
Feb. 10, 1998	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Nov. 18, 1997	PUBLISHED FOR OPPOSITION	
Oct. 17, 1997	NOTICE OF PUBLICATION	
Sep. 15, 1997	APPROVED FOR PUB - PRINCIPAL REGISTER	
Sep. 13, 1997	ASSIGNED TO EXAMINER	64390

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Section 15 - Accepted
Incontestability:

Renewal Date: Sep. 04, 2011

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: Not Found

Date in Location: Aug. 13, 2011

Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Registrant: ASTRAZENECA AB

Assignment 1 of 1

Conveyance: CHANGE OF NAME

Reel/Frame: [2191/0437](#)

Pages: 12

Date Recorded: Aug. 14, 2000

Supporting Documents: [assignment-tm-2191-0437.pdf](#)

Assignor

Name: [ASTRA AB \(ASTRA AKTIEBOLAG\)](#)

Execution Date: Jan. 03, 2000

Legal Entity Type: SWEDEN CORPORATION

State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [ASTRAZENECA AB](#)

Legal Entity Type: SWEDEN CORPORATION

State or Country Where Organized: No Place Where Organized Found

Address: 151 85 SODERTALJE
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Correspondent

Correspondent Name: GRAHAM, CAMPAIGN P.C.

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36 WEST 44TH STREET
NEW YORK, NY 100036-8178

Domestic Representative - Not Found