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

Registration No. 1,987,445	
Alfacell Corporation	
Petitioner	Cancellation No. 32,202
v.	
Anticancer, Inc.	CROSS-MOTION FOR SUMMARY JUDGEMENT FOR FINDING OF NON-USE AND ABANDONMENT
Registrant	

Box TTAB
Assistant Commissioner for Trademarks
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Arlington VA 22202-3513

Introduction

Registrant Anticancer, Inc. has moved for summary judgement. Anticancer contends it is "using" its alleged mark ONCASE in connection with its rMETase pharmaceutical product and that Registrant never intended to abandon ONCASE as a trademark.

Registrant may indeed be "using" ONCASE, but this "use" is legally of no account. The Lanham Act is a Federal Statute, and requires a particular type of use, namely "use in commerce" as that term is defined in Section 45 (15 U.S.C. §1127). A review of Registrant's motion, and the therein-included Declaration of Dr. Hoffman with attached specimens of "use", reveals that when evaluated in accordance with the statutory definition of the term, Registrant's use of its alleged ONCASE mark does not constitute use in commerce. Registrant's professed lack of intent to abandon ONCASE is therefore irrelevant.

Registrant's Declaration Fails to Show Use of ONCASE "In Commerce"

Section 45 of the Lanham Act defines "use in commerce" as follows:

> The term "use in commerce" means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this Act, a mark shall be deemed to be in use in commerce –
>
> (1) on goods when –
>
> (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and
>
> (B) the goods are sold or transported in commerce....

Registrant's rMETase pharmaceutical product is clearly a "good" within the meaning of the Lanham Act. Therefore, for Registrant to be using its alleged ONCASE mark in commerce, Registrant must use the mark on the product or on its container or on tags or labels affixed to it. Other uses do not constitute "use in commerce".[1]

Dr. Hoffman's Declaration makes it clear that Registrant's use of ONCASE is not on the rMETase product, is not on the rMETase container, is not on tags affixed to the rMETase product, and is not on labels affixed to the rMETase product. This will be demonstrated by going through his Declaration paragraph by paragraph, beginning at paragraph 2:

In Paragraph 2, Registrant claims it has used its ONCASE mark in commerce in connection with its rMETase product, but no specimen showing the manner of use is attached.

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[1]For example, a specimen showing use of a trademark in advertising does not demonstrate use of that trademark in commerce. *See*, e.g., T.M.E.P. Section 905.05.

In Paragraph 3, Registrant claims it has consistently used its ONCASE mark in connection with its rMETase product, but no specimen showing the manner of use is attached.

In Paragraph 4, Registrant states it has never intended to abandon the ONCASE mark nor taken any steps to do so, but this does not show that the Registrant is using the mark in commerce.

In Paragraph 5, Registrant states that for four years it used its ONCASE mark at annual meetings of a trade show. Registrant then proceeds to state that at each meeting, it distributed "technical bulletins" bearing the ONCASE mark and bibliographies of all ONCASE publications, with a specimen of the bulletin being attached as Exhibit A and a specimen of the bibliography being attached as Exhibit B.

Exhibit A is an information bulletin. It was clearly not on the rMETase product, or on its container, or on a tag or on a label; in the words of the Trademark Trial & Appeal Board, it did not "travel with the product".[2] Exhibit A therefore does not evidence use of the ONCASE mark in commerce. Likewise, as to the bibliography of Exhibit B. Neither the Exhibit A nor the Exhibit B specimens demonstrate "use in commerce" within the meaning of Section 45 of the Lanham Act.

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[2]In In re ITT Rayonier Inc., 208 U.S.P.Q. 86, 87 (T.T.A.B. 1980), the Board held that an information bulletin did not evidence use of a trademark in commerce. At page 87, the Board noted that the information bulletins did not "travel with the product". And, relying on In re Bright of America, Inc., 205 U.S.P.Q. 63 (T.T.A.B. 1979), the Board said at page 87:

> ... we held that use of a mark on literature that is not point-of-purchase material designed to attract the attention of prospective purchasers (which unassociated literature is the only manner of use claimed in the application or illustrated by the specimens of record) is not a display associated with the goods in fullfillment of the statutory definition of use in commerce in §45 of the Act. Such use, therefore, does not satisfy the requirements of §1 of the Act.

Paragraph 6 is to the same effect as paragraph 5, but refers to annual meetings of a different trade show. The above comments to paragraph 5 apply with full force to paragraph 6; "use in commerce" is shown by neither the Exhibit A nor Exhibit B specimens.

In Paragraph 7, Registrant states that scientific papers continue to be published regarding the "ONCASE product", and Exhibits C through M are copies of those scientific papers. These scientific papers are clearly not affixed to the rMETase product, or to its containers, and are clearly neither tags nor labels. Moreover, as far as the undersigned can determine, not one of these papers uses the ONCASE mark! The rMETase product is referred to by its name: rMETase.

In Paragraph 8, Registrant states that it collaborated with the University of Texas, Southwestern Medical School for preclinical trials of "the ONCASE product", and that Registrant never intended to abandon using the ONCASE mark. Clearly, this fails to demonstrate "use in commerce".

In Paragraph 9, Registrant states that it conducted clinical trials of ONCASE in Mexico and refers to two scientific papers attached as Exhibits N and O. Clearly, these specimens fail to demonstrate use in commerce. Furthermore, trials in Mexico are not "in commerce" within the meaning of the Lanham Act[3].

Paragraphs 10, 11, and 12 all recite the names of foreign firms that are studying and/or developing "the ONCASE product". As above, there is no showing of use of ONCASE in commerce. Nor can there be, since the recited firms are located in Japan, China, France, and Korea, and trials there are not "in commerce" because, as in the case of Mexico above, Congress may not regulate trials in Japan, China, France, or Korea.

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[3]The Lanham Act, Section 45, says that "The word 'commerce' means all commerce which may lawfully be regulated by Congress." Congress has no right to regulate clinical trials in Mexico.

Registrant Has Made a *Prima Facie* Showing That the ONCASE Mark is Abandoned

Section 45, in the section that defines "abandoned", says:

> Nonuse for 3 consecutive years shall be prima facie evidence of abandonment.

Registrant has submitted specimens of "use" covering 1998 to the present, i.e. lasting for not 3 but rather 4 years. Not a single one of these specimens demonstrates "use in commerce" within the meaning of Section 45 of the Lanham Act. For this reason, Registrant has itself made a prima facie showing that its alleged ONCASE mark is abandoned.

Summary and Conclusion

The Lanham Act requires use in commerce, and that required use in commerce must conform with the statutory definition set out in Section 45.

Registrant has submitted not one label, not one tag, and not one container to show that its alleged ONCASE mark is used in commerce as the Lanham Act requires. Rather, over a four year period, all the Registrant can do is to offer up use of the mark on an information bulletin, use of the mark on a bibliography, and a collection of scientific papers in which use of the ONCASE mark cannot be discerned.

This is not use in commerce, and a four year period of nonuse is a prima facie abandonment. Accordingly, the Board should issue summary judgement against Registrant, cancelling Registration No. 1,987,445 for abandonment.

Respectfully submitted

Date: 8 MAR 2002

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Proof of Service

I hereby certify that, pursuant to the provisions of 37 CFR §2.119(a), a copy of this paper was served upon counsel for Registrant in accordance with the provisions of 37 CFR §2.119(b)(4) by transmitting it, on March 8, 2002, by first-class mail, in an envelope addressed to:

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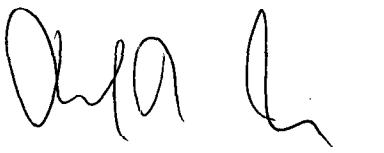

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