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

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	:	
Registration No. 1,987,445	:	
	:	
Alfacell Corporation	:	
	:	Cancellation No. 32,202
Petitioner	:	
	:	
v.	:	<u>PETITIONER'S OPPOSITION TO</u>
	:	<u>REGISTRANT'S MOTION TO</u>
Anticancer, Inc.	:	<u>EXTEND TIME TO FILE BRIEF</u>
	:	
Registrant	:	
	:	
-----X	:	



10-16-2003

U.S. Patent & TMO/TM Mail RptDt. #57

Commissioner for Trademarks
2900 Crystal Drive
Arlington VA 22202-3514

On October 7, 2003, two days before the date on which its Brief was due, Registrant filed a Motion to extend the time in which to file its Brief. Petitioner opposes.

Registrant adduces two reasons for its Motion. The first is that between Registrant's receipt of Petitioner's Brief and "last week" (presumably the week of September 29, 2003), Registrant's President took two lengthy business trips to Asia, defendant's counsel "had difficulty obtaining the required input and therefore could not begin preparation" of the Brief (emphasis supplied).

The second is that "Petitioner raised a new issue in its brief", which issue "was not included in the petition to cancer, nor did either party conduct discovery on the issue or take testimony on the issue".

As to the first reason, Registrant's Motion does not say when, and for how long, Registrant's President was unavailable or whether other corporate personnel could have provided the information sought by Registrant's counsel. A similarly undetailed motion - likewise seeking an extension of time based upon a party's allegedly busy travel schedule - has been held to contain insufficient facts on which

to find good cause for the extension sought¹. Furthermore, Petitioner's Brief was filed early, which gave Registrant additional time for response. Finally, and significantly, Registrant's counsel states that she did not even begin preparation of her client's Brief without "obtaining the required input" from her client. A late beginning is the cause of an untimely end, not a reason to excuse it.

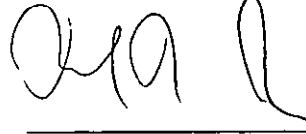
As to the "new issue", which was indeed absent from the petition to cancel, Registrant's counsel cannot claim surprise. Attached as Exhibit A is an exchange of correspondence between counsel that relates to this "new issue". This correspondence shows a) that the "new issue" arose because of Registrant's trial testimony (actually, because Registrant's counsel prevented Registrant from testifying), b) that Petitioner requested Registrant's consent to conduct discovery on the "new issue", and c) that Registrant refused to grant that consent. Therefore, even though Registrant's counsel has been on notice of this "new issue" since the middle of last May, she apparently did nothing to investigate it until she received Petitioner's Brief. And, Registrant now uses the absence of discovery as a reason why last-minute work is needed, when the absence of discovery came about because Registrant did not consent to it!

TBMP 509.01(a) states that the Board will "scrutinize carefully" any motion to extend time, to determine whether the requisite good cause has been shown. And, the cases cited in footnote 131 of TBMP 509.01(a) clearly evidence the Board's displeasure with motions to extend that are filed at the very end of the applicable time period, as was Registrant's present Motion. *Petitioner's Brief was filed early, even though Petitioner's CEO also travels, and even though Petitioner's counsel is a sole practitioner. Registrant, on the other hand, which is represented by a major law firm with almost 20 offices and many hundreds of lawyers to call upon, and with notice almost one-half year ago of an issue it now calls "new", did not even begin preparing its Brief until its President returned from his travels, and filed its Motion to Extend Time only two days before its Brief was due.*

¹Luemme, Inc. v. D.B. Plus, Inc., 53 USPQ 2d 1758 at 1760-61 (TTAB 1999).

Registrant's Motion to Extend should be denied, Registrant's forthcoming Brief should be ignored as having been untimely filed, and this proceeding should be decided based upon the evidence of record and Petitioner's Brief on Appeal.

Respectfully submitted



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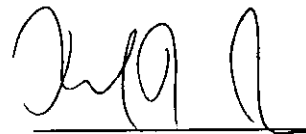
Attorney for Petitioner
Alfacell Corporation

Date: 14 Oct 2003

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 October 14, 2003, by first-class mail, in an envelope addressed to:

Jennifer Lee Taylor, Esq.
Morrison & Foerster LLP
425 Market Street
San Francisco CA 94105-2482



Mark H. Jay
Reg. No. 27,507

May 16, 2003
By Facsimile:
415-268-7522

Jennifer Lee Taylor, Esq.
Morrison & Foerster LLP
425 Market Street
San Francisco CA 94105-2482

Re: Alfacell Corporation v. Anticancer, Inc.
Cancellation No. 32,202

Dear Ms. Taylor,

I yesterday received the transcript of Dr. Hoffman's deposition, for which I thank you.

Based on this deposition transcript, Petitioner believes that there is another ground upon which it can legitimately request cancellation of Registrant's registration, namely, that the commerce upon which Registrant obtained its registration was unlawful.

More specifically, to obtain its registration, Registrant apparently relied upon its exportation of its ONCASE pharmaceutical to Mexico for the purpose of conducting clinical trials there. In Registrant's Exhibit 3, paragraph 8, Registrant stated that in the mid-1990's, it conducted clinical trials of ONCASE in Mexico during which the product was tested on human patients, and that doctors carried the ONCASE product from California to Mexico.

Such exportation from the U.S. to Mexico was and is subject to the laws of the United States, including regulations promulgated by the Food and Drug Administration ("FDA"), of which 21 CFR §312.110(b) is one. Under this provision, this exportation could only have been legal if the exporter had an Investigational New Drug application ("IND") in effect or if the FDA had authorized the exportation.

We know that Registrant has not ever filed an IND for ONCASE. And, at Dr. Hoffman's deposition, Petitioner asked him whether, at the time of the exportation, the FDA knew about it. Counsel did not permit Dr. Hoffman to answer. (See page 106, line 21ff of the transcript.)

Jennifer Lee Taylor, Esq.
May 16, 2003 (by facsimile)
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On these facts, Petitioner may clearly infer that in fact the FDA did not know about, and certainly did not authorize, this exportation. And, as you know, under 37 CFR §2.69, the USPTO will not grant a registration based on unlawful use in commerce. Hence, based on the facts now known to it, Petitioner believes that Registrant obtained its registration on the basis of unlawful commerce, and that its registration should therefore be cancelled for this reason as well.

Alfacell intends to amend its pleadings to recite this additional ground for cancellation, to reopen discovery so that it may know exactly what uses in commerce served as the basis for Registrant's allegation of use and of Registrant's compliance with all applicable FDA regulations, and to reset the periods for testimony and briefing. The question is, whether Registrant will consent to these steps, or whether Alfacell will need to apply to the Board for relief.

Please advise as to your position on these issues at your earliest opportunity. Thank you.

Very truly yours,

Mark H. Jay

MHJ:bms

cc: Kuslima Shogen, CEO
Alfacell Corporation
(by facsimile: 973-748-1355)

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May 30, 2003

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By Telefacsimile

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Intellectual Property Law
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Short Hills, NJ 07078-0383

Re: Alfacell Corp. v. Anticancer, Inc.

Dear Mark:

We have received your letter of May 16, 2003. You have inquired as to whether Anticancer, Inc. ("Anticancer") will consent to an amendment of Alfacell Corp.'s ("Alfacell") pleadings to recite an additional ground for cancellation, reopening of discovery, and resetting of the periods for testimony and briefing.

In response to your letter, we wish first to inform you that the use-in-commerce upon which Anticancer's registration for the mark ONCASE is based was and is lawful. Second, we wish to inform you that notwithstanding the lawfulness of Anticancer's use-in-commerce, we consider Alfacell's request to amend its pleadings, reopen discovery, and reset the testimony and briefing periods to be untimely; Alfacell has already had ample opportunity to discover and plead all potential grounds for its cancellation of Anticancer's registration of the mark ONCASE.

Accordingly, Anticancer will not consent to any of the aforementioned steps about which you inquired in your letter.

MORRISON & FOERSTER LLP

Mark H. Jay, Esq.
May 30, 2003
Page Two

Thank you for your consideration in this matter. Please do not hesitate to contact me if you have any further questions or concerns.

Sincerely,



Jennifer Lee Taylor

cc: Maame A.F. Ewusi-Mensah, Esq.
Dr. Robert M. Hoffman, Anticancer, Inc.