TTAB

TRADEMARK

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

NYCOMED US INC. Petitioner, v. ELARA NUTRICEUTICALS, INC. Registrant.	Mark: PARANEX Registration No. 3,547,375 Cancellation No. _____

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

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PETITION FOR CANCELLATION

In the matter of U.S. Trademark Registration No. 3,547,375, registered December 16. 2008, by Elara Nutriceuticals, Inc., a Florida corporation, P.O. Box 335, Fate, Texas 75132 (hereinafter referred to as "Registrant") for goods in Class 5;

Nycomed US Inc., a New York having its principal place of business at 60 Baylis Road, Melville, New York 11747 (hereinafter referred to as "Petitioner") believes that it is being or will be damaged by said registration and hereby petitions to cancel the registration.

The grounds for cancellation are as follows:

1. Petitioner, and/or its predecessor in interest, first used the mark PERANEX in connection with hemorrhoid preparations, creams, ointment and pads at least as early as December 14, 2007, and Petitioner filed its PERANEX trademark application with the U.S. Patent and Trademark Office on November 21, 2006. These dates are prior to the date of first use stated in the above registration. Petitioner, and/or its predecessor in interest, has continuously so used the PERANEX mark since at least as early as December 14, 2007.

05-21-2010

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

2. Petitioner is the owner of the trademark PERANEX for hemorrhoid preparations, creams, ointments and pads and is the owner of Registration No. 3,477,256, a copy of which is attached as Exhibit A, registered July 29, 2008.

3. By virtue of its prior usage of the mark PERANEX in connection with hemorrhoid preparations, creams, ointments and pads, Petitioner has created substantial goodwill in its business under this mark. Such goodwill extends to the product sold by Petitioner.

4. Petitioner's goods and Registrant's goods are related in as much as some of the goods listed in Reg. No. 3,547,375 are the same types of goods as have been sold by Petitioner in association with other marks.

5. Petitioner's registered mark and Registrant's mark are virtually identical in appearance, pronunciation and connotation, differing only in the spelling of each mark.

6. The mark shown in Reg. No. 3,547,375 comprises a mark which so resembles Petitioner's mark registered in the Patent and Trademark Office as to be likely, when used on or in connection with the goods of the Registrant, to cause confusion or to cause mistake or to deceive.

7. The continued existence of Registration No. 3,547,375 for the mark PARANEX will damage Petitioner in that it will create legal uncertainty with respect to Petitioner's own use of the mark PERANEX. In addition, Registrant's use of PARANEX is likely to cause confusion and dilution relative to Petitioner's mark.

WHEREFORE, Petitioner requests the cancellation of Registration No. 3,547,375.

Please deduct the required filing fee of $300.00 from our Deposit Account 500996 (NYCO.160TA) for this Petition for Cancellation. Authority is given to charge/credit additional fees/overages to complete this filing.

Petitioner is serving a copy of this Petition for Cancellation on Registrant, as set forth in the below Certificate of Service.

The undersigned hereby appoints Linda M. Byrne, Reg. No. 32,404; Robert Crawford, Reg. No. 32,122 ; and Eric Curtin, Reg. No. 47,511 of the law firm of Crawford Maunu PLLC as its attorneys with the full power to represent the Petitioner in connection with this cancellation proceeding.

Please send all correspondence to the undersigned.

Respectfully submitted,

NYCOMED US INC.

By its attorneys,

Linda M. Byrne, Reg. No. 32,404
CRAWFORD MAUNU PLLC
1150 Northland Drive, Suite 100
St. Paul, MN 55120
(651) 259-2302 telephone
(651) 686-7111 facsimile
Lbyrne@ip-firm.com

(NYCO.160TA)

CERTIFICATE OF MAILING

I hereby certify that this PETITION FOR CANCELLATION is being deposited with the United States Postal Service, first class mail, in an envelope addressed to Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, P.O. Box 1451, Alexandria, VA 22313-1451 on this 18th day of May, 2010.

Lisa A. Joyce

CERTIFICATE OF SERVICE

I hereby certify that this PETITION FOR CANCELLATION is being deposited with the United States Postal Service, first class mail, in an envelope addressed to Registrant:

Elara Nutriceuticals
P.O. Box 335
Fate, TX 75132

on this 18th day of May, 2010.

Lisa A. Joyce

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

NYCOMED US INC.	)
Petitioner,	) Registration No. 3,547,375
	)
v.	) Cancellation No. _____
ELARA NUTRICEUTICALS, INC.	)
Registrant	) Mark: PARANEX
	)

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Trademark Trial and Appeal Board, U.S. Patent and Trademark office, P.O. Box 1451, Alexandria, VA 22313-1451, on May 18, 2010.

By: _____
Name: Lisa Joyce

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Commissioner:

We are transmitting herewith the attached:

- ☒ Return postcard.
- ☒ Transmittal Sheet containing Certificate Under 37 C.F.R. 1.8
- ☒ Petition for Cancellation of Registration No. 3,547,375
- ☒ **Please charge Deposit Account 50-0996 (NYCO.160TA) $300.00 in payment of the Filing Fee.** Authority is given to charge/credit additional fees/overages to complete this filing.

CRAWFORD MAUNU PLLC
1150 Northland Drive, Suite 100
St. Paul, MN 55120
(651) 259-2302

By: _____
Name: Linda M. Byrne
Reg. No. 32,404