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Filing date: **04/12/2012**

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

|                        |  |
|------------------------|--|
| Proceeding             | 91201582   |
| Party                  | Defendant<br>Guerlain S.A.   |
| Correspondence Address | DAVID EHRLICH<br>FROSS ZELNICK LEHRMAN & ZISSU, P.C.<br>866 UNITED NATIONS PLZ<br>NEW YORK, NY 10017-1822<br>UNITED STATES<br>ehrllich-docket@fzlj.com |
| Submission             | Answer and Counterclaim  |
| Filer's Name           | David Ehrlich  |
| Filer's e-mail         | ehrllich-docket@fzlj.com   |
| Signature              | /dwe/  |
| Date                   | 04/12/2012   |
| Attachments            | Lupin Pharmaceuticals v. Guerlain - Answer and Cancellation Counterclaim (F0992144).PDF ( 7 pages )(286426 bytes )                                     |

Registration Subject to the filing

|                 |   |                   |            |
|-----------------|---|-------------------|------------|
| Registration No | 4024405   | Registration date | 09/13/2011 |
| Registrant      | Lupin Pharmaceuticals, Inc.<br>Harborplace Tower 111 South Calvert Street, 21st Floor<br>Baltimore, MD 21202<br>UNITED STATES |                   |            |

Goods/Services Subject to the filing

Class 005. First Use: 2005/07/01 First Use In Commerce: 2005/07/01  
All goods and services in the class are requested, namely: HOUSE MARK FOR FULL LINE OF PHARMACEUTICALS FOR MEDICAL PURPOSES, BUT EXCLUDING DIETARY SUPPLEMENTS AND EDIBLE FLOUR

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

In the Matter of Application No. 85/161,714  
Trademark: ARSENE LUPIN  
Applicant's Ref.: GNS 1108044

|                        |   |
|------------------------|---|
| -----X                 |   |
| Lupin Pharmaceuticals, | : |
|                        | : |
| Opposer,               | : |
|                        | : |
| v.                     | : |
|                        | : |
| Guerlain S.A.,         | : |
|                        | : |
| Applicant.             | : |
|                        | : |
| -----X                 |   |

Opposition No. 91201582

**APPLICANT'S ANSWER AND CANCELLATION COUNTERCLAIM**

Applicant, by its undersigned attorney, hereby answers the Notice of Opposition as follows and makes the following counterclaim:

1. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1 in the Notice of Opposition.
2. Applicant admits the allegations of the Paragraph 2 of the Notice of Opposition.
3. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 3 in the Notice of Opposition.
4. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 4 in the Notice of Opposition.
5. Applicant denies the allegations of Paragraph 5 of the Notice of Opposition.

6. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 6 in the Notice of Opposition.
7. Applicant denies the allegations of Paragraph 7 of the Notice of Opposition.
8. Applicant denies the allegations of Paragraph 8 of the Notice of Opposition.
9. Applicant admits that the marks are inherently distinctive for pharmaceuticals not containing ingredients derived from the lupin plant and otherwise denies the allegations of Paragraph 9 of the Notice of Opposition.
10. Applicant admits the allegations of the Paragraph 10 of the Notice of Opposition.
11. Applicant admits that Opposer's application filing dates, for its two claimed applications, predate the filing date of the opposed application and otherwise denies the allegations of Paragraph 11 of the Notice of Opposition.
12. Applicant denies the allegations of Paragraph 12 of the Notice of Opposition.
13. Applicant admits that the literary character name and mark ARSENE LUPIN includes the word LUPIN and otherwise denies the allegations of Paragraph 13 of the Notice of Opposition.
14. Applicant denies the allegations of Paragraph 14 of the Notice of Opposition.
15. Applicant denies the allegations of Paragraph 15 of the Notice of Opposition.
16. Applicant denies the allegations of Paragraph 16 of the Notice of Opposition.
17. Applicant denies the allegations of Paragraph 17 of the Notice of Opposition.

18. Applicant denies the allegations of Paragraph 18 of the Notice of Opposition.
19. Applicant admits that this opposition was filed within the extended opposition deadline.

### **CANCELLATION COUNTERCLAIM**

1. Opposer is the record owner of U.S. trademark Reg. No. 4024405, maturing from Serial No. 77/766,890, for the mark LUPIN for “house mark for a full line of pharmaceuticals for medical purposes, but excluding dietary supplements and edible flower,” which claims the date of first use of July 1, 2005, and which was filed on June 24, 2009, on the basis of use under Section 1(a), covering “house mark for a full line of pharmaceuticals for medical purposes.” The limiting phrase “but excluding dietary supplements and edible flower” was added by amendment later, during prosecution.
2. Section 1402.03(c) now states that, in an application in which the goods are a full line of pharmaceuticals, “the Examining Attorney must require the applicant to provide evidence that it uses the mark in connection with pharmaceuticals to treat diseases or health problems in all categories in the World Health Organization (“W.H.O.”) International Statistical Classification Of Diseases And Related Health Problems. Upon information and belief, the ninth revision of this list was in effect on the June 24, 2009 filing date of the application concerned and is still widely used in the United States. Upon information and belief, this list is organized with 18 top level classifications that group diseases or health conditions in broad scientific categories.
3. Upon information and belief, the Opposer was selling, in the United States, on the filing date of the application concerned, June 24, 2009, pharmaceuticals classified in fewer than such 18 categories.

4. Upon information and belief, on such date, the pharmaceuticals sold by Opposer in the United States consisted entirely of pharmaceuticals of the following types:
  1. Antibiotics
  2. Cardiovascular drugs
  3. Anti-inflammatory drugs
  4. Drugs for mental disorders and convulsions
  5. Drugs for nervous system disorders

Upon information and belief, these drugs not only do not fall within all 18 of the required categories for a full line of pharmaceuticals, but do not even fall in one half of the required categories for a full line of pharmaceuticals. Upon information and belief, for example, Opposer's LUPIN drugs sold in the U.S. did not then include such required W.H.O. categories as neoplasms (cancer) and diseases of the digestive system.

#### **COUNT I – INVALIDITY**

5. Contrary to the claim of use in its application, Opposer was not using the mark LUPIN "in commerce," within the meaning of that term in the Lanham Act, for "full line of pharmaceuticals for medical purposes" on the filing date of its application, June 24, 2009.
6. The registration maturing from that application is accordingly invalid for a lack of use for the claimed goods under Section 1 of the Lanham Act.
7. If, as a matter of law, the TTAB determines that use of a mark for less than a full line of pharmaceuticals, in a registration claiming such use, is not a basis for complete cancellation, then the identification of goods in the registration should be appropriately limited to name the actual drug categories, such as antibiotics and pharmaceutical preparations for cardiovascular diseases, sold in commerce under the mark on the filing date.

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