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

Proceeding	91211414
Party	Defendant Purepharma ApS
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PURAPHARM INTERNATIONAL (H.K.) §  
LIMITED, §

Opposer, §

v. §

OPPOSITION NO. 91211414

PUREPHARMA APS, §

Applicant. §

**APPLICANT’S OPPOSITION TO OPPOSER’S MOTION FOR SUSPENSION**  
**PURSUANT TO TRADEMARK RULE 2.117**

Applicant PurePharma APS (“PurePharma” or “Applicant”) hereby respectfully requests that the Board deny the motion of Opposer for entry of an Order suspending this case. As cause for this opposition, Applicant asserts that Applicant, through its counsel Bill Barber, Esq. of Pirkey Barber PLLC, has served a motion for Rule 11 sanctions against counsel for Opposer, including Melissa S. Rizzo, Alexandra E. Howard, and Adams and Reese, LLP, pursuant to Fed. R. Civ. P. 11(c), for filing a Complaint asserting materially false allegations as to the validity and incontestability of the Opposer’s Registration No. 2,639,990.

Opposer’s Complaint and Motion to Suspend represent an improper attempt to avoid Applicant’s Motion to Amend to Assert Counterclaims and Restrictions against that registration and the consequences of Opposer’s false allegations to the USPTO, which are material to Opposer’s claims. Refusing to grant the Motion to Suspend will deter similar misconduct in the future.

Further, as Applicant has challenged Opposer's right to assert Registration No. 2,639,990 in the district court, the landscape of facts and issues will shift materially, thereby rendering any decision on the Motion to Suspend at this point premature. On the other hand, Applicant's Motion to Amend is fully briefed, and the parties are on the eve of trial and summary disposition at the TTAB. Applicant respectfully requests that the Board exercise its discretion to defer ruling on the Opposer's Motion to Suspend until after the Rule 11 Motion and the Motion to Amend to Assert Counterclaims and Restrictions are decided and this case is ready for disposition.

### **I. Introduction**

On November 6, 2014 Melissa S. Rizzo signed and filed with the United States District Court a Complaint on behalf of Opposer seeking a permanent injunction and extensive damages from Applicant based on accusations of willful federal trademark infringement, and false designation of origin and unfair competition. *See* Ex. A ("Complaint"). In the Complaint, Opposer asserted (among other things) that (1) Opposer's PURAPHARM mark was first used in United States commerce in 2001 (Complaint at ¶ 9); (2) Opposer's PURAPHARM registration is valid (Complaint at ¶ 14); and (3) Opposer's PURAPHARM registration is incontestable (Complaint at ¶ 14).

Simultaneously, Ms. Rizzo filed a Motion to Suspend this opposition pending the outcome of the Civil Action.

On November 12, 2014, another of Opposer's counsel, based in Hong Kong, sent letters to some of Applicant's major U.S. customers, threatening a permanent injunction, costs and damages. This letter was based on, inter alia, Opposer's invalid registration. *See* Exhibit F.

As set forth in Applicant's Motion to Amend to Assert Counterclaim (TTAB Docket Nos. 14 and 15), no genuine issues of fact exist that Opposer's registration is invalid and is not incontestable. Specifically, in response to Applicant's Request for Admissions, Opposer's counsel, Ms. Rizzo admitted<sup>1</sup> that Opposer had not used the mark on nine (9) classes of goods set forth in the registration. *See*, Exhibit E. Further, she thereby also admitted that the Declaration of Incontestability (as well as the Statement of Use, Section 8 Affidavit, and Renewal Affidavit) which stated that the mark was in use on *all* the goods listed in the registration were false (emphasis in original). *See*, Exhibits B-E. Based on this information, Applicant has asserted that Opposer's and Ms. Rizzo's assertions in the Complaint of validity of the registration and incontestability were false and have no evidentiary or legal basis. Further, Applicant asserts that Opposer and its counsel filed the Complaint and the Motion to Suspend solely for purposes of delay and to avoid resolution of Applicant's claims.

Because of this, Applicant has served a Rule 11 sanctions motion in the district court matter asking Opposer to either withdraw or amend the Complaint, to deter Opposer from representing material assertions in federal court filings.

Applicant asks that the Board defer ruling on the Opposer's Motion to Suspend until after the Rule 11 Motion and the Motion to Amend to Assert Counterclaims are decided. If Opposer withdraws the Complaint, there will be no further basis for delaying the Board proceeding. If Opposer amends the Complaint to acknowledge the invalidity of the registration and to base the Complaint solely on common law rights, the factual landscape affecting the Board's decision on the motion to suspend will alter materially.

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<sup>1</sup> Ms. Rizzo signed the Request for Admission responses on behalf of Opposer. *See*, Exhibit E

## II. Factual Background

Opposer – a company formed and headquartered in Hong Kong – filed a federal trademark application with the United States Patent and Trademark Office (“USPTO”) for the mark PURAPHARM on an intent-to-use basis on September 21, 1998, Serial No. 75555761. Four years later, on June 14, 2002, Opposer filed a Statement of Use swearing that it was using the mark in commerce on or in connection with *all* of the goods listed in the application, and that the mark was first used in commerce on July 26, 2001. *See* Ex. B. This sworn statement was signed by Opposer’s President Abraham Chan. *See id.* Based on these representations, the registration (Reg. No. 2639990, the “Registration”) issued on October 22, 2002 for the following goods:

Health food for medically restricted diets; food supplements, namely, herbal extract in the form of capsule tablet, powder and granule; food supplements, namely, vitamins, vitamin preparations, minerals, enzymes, and enzymes preparations; dietary and nutritional supplements; nutritional supplements, namely, drink mixes in powder form; dietetic food preparations, dietetic beverages, dietetic substances, and food preparations all for medically restricted diets; digestives for pharmaceutical purposes; appetite suppressants; pharmaceutical preparations and substances for appetite control and weight management; analgesics; sedatives; tranquilizers; sunburn ointments and sunburn preparations for medical use; pharmaceutical preparations for skin care; medicated mud for skin care, medicated skin care mud for baths; medicated mouth washes; medicines for dental purposes; Chinese medicines, for use with human biological systems, namely, Chinese medicines for the respiratory system, gastrointestinal system, endocrine system, cardiovascular system, nervous system, musculoskeletal system, urinary system, integumentary system and reproductive system; balms for medical purposes for the treatment of muscle pain, veterinary nutritional supplements for pets and livestock and medicated preparations for pet and livestock.

On October 17, 2008, Opposer filed a Combined Declaration of Use and Incontestability Under Sections 8 & 15 for this Registration, swearing that the PURAPHARM mark was

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