

TTAB

EXPRESS MAIL NO. EL915073410US

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

PETITION TO CANCEL

In the matter of trademark Registration No.: 2,181,004

Registration Date: August 11, 1998

For the mark: ICOGEN



05-02-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #70

-----: :
Icagen, Inc. : :
 : :
 Petitioner, : :
 : :
 v. : :
 : :
Icogen Corporation : :
 : :
 Registrant. : :
 -----: :

Cancellation No. _____

05/06/2002 TSHITH 00000249 2181004
01 FC:376 300.00 07

Commissioner for Trademarks
BOX TTAB/FEE
2900 Crystal Drive
Arlington, VA 22202-3513

PETITION TO CANCEL

Petitioner, Icagen, Inc. ("Petitioner"), a Delaware corporation with an office located at 4222 Emperor Boulevard, Suite 350, Durham, North Carolina and a mailing address at P.O. Box 14487, Research Triangle Park, NC 27709, submits this Petition to Cancel dated May 2, 2002.

To the best of Petitioner's knowledge, the name and address of the current owner of Registration No. 2181004 is IcoGen Corporation ("Registrant"), a Washington corporation located at 454 N. 34th Street, Seattle, WA 98103.

The above-identified Petitioner believes that it has been, and will continue to be, damaged by the above-identified registration of the mark "ICOGEN" for "research and development services in the field of pharmaceutical drugs, in International Class 042" (the "Services"), and hereby petitions to cancel the same.

Petitioner is engaged in offering, using the trade name Icagen, throughout the United States, various goods and services to others which goods and services are similar in nature to, move within the same channels of trade as, and are within the same field of, Registrant's Services.

The grounds for cancellation are as follows:

1. Petitioner was incorporated as a Delaware corporation on or about November 23, 1992 and has remained active as a validly existing corporation since that time;
2. Petitioner has been operating under the trade name Icagen, Inc. since at least 1992;
3. Petitioner has obtained common law rights based on use in commerce in the trademark and trade name "ICAGEN";
4. Registrant obtained registration of the mark "ICOGEN" for "research and development services in the field of pharmaceutical drugs, in International Class 042" on August 11, 1998 based on an intent-to-use application filed on December 19, 1995;
5. Petitioner, since at least 1992 under the trade name Icagen, Inc., has been providing services in the ordinary course of business which are substantially similar to Registrant's Services, and therefore has priority of use;

6. Petitioner filed a trademark application for the mark "ICAGEN", as evidenced by Application Serial No. 76/301114 filed on August 17, 2001, for "pharmaceutical preparations for the treatment of atrial fibrillation, sickle cell anemia, urinary incontinence, and central nervous system diseases; anti-convulsant preparations; anti-inflammatory preparations; ion channel modulators, in International Class 005";

7. Petitioner has a valid and legal right to describe its goods and services by use of the term "ICAGEN";

8. Petitioner has expended considerable sums of money and considerable efforts in promoting the "ICAGEN" mark and now enjoys a high reputation with many pharmaceutical companies and research universities, and has valuable goodwill invested and symbolized by its "ICAGEN" trademark;

9. Petitioner believes that a likelihood of consumer confusion exists in the relevant channels of trade due to the similarity of Registrant's "ICOGEN" trademark and associated Services in comparison to Petitioner's trade name and common law trademark in "ICAGEN". Therefore, it is Petitioner's position that Registrant's registration should be cancelled based on Petitioner's priority of use of the trademark "ICAGEN" in association with Petitioner's provision of research and development services and related uses;

10. Petitioner has been made aware of actual confusion by potential employees of Petitioner in the form of such potential employees being misdirected to Registrant's website while seeking out information about employment opportunities with Petitioner;

11. By reason of the foregoing allegations, Petitioner believes that it has been harmed by, and will continue to be harmed by, the registration of the "ICOGEN" trademark as represented by Registration No. 2,181,044; and

12. In view of the allegations above, Registrant is not entitled to maintain federal registration of the "ICOGEN" mark, is not entitled to the exclusive use of the "ICOGEN" mark, or any other confusingly similar mark, in association with the Services or any goods and services substantially similar to those of Petitioner.

THEREFORE, Petitioner prays that this Petition to Cancel be sustained in favor of Petitioner and that Registration No. 2,181,004 be CANCELLED.

A duplicate copy of this Petition to Cancel is enclosed.

FEE: A check in the amount of \$300 is enclosed as payment of the required filing fee for a cancellation proceeding in one (1) International Class.

Respectfully submitted,



Neal B. Wolgin
Attorney for Petitioner

Date: May 2, 2002

Hutchison & Mason PLLC
3110 Edwards Mill Road, Suite 100
Raleigh, North Carolina 27612
(919) 829-9600
(919) 829-9696 (fax)

Enclosures

Our Ref.: ICA.38



**HUTCHISON
& MASON
PLLC**

nwolgin@hutchlaw.com
(919) 829-4320



05-02-2002

U.S. Patent & TMOtc/TM Mail RcptDt. #70

May 2, 2002

VIA EXPRESS MAIL NO. EL915073410US

Commissioner of Trademarks
BOX: BOX TTAB/FEE
2900 Crystal Drive
Arlington, Virginia 22202-3513

TRADEMARK TRIAL AND
APPEAL BOARD
02 MAY -8 PM 9:23

Dear Commissioner:

Enclosed please find the following:

1. Original and Duplicate Copy of the Petition of ICAgen, Inc. to Cancel the mark "ICOGEN", Registration No. 2,181,044;
2. A check in the amount of \$300.00 in payment of the filing fees; and
3. A self-addressed, postage-prepaid postcard. Please stamp the postcard with the filing date and return it to the address indicated.

If there are any questions regarding the enclosed, please contact the undersigned.

Respectfully submitted,

Neal B. Wolgin
Attorney for Applicant

Enclosures

cc: Ed Gray, Esq.

Fred D. Hutchison (without enclosures)