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

Proceeding	91214457
Party	Defendant Dermpharma, Inc.
Correspondence Address	MICHAEL J SULLIVAN LAW OFFICE 111 N MARKET ST STE 300 SAN JOSE, CA 95113 UNITED STATES msullivan@mikesullivanlaw.com
Submission	Opposition/Response to Motion
Filer's Name	Michael J. Sullivan
Filer's e-mail	msullivan@mikesullivanlaw.com
Signature	/Michael J. Sullivan/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 85949729
Mark: **RETINEX**
Published in the Official Gazette of Oct. 29, 2013

Valeant International Bermuda, Opposer, v. Dermpharma, Inc., Applicant.	Opposition No.: 91214457

APPLICANT'S OPPOSITION TO
OPPOSER'S MOTION FOR SUMMARY JUDGMENT

Applicant Dermpharma, Inc. ("Applicant") hereby opposes Opposer Valeant International Bermuda's ("Opposer") Motion for Summary Judgment filed March 20, 2015 (the "Motion").

I. OPPOSER'S MOTION SHOULD BE DENIED AS UNTIMELY

The current proceeding was filed on January 7, 2014, and on January 14, 2014 the Board issued a notice setting trial dates, including setting the opening of the first testimony period for November 5, 2014. On December 5, 2014, the Board suspended the proceeding pending disposition of a motion for leave to amend filed by Opposer on October 31, 2014. This motion was decided by the Board on February 6, 2015, and the opening of the first testimony period was rescheduled for March 21, 2015. Opposer then filed its present Motion on March 20, 2015. Seraj

Decl., ¶¶ 2–3, 6–7.

The Board has established that the filing of a motion for leave to amend the notice of opposition does not automatically suspend the proceedings or toll the movant's obligation to respect any deadlines set by the Board. *Sdt Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707 (TTAB 1994); *see also Super Bakery Inc. v. Benedict*, 96 USPQ2d 1134, 1135 (TTAB 2010) (mere filing of motion for summary judgment does not automatically suspend proceedings; only an order of the Board formally suspending proceedings has such effect); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 965 (TTAB 1986) (mere filing of a potentially dispositive motion does not automatically suspend proceedings; only an order of the Board formally suspending proceedings has such effect); *Consultants & Designers, Inc. v. Control Data Corp.*, 221 USPQ 635, 637 n.8 (TTAB 1984) (filing of motion for entry of default judgment for failure to answer does not automatically suspend proceedings). Applicant therefore contends that Opposer's motion filed on October 31, 2014 did not automatically suspend the proceedings and that proceedings were only suspended upon the order of the Board on December 5, 2014, after the opening of the first testimony period on November 5, 2014.

The Board has also established in TBMP § 528.02 that "Once the first testimony period commences, however, any summary judgment motion filed thereafter is untimely, even if filed prior to the opening of a rescheduled testimony period-in-chief for plaintiff, and even if no trial evidence has actually been introduced by the plaintiff in a previously open, but later reset trial period." Although Opposer's Motion was filed the day prior to the opening of the rescheduled testimony period-in-chief for Opposer, per TBMP § 528.02 Opposer's Motion is untimely as i) the first-scheduled testimony period-in-chief for Opposer opened on November 5, 2014 while the proceedings were non-suspended and ii) Opposer's Motion was not filed prior to November 5,

2014.

Opposer may reply that it could not file a motion for summary judgment on the issue of lack of *bona fide* intent-to-use prior to receiving leave to amend its notice of opposition to include this grounds for opposing registration of Applicant's mark. However, parties in opposition proceedings are permitted by the Board pursuant to TBMP § 528.07(a) to "seek[] summary judgment on an unpleaded issue [by] simultaneously mov[ing] to amend its pleading to assert the matter." The Board has additionally stated that this simultaneous motion for summary judgment on a previously unpleaded ground and motion to amend the pleading to assert the new ground is preferred over the alternative of having the movant first receive permission to amend its pleading and then file a subsequent motion for summary judgment on the new ground. *See Societe Des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L.*, 10 USPQ2d 1241, 1242 n.4 (TTAB 1989); *see also American Express Mktg. & Dev. Corp v. Gilad Dev. Corp.*, 94 USPQ2d 1294 (TTAB 2010). As the Board has permitted and encouraged the simultaneous filing of a motion for summary judgment and a motion for leave to amend the pleading to assert the new ground that is the basis of the motion for summary judgment, Opposer should not be allowed to assert that its failure to file the motion for summary judgment prior to the opening of the first testimony period should be excused because it had to wait for a decision on its motion for leave to amend the pleading.

Opposer may further reply that it could not have filed an earlier motion for summary judgment as its currently pending Motion depends for support upon the citing of Applicant's Answer to Opposer's Amended Notice of Opposition ("Applicant's Answer"). However, Applicant's Answer is cited in the Motion exactly zero times to assert information that was not already available prior to Applicant's Answer in Applicant's responses to Opposer's discovery

requests or in publicly available documents. All citations to Applicant's Answer in Opposer's Motion are therefore duplicative of the evidence previously available through other sources. Specifically:

1. Applicant's answer is cited on page 3 of the Motion in support of the facts concerning Applicant's U.S. Trademark Application Ser. No. 85949729 (hereinafter, the "Application"), including its filing date, description of goods, International Class, and filing basis under Section 1(b), all of which are facts available from the Application itself and do not require Opposer to rely upon Applicant's Answer;
2. Applicant's Answer is cited on pages 8 to 10 and 12 of the Motion in support of alleged facts that also include supporting citations to Applicant's responses to Opposer's discovery requests or to the public record;
3. Applicant's Answer is also cited in the Motion in support of alleged facts that do not also contain citations to other sources of support; however, each of the following such claims could just as easily be based on Applicant's initial responses to Opposer's discovery requests:
    a. The claim on page 8 of the Motion that "Applicant had never engaged in the business of producing retinol skin cream or any other cosmetic product prior to June 4, 2013" could just as easily be based on Applicant's responses to Admission Request No. 1 (Seraj Decl., ¶ 5, Exhibit B, ¶ 1), to Document Requests Nos. 35 and 37 (Seraj Decl., ¶ 5, Exhibit C, ¶¶ 35, 37), and to Interrogatories Nos. 9 to 11 (Seraj Decl., ¶ 5, Exhibit D, ¶¶ 9–11);
    b. The claim on page 10 of the Motion that "Applicant's lack of investment in and/or concrete steps toward using the RETINEX mark clearly demonstrates that it

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