

ESTTA Tracking number: **ESTTA907444**

Filing date: **07/05/2018**

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

Proceeding.	91219485
Applicant	Plaintiff Ferring B.V.
Other Party	Defendant Allergan, Inc.
Have the parties held their discovery conference as required under Trademark Rules 2.120(a)(1) and (a)(2)?	Yes

### Motion for Suspension in View of Civil Proceeding With Consent

The parties are engaged in a civil action which may have a bearing on this proceeding. Accordingly, Ferring B.V. hereby requests suspension of this proceeding pending a final determination of the civil action. Trademark Rule 2.117.

Ferring B.V. has secured the express consent of all other parties to this proceeding for the suspension and resetting of dates requested herein.

Ferring B.V. has provided an email address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address of record by Email on this date.

Respectfully submitted,  
/s/ James D. Weinberger  
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07/05/2018

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

FERRING, B.V.,

Opposer,

-against-

ALLERGAN, INC.,

Applicant.

**Opposition Nos. 91219485 (parent),  
91219486, 91219487**

**MOTION ON CONSENT TO SUSPEND  
OPPOSITIONS PENDING RESOLUTION OF CIVIL ACTION**

Opposer Ferring, B.V. (“Opposer”), with the consent of Applicants Allergan, Inc. and Serenity Pharmaceuticals, LLC (“Serenity” and together with Allergan, Inc., “Applicants”<sup>1</sup>), hereby moves to suspend these consolidated Oppositions pursuant to 37 C.F.R. § 2.117(a), pending the resolution of a civil action pending in the United States District Court for the Southern District of New York, captioned *Ferring B.V. et al. v. Serenity Pharmaceuticals, LLC et al.*, No. 17-CV-9922 (RWS) (S.D.N.Y.) (the “Civil Action”). The Answer, Affirmative Defenses and Counterclaims to Plaintiffs’ First Amended Complaint for Declaratory Judgment, filed by Serenity and its co-defendants and counterclaimants in the Civil Action is attached to this motion as Exhibit A.

The Civil Action involves overlapping parties, the same marks and issues of law or fact which may have a bearing on these Oppositions. Both Opposer and Applicant Serenity are parties to the Civil Action. Moreover, the question of whether Serenity’s NOCTIVA mark (App. Ser. No. 86247669) is likely to be confused with Opposer’s NOCDURNA mark – the same

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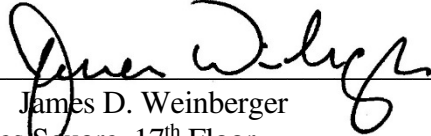
<sup>1</sup> As the Board is aware, Allergan, Inc. has assigned the marks at issue in this proceeding to Serenity and a motion to substitute is currently *sub judice*. See 35 TTABVue.

marks at issue in the parent Opposition, is at issue in the Civil Action. *See* Exhibit A, Counterclaims, ¶¶ 1, 2, 44-54, 90-93.<sup>2</sup> Accordingly, a decision by the federal district court of whether there is or is not a likelihood of confusion between the marks at issue in the Civil Action will have a bearing on the issues present in these Oppositions.

WHEREFORE, in view of the above, Opposer requests the Board grant this motion and suspend this proceeding final resolution of the Civil Action.

Dated: July 5, 2018  
New York, New York

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By:   
James D. Weinberger  
4 Times Square, 17<sup>th</sup> Floor  
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*Attorneys for Opposer*

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<sup>2</sup> Although Serenity's NOCUVANT (App. Ser. No. 86247674) and NOCTRISA (App. Ser. No. 86247672) marks, which are also the subject of these Oppositions, are not at issue in the Civil Action, the parties believe that the disposition of the Civil Action will likely have a direct impact on their interest in further proceedings before the Board concerning such applications.

## **EXHIBIT A**

**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK**

----- X  
FERRING B.V., FERRING INTERNATIONAL )  
CENTER S.A., and FERRING )  
PHARMACEUTICALS INC., )

Plaintiffs, )

-v- )

SERENITY PHARMACEUTICALS, LLC, and )  
REPRISE BIOPHARMACEUTICS, LLC, )

Defendants. )  
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No. 17-cv-9922 (RWS)  
ECF CASE

**FILED UNDER SEAL**

----- X  
SERENITY PHARMACEUTICALS, LLC, )  
REPRISE BIOPHARMACEUTICS, LLC, and )  
AVADEL SPECIALTY PHARMACEUTICALS, )  
LLC, )

Counterclaim-Plaintiffs, )

-v- )

FERRING B.V., FERRING INTERNATIONAL )  
CENTER S.A., and FERRING )  
PHARMACEUTICALS INC., )

Counterclaim-Defendants. )  
-----

No. 17-cv-9922 (RWS)  
ECF CASE

**FILED UNDER SEAL**

**ANSWER, AFFIRMATIVE DEFENSES, AND COUNTERCLAIMS  
TO PLAINTIFFS' FIRST AMENDED COMPLAINT  
FOR DECLARATORY JUDGMENT**

Defendants Serenity Pharmaceuticals, LLC ("Serenity") and Reprise Biopharmaceutics, LLC ("Reprise") (collectively, "Defendants"), by and through their undersigned counsel, hereby submit their Answer and Affirmative Defenses to the Amended Complaint for Declaratory Judgment (D.I. 18) ("FAC") filed by Ferring Pharmaceuticals Inc., Ferring B.V., and Ferring

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