

ESTTA Tracking number: **ESTTA1347634**
Filing date: **03/21/2024**

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

Proceeding no.	91287565
Party	Defendant AltruBio Inc.
Correspondence address	JOHN C. CAIN MUNCK WILSON MANDALA, LLP 1330 POST OAK BLVD., STE 2850 HOUSTON, TX 77056 UNITED STATES Primary email: fmtrademarks@munckwilson.com Secondary email(s): jcain@munckwilson.com, crifai@munckwilson.com 832-615-2744
Submission	Motion to Amend Application
Filer's name	John C. Cain
Filer's email	fmtrademarks@munckwilson.com, jcain@munckwilson.com, crifai@munckwilson.com
Signature	/John C. Cain/
Date	03/21/2024
Attachments	Applicant Response to Bd Order Bausch with exhibits.pdf(3619844 bytes)

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

-----X
: BAUSCH HEALTH IRELAND LIMITED, :
: :
: Opposer, :
: :
: vs. : Opposition No. 91287565
: :
: ALTRUBIO INC., :
: :
: Applicant. :
: :
-----X

**RENEWED MOTION ON CONSENT TO AMEND APPLICATION
AND SUSPEND PROCEEDINGS AND, IF ACCEPTED, TO
WITHDRAW THE OPPOSITION**

Applicant, AltruBio Inc. (“Applicant”), files this response to the Board’s denial of the Motion on Consent to Amend Application and Suspend Proceedings and, if accepted to Withdraw the Opposition filed on February 13, 2024 (the “First Motion”).

BACKGROUND

In the First Motion, Applicant proposed (with Opposer’s consent) to modify the Class 5 description of goods in the Application as shown below (new matter in bold):

Class 5: **a house mark for** pharmaceutical preparations for use in the treatment of immunoregulatory diseases, inflammatory diseases, autoimmune diseases and cancers, **excluding pharmaceutical preparations for the treatment of hemophilia, blood diseases, blood disorders, dermatologic conditions, and skin care disorders**

(hereafter, the “Proposed Amendment”).

The Board denied the First Motion, without prejudice, on February 20, 2024, alleging that by requesting that the language “a house mark for” be added to Class 5, Applicant was impermissibly requesting that the identification set forth the provider of the goods. The Board then

suspended the opposition proceeding for thirty days, during which time period Applicant and Opposer were invited to file a revised motion to amend.

Applicant respectfully asserts that the Proposed Amendment was in fact proper under USPTO rules and precedent. In support of this position, Applicant presents the below arguments and attaches additional evidence of house mark usage for Applicant's Mark.

**APPLICANT'S RESPONSE TO BOARD'S ORDER ON MOTION ON CONSENT TO
AMEND APPLICATION**

The USPTO will register a mark as a house mark when there is sufficient evidence of the mark being used as a house mark. TMEP 1402.03(b). This is a common practice in the pharmaceutical industry, with at least 200 marks currently registered on the Principal Register in Class 5 for pharmaceutical goods with "house mark" language in various forms. *See*, Exhibit 1. Many of these records include instances where the owner originally applied for a listing of goods in Class 5, then later amended the application to include "house mark" language. *See, e.g.*, U.S. Trademark Registration Nos. 4493244, 4615527, 5682519, 5851798, 5614467, 6253614, and 6653958 (copies of the TSDR for these registrations are attached as Exhibits 2 to 8).

Indeed, the record for U.S. Trademark Registration No. 6653958 for the mark TRICIDA by Tricida, Inc., attached as Exhibit 8, is particularly instructive in this instance. The company originally filed under Class 5 for various pharmaceutical preparations, the application as published, and a Notice of Allowance issued for these goods. *Id.* However, before a Statement of Use was filed, Tricida, Inc. entered into an agreement with a third party under which Tricida, Inc. agreed to amend the Class 5 goods to include "a house mark for" language. *See* Exhibit 9, Petition to Director for Application No. 87931649. The Petition to the Director was granted, and Tricida, Inc. later filed the below specimen with its Statement of Use, which was accepted. Exhibit 8.



These records demonstrate that this type of amendment is routinely allowed during the prosecution of an application and found to not broaden the scope of the goods or require republication of the subject application. Thus, the Proposed Amendment is proper and should be allowed in this instance.

The below specimens are currently on record with the Application, demonstrating use of the ALTRUBIO mark as a house mark on at least two of Applicant's pharmaceutical products:



Applicant respectfully asserts that these photographs demonstrate house mark usage for Applicant's Mark. However, additional evidence of Applicant's use of the ALTRUBIO mark as a house mark is attached as Exhibit 10. With this additional evidence, Applicant believes that there is sufficient evidence to show broad use of the ALTRUBIO mark as a house mark, as required under 37 C.F.R. §2.61(b).

RENEWED MOTION

Applicant therefore renews its motion, with the consent of Opposer Bausch Health Ireland Limited ("Opposer"), to amend the Class 5 description of goods in the Application as originally submitted. Because the proposed amendment is in the nature of a limitation, no re-publication should be required, and the amendment therefore should be permissible.

The parties also jointly renew their motion to suspend the above-captioned opposition proceeding pending review by the Board of the proposed amendment to the Application. The parties further consent that upon the approval and entry of the proposed amendment to the Application, the opposition proceeding and all claims asserted therein shall be dismissed.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.