

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: April 25, 2012

Opposition No. 91202162

Biotivia, LLC

v.

ChromaDex Inc.

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of applicant's motion (filed March 26, 2012) to suspend this proceeding pending disposition of a civil action. The motion has been fully briefed.¹

The Board may, upon its initiative, resolve a motion filed in an inter partes proceeding by telephone conference. See Trademark Rule 2.120(i)(1); TBMP § 502.06(a) (3d ed. 2011). On April 24, 2012, the Board convened a telephone conference to resolve the issue(s) presented in the motion. Participating were opposer's counsel Aaron Shechet, Esq., applicant's counsel Joseph T. Nabor, Esq., and the assigned Interlocutory Attorney.

The Board has reviewed the parties' arguments and submissions, but for efficiency does not restate them

¹ A reply brief was not filed.

herein. This order summarizes the Board's analysis and findings based on the briefs, and clarifications provided by the parties during the conference.

Analysis

It is the policy of the Board to suspend proceedings when a party or the parties are involved in a civil action, which may be dispositive of or have a bearing on the Board proceeding. The applicable authority, Trademark Rule 2.117(a), reads as follows:

- (a) Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

See also TBMP § 510.02(a) (3d ed. 2011); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1937 (TTAB 1992).

To the extent that a civil action in a federal district court involves issues in common with those in a proceeding before the Board, the decision of the district court is often binding on the Board, while the decision of the Board is not binding on the district court. *See, e.g., Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988); *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F Supp 563, 2 USPQ2d 1208 (D.Minn

1986). Suspension of a Board proceeding, pending the final determination of another proceeding, is solely within the discretion of the Board. See TBMP § 510.02(a) (3d ed. 2011).

The referenced federal court proceeding is *Chromadex, Inc. v. Biotivia, LLC and Biotivia Bioceuticals, LLC*, Case No. SACV 11-01273 CJC (MLGx), filed August 30, 2011 and pending in the United States District Court for the Central District of California ("civil action"). Applicant submitted with its motion a copy of the complaint filed therein so as to aid the Board in determining whether the final decision in the civil action may have a bearing on the issues in this opposition. See TBMP § 510.02 (3d ed. 2011).

At issue in this opposition is the registrability of applicant's mark THE NEXT GENERATION RESVERATROL (standard characters; RESVERATROL disclaimed) for "phytochemicals for use in the manufacturing of dietary supplements, nutritional supplements, nutritional beverages, pharmaceuticals and cosmetics" in International Class 1, in view of opposer's claim that the mark is merely descriptive pursuant to Trademark Act Section 2(e)(1). Within said notice of opposition, opposer alleges, in part:

15. Registration of the Mark will prevent Biotivia, a seller of pterostilbene supplements, from using phrases which are descriptive of pterostilbene, and will inhibit Biotivia's ability to accurately describe and effectively market its products.

16. Chromadex seeks to prevent Biotivia from using phrases it deems "similar" to the Mark, and has filed a lawsuit in the Central District of California, case number 8:11-CV11-01273 CJC (MLGx), partly based on Biotivia's use of phrases such as "taking resveratrol to the next level," which are descriptive of pterostilbene.

A review of the pleadings filed in the civil action indicates that applicant (as plaintiff therein) asserts, inter alia, claims of unfair competition and false advertising alleging that opposer's uses of phrases incorporating "taking resveratrol to the next level" and "takes resveratrol to a new level" are likely to confuse consumers based on the similarity to the mark subject to opposition, THE NEXT GENERATION RESVERATROL. In its prayer for relief, applicant seeks permanent injunctive and equitable relief enjoining and restraining opposer from engaging in any acts or activities directly or indirectly calculated to infringe applicant's mark THE NEXT GENERATION RESVERATROL. In its answer, opposer has asserted several affirmative defenses, which include, inter alia, that "[S]ome or all of the intellectual property rights asserted by Plaintiff, including trademarks and/or copyrights, are invalid and/or unenforceable."

The Board finds that the district court's ruling can potentially have a bearing on this opposition proceeding. In particular, any determination that applicant's mark THE NEXT GENERATION RESVERATROL is invalid could impact this opposition, and any determination of the rights of opposer

could potentially bear on opposer's standing. Moreover, the strength of applicant's mark is at issue in the opposition, and could be at issue in the civil action in the course of ascertaining the elements of likelihood of confusion; thus, discovery regarding these issues could overlap. In view thereof, judicial economy, and the unnecessary duplication of efforts, will be served through suspension. Lastly, suspension would avoid the possibility that the court and the Board could reach contrary outcomes with respect to the rights in the mark.

In view of this record, the Board has determined that the outcome in the civil action may have a bearing on the opposition proceeding. Applicant's motion to suspend pursuant to Trademark Rule 2.117(a) is hereby granted.

Accordingly, this proceeding is suspended pending final disposition of the civil action. Within twenty (20) days after the final determination of the civil action, the parties shall so notify the Board by filing notice of said outcome herein (including a copy of any final judgment(s) issued by the court), so that the Board can call this case up for any appropriate action.²

² A proceeding is considered to have been finally determined when a decision on the merits of the case (i.e. a dispositive ruling that ends litigation on the merits) has been rendered, and no appeal has been filed therefrom or all appeals filed therefrom have been decided. See TBMP § 510.02(b) (3d ed. 2011).

As the Board noted during the conference, through the suspension period the Board may issue periodic inquiries regarding the status of the pending civil action.

During the suspension, the parties shall notify the Board of any address changes for the parties or their attorneys.