

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Ryan

MAILED: August 2, 2003

Opposition No. 154,027

Inspire Pharmaceuticals Inc.

v.

Rexam Image Products Inc.

Before Karyn K. Ryan, Interlocutory Attorney  
Trademark Trial and Appeal Board.

By the Board:

It has come to the Board's attention that an error occurred in the Board's processing of the parties' responses to the Board's April 21, 2003 order, occasioned by a delay in entry of opposer's May 19, 2003 response in the proceeding record. We regret the error and apologize for any inconvenience to the parties caused by this delay.

A brief review of the pertinent case history would be helpful. On April 21, 2003, the Board issued an order requiring the parties to clarify whether opposer's February 6, 2003 withdrawal of the opposition was contingent on the Board's approval of the applicant's January 31, 2003 proposed amendment to its application, Serial No. 76/339,397. Applicant on May 1, 2003 filed its response, stating that "opposer's attorney Barbara

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Johnson, has confirmed . . . that the withdrawal of the opposition was not conditioned upon the Board's approval of the amendment." The Board on June 2, 2003 issued an order denying applicant's January 31, 2003 proposed amendment and, because the record showed no contingency to opposer's withdrawal and no response by opposer to the Board's April 21, 2003 order, the Board dismissed the opposition with prejudice.

It now appears that, on May 19, 2003, opposer had filed a timely response to the Board's April 21, 2003 order for clarification. Because the Board did not associate opposer's May 19, 2003 submission with the proceeding file prior to issuance of the dismissal order, opposer's submission was not previously considered herein.

By its May 19, 2003 submission, opposer has refuted applicant's prior assertion that the withdrawal was not contingent. In view thereof, and because it now appears that opposer's February 6, 2003 withdrawal was not effective upon our denial of applicant's January 31, 2003 request to amend, we find that the June 2, 2003 dismissal of this proceeding was improper. Accordingly, we **vacate** the June 2, 2003 decision to the extent of the dismissal<sup>1</sup> and proceedings are now **resumed**.

We turn our attention next to the parties' July 1, 2003 submission, which includes a second consented motion to amend the

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<sup>1</sup> Nonetheless, the Board's decision to deny applicant's January 31, 2003 proposed amendment stands.

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applicant's application and another contingent motion to withdraw the opposition. We observe that applicant seeks to amend the application by deleting the International Class 5 goods<sup>2</sup> and proposes an alternative amendment to the identification of goods for the International Class 10 goods. By the proposed amendment, applicant seeks to change the International Class 10 goods to the following:

**"permeable plastic films for medical use in the manufacture of wound care dressings."**

By adding "in the manufacture of wound care dressings" to the existing identification, the proposed new language, when considered overall, may identify component or raw materials for manufacture into composite medical goods. The term "medical" in the identification creates an incongruity as to whether the identified goods are composite or raw materials -- goods that clearly fall outside the scope of the original identification and goods that may be more appropriately classified in International Class 17. Consequently, the proposed amended identification does not describe the nature and intended uses of applicant's goods with sufficient particularity. See TMEP §1402.01,

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<sup>2</sup> In an opposition to an application having multiple classes, if the applicant files a request to amend the application to delete an opposed class, the request for amendment is, in effect, an abandonment of the application with respect to that class, and is governed by Trademark Rule 2.135. That rule provides that if, in an inter partes proceeding, the applicant files an abandonment without the written consent of every

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1402.01(a), 1402.03, 1402.05(a) and (b). In short, the proposed amended identification may logically encompass goods that fall outside the scope of the original identification and outside of International Class 10. See Trademark Rule 2.71(a). See also TMEP §1402.07(d).

In view thereof, and inasmuch as the Board will not approve any proposed amendments that impact the classification of applicant's goods, the Board finds the alternative amendment unacceptable for entry into the record. Because applicant has not expressly stated that it seeks to delete the International Class 5 goods irrespective of our decision on the proposed amendment to the International Class 10 identification, we **deny** in entirety applicant's July 1, 2003 alternative request to amend.<sup>3</sup> See Trademark Rule 2.133(a) and TBMP §514 et seq.

Inasmuch as proceedings are now resumed, applicant is allowed until **thirty** days from the mailing date set forth on page one of this order to file its answer to the notice of opposition.

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adverse party to the proceeding, judgment shall be entered against applicant.

<sup>3</sup> Ordinarily, the Board endeavors to propose alternative language for an amendment to an identification of goods. However, in this instance, we decline to do so. It is apparent that the parties are trying to settle this case in a manner that is not acceptable to the Board, i.e., by changing the nature of applicant's identified goods from composite goods to component goods for use in the manufacture of wound care dressings. We will not entertain further proposed amendments to the involved application that do not clearly identify composite pharmaceutical or medical goods that fall within the scope of the existing International Class 5 and 10 identifications. If applicant seeks to register its mark for component or raw materials used in the manufacturing of wound dressings, which may be more properly classified in International Class 17, applicant may file a new application.

Discovery is open. The close of discovery and trial dates are **reset** as indicated below.<sup>4</sup>

DISCOVERY PERIOD TO CLOSE:	<b>January 6, 2004</b>
30-day testimony period for party in the position of plaintiff to close:	<b>April 5, 2004</b>
30-day testimony period for party in the position of the defendant to close:	<b>June 4, 2004</b>
15-day rebuttal period for party in the position of the plaintiff to close:	<b>July 19, 2004</b>

**IN EACH INSTANCE**, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within **thirty days** after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

***By the Trademark Trial  
and Appeal Board***

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<sup>4</sup> If the parties seek any further extensions to the trial schedule in this case, any future consented motions to extend should set forth all dates in the format shown in this order. See Trademark Rule 2.121(d).