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

EJW

Mailed: March 30, 2009

Opposition No. 91157150
Cancellation No. 92042253

MD FORMULATIONS, INC.
(by change of name from
BIOCEUTIX INC.)[1]

v.

DENNIS F. GROSS

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

This case now comes up for consideration of opposer/petitioner's notification to the Board that there has been a dispositive determination in the remaining[2] civil action between the parties that occasioned the suspension of these consolidated proceedings on October 20, 2003[3] and of its motion therein requesting that, *inter alia*, applicant/respondent's registrations should now be cancelled. Applicant/respondent contests

[1] The Board notes the change of name of opposer/petitioner filed with the Assignment Branch of the Office on both December 21, 2006 and on April 5, 2007 at Reel/Frame 3448/0945 and 3516/0529, respectively. Board records have been updated accordingly.

[2] Opposer/Petitioner MD Formulations, Inc. (formerly Bioceutix, Inc.) advised the Board on April 20, 2006 that the civil action between the parties in the Northern District of California, Civil Action No. C 05-01707, was dismissed on November 30, 2005.

opposer/petitioner's notification to the Board that there has been a dispositive determination in the above-referenced civil action and, as discussed herein, requests that these proceedings remain suspended.

The Board notes that on May 23, 2007, in response to the notification of opposer/petitioner, the Board ordered that these proceedings should remain suspended pending final determination of the pending civil action. On November 28, 2008, opposer/petitioner advised the Board that there had been a "dispositive determination" in the civil action because the District Court had granted the motion for summary judgment of MD FORMULATIONS, INC. on its claim for trademark infringement, "finding that registrant is infringing the trademarks of petitioner through use of registrant's marks 'M.D. Skincare' (Reg. No. 2,464,380), 'M.D. Skin Care' (Reg. No. 3,493,178) and 'M.D. Skincare Dr. Dennis Gross' (App. Serial No. 76/413,878)." Opposer/petitioner requests that the Board cancel the referenced registrations and "reject" applicant/respondent's application for registration of "M.D. Skincare Dr. Dennis Gross." In support of its motion, opposer/petitioner provided a copy of the Court's order dated November 19, 2008.

[3] Civil Action No. 03 CV 3089 (RLC)) pending in the Southern District of New York.

Applicant/respondent, in his "Objection to Notice of Determination in Civil Proceeding Warranting Continued Suspension of Proceedings," states that a final determination has not yet been rendered in the civil action. Specifically, applicant/respondent argues that there has been no final determination because the District Court has not issued a final judgment in the civil action, and that decision is subject to a motion for reconsideration and an appeal to the relevant appellate court. "As there are also other claims remaining in the case to be resolved at trial, the time for filing an appeal as of right of the November 19, 2008 decision has not yet even commenced, let alone expired." Based on these statements, applicant/respondent requests that these proceedings remain suspended.

Section 510.02(b) of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) (2d ed. rev. 2004) provides that 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 have been decided. At the time applicant/respondent filed his objection to opposer/petitioner's notification regarding the civil action, applicant/respondent stated that the District Court's decision was subject to a motion for reconsideration

and appeal, and that other claims remained to be tried. Opposer/petitioner has not contradicted these statements. Further, the Board notes that the District Court Judge intends to address plaintiffs' remaining claim for summary judgment (on defendants' fifth counterclaim) in a separate opinion, which has not been provided to the Board. Thus, at this point, it is not clear what the final determination on the merits will be subsequent to the order submitted by opposer/petitioner or after any potential appeal is resolved. In view of the foregoing, for Board purposes, the district court litigation has not finally determined the merits of the case.

Accordingly, opposer/petitioner's motion that the Board cancel applicant/respondent's registrations (*i.e.*, U.S. Reg. Nos. 2464380 and 2493178) and deny registration in connection with applicant/respondent's pending application (*i.e.*, Serial No. 76413878) is denied as premature without prejudice to being refiled when the proceedings are finally determined, *i.e.*, following the termination of any and all appeals and remands.

Furthermore, proceedings herein remain **SUSPENDED** pending final determination of the civil action. *See* Trademark Rule 2.117(a).

Within twenty days after the final determination of the subject civil action, the parties shall so notify the Board

and call up this proceeding for appropriate action. During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.

☼☼☼

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:
http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm