

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

Winter/vb

Mailed: May 1, 2008

Opposition No. 91177185

Bristol-Myers Squibb Company

v.

Renovo Limited

**Elizabeth J. Winter, Interlocutory Attorney:**

On March 17, 2008, applicant filed, pursuant to the parties' co-existence agreement, applicant's proposed amendment to its application Serial No. 78565997, with opposer's written consent; and on March 18, 2008, opposer filed its withdrawal of the opposition without prejudice, with applicant's written consent.

By the proposed amendment applicant seeks to change the identification of goods **from:**

"Pharmaceutical preparations, namely, wound healing preparations, preparations for the prevention, reduction, inhibition or treatment of scarring, preparations for the treatment, reduction, inhibition or prevention of fibrosis, preparations for the treatment, inhibition or prevention of the development of fibrotic conditions, preparations for the purpose of prevention, reduction, inhibition or treatment of scarring in connection with elective surgery and trauma, treatment of nerves, surgery of nerves or trauma, preparations for the treatment, reduction, inhibition or prevention of dermal wounds, preparations for the treatment, reduction, inhibition or prevention of dermal scarring, preparations for the

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treatment, reduction, inhibition or prevention of dermal fibrotic conditions, preparations for the treatment of damaged ligaments, tendons or cartilage, preparations for the promotion of re-epithelialization, preparations for the treatment of chronic wounds, preparations for the treatment of burns, preparations for the treatment, reduction, inhibition or prevention of ulcers or pressure sores, preparations for the treatment, reduction, inhibition or prevention of adhesions and strictures, preparations for the treatment of cardiovascular and vascular restenosis, preparations for the purpose of prevention, reduction, inhibition or treatment of scarring in the treatment of the eye, preparations for the purpose of prevention, reduction, inhibition or treatment of scarring in the treatment of nerves, surgery of nerves or trauma,"

**To:**

"Wound healing preparations namely preparations for accelerating wound healing, preparations for the promoting re-epithialisation, preparations for promoting the healing of skin graft donor sites; preparations for promoting the healing of dermal wounds and chronic wounds including ulcers and pressure sores; preparations for promoting the healing of burns; preparations for the treatment of damaged ligaments, tendons or cartilage; preparations for the prevention, reduction, inhibition or treatment of scarring namely dermal scarring and/or scarring arising from elective surgery and or trauma, nerves surgery, tendon & ligament surgery, eye and or corneal surgery/procedures, preparations for the prevention, reduction, inhibition or treatment of fibrosis of fibrotic conditions including adhesions and strictures; preparations for the treatment of cardiovascular and vascular restenosis; preparation for the treatment of wounds or fibrotic conditions of the eye; all of the aforesaid for parenteral use including liquids for injection, in combination use with devices, eye drops, lavage solutions, ointments, creams, gels and the like for topical application."

The proposed amendment is unacceptable for the following reasons:

(1) the wording "pharmaceutical preparations, namely," which preceded all other wording in the identification of

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goods (as published) has been deleted. In addition, the proposed identification of goods uses semi-colons instead of commas between each type of preparation so that the type of preparation (either pharmaceutical or medicinal) must be restated for each individual product. As a result, the proposed identification of goods in its entirety is broader than the identification of goods that was published.

(2) In addition, the wording "skin graft donor sites" has been added and is beyond the scope of the original identification (as published). This phrase must be amended to fit within the original wording.

(3) The wording "or," "and/or," and "and the like" is viewed as indefinite and must be amended or deleted, respectively.

(4) The wording following "parenteral use" is unclear.

For these reasons, the proposed amendment is **DENIED**.

See Trademark Rules 2.32(a)(6), 2.32(d), 2.71(b) and 2.133(a), 37 C.F.R. §§ 2.32(a)(6), 2.32(d), 2.71(b) and 2.133(a). See also TMEP § 1402.01 (5th ed. 2007).

The following identification of goods, *if accurate*, would be acceptable:

**"Pharmaceutical<sup>1</sup> preparations, namely,** wound healing preparations ~~namely preparations~~ for accelerating wound healing, preparations for the promoting re-epithialisation, preparations for promoting the healing of **dermal wounds, namely,** skin graft donor sites,

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<sup>1</sup> The word "medicinal" may be substituted for "pharmaceutical."

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preparations for promoting the healing of dermal wounds and chronic wounds, including ulcers and pressure sores, preparations for promoting the healing of burns, preparations for the treatment of damaged ligaments, tendons ~~or~~ and cartilage, preparations for the prevention, reduction, inhibition ~~or~~ and treatment of scarring, namely, dermal scarring ~~and/or~~ and scarring arising from elective surgery and ~~or~~ trauma, nerves surgery, tendon ~~or~~ and ligament surgery, eye and ~~or~~ corneal eye surgery and procedures, preparations for the prevention, reduction, inhibition ~~or~~ and treatment of fibrosis ~~or~~ and fibrotic conditions, including adhesions and strictures, preparations for the treatment of cardiovascular and vascular restenosis, and preparations for the treatment of wounds ~~or~~ and fibrotic conditions of the eye; all of the aforesaid for parenteral use ~~including~~ and which may be administered by liquids for injection, in combination use with devices, eye drops, lavage solutions, ointments, creams, and gels ~~and the like~~ for topical application".

Inasmuch as the parties appear desirous of settling this matter, applicant is allowed until **THIRTY DAYS** from the date of this order to file a corrected consented amendment to the identification of goods in compliance with Trademark Rule 2.71(b), 37 C.F.R. § 2.71(b), failing which this proceeding will resume based on the current identification of goods.

Further, on review of opposer's withdrawal of its opposition, the Board notes that applicant has not withdrawn its counterclaim against Registration Nos. 1597127 and 2904718.

In view thereof and because the proposed amendment is not acceptable, the Board's consideration of opposer's withdrawal of the opposition is **deferred**. Applicant is thus

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also allowed **THIRTY DAYS** from the mailing date of this order to inform the Board regarding the disposition of the counterclaim, failing which, if applicant's submits a consented and acceptable amendment to the identification of goods in the involved application, the Board will dismiss the opposer's claim without prejudice and resume proceedings with respect to the counterclaim only.

This proceeding otherwise remains **SUSPENDED** until further written notice by the Board.



**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](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>