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

GCP

Mailed: March 12, 2012

Opposition No. 91203035

Merck Sharp & Dohme Corp.

v.

Laboratorios Sanfer, S.A. de C.V.

By the Trademark Trial and Appeal Board:

This case now comes before the Board for consideration of applicant's motion (filed February 23, 2012) to suspend this proceeding for ninety days so that the parties may pursue settlement negotiations. Opposer filed an opposition to the motion on March 8, 2012.

The Board, in its discretion, suggested that the issues raised in the aforementioned motion should be resolved by telephonic conference as permitted by TBMP § 502.06 (3d ed. 2011). The Board contacted the parties to discuss the date and time for holding the phone conference.

The parties agreed to hold a telephone conference at 2:30 p.m. Eastern time on Friday, March 9, 2012. The conference was held as scheduled among Keith E. Sharkin, as counsel for opposer, Michele Katz, as counsel for applicant,

and George C. Pologeorgis, as a Board attorney responsible for resolving interlocutory disputes in this case.

The Board carefully considered the arguments raised by counsels for both parties, as well as the supporting correspondence and the record of this case, in coming to a determination regarding the above matters. During the telephone conference, the Board made the following findings and determinations:

Applicant's Motion to Suspend Proceedings

For the reasons set forth below, applicant's motion to suspend this opposition proceeding for settlement is **denied**.

In support of its motion, applicant maintains that the parties are in the process of obtaining a fully-executed settlement agreement concerning this case and therefore requests a ninety day suspension of this proceeding to allow the parties to finalize their agreement.

In response to the applicant's motion, opposer argues that it did not provide any consent to suspend this case for settlement and that, instead of seeking opposer's consent for an extension of time to file an answer, applicant resorted to misrepresentations in attempt to frame its motion to suspend as being with consent. Moreover, opposer contends that, other than a preliminary discussion in connection with the first extension of time filed by applicant on January 27, 2012, there have been no settlement discussions between the parties,

no settlement agreement has been negotiated, and there is certainly no agreement waiting execution. Finally, in light of applicant's unjustified failure to file its answer by the February 23, 2012 due date, coupled with its alleged blatant misrepresentations in its motion to suspend, opposer requests the entry of default judgment against applicant.

During the telephone conference, the Board questioned applicant's counsel regarding the basis of applicant's motion to suspend in light of opposer's opposition thereto. Applicant's counsel stated that applicant's foreign counsel in Mexico was discussing settlement with in-house counsel for opposer's Mexican wholly-owned subsidiary and was informed by foreign counsel that, in light of such settlement discussions, it should proceed with the filing of a motion to suspend for settlement. In response, opposer's counsel indicated that opposer was not aware of such settlement discussions between its Mexican wholly-owned subsidiary and applicant.

Inasmuch as opposer has not consented to applicant's motion to suspend for settlement and because, under the circumstances, there appears to have been miscommunication regarding whether the parties to this proceeding are currently negotiating settlement, applicant's motion to suspend for settlement is **denied** for a lack of showing of good cause. Trademark Rule 2.117(c).

Toward the conclusion of the telephone conference, applicant's counsel advised that applicant would be filing an express abandonment of its involved applications. In fact, applicant filed an express abandonment of its involved application Serial Nos. 85132502 and 85136842 without opposer's written consent during the telephone conference.

In light of the aforementioned filing, the Board noted that Trademark Rule 2.135 provides that if, in an *inter partes* proceeding, applicant files an abandonment without the written consent of every adverse party to the proceeding, judgment shall be entered against applicant.

In view thereof, and because opposer's written consent to the abandonment is not of record, judgment is hereby entered against applicant, the opposition is sustained and registration to applicant is refused.[1]

[1] In light of this order, opposer's request for default judgment is deemed moot and will be given no further consideration.