

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

Mailed: November 30, 2014

Opposition No. 91211414

Purapharm International (H.K.)  
Limited

v.

Purepharma ApS

**Robert H. Coggins,  
Interlocutory Attorney:**

Now before the Board are applicant's motion (filed August 8, 2014) for leave to amend the answer to add a counterclaim, opposer's cross-motion (filed August 25, 2014) to re-open discovery, and opposer's motion (filed November 6, 2014) to suspend the opposition proceeding pending disposition of a civil action. Each motion is contested, with the motions to amend and reopen being fully briefed. The Board exercises its discretion to determine the motion to suspend prior to the time in which opposer might otherwise file a reply brief in support thereof.

Motion to Suspend

The parties to the Board opposition are in the same positions in a civil action pending in the United States District Court for the Southern District

of Texas.<sup>1</sup> The civil action complaint specifically references the subject application (*see* Civil Complaint para., 18) and the opposition proceeding (*see* Civil Complaint paras. 21-23), and asks that the District Court enjoin applicant from using the mark in the subject application (*see* Civil Complaint, p. 10 (Prayer for Relief, para. 1)).

It is the policy of the Board to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case. *See* TBMP § 510.02(a) (2014). *See also New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011). In view this policy, opposer's motion to suspend proceedings pending final disposition of the civil action between the parties is **granted**. *See* Trademark Rule 2.117(a). Applicant's arguments against suspension and against the Board's quick determination (i.e., prior to the District Court's ruling of an alleged Rule 11 motion) of the motion to suspend are not persuasive. It appears that the outcome of the civil action may have a direct bearing on the Board proceeding whether opposer relies in the civil action upon its pleaded registration or common law rights - both of which appear to be pleaded in the civil action (*see* Civil Complaint, paras. 9-14). Accordingly, proceedings are suspended pending final disposition of the civil action.

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<sup>1</sup> Civil Action No. 4:14-cv-03181, styled *Purapharm International (H.K) Limited v. PurePharma, Inc. and PurePharma ApS*.

Within thirty days after the final determination of the civil action (including the time for all appeals<sup>2</sup>) the parties shall so notify the Board so that this proceeding may be called up for appropriate action. Such notification to the Board should include a copy of any final order or final judgment which issued in the civil action.

During the suspension period, the parties must notify the Board of any address changes for the parties or their attorneys. In addition, the parties are to promptly inform the Board of any other related cases, even if they become aware of such cases during the suspension period.

#### Motions to Amend and Reopen

In view of the suspension order herein, the outstanding motions to amend and to reopen are **denied without prejudice** and are therefore moot. If either party believes that its previously outstanding motion, which was pending at the time of this order and denied hereby, has not been resolved or made moot by the civil action, the party may renew the motion in its notification of the final determination of the civil action by citing the motion's title, date of filing, and docket entry number in the Board's electronic proceeding file (i.e., TTABVUE). Any renewed motion must be accompanied by a signed statement that the motion has been

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<sup>2</sup> 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. *See* TBMP § 510.02(b).

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contemporaneously reviewed in its entirety and concerns matters still  
disputed between the parties.