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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91218833
Party	Plaintiff Horus Pharma
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**IN THE U.S. PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD**

Atty Ref.: 123.0906

HORUS PHARMA,

Opposer,

v.

RICARDO A. FUENMAYOR,

Applicant.

Opposition No. 91218833

**OPPOSER'S RESPONSE & OBJECTION TO APPLICANT'S MOTION TO
REQUEST EXTENSION OF TIME TO FILE ANSWER FOR SETTLEMENT TALKS AND
APPLICANT'S MOTION TO AMEND MARK REGISTRATION**

HORUS PHARMA, Opposer herein, for the reasons that follow, files the instant response and objections to Applicant's MOTION TO REQUEST EXTENSION OF TIME TO FILE ANSWER FOR SETTLEMENT TALKS (Dkt. 4), filed November 17, 2014, and Applicant's MOTION TO AMEND MARK REGISTRATION (Dkt. 5), filed November 18, 2014.

At the outset, Opposer is mindful that Applicant is currently representing himself *pro se*. However, Opposer is likewise mindful that *pro se* parties are still bound by the rules of the Board.

**Applicant's Motion To Request Extension
of Time to File Answer for Settlement Talks**

With regard to Applicant's MOTION TO REQUEST EXTENSION OF TIME TO FILE ANSWER FOR SETTLEMENT TALKS (Dkt. 4), Opposer has no objection to a 60-day extension of time for Applicant to file his Answer in this matter, namely, until **January 23, 2015** because settlement negotiations are pending.

However, Opposer objects to the submission to the Board of communications between Applicant and Opposer's undersigned counsel clearly labeled "For Settlement Purposes Only Pursuant to Fed. R. Ev. 408". See Dkt. 4, Ev. 2, Ev. 4 & Ev. 5. Settlement discussions are intended to encourage open communications between parties without the possibility of the information furnished during such negotiations being used as evidence during trial. Applicant's attachment of these communications to his motion makes these discussions available to the public and to the Board, the ultimate finder of fact in this matter. Once seen, such materials cannot be unseen by the Board or the public. While these materials remain part of the record, the Board will see them and could consider them. Therefore, Opposer requests that the evidence clearly marked as "For Settlement Purposes Only Pursuant to Fed. R. Ev. 408" be stricken from Applicant's motion and expunged from the TTAB's online record.

The continued appearance of these materials at that TTABVue database and the possibility of Applicant continuing to make such discussions public is and will continue to hamper discussions between the parties.

Applicant's MOTION TO AMEND MARK REGISTRATION

Opposer hereby objects to Applicant's MOTION TO AMEND MARK REGISTRATION (Dkt. 5).

The parties are currently negotiating a possible settlement of this matter. To date, discussions have involved, *inter alia*, the possibility of a limitation of Applicant's identification of goods. However, Opposer has not agreed to the proposed amendment submitted by Applicant. Moreover, Applicant's attempt to unilaterally amend his

identification of goods while negotiations remain pending circumvents the ongoing negotiations between the parties. His request while negotiations remain pending is insincere and comes as a surprise to Opposer.

“If an amendment is filed in an application that is the subject of an opposition, the Board has jurisdiction over the application and will determine the propriety of the amendment. Once an opposition has commenced, the application that is the subject of the opposition may not be amended in substance, except with the consent of the other party or parties and the approval of the Board, or upon motion granted by the Board.” 37 CFR § 2.133; TBMP § 212.07; TBMP § 514.

Opposer does not consent to Applicant’s proposed amendment. Opposer does not believe that Applicant’s proposed amendment eliminates the likelihood of confusion alleged in Opposer’s NOTICE OF OPPOSITION (Dkt. 1). Therefore, Applicant’s motion may not be granted based on “the consent of the other party or parties *and* the approval of the Board”.

Moreover, contrary to Applicant’s assertion, most of his proposed amendments (two of three) do not further restrict the goods covered by Application Serial No. 86157681; rather, they *expand* the goods. “A proposed amendment to any application or registration which is the subject of an *inter partes* proceeding must also comply with all other applicable rules and statutory provisions. These include 37 CFR § 2.71-37 CFR § 2.75, in the case of a proposed amendment to an application; 37 CFR § 2.173 and Trademark Act § 7(e), 15 U.S.C. § 1057(e), in the case of a proposed amendment to a registration. Thus, for example, a proposed amendment which involves an addition to the identification of goods or services, or which materially alters the character of the

subject mark, will not be approved by the Board.” TBMP § 514.01. “The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services.” 37 CFR § 2.71(a). It is true that deletion of “medical devices, namely, surgical implant devices comprised primarily of artificial materials for use in plastic surgery as cosmetic devices for improving appearance” is a restriction of the goods. However, the deletion of the limiting language “[B]eautifying devices, namely,” and “thus minimizing his/her wrinkles” amounts to an *expansion* of the goods. Insofar as Applicant’s proposed amendments amount to an expansion of the goods, the Board may not grant Applicant’s motion. Opposer does not believe providing its consent to an amendment that the Board and the Examining Attorney are legally proscribed from accepting is not in its (or Applicant’s) interest.

Opposer further objects to the content of Applicant’s MOTION TO AMEND MARK REGISTRATION to the extent Applicant argues the merits of Opposer’s claim before even having filed an Answer. Applicant argues his position that the marks are phonetically different, the marks are visually different, the existence of different actual English words (although **THORUS** is not an actual English word), his position that the marks’ meanings are different, and other arguments. These arguments are premature.

To the extent that the Board may liberally treat Applicant’s motion as a Motion to Dismiss under Fed. R. Civ. P. 12(b)(6), the Board may not consider any matters outside the pleadings. *See* Fed. R. Civ. P. 12(d). Insofar as Applicant has not filed his Answer, the only operative pleading is Opposer’s NOTICE OF OPPOSITION, and the only pleading the Board may consider. Applicant’s arguments are premature, having not yet filed his Answer. To withstand a motion to dismiss, a notice of opposition need only allege facts

that, if proved, would establish that opposer is entitled to the relief sought, namely that: (1) opposer has standing to challenge the application, and (2) a valid ground exists for seeking to oppose registration. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 U.S.P.Q. 185 (C.C.P.A. 1982); *Order Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 U.S.P.Q.2d 1221 (T.T.A.B. 1995). Allegations in the complaint [opposition] must be construed liberally under Fed. R. Civ. P. 8. Notably, Applicant has not challenged the legal sufficiency of grounds asserted in the Opposition on any relevant basis – he does not contend that the claims in the Opposition were defectively pled; nor does he challenge Opposer’s standing.

Instead, Applicant effectively asks the Board to dismiss each of the properly pleaded grounds in the Opposition based on Applicant’s unilateral request to amend the goods, supported by factual arguments, which are premature and outside the scope of the pleadings.

For the above reasons, Applicant’s motion should be **DENIED** by the Board.

CONCLUSION

For the above reasons:

1. Opposer does not object to an extension of time for Applicant to file his Answer until January 23, 2015;
2. Opposer objects to the submission of communications between the parties to the Board because those materials are not intended for consideration by the Board, nor are they for public consumption;
3. Opposer requests that Applicant’s Dkt. 4, Ev. 3, 4 and 5 be removed from the online record and from Board consideration; and

4. Opposer requests that the Board **DENY** Applicant's motion to amend the identification of goods in the opposed application.

Respectfully submitted,

HORUS PHARMA

Dated: November 21, 2014

By:



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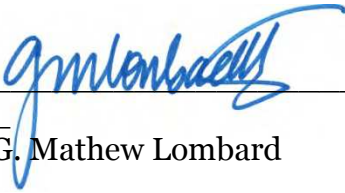
917.779.9967

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the OPPOSER'S RESPONSE & OBJECTION TO APPLICANT'S MOTION TO REQUEST EXTENSION OF TIME TO FILE ANSWER FOR SETTLEMENT TALKS AND APPLICANT'S MOTION TO AMEND MARK REGISTRATION was served on the following individuals at the following addresses of record, by first class mail, postage prepaid, this 21st day of November 2014:

RICARDO A. FUENMAYOR
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BROOKLYN, NEW YORK 11204-3305



G. Mathew Lombard