**UNITED STATES PATENT AND TRADEMARK OFFICE**
**Trademark Trial and Appeal Board**
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JLE

September 22, 2020

Opposition No. 91239468

*Sun Pharmaceutical Industries, Inc.*

*v.*

*Jeremy Sunseri*

**Ann Linnehan, Interlocutory Attorney**

This matter comes before the Board for consideration of Opposer's motion (filed July 28, 2020) to suspend this proceeding pending final determination of Civil Action No. 5:20-cv-00200, filed July 24, 2020, in the United States District Court for the Northern District of Florida (the "Federal Litigation"); and the parties' stipulated extension of time for Applicant to file an opposition to file the motion to suspend, up to and including September 8, 2020 (filed August 17, 2020). Applicant failed to respond to the motion to suspend under the original or stipulated extended deadline; nonetheless, rather than consider the motion as conceded, the Board exercises its discretion to review the motion on its merits.

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* Trademark Rule 2.117(a). In the Board proceeding, Opposer asserts that Applicant's

mark SUN DERMATOLOGY for "Dermatology services," Serial No. 87407284, is likely to be confused with Opposer's prior SUN formative marks, namely, SUN, SUN PHARMA and SUN DERMATOLOGY for various pharmaceutical products.[1] Trademark Section 2(d), 15 U.S.C. § 1052(d). *See* 1 TTABVUE.[2]

In the Federal Litigation, Opposer and its parent company ("plaintiffs") allege they are the owners of various trademarks that include the word "sun" and/or the "SUN logo" (the "SUN Marks"), which are registered for use in connection with pharmaceutical products. 39 TTABVUE 11-13. The plaintiffs allege, inter alia, that Applicant's challenged application Serial No. 87407284 to register the mark SUN DERMATOLOGY is "invalid and not entitled to registration," and use of Applicant's SUN DERMATOLOGY mark infringes the plaintiffs' rights and constitutes unfair competition in violation of the Lanham Act and the common law of the state of Florida. 39 TTABVUE 18-23. Among other remedies, the plaintiffs seek a permanent injunction barring Applicant "from using in commerce the mark SUN DERMATOLOGY . . ." and requiring Applicant to "cancel or withdraw all federal or state trademark applications or registrations . . . for marks or names that are confusingly similar to Sun's SUN Marks.". *Id.* at 24.

It is clear from the complaint that the Federal Litigation may have a bearing on the Board proceeding. Specifically, should the district court declare that Applicant's

[1] Registration Nos. 4706976 and 5212252, Application Serial No. 87590868. The asserted registrations are owned by Applicant's parent company, Sun Pharmaceutical Industries Limited, which is a party-plaintiff in the Federal Litigation.

[2] Record citations are to TTABVUE, the Board's publicly available docket history system. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

challenged application is not entitled to registration, this may have a bearing on the pending claim in the Board proceeding. *See B&B Hardware, Inc. v. Hargis Indus., Inc.,* 575 U.S. 138, 113 USPQ2d 2045 (2015) ("When a district court, as part of its judgment, decides an issue that overlaps with part of the TTAB's analysis, the TTAB gives preclusive effect to the court's judgment.").

In view of the foregoing, Opposer's motion to suspend is **granted**, and proceedings are **suspended** pending final disposition of the Federal Litigation.[3] Within twenty days after the final determination of the civil action, the parties shall so notify the Board so that this proceeding may be called up for appropriate action.[4] 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 or email 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. Upon resumption, if appropriate, the Board may consolidate related Board cases.

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[3] All other pending motions, including Opposer's motion to extend the discovery period and compel discovery (38 TTABVUE) and Applicant's motion to amend its application (5 TTABVUE), are **deferred**. The Board observes that Opposer's motion to compel does not include a copy of the requests for discovery as required by Trademark Rule 2.120(f).

[4] A proceeding is considered to have been finally determined when an order or ruling that ends litigation has been rendered, and no appeal has been filed, or all appeals filed have been decided and the time for any further review has expired. *See* TBMP § 510.02(b).