

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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lw/JMM

May 15, 2020

Opposition No. 91253577

Neurocrine Biosciences, Inc.

v.

Aclaris Therapeutics, Inc.

Jill M. McCormack, Interlocutory Attorney:

On April 1, 2020, Applicant filed a proposed amendment to its involved application Serial No. 88372841, with Opposer's written consent, and Opposer's withdrawal of the opposition without prejudice, contingent upon entry of the amendment.

By the proposed amendment, Applicant seeks to amend the identification of goods in International Class 42 as follows: (deletions shown in strikethrough; additions shown in bold).

From: Research and development of pharmaceutical preparations, products and technology in the fields of dermatology; providing medical and scientific research information in the fields of dermatology, **and** pharmaceuticals ~~and clinical trials~~; drug discovery services; **a drug discovery platform**

To: Research and development of pharmaceutical preparations, products and technology in the fields of dermatology; providing medical and scientific research information in the fields of dermatology and pharmaceuticals; drug discovery services; a drug discovery platform

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, including Trademark Rules 2.71-2.75. *See* TBMP §§ 514.01 and 605.03(b). In particular, while an applicant may amend to clarify or limit the identification, adding to or broadening the scope of the identification is not permitted. *See* Trademark Rule 2.71(a); TMEP §§1402.06 et seq., 1402.07.

Applicant's proposed amendment to the identification of goods in Class 42 is unacceptable. Specifically, the addition of the phrase "a drug discovery platform" in the proposed amendment makes the identification indefinite because the nature of the services is not clear and because the wording is so broad that it may include goods/services outside of International Class 42. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1402.01 (Oct. 2018). In view of the foregoing, the requested amendment to the identification of goods is **denied without prejudice**. The present identification of goods/services, that is, the identification prior to the filing of the motion to amend, remains operative for purposes of future amendment. *See* Trademark Rule 2.71(a); TMEP §1402.07(d).

However, inasmuch as the filing of the proposed amendment indicates to the Board that the parties are making efforts to settle this matter, proceedings are suspended, and the parties are allowed until **30 days from the date of this order** to file a revised motion to amend, failing which the Board will resume proceedings and reset dates, and the opposition will go forward on the present application.