

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Baxley

February 19, 2019

Opposition No. 91245889

Celator Pharmaceuticals, Inc.

v.

Vytalix Inc. dba Vytalix

Andrew P. Baxley, Interlocutory Attorney:

After the Board, in a January 29, 2019 order (5 TTABVUE), rejected the parties' stipulation (filed January 21, 2019, 4 TTABVUE) to amend involved application Serial No. 87719755, Applicant, on February 13, 2019, the parties filed a renewed stipulation to amend that application.

By the renewed proposed amendment, the parties agree to amend the identification of goods in International Class 5 from

Compounded pharmaceuticals, namely, sterile injectables, non-sterile solutions, suspensions, ointments, creams, powders, capsules, tablets and troches for use in the areas of, Weight management, Erectile dysfunction treatment, Male hormone replacement treatment, Female hormone replacement treatment, Bio-identical hormone replacement, Adrenal dysfunction treatment, Thyroid dysfunction treatment, Pain management, Palliative care, Sports medicine, Amino acid replacement therapy, Mineral replacement therapy, Vitamin replacement therapy, Anti-aging therapy, Dermatology, Fertility, Growth Hormone therapy; and Anticonvulsant agents, Antihypertensive agents, Antidiabetic agents, Non-steroidal anti-inflammatory agents, Anesthetic agents, Vasoactive agents, Lipotropic agents, Chelating agents, Psychoactive agents; Compounded personalized pharmaceuticals, namely, sterile

injectables, non-sterile solutions, suspensions, ointments, creams, powders, capsules, tablets and for use in the areas of, Weight management, Erectile dysfunction treatment, Male hormone replacement treatment, Female hormone replacement treatment, Bio-identical hormone replacement, Adrenal dysfunction treatment, Thyroid dysfunction treatment, Pain management, Palliative care, Sports medicine, Amino acid replacement therapy, Mineral replacement therapy, Vitamin replacement therapy, Anti-aging therapy, Dermatology, Fertility, Growth Hormone therapy; and Anticonvulsant agents, Antihypertensive agents, Antidiabetic agents, Non-steroidal anti-inflammatory agents, Anesthetic agents, Vasoactive agents, Lipotropic agents, Chelating agents, Psychoactive agents; Compounded personalized pharmaceuticals, namely, sterile injectables, non-sterile solutions, suspensions, ointments, creams, powders, capsules, tablets and troches based on medical, genetic, genomic, nutrigenomic, pharmacogenomic, microbiomic, metabolomic, proteomic, biochemistry, biomarker, health, dietary, nutrition, exercise, physical fitness, lifestyle and personal information for use in the areas of, Weight management, Erectile dysfunction treatment, Male hormone replacement treatment, Female hormone replacement treatment, Bio-identical hormone replacement, Adrenal dysfunction treatment, Thyroid dysfunction treatment, Pain management, Palliative care, Sports medicine, Amino acid replacement therapy, Mineral replacement therapy, Vitamin replacement therapy, Anti-aging therapy, Dermatology, Fertility, Growth Hormone therapy; and Anticonvulsant agents, Antihypertensive agents, Antidiabetic agents, Non-steroidal anti-inflammatory agents, Anesthetic agents, Vasoactive agents, Lipotropic agents, Chelating agents, Psychoactive agents; Genetic marker tests comprised of reagents for medical purposes; Medical diagnostic reagents and assays for testing of body fluids in the nature of genomic, microbiomic, metabolomic, and biochemical tests; Medical diagnostic test kits comprised of medical diagnostic reagents and assays used to collect test samples for analyzing DNA, blood, hair, saliva and stool information for use in DNA, blood, hair, saliva and stool testing of humans; Kits comprised of medical diagnostic reagents and assays for use in genetic, genomic, microbiomic, metabolomic, and biochemical testing; Kits comprised of medical diagnostic reagents and assays for use in DNA, blood, hair, saliva and stool testing of humans; Medical diagnostic test media in the form of strips, threads, swabs, cartridges, and collection tubes for collecting and analyzing genetic, genomic, microbiomic, metabolomic, and biochemical data

to (additional wording in bold, deleted wording struck through)

~~Compounded—pharmaceuticals,—namely,~~ Sterile **prescription** injectables, non-sterile **prescription** solutions, **prescription** suspensions, **prescription** ointments, **prescription** creams, **prescription** powders, **prescription** capsules, **prescription** tablets and **prescription** troches for use in the areas of Weight management, Erectile dysfunction treatment, Male hormone replacement treatment, Female hormone replacement treatment, Bio-identical hormone replacement, Adrenal dysfunction treatment, Thyroid dysfunction treatment, Pain management, Palliative care, Sports medicine, Amino acid replacement therapy, Mineral replacement therapy, Vitamin replacement therapy, Anti-aging therapy, Dermatology, Fertility, Growth Hormone therapy; and Anticonvulsant agents, Antihypertensive agents, Antidiabetic agents, Non-steroidal anti-inflammatory agents, Anesthetic agents, Vasoactive agents, Lipotropic agents, Chelating agents, Psychoactive agents; ~~Compounded personalized—pharmaceuticals,—namely,~~ Sterile **prescription** injectables, non-sterile **prescription** solutions, **prescription** suspensions, **prescription** ointments, **prescription** creams, **prescription** powders, **prescription** capsules, **prescription** tablets and **troches based on medical, genetic, genomic, nutrigenomic, pharmacogenomics, microbiomic, metabolomics, proteomic, biochemistry, biomarker, health, dietary, nutrition, exercise, physical fitness, lifestyle and personal information** for use in the areas of, Weight management, Erectile dysfunction treatment, Male hormone replacement treatment, Female hormone replacement treatment, Bio-identical hormone replacement, Adrenal dysfunction treatment, Thyroid dysfunction treatment, Pain management, Palliative care, Sports medicine, Amino acid replacement therapy, Mineral replacement therapy, Vitamin replacement therapy, Anti-aging therapy, Dermatology, Fertility, Growth Hormone therapy; and Anticonvulsant agents, Antihypertensive agents, Antidiabetic agents, Non-steroidal anti-inflammatory agents, Anesthetic agents, Vasoactive agents, Lipotropic agents, Chelating agents, Psychoactive agents; ~~Compounded personalized pharmaceuticals, namely, sterile injectables, non-sterile solutions, suspensions, ointments, creams, powders, capsules, tablets and troches based on medical, genetic, genomic, nutrigenomic, pharmacogenomic, microbiomic, metabolomic, proteomic, biochemistry, biomarker, health, dietary, nutrition, exercise, physical fitness, lifestyle and personal information for use in the areas of, Weight management, Erectile dysfunction treatment, Male hormone replacement treatment, Female hormone replacement treatment, Bio-identical hormone replacement, Adrenal dysfunction treatment, Thyroid dysfunction treatment, Pain management, Palliative care, Sports medicine, Amino acid replacement therapy, Mineral replacement~~

~~therapy, Vitamin replacement therapy, Anti-aging therapy, Dermatology, Fertility, Growth Hormone therapy; and Anticonvulsant agents, Antihypertensive agents, Antidiabetic agents, Non-steroidal anti-inflammatory agents, Anesthetic agents, Vasoactive agents, Lipotropic agents, Chelating agents, Psychoactive agents;~~ Genetic marker tests comprised of reagents for medical purposes; Medical diagnostic reagents and assays for testing of body fluids in the nature of genomic, microbiomic, metabolomic, and biochemical tests; Medical diagnostic test kits comprised of medical diagnostic reagents and assays used to collect test samples for analyzing DNA, blood, hair, saliva and stool information for use in DNA, blood, hair, saliva and stool testing of humans; Kits comprised of medical diagnostic reagents and assays for use in genetic, genomic, microbiomic, metabolomic, and biochemical testing; Kits comprised of medical diagnostic reagents and assays for use in DNA, blood, hair, saliva and stool testing of humans; Medical diagnostic test media in the form of strips, threads, swabs, cartridges, and collection tubes for collecting and analyzing genetic, genomic, microbiomic, metabolomic, and biochemical data; **all of the foregoing, excluding pharmaceuticals for the treatment of cancer**

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. That is, any amendment to the identification of goods must remain within the scope of the identification of goods as published for opposition.

The proposed amendment is unacceptable because inasmuch as it identifies goods are not within the scope of the identification that was published for opposition.¹ The

¹ The revised proposed amendment indicated that the only changes in the identification of goods would be deletion of the wording “Compounded pharmaceuticals, namely,” and “Compounded personalized pharmaceuticals, namely,” and addition of the wording “all of the aforesaid, excluding, pharmaceuticals for the treatment of cancer.” 6 TTABVue 2. As noted

scope of goods in the identification of goods in International Class 5 that was published for opposition was defined as “[c]ompounded pharmaceuticals” and “[c]ompounded personal pharmaceuticals.” The applicable definition of “compound” is “comprised of two or more substances or parts,” and the applicable definition of “pharmaceutical” is “[a] drug or medication.” Webster’s II New College Dictionary 231 and 824 (1995). By the proposed amendment, Applicant essentially seeks to redefine that scope as “prescription” goods. Even if the Board assumes that all such prescription goods are with the scope of pharmaceuticals and personal pharmaceuticals, the proposed amended identification is unacceptable because it is presumed to encompass compounded pharmaceuticals and personal pharmaceuticals, as well as pharmaceuticals and personal pharmaceuticals that are composed of a single substance. *Cf. In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (where goods are broadly identified and there are no limitations as to their nature, type, channels of trade or classes of purchasers, the Board must presume that the scope of the identified goods encompasses all goods of the nature and type described, that those goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers). Thus, any amendment must stay within the broader classification of “[c]ompounded pharmaceuticals” and

supra, the proposed amendment included far greater additional wording than “all of the aforesaid, excluding, pharmaceuticals for the treatment of cancer.” The parties are reminded that their redlining of proposed amendments should accurately reflect additions and deletions from the identifications of goods and/or services at issue.



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