

TTAB

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

In The Matter of Application Serial No. 76314502  
filed September 19, 2001



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OTSAR SIFREI LUBAVITCH, INC. :  
: Opposer, :  
: v. :  
KEHOT PUBLICATION SOCIETY, :  
a division of Merkos L'Inyonei :  
Chinuch, Inc. :  
Applicant. :  
-----X

07-03-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

Opposition No. 91,156,049

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Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

**MEMORANDUM OF LAW IN OPPOSITION  
TO MOTION TO SUSPEND AND IN PARTIAL  
OPPOSITION TO THE MOTION TO CONSOLIDATE**

Introduction

This Opposition No. 91,156, 049 was filed on December 6, 2002 by Opposer, Otsar Sifrei Lubavitch, Inc. ("Otsar") with regard to the application filed by Kehot Publication Society, assertedly a division of Merkos L'Inyonei Chinuch, Inc. for a badge Design including various Hebrew Words and claiming a first use and first use in commerce at an unspecified date in 1942.

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I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail" Post Office to Addressee" Service under 37 CFR 1.10 on the date indicated below and is addressed to the Commissioner for Trademarks, TTAB, 2900 Crystal Drive, Arlington, Virginia 22202-3514

July 3, 2003 Date of Deposit  
Jacob Laufer Typed or Printed name  
Of Person mailing paper or fee

Jacob Laufer Signature

The Opposition asserts use by Otsar of the design at issue and contests applicant's right to the mark on a number of grounds. Applicant's Answer filed on June 10, 2003 denies the allegations in the Opposition except admits use by Otsar and claims that such use is unauthorized. In addition to the instant Opposition, two other Oppositions (Nos. 91, 156,050 and 91,056, 151) were filed by independent parties on January 6, 2003 asserting similar grounds but also alleging prior use as against the use of the real party in interest on behalf of Applicant. Applicant answered these Oppositions on June 10, 2003 by also denying the allegations and admitting use by Opposers and claiming that such use is unauthorized.

Accordingly there at least three parties actively using the mark at issue who have filed Notices of Opposition seeking resolution and determination of the asserted Trademark rights of claimed Applicant. As is evident from the Notices of Opposition and Answers filed, the issues relate to a logo having widespread use in the United States and elsewhere by members of the international Chasidic Lubavitch movement. The early determination of a claimed trademark right seeking to exclusively appropriate the use of the logo by one segment of movement ( first filed for registration almost 60 years after the claimed first use) is of manifest public importance and worldwide interest.

On June 13, 2003 Applicant moved in each of the pending proceedings (service on Opposers was by mail) to Consolidate and Suspend all of the pending proceedings pending determination of a civil action where one of the Opposers, ( ie. Opposer in the instant opposition) is a party. As regards consolidation, ordinarily the three proceedings would clearly be logical candidates for consolidation. The difficulty here arises from the impact of the concurrent request to suspend proceedings. That issue will be addressed first.

### **Suspension of Proceedings**

The principles applicable under Rule 510 relating to suspension are straightforward and not incorrectly stated in applicant's Memorandum. However, suspension is not appropriate here for the following reasons;

1. The action between the alleged parent entity of Applicant and Otsar pending in the United States District Court only incidentally involves the trademark issue pending here. The named applicant here "Kehot Publication Society"-the supposed owner of the trademark for which registration is sought - is not named as party. The second claim asserted in the District Court complaint is styled as being a direct claim for trademark infringement by the asserted parent Merkos L'Inyonei Chinuch, Inc., but in actuality is specifically identified as a cause of action for false designation of Origin. See Exhibit B to Motion- paragraph 21. The false designation is claimed to arise not merely from Otsar's use of the logo but also because Otsar has allegedly published one particular book using a pagination similar to that used by the plaintiff and further that Otsar specifically intended to confuse purchasers as to the origin of that book. See Exhibit B paragraphs 19-20. Even if plaintiff in the District Court action were to prevail on that claim it would not preclude Opposer's position here that the trademark itself is not entitled to Registration.

Indeed in all proceedings in that matter to date the trademark issue was not even reached and that the parties have primarily litigated only the Copyright claim which is the main focus of the action. See Merkos L'Inyonei Chinuch, Inc. v. Otsar Sifrei Lubavitch, Inc. 312 F.3d 94 (2d Cir. 2002). Indeed the action may be disposed of by reason of any one of a number of affirmative defenses without the underlying trademark issue ever being decided. See Exhibit C to Motion ,

paragraphs 44, 47, 48, 49 and 51.

2. The result in the pending action in the District Court will in any event not be binding on the other Opposers who use the logo at issue, who are separately before this Board and who are not parties to the District Court action. They may assert here their own right to take discovery and adduce testimony to obtain an adjudication of their rights. In this connection the Board should be further advised that discovery proceedings in the District Court action conducted by Otsar were very limited and prematurely terminated when for financial reasons Otsar was unable to proceed at that time. Even if plaintiff prevails in the District Court the other opposers (and possibly even Otsar) may legitimately assert that as regards the issue of trademark Registration a full record based on complete discovery is required— and should proceed forthwith. Otsar should be permitted to participate in the discovery and determination of the proceedings before this Board along with the other Opposers without being separately required to wait for a determination of the District Court action.

### **Consolidation**

This Opposer, Otsar Sifrei Lubavitch Inc. has no objection to consolidation if the proceedings are to proceed. Otsar does object to this opposition being consolidated with any other proceeding which is suspended.

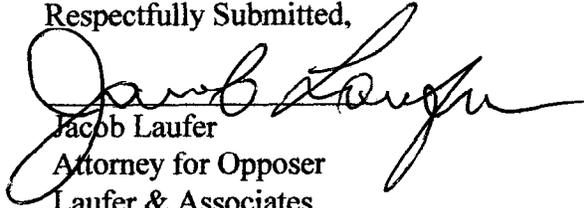
### **CONCLUSION**

For the foregoing reasons, Applicant's motion to suspend the proceeding should be

denied. Applicant's motion to consolidate should be granted only to the extent that and only for those proceedings where the consolidated oppositions are not suspended.

Dated: Brooklyn, New York  
July 3, 2003

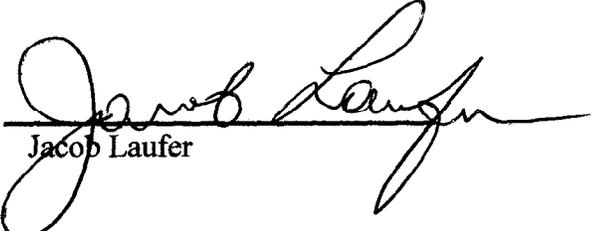
Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Jacob Laufer", written in a cursive style. The signature is positioned over the typed name and title.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that I have this day July 3, 2003 caused the foregoing Memorandum of Law to be served on opposing counsel by mailing a copy first class mail postage prepaid to Applicants Counsel, COWAN, LIEBOWITZ & LATMAN, P.C., 1133 Avenue of the Americas, New York, New York 10036-6799.

  
Jacob Laufer