

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Baxley

Mailed: October 1, 2003

Opposition No. **91156049**

Otsar Sifrei Lubavitch Inc.

v.

Kehot Publication Society, a
division of Merkos L'Inyonei
Chinuch, Inc.

Opposition No. **91156050**

Vaad Hanochos Hatmimim

v.

Kehot Publication Society, a
division of Merkos L'Inyonei
Chinuch, Inc.

Opposition No. **91156051**

Vaad L'Hafotzas Sichos, Inc.

v.

Kehot Publication Society, a
division of Merkos L'Inyonei
Chinuch, Inc.

Andrew P. Baxley, Interlocutory Attorney:

Kehot Publication Society, a division of Merkos
L'Inyonei Chinuch, Inc. ("applicant"), seeks to register the
following mark

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("the Kehot logo") for "books, magazines, charts, maps, and photographs on a variety of aspects of Jewish life" in International Class 16.¹

Registration has been opposed by Otsar Sifrei Lubavitch Inc., Vaad Hanochos Hatmimim, and Vaad L'Hafotzas Sichos, Inc. (referred to collectively as "opposers") in separate proceedings, on grounds that the Kehot logo is merely descriptive of, and generic for, the involved goods, and

¹ Application Serial No. 76/314,502, filed September 19, 2001, alleging 1942 as the date of first use and date of first use in commerce. The application includes the following description:

The mark is in the form of a badge design, incorporating Hebrew words, the transliteration of which is as follows - the upper part of the design incorporates the Hebrew words "hotzoas seforim", which, in English, means "publication society". Below that are the Hebrew words "karnei hod torah", which, in English, means "torah is a majestic crown" In the center of the design are the Hebrew letters "K H T", which are the initial letters of the Hebrew words set forth above, ie "karnei hod torah". (This combination of the three Hebrew letters is pronounced "kehot"). At the bottom of the design is the word "Lubavitch", which indicates that applicant is the official publishing house of the Lubavitch organization, of which Merkos L'Inyonei Chinuch, Inc. is the educational arm.

The application also includes a disclaimer of an exclusive right to use the Hebrew characters translating to "Hotzoas Seforim" and "Lubavitch" apart from the mark as shown.

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because applicant is not the true and correctly identified party in interest.

This case now comes up for consideration of (1) applicant's consented motions (filed June 2, 2003) to extend time answer, and (2) applicant's combined motions (filed June 13, 2003) to consolidate and suspend the above-captioned proceedings. Otsar Sifrei Lubavitch Inc., the plaintiff in Opposition No. 156,049, and Vaad L'Hafotzas Sichos, Inc., the plaintiff in Opposition No. 156,051, have filed briefs in opposition thereto.² Although Vaad Hanochos Hatmimim, the plaintiff in Opposition No. 156,050, did not file a brief in opposition to applicant's combined motions, the Board declines to grant those motions as conceded and instead will decide all of applicant's motions on the merits. See Trademark Rule 2.127(a).

Turning first to applicant's consented motions to extend time to answer, those motions are hereby granted. Applicant's answers were due not later than June 10, 2003.

The Board turns next to the motions to consolidate. When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. See Fed. R. Civ. P. 42(a); see also, *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d

² The Board, in its discretion, has elected to consider applicant's reply briefs in Opposition Nos. 156,049 and 156,051.

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1154 (TTAB 1991) and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991).

After reviewing the pleadings in the opposition proceedings and the parties' arguments with regard to applicant's motions, the Board finds that, notwithstanding the fact that the oppositions were brought by different plaintiffs, consolidation is appropriate because the proceedings involve the same alleged mark and essentially the same claims. Further, consolidation will save the Board and the parties considerable time, effort, and expense, while opposers have alleged no specific prejudice resulting from such consolidation.³ See TBMP Section 511. Accordingly, Opposition Nos. 156,049, 156,050 and 156,051 are hereby consolidated.

The consolidated cases may be presented on the same record and briefs. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989) and *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993).

The Board file will be maintained in Opposition No. 156,049 as the "parent" case. As a general rule, from this point on only a single copy of any paper or motion should be filed herein; but that copy should bear both proceeding

³ Moreover, it is noted that opposers are represented by the same attorney. Cf. TBMP Section 117.02.

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numbers in its caption. Exceptions to the general rule involve stipulated extensions of the discovery and trial dates, see Trademark Rule 2.121(d), and briefs on the case, see Trademark Rule 2.128.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleading; a copy of the decision shall be placed in each proceeding file.

Turning next to the motion to suspend, the Board generally suspends proceedings before it pending final determination of civil actions which may have a bearing on those proceedings. See Trademark Rule 2.117(a). That is primarily because, to the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the Board, while the decision of the Board is not binding upon the court. See, e.g., *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir. 1988).

After reviewing the parties' arguments and the pleadings in the civil action,⁴ the Board finds that

⁴ The civil action is styled *Merkos L'Inyonei Chinuch, Inc. v. Ostar Sifrei Lubavitch, Inc.*, Case No. CV 01 7406, filed November 5, 2001 in the United States District Court for the Eastern District of New York.

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suspension is appropriate in this case. To prevail in the district court on its claims of false designation of origin and dilution, applicant must prove the existence of its trademark rights in the Kehot logo mark. Further, to prevail on its affirmative defense that the Kehot logo is a generic designation for the involved goods, Ostar Sifrei Lubavitch, Inc., the plaintiff in Opposition No. 156,049, must establish such genericness. The district court's findings with regard to the claims and affirmative defense clearly will have a bearing on opposers' claim that the alleged mark is merely descriptive and generic. More importantly, those findings would be binding upon the Board. See *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971). In short, the Board finds that these considerations outweigh the facts that Vaad Hanochos Hatmimim, the plaintiff in Opposition No. 156,050, and Vaad L'Hafotzas Sichos, Inc., the plaintiff in Opposition No. 156,051, are not parties to the civil action, that applicant is a division of the plaintiff in the civil action, and that the civil action also involves claims of copyright infringement.

Therefore, in the interest of judicial economy and consistent with the Board's inherent authority to regulate its own proceedings to avoid duplicating the effort of the district court and the possibility of reaching an

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inconsistent conclusion, applicant's motions to suspend these now-consolidated proceedings pending final determination, (i.e., following the termination of any and all appeals and remands), of Case No. CV 01 7406 is hereby granted. See Trademark Rule 2.117. Proceedings herein are suspended indefinitely, pending final determination of Case No. CV 01 7406.

Bi-annual inquiry may be made as to the status of the civil action. Within twenty days after the final determination of the civil action, the interested party should notify the Board so that this case may be called up for appropriate action. During the suspension period the Board should be notified of any address changes for the parties or their attorneys.