

TTAB



08-22-2003

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

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

CARLOS A. ARREDONDO, in his capacity as  
Trustee of The 2000 Trust for the Grandchildren of  
Carlos A. Arredondo and Mari V. Arredondo,  
General Partner of Arredondo Properties Limited  
Partnership,

Opposer,

Opposition No. 91157195

Serial No. 76/446,778

Regarding U.S. Application for  
DESIGN ONLY filed on  
September 3, 2002  
Published on June 24, 2003  
at Page TM 513

03 SEP -3 PM 9:32  
TM TRIAL BOARD

AND

Opposition No. 156,040  
(Consolidated Opposition Nos.  
91156192 and 91156040)

v.

ARREDONDO & CO., LLC,

Applicant.

Commissioner for Trademarks  
BOX TTAB - NO FEE  
2900 Crystal Drive  
Arlington, VA 22202-3513

In the matter of Application Serial No. 76/446,778, filed on September 3, 2002,  
for the mark DESIGN ONLY, published on June 24, 2003, and Opposition No. 156,040,  
the "parent" case consolidating Opposition Nos. 91156192 and 91156040.

**STIPULATED MOTION TO CONSOLIDATE  
AND SUSPEND OPPOSITION PROCEEDINGS**

Madam:

Opposer Carlos A. Arredondo (hereinafter "Opposer"), pursuant to the provisions  
of Trademark Rule 2.117(a), 37 C.F.R. § 2.117, and Applicant Arredondo & Co.  
(hereinafter "Applicant") hereby move jointly to consolidate Opposition No. 91157195  
with Opposition No. 156,040 and to then suspend the consolidated proceeding pending

disposition of a civil action between the parties currently pending in the United States District Court for the District of Connecticut.

### **Factual Background**

#### **A. The Parties and the Civil Action**

Opposer owns certain self-storage facilities located in Connecticut and New York. The facilities are operated under the marks WESTY, WESTY'S and a design of a terrier (the "Terrier Design").

Opposer and Applicant dispute who is the true owner of all right, title and interest in and to the Terrier Design and the marks WESTY and WESTY'S. To resolve this dispute, Opposer filed a declaratory judgment action against Applicant on December 12, 2002 in the United States District Court for the District of Connecticut, Civil Action No. 3:02 CV 2200 (CFD) (the "Civil Action"). This action is currently pending. A true and correct copy of Opposer's Complaint is attached hereto as Exhibit A. Applicant has denied the salient allegations of the Complaint.

#### **B. Applicant's Trademark Registration Applications**

On September 3, 2002, Applicant filed applications with the Trademark Office to register the marks WESTY, WESTY's, and the Terrier Design in its own name. The Trademark Office assigned, Application No. 76/446,777 to the application for WESTY (the "'777 Application"); Application No. 76/445,815 to the application for WESTY'S (the "'815 Application"); and Application No. 76/446,778 to the application for DESIGN ONLY (the Terrier Design) (the "'778 Application").

The Board published the '777 Application for opposition on March 25, 2003 and the '815 for opposition on March 18, 2003. Opposer timely filed Notices of Opposition to each of these applications on April 3, 2003. The Board assigned Opposition No. 91156192 to Opposer's opposition to the '777 Application and Opposition No. 91156040 to Opposer's opposition to the '815 Application. At the time, the '778 Application had not yet been approved for publication.

On May 30, 2003, Opposer and Applicant filed with the Board a Stipulated Motion to Consolidate and Suspend Opposition Proceedings, requesting that the Trademark Office consolidate Opposition Nos. 91156192 and 91156040 and suspend the consolidated proceeding pending resolution of the Civil Action. The Board granted the Motion in an Order dated June 30, 2003 and assigned the consolidated opposition Opposition No. 156,040.

On June 24, 2003, the Trademark Office approved the '778 Application for publication, and Opposer timely filed a Notice of Opposition to the application on July 8, 2003. The Board assigned Opposition No. 91157195 to the Terrier Design opposition proceeding.

#### Argument

Because ownership of the Terrier Design is also contested in the parties' ongoing dispute in the District Court for the District of Connecticut, Opposer and Applicant request that the Terrier Design opposition proceeding be consolidated with the proceedings for WESTY and WESTY'S, already consolidated by the Board as Consolidated Opposition No. 156,040. Because the pending Civil Action involves the same issues that are before the Board in all three opposition proceedings, and because the Civil Action will be dispositive of all issues in all of the opposition proceedings, Opposer and Applicant request that all further proceedings in Opposition No. 91157195 be suspended pending disposition of the Civil Action pursuant to Trademark Rule 2.117(a). 37 C.F.R. § 2.117(a). See also General Motors Corp. v. Cadillac Club Fashions Inc., 22 U.S.P.Q.2d 1933, 1937 (TTAB 1992); Toro Co. v. Hardigg Indust., Inc., 187 U.S.P.Q. 689, 692 (TTAB 1975); Other Telephone Co. v. Conn. Nat'l Telephone Co., Inc., 181 U.S.P.Q. 125, 126-27 (TTAB 1974).

Opposer requests that the Board send all correspondence to Opposer regarding this matter to Dana Marty Haas, counsel for Opposer, at the address listed below.

Counsel for Applicant, David M. Kelly, has stipulated to this Motion on Applicant's behalf.

Respectfully submitted,



Martin J. Elgison  
David J. Stewart  
Dana Marty Haas  
Alston & Bird LLP  
One Atlantic Center  
1201 West Peachtree Street  
Atlanta, Georgia 30309-3424  
(404) 881-7000

Attorneys for Opposer  
CARLOS A. ARREDONDO

Dated: August 21, 2003

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

CARLOS A. ARREDONDO, in his capacity as  
Trustee of The 2000 Trust for the Grandchildren of  
Carlos A. Arredondo and Mari V. Arredondo,  
General Partner of Arredondo Properties Limited  
Partnership,

Opposer,

v.

ARREDONDO & CO., LLC,

Applicant.

Opposition No. 91157195

Serial No. 76/446,778

Regarding U.S. Application for  
DESIGN ONLY filed on  
September 3, 2002  
Published on June 24, 2003  
at Page TM 513

AND

Opposition No. 156,040  
(Consolidated Opposition Nos.  
91156192 and 91156040)

**CERTIFICATE OF SERVICE**

I hereby certify that I have this date, August 21, 2003, served a true and correct copy of the within and foregoing Stipulated Motion to Consolidate and Suspend Opposition Proceedings upon Applicant by causing a copy of the same to be deposited in the United States Mail, first-class postage prepaid, and addressed to Applicant's counsel of record as follows:

Craig A. Raabe  
Robinson & Cole LLP  
280 Trumbull Street  
Hartford, CT 06103

and

David M. Kelly  
Finnegan, Henderson, Farabow,  
Garrett & Dunner, LLP  
1300 I Street, N.W.  
Washington, DC 20005

  
Dana Marty Haas

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

CARLOS A. ARREDONDO, in his capacity as  
Trustee of The 2000 Trust for the Grandchildren of  
Carlos A. Arredondo and Mari V. Arredondo,  
General Partner of Arredondo Properties Limited  
Partnership,

Opposer,

v.

ARREDONDO & CO., LLC,

Applicant.

Opposition No. 91157195

Serial No. 76/446,778

Regarding U.S. Application for  
DESIGN ONLY filed on  
September 3, 2002  
Published on June 24, 2003  
at Page TM 513

AND

Opposition No. 156,040  
(Consolidated Opposition Nos.  
91156192 and 91156040)

**EXPRESS MAIL CERTIFICATION ACCOMPANYING PAPER**

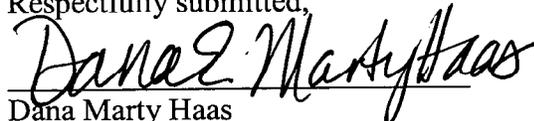
Commissioner for Trademarks  
BOX TTAB - NO FEE  
2900 Crystal Drive  
Arlington, VA 22202-3513

"Express Mail" mailing label number: EV211236285US

Date of Deposit: August 21, 2003

I hereby certify that the attached Stipulated Motion to Consolidate and Suspend Opposition Proceedings is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service pursuant to 37 C.F.R. § 1.10 on the date indicated above and is addressed to Commissioner for Trademarks, BOX TTAB NO FEE, 2900 Crystal Drive, Arlington, VA 22202-3513.

Respectfully submitted,

  
Dana Marty Haas

A

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF CONNECTICUT

Dec 12 4 04 PM '02

CARLOS A. ARREDONDO, in his capacity as  
Trustee of The 2000 Trust for the Grandchildren of  
Carlos A. Arredondo and Mari V. Arredondo,  
General Partner of Arredondo Properties Limited  
Partnership,

Plaintiff,

v.

CAESAR A. ARREDONDO, individually and in  
his capacity as Trustee of The 2000 Trust for the  
Grandchildren of Caesar A. Arredondo and Carolyn  
Abad Arredondo; THE 2000 TRUST FOR THE  
GRANDCHILDREN OF CAESAR A.  
ARREDONDO AND CAROLYN ABAD  
ARREDONDO, in its capacity as General Partner  
of Arredondo Properties Limited Partnership; and  
ARREDONDO & CO., LLC,

Defendants.

U.S. DISTRICT COURT  
BRIDGEPORT, CONN.

CIVIL ACTION FILE

NO. \_\_\_\_\_

Filed December 12, 2002

**COMPLAINT FOR DECLARATORY JUDGMENT**

Plaintiff Carlos A. Arredondo, in his capacity as trustee of one of the two general partners  
of Arredondo Properties Limited Partnership ("APLP"), complains and alleges as follows:

**NATURE AND BASIS OF ACTION**

1.

This is an action under 28 U.S.C. § 2201 for a declaratory judgment that APLP is the true  
and exclusive owner of certain marks, including WESTY and WESTY'S, and for relief  
necessary to preserve and protect APLP's exclusive ownership of the marks.

## PARTIES, JURISDICTION AND VENUE

2.

Plaintiff Carlos A. Arredondo (“Carlos Arredondo” or “Carlos”) brings this suit in his capacity as the trustee for The 2000 Trust for the Grandchildren of Carlos A. Arredondo and Mari V. Arredondo (the “Carlos Arredondo Trust”), a trust organized and existing under the laws of the State of Connecticut and having its principal place of business at Metro Center, One Station Place, Stamford, Connecticut 06902. The Carlos Arredondo Trust is one of the two general partners of APLP, a limited partnership organized and existing under the laws of the State of Connecticut.

3.

Defendant Caesar A. Arredondo (“Caesar Arredondo” or “Caesar”) is the trustee for Defendant The 2000 Trust for the Grandchildren of Caesar A. Arredondo and Carolyn Abad Arredondo (the “Caesar Arredondo Trust”), a trust organized and existing under the laws of the State of Connecticut and having its principal place of business at Metro Center, One Station Place, Stamford, Connecticut 06902. The Caesar Arredondo Trust is the second general partner of APLP.

4.

Upon information and belief, Defendant Caesar Arredondo resides at Mead Point Drive, Greenwich, Connecticut 06830.

5.

Defendant Arredondo & Co., LLC is a limited liability company organized under the laws of the State of Connecticut, having its principal place of business at Metro Center, One Station Place, Stamford, Connecticut 06902.

6.

This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331, 1338, 2201, and 2202 because this case arises under the Federal Declaratory Judgment Act, 28 U.S.C. § 2201 and the Trademark Act of 1946, 15 U.S.C. § 1051, et seq.

7.

Venue is proper in this District pursuant to 28 U.S.C. § 1391(b).

### **FACTS GIVING RISE TO ACTION**

#### **APLP and the Westy Storage Center Business**

8.

Carlos and Caesar Arredondo are brothers who have engaged in various real estate oriented business ventures together since 1961.

9.

In 1980, the brothers formed APLP as a vehicle for investing capital for future generations of their respective families. Currently, the brothers personally own no interest in APLP, but they manage APLP in their capacities as trustees of the general partners of APLP, namely, the Carlos Arredondo Trust and the Caesar Arredondo Trust.

10.

Since 1991, APLP has been engaged in the business of offering high-end self storage facilities, services, and related goods to the public under the service mark and trademark WESTY'S.

11.

APLP's first self storage facility was located in Port Chester, New York. Since the opening of the Port Chester facility, the business has grown to include eleven (11) facilities located in Connecticut and New York.

12.

In 1997, APLP opened a storage facility in Elmsford, New York. Beginning with the opening of this facility, APLP began using the mark WESTY instead of WESTY'S as the principal mark for the business's self storage facilities, services and related products.

13.

Today, all eleven of the business's self-storage facilities operate under the WESTY mark. APLP nevertheless continues to use the WESTY'S mark to identify certain goods and services. (The WESTY'S and WESTY mark are hereinafter referred to collectively as the "WESTY Marks.")

14.

The real estate for each of the WESTY storage facilities is owned by separate limited liability companies, eight of which are owned by APLP. The three remaining companies (Norwalk Project LLC, Milford Project LLC, and Stamford Project LLC) were formed by Carlos and Caesar jointly, and each brother owns 50% of each company. APLP owns the limited liability companies that own the Port Chester and Elmsford storage facilities.

15.

In 1996, the brothers incorporated Westy Connecticut, Inc. under the laws of Connecticut to serve as the manager of the WESTY branded facilities located in Connecticut.

16.

A limited liability company the brothers had owned jointly through a predecessor company since 1965, Arredondo & Co., LLC ("Arredondo & Co."), provided site selection, building design, construction, accounting and tax services to APLP in connection with the WESTY business for specific fees.

**APLP's Service Mark and Trademark Rights**

17.

APLP has continuously and exclusively used the WESTY'S mark in interstate commerce since 1991, and the WESTY mark in interstate commerce since 1997, to identify the sale of self-storage services and related goods and services. APLP is therefore the exclusive owner of all right, title and interest in and to both marks.

18.

Through significant advertising, promotion and use in connection with high quality goods and services, the WESTY Marks are associated with one of the best known and most widely respected brand names in the self-storage industry. The WESTY Marks are therefore assets of substantial value to APLP.

19.

APLP has also used a number of other marks in connection with its business. Since the opening of its first store in 1991, APLP has used the following distinctive image of a West Highland White Terrier (commonly known as a "Westy") in commerce as a trademark and service mark to identify the WESTY branded storage facilities and their goods and services (hereinafter the "Terrier Design"):



20.

For years, APLP has also used the slogan SELF-STORAGE MADE EASY in interstate commerce as a service mark and trademark to identify the WESTY business and its goods and services (hereinafter the "Westy Slogan").

21.

By virtue APLP's continuous and exclusive use of the Terrier Design and Westy Slogan to identify the sale of self-storage services and related goods and services, APLP is the exclusive owner of all right, title and interest in and to the marks. (The Terrier Design and Westy Slogan are hereinafter referred to collectively with the WESTY and WESTY'S marks as the WESTY Marks.)

22.

APLP licenses each of the WESTY storage facilities to use the WESTY Marks.

**Defendants' Unauthorized Attempt to  
Transfer Ownership of the WESTY Marks**

23.

In an effort to relieve personal and professional tension that had developed between the brothers, Carlos sold his half interest in Arredondo & Co. to Caesar as of December 31, 1999 for a fraction of its true value.

24.

On December 21, 1999, Caesar caused Westy Connecticut, Inc. to execute a written agreement that purported to assign all right, title, and interest in the marks WESTY'S and SELF-STORAGE MADE EASY to Arredondo & Co. Westy Connecticut, Inc. never owned any rights in these marks; therefore, the agreement conveyed no rights of any kind in the marks to Arredondo & Co. The agreement made no mention of the WESTY or Terrier Design marks.

25.

On September 3, 2002, Arredondo & Co. filed federal trademark registration applications for the WESTY'S and WESTY marks with the U.S. Patent and Trademark Office ("PTO"). The PTO assigned these applications Serial Nos. 76-445,815 and 76-446,777, respectively.

26.

After discovering the applications, Carlos sent Caesar a letter dated October 30, 2002 that: (a) clarified that APLP owns the WESTY and WESTY'S service marks and (b) reminded Caesar of his fiduciary duty as a General Partner of APLP to protect the partnership's assets. A true and correct copy of Carlos' letter is attached as Exhibit A.

27.

In a response letter sent the same day, Caesar denied that APLP owns the WESTY Marks and asserted that Arredondo & Co. now owns the marks because of the purported assignment he executed from a company that never owned any rights in the marks. A true and correct copy of Caesar's letter is attached as Exhibit B.

28.

In preparing this Complaint, APLP discovered that Arredondo & Co. filed a trademark registration application with the PTO on September 3, 2002, for the Terrier Design, despite the

fact that Arredondo & Co. owns no rights of any kind in this mark. The PTO assigned Arredondo & Co.'s application Serial No. 76-446,778.

## COUNT I

### Declaration of Trademark Ownership

29.

Plaintiff incorporates by reference the allegations of paragraphs 1 through 28 above as if fully set forth herein.

30.

Caesar Arredondo's attempt to exert exclusive ownership and control over the WESTY Marks through Arredondo & Co. and against the true owner of the mark, APLP, gives rise to a case of actual controversy with respect to ownership of the WESTY Marks under the Federal Trademark Act of 1946.

31.

Pursuant to 28 U.S.C. § 2201, Carlos Arredondo, in his capacity as trustee of a general partner of APLP, respectfully requests that the Court declare that APLP is the true and exclusive owner of the WESTY Marks and grant plaintiff the relief requested below to remedy the defendants' unlawful attempts to exercise ownership and control over the marks.

### JURY DEMAND

Plaintiff hereby demands a trial by jury of all issues so triable.

### PRAYER FOR RELIEF

WHEREFORE, plaintiff prays that the Court:

- (1) Declare that APLP is the true and exclusive owner of the WESTY Marks;

(2) Order Arredondo & Co. to expressly abandon its pending applications for registration of the WESTY, WESTY'S, and Terrier Design marks;

(3) Order the Director of the Trademark Office of the PTO to deny registration to Arredondo & Co.'s pending applications for registration of the WESTY, WESTY'S, and Terrier Design marks;

(4) Enjoin the defendants, individually and collectively, from taking any action or doing any thing that is inconsistent with APLP's true and exclusive ownership of the WESTY Marks;

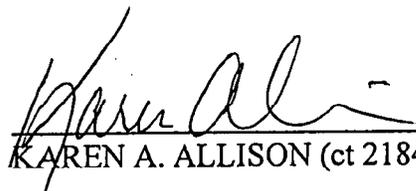
(5) Enjoin the defendants, individually and collectively, from using, registering or seeking to register any trademark, service mark, trade name, domain name, meta tag, or search engine keyword that consists in whole or in part of the term "WESTY" or the Terrier Design, or that is likely to cause confusion with any of the WESTY Marks.

(6) Find that this case is exceptional pursuant to 15 U.S.C. § 1117 in light of the defendants' willful, bad faith conduct and award plaintiff recovery of its reasonable attorneys' fees incurred in connection herewith;

(7) Award plaintiff recovery of its costs; and

(8) Grant APLP such other, different, and additional relief as the Court deems just and proper.

Respectfully submitted, this 12th day of December, 2002.

  
KAREN A. ALLISON (ct 21849)

CUMMINGS & LOCKWOOD LLC  
Four Stamford Plaza, P.O. Box 120  
Stamford, Connecticut 06904-0120  
Ph (203) 327-1700

Fx (203) 708-5647

OF COUNSEL:

MARTIN J. ELGISON  
Georgia Bar No. 243187  
DAVID J. STEWART  
Georgia Bar No. 681149  
EMILY M. WASHBURN  
Georgia Bar No. 506576

ALSTON & BIRD LLP  
One Atlantic Center  
1201 West Peachtree Street  
Atlanta, Georgia 30309-3424  
Ph (404) 881-7000  
Fx (404) 881-7777

Counsel for Plaintiff



*Carlos A. Arredondo  
Serrano 42, 2dcha  
Madrid, Spain 28001  
Telephone/Facsimile No.: 011-34-91-426-1068  
Mobile No.: 011-34-690-216-292*

VIA FACSIMILE & COURIER

October 30, 2002

**Caesar A. Arredondo**  
Trustee of the 2000 Trust for the Grandchildren of Caesar A. and Carolyn Abad Arredondo,  
General Partner  
Of Arredondo Properties Limited Partnership  
Telephone Number: 001-203-357-0348  
Facsimile Number: 001-203-357-0200

**Re: Arredondo Properties Limited Partnership**

Dear Caesar:

It has come to my attention that Arredondo & Company, LLC ("Arredondo & Co.") has filed applications with the United States Patent and Trademark Office ("USPTO") on September 3, 2002 to register the marks "WESTY" and "WESTY'S" in the name of Arredondo & Co.

As you know, these marks were first used commercially in the United States by Arredondo Properties Limited Partnership ("APLP"). Under well-established principles of trademark law, APLP is the owner of all common law rights to the marks. It is therefore improper for Arredondo & Co. to claim that it is the owner of the "WESTY" and "WESTY'S" marks. These two (2) marks are valuable assets of the partnership, and as General Partners of APLP, we both have a fiduciary responsibility to protect these assets. Accordingly, the filing of trademark applications for these marks in name of Arredondo & Co., which you control, constitutes a breach of your fiduciary duty as a General Partner of APLP. The applications should be withdrawn immediately.

In order to resolve this problem amicably, I propose that we do the following:

1. APLP will file with the USPTO to register its ownership of the "WESTY" and "WESTY'S" marks. The filing by Arredondo & Co. will be withdrawn and we will proceed to execute all appropriate applications and any other documents that are required to perfect ownership of the marks by APLP.
2. APLP will agree to enter into royalty-free licenses with you, myself, and any present and future general or limited partners of APLP or entities entirely owned by the aforementioned, that will allow them to use the "WESTY" and "WESTY'S" marks to build and operate warehouse and general storage facilities, as long as the ownership of such facilities remains with you, myself or the present or future general or limited partners of APLP.
3. And lastly, APLP will agree to enter into royalty-free licenses with the following entities owned by us jointly that will allow these entities to continue to use the "WESTY" and "WESTY'S" marks in connection with existing warehouse and general storage facilities: Norwalk Project LLC, Milford Project LLC, and Stamford Project LLC.

This structure will assure the satisfaction of each of our duties as General Partners to the other partners of APLP. It will also permit the continued use of the "WESTY" and "WESTY'S" marks in connection with existing storage facilities, and allow the members of APLP that would like to do so, to continue to expand the business under those marks. I believe this structure will inure to the benefit of all concerned parties, without in any way harming anyone's current interests or future plans.

As the "WESTY" and "WESTY'S" marks are valuable assets of APLP and we both have the fiduciary duty to protect them, I must insist that you respond to this letter, in writing, within five (5) business days of your receipt of it, informing me of the steps you intend to take as a General Partner of APLP, to protect these assets. As I will be out of town until November 6<sup>th</sup>, please send your response to my facsimile machine and to the address in Madrid listed on this letterhead.

Very Cordially Yours,

Carlos A. Arredondo  
Trustee of the 2000 Trust for the Grandchildren of Carlos A. and Mari Vara Arredondo,  
General Partner  
Of Arredondo Properties Limited Partnership



**Arredondo & Co.**LLC  
OWNER-BUILDER

October 30, 2002

TO: CARLOS  
FROM: CAESAR  
RE: WESTY TRADEMARK

VIA FAX & FEDERAL EXPRESS

In response to your letter today, I think it will be helpful for me to remind you of the following:

1. The Westy trademark and related trademarks were owned by Westy Connecticut, Inc.
2. In December 1999, before dissolving Westy Connecticut, Inc., you and I agreed to transfer all the trademarks to Arredondo & Co., LLC. We signed the appropriate papers and had the trademark lawyer make the filing.
3. When you sold to me all of your interest in Arredondo & Co., LLC as of January 1, 2000, specifically included in the sale were the trademarks, which were set forth in our written agreement.
4. At no time did Arredondo Properties Limited Partnership own the Westy trademark or any of the related trademarks.
5. The September 2002 filing was simply a re-filing of the trademark by the same owner as advised by our trademark attorney.

I think it is important that this matter be put to bed once and for all. Arredondo & Co., LLC is the owner of the trademarks and there is no reason for a debate to continue on the subject.

As you know, I am leaving for vacation tomorrow morning and will be back in the office on November 11<sup>th</sup>. At that time, we should plan to discuss the questions you raised about the recent resolution for APLP and discuss Mechaniceburg.

