

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

Ryan

MAILED: June 2, 2005

Opposition No. 91162422

V Secret Catalogue, Inc.

and

Intimate Beauty Corporation

v.

Rick Worobec

**Karyn K. Ryan, Interlocutory Attorney
Trademark Trial and Appeal Board:**

On March 24, 2005, the Board issued an order granting applicant's motion to suspend this proceeding pending final determination of a related Board proceeding, identified as Opposition No. 91125739 ("the '739 case"). In that order, we relied on Trademark Rules 2.117(c) and 2.127(a), considering the motion to suspend as "well-taken" and treating that motion as conceded in view of opposers' failure to file a response thereto.

It now appears that, on March 4, 2005, opposers had filed their brief in response to the motion to suspend. Because opposers' objections were not associated with the Board's proceeding file at the time we rendered our March

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24, 2005 decision, they were not previously considered herein.

On April 11, 2005, opposers filed a motion seeking reconsideration of our decision to suspend, requesting that the Board consider opposers' objections to the proposed suspension and allow this case to go forward without delay. Applicant, on April 29, 2005, opposed this motion for reconsideration, arguing that the decision to suspend was appropriate and should not be set aside.

Inasmuch as the record is now clear that applicant's motion to suspend was contested, our decision to treat that motion as conceded was incorrect. Accordingly, it is appropriate for us to revisit the issue of suspension in light of both parties' submissions. The motion for reconsideration is **granted**. See Trademark Rule 2.127(b). See also TBMP section 518 (2d. ed. rev. 2004).

By the motion to suspend, applicant seeks to suspend this proceeding pending the Board's decision in Opposition No. 91125739, an opposition proceeding in which Sexy Hair Concepts, LLC has opposed an intent-to-use application for the mark SO SEXY, Serial No. 78094035, filed by V Secret Catalogue, Inc. (one of the opposers in this proceeding). In the '739 case, opposer Sexy Hair Concepts pleads priority and likelihood of confusion with its registered mark SEXY HAIR, Registration No. 2403396.

Pursuant to 37 CFR § 2.117(a), the Board may, in its discretion, suspend a proceeding pending the final determination of another Board proceeding in which the parties are involved, or a civil action pending between the parties in a state court, or a foreign action between the parties, wherein one party challenges the validity of a foreign registration upon which the other party's subject application is based, or even another proceeding in which only one of the parties is involved. Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on the issues before the Board. See, e.g., *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125 (TTAB 1974), *petition denied*, 181 USPQ 779 (Comm'r 1974); see also TBMP section 510.02(a) (2d. ed., rev. 2004). Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board. See *Opticians Ass'n of America v. Independent Opticians of America Inc.*, 734 F.Supp. 1171, 14 USPQ 2021 (D.N.J. 1990), *rev'd on other grounds*, 920 F.2d 187, 17 USPQ 1117 (3d Cir. 1990).

Additionally, proceedings may also be suspended, for good cause, upon motion approved by the Board. See Trademark Rule 2.117(c).

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The Board is not persuaded by opposers' arguments in opposition to suspension herein. Opposition No. 91125739 and this opposition proceeding involve common legal and factual issues, including, at a minimum, likelihood of confusion and the strength of opposer's SO SEXY mark in the hair care field. Even if there is another claim pleaded in the '739 opposition that will not be addressed in the subject opposition, or vice versa, the Board's findings and decision in the '739 case may narrow the issues for discovery, trial, and decision herein. Thus, the outcome of the '739 case will have a bearing on this opposition proceeding.

As such, in the interest of judicial economy and consistent with our inherent authority to regulate our own proceedings to avoid unnecessary effort by the Board and the parties, and the possibility of reaching an inconsistent conclusion, the Board in its discretion finds that suspension is warranted. Accordingly, we **affirm** our March 24, 2005 decision to grant the motion to suspend. Nonetheless, we recognize that Trademark Rule 2.117(a) also serves as a ground for suspension and that Trademark Rule 2.127(a) is not applicable in this instance. We hereby **modify** the March 24, 2005 decision by deleting (i) the reference to Trademark Rule 2.127(a) and (ii) our statement

that opposers have not "lodged any objections" to the motion to suspend.

Proceedings herein shall remain suspended pending final disposition of Opposition No. 91125739. Within **twenty days** of such final determination, the Board must be so notified in writing, so that proceedings may be resumed and appropriate action taken.

The Board must be informed in writing of any change in correspondence address for the parties which might occur during the suspension period. See Trademark Rule 2.18.

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Notice Regarding TTAB Electronic Resources and New Rules

- TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.
- Parties should also be aware of changes in the rules affecting trademark matters, including rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003) Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes are available at www.uspto.gov.
- The second edition of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) has been posted on the USPTO web site at www.uspto.gov/web/offices/dcom/ttab/tbmp/.