

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

ZANELLA LTD.,	)
	)
Opposer	)
	)
v.	)
	)
NORDSTROM, INC.,	)
	)
Applicant	)
(S/N 77025747)	)
	)

77/025,247

Opposition No. 91177858

TRADEMARK PROCESS RECEIVED  
 2008 MAR 18 P 12:48  
 U.S. PATENT & TRADEMARK OFFICE

**MOTION TO RESUME PROCEEDING**

Opposer Zanella Ltd. hereby moves for an order resuming this proceeding. Its reasons for this motion are as follows.

On January 15, 2008, Applicant filed a motion for summary judgment cancelling Opposer's registrations and a motion to amend its answer to add a counterclaim for cancellation of the registrations. On the same date, Applicant filed a motion for suspension of this proceeding pending the Board's decision on its motion to amend and its motion for summary judgment. In support of its motion to suspend, Applicant stated that its motions were potentially dispositive of the proceeding and therefore suspension was appropriate under 37 C.F.R. § 2.127(d).

On January 22, 2008, in reliance on Applicant's representation that its motion was potentially dispositive of the case, the Board granted Applicant's motion to suspend the proceeding. It did so before Opposer had filed a response.

On February 19, 2008, Opposer filed a response to Applicant's motion for summary judgment. In its response, Opposer pointed out that the motion for summary



03-18-2008

judgment was not potentially dispositive of the case because (1) Applicant's motion was limited to a request for cancellation of Opposer's registrations, (2) Opposer's opposition is based not only on Opposer's registrations, but also on Opposer's long years of previous use of its trademark, and (3) Applicant has not challenged the validity of Opposer's common law trademark, and indeed Applicant itself has been selling Opposer's goods under the ZANELLA mark for many years. Opposer also pointed out that continued suspension of the proceeding would be prejudicial to Opposer because Applicant continues to use its mark to Opposer's detriment. See Opposer's Response to Applicant's Motion for Summary Judgment, at 19-20.

On March 10, 2008, Applicant filed a reply in support of its motion for summary judgment. Applicant's Reply in Support of Motion for Summary Judgment Cancelling Opposer's Registrations for Fraud (hereinafter "Reply"). In its Reply, Applicant does not repeat its assertion that its motion for summary judgment is dispositive of the proceeding. Rather, it states that its motion is potentially dispositive only of Opposer's registrations. Reply at 7.

Trademark Rule 2.127(d) provides for suspension in the event of a motion that is "potentially dispositive of a proceeding..." (Emphasis added.) It does not provide for suspension based on a motion potentially dispositive of a registration.

Applicant in its Reply no longer asserts that cancellation of the registrations would be dispositive of the proceeding. And it does not contest Opposer's common-law rights based on its years of previous use of its ZANELLA, which are an independent basis for its opposition under section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

Applicant apparently admits that its motion is not potentially dispositive of this proceeding.

As a reason for continuing the suspension, Applicant in its Reply now claims only that cancellation of Opposer's registrations "will have a significant affect (*sic*) on the structuring of discovery." For this new assertion, it cites 37 C.F.R. § 2.117(c). It does not explain how or why the effect of its motion and counterclaim on discovery in this case will be "significant."

Trademark Rule 2.117(c) requires good cause for suspension of an opposition proceeding. The mere fact that there might be some additional discovery does not constitute good cause. In this case, any further discovery with respect to Applicant's request to cancel Opposer's registrations will not be so significant as to work any undue hardship on the parties. To the contrary, Applicant's counterclaim is at best a side issue and a diversion from the real issue in this case, and will have no bearing on the outcome of this proceeding.

The issue in this case is the likelihood of confusion caused by Applicant's adoption and use of the ZELLA mark. Discovery and trial on that issue will not be affected by Applicant's counterclaim. The primary effect of continued suspension will be to delay a decision on the merits of this opposition and to prolong Applicant's use of its offending mark, to the detriment of Opposer and the purchasing public.

When proceedings have been suspended based on a potentially dispositive motion and the determination of the motion does not dispose of the case, the Board issues an order resuming proceedings and taking further appropriate action, including resetting dates to resume the proceeding at the point at which the motion was filed. *See* 37 C.F.R.

§ 2.127(d) and, for example, *Electronics Industries Association v. Potega*, 50 USPQ2d 1775, 1776 n.4 (TTAB 1999).

The determination of Applicant's motion cannot be dispositive of this case. Accordingly, Opposer respectfully requests that the Board immediately remove the suspension and order resumption of the proceeding. Opposer also requests that, if the Board grants this motion, the Board at that time reset the discovery and trial dates at the point at which the motion to suspend was filed.

Dated: March 18, 2008

Respectfully submitted,



Stuart E. Benson  
Michael H. Selter  
MANELLI DENISON & SELTER PLLC  
2000 M Street, N.W.  
Suite 700  
Washington, D.C. 20036  
202.261.1000

Attorneys for Opposer Zanella Ltd.

CERTIFICATE OF SERVICE

I, Stuart E. Benson, hereby certify that on this 18<sup>th</sup> day of March, 2008, I caused a copy of the foregoing MOTION TO RESUME PROCEEDING to be served on counsel for Applicant by depositing same with the U.S. Postal Service, first-class postage prepaid, addressed as follows:

William O. Ferron, Jr., Esq.  
SEED IP Law Group PLLC  
701 Fifth Avenue, Suite 5400  
Seattle, Washington 98104



Stuart E. Benson