

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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

Baxley

Mailed: December 10, 2009

Opposition No. **91178747**

Mine Design a d.b.a. of Amal
Flores

v.

Votivo, Ltd. and Votivo, LLC

Before Holtzman, Cataldo and Ritchie,
Administrative Trademark Judges

By the Board:

On September 19, 2008, the Board issued an order wherein, among other things, we: (1) denied opposer's motion for summary judgment on its pleaded genericness claim; 2) denied applicant's cross-motion for summary judgment on the ground of lack of standing based on a permanent injunction that was entered against opposer, as defendant, in Case No. CV 03-6017-DT, styled *Votivo, Ltd. v. Mine Design*, by the United States District Court for the Central District of California ("the 2003 case"); and (3) *sua sponte* struck the *de jure* functionality claim set forth in paragraphs 29-32 of the notice of opposition.

The following motions are pending before the Board:
(1) applicant's motion (filed October 9, 2008) for partial reconsideration of the September 19, 2008 order solely with

Opposition No. 91178747

regard to the denial of applicant's motion for summary judgment; (2) applicant's motion (filed October 9, 2008) to suspend proceedings pending the Board's decision on its request for reconsideration and a decision by the United States District Court for the Central District of California on applicant's "application" in the 2003 case for issuance of an order to show cause why opposer should not be held in contempt;¹ (3) opposer's cross-motion (filed October 24, 2008) for partial reconsideration of the September 19, 2008 order based on the Board's striking opposer's functionality claim; and (4) applicant's motion (filed March 30, 2009) to supplement the record in connection with applicant's request for reconsideration to make of record a copy of a March 10, 2009 order ("the March 10, 2009 order") in which the district court denied applicant's motion to enforce a permanent injunction that was entered against opposer as defendant in the 2003 case.²

We turn first to opposer's motion for partial reconsideration of the Board's September 19, 2008 order striking the functionality claim. As clearly stated in that order, the involved MANDARINE mark consists entirely of

¹ This proceeding has been suspended under Trademark Rule 2.127(d) since issuance of a Board order on October 20, 2008. Accordingly, the motion to suspend is moot.

² In that order, the district court found that the parties' settlement agreement "is unambiguous in its construction and that

Opposition No. 91178747

wording, whereas only utilitarian product features can be refused registration based on *de jure* functionality. See TMEP Section 1202.02(a) (6th ed. 2009). Contrary to opposer's assertion, wording that is merely informational may be refused registration because it does not function as a mark and not because such wording is functional. See TMEP Sections 1202.04 and 1301.02(a) (6th ed. 2009). In short, and as previously noted in our September 19, 2008 order, a functionality claim simply is not available against a mark consisting solely of wording. Accordingly, the Board did not err in striking the functionality claim, and opposer's request for partial reconsideration is therefore denied.

We will now consider applicant's motion to supplement the record in connection with applicant's request for partial reconsideration. 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 findings of the Federal district court with regard to those issues are binding upon the Board. See, e.g., *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir. 1988). As such, the district court's findings with regard to the permanent injunction may inform the Board's determination regarding whether or not opposer has standing to maintain this proceeding.

[applicant] has waived any right to enforce the permanent

Opposition No. 91178747

Accordingly, the motion to supplement the record is granted to the extent that the Board will consider the March 10, 2009 order in deciding applicant's motion for partial reconsideration. Inasmuch as applicant's request for partial reconsideration has long since been fully briefed, the Board will not consider any additional legal arguments set forth in connection with the motion to supplement the record. See Trademark Rules 2.127(a) and (b); TBMP Section 518 (2d ed. rev. 2004).

As an exhibit to the motion to suspend, applicant included a copy of an "application for an order to show cause why [opposer] should not be held in contempt" that it filed on August 20, 2008 in the 2003 case ("the August 20, 2008 application"). In that application, applicant asked, among other things, that the district court: (1) issue an order requiring opposer to show cause why he should not be held in contempt based on opposer's use of the term MANDARIN in connection with candles; and (2) require opposer to withdraw this opposition.³

While the March 10, 2009 order does not indicate how the district court decided the August 20, 2008 application,

injunctive...."

³ The parties should have notified the Board immediately that the August 20, 2008 application had been filed. Such notification could have enabled the Board to consider prior to the issuance of the September 19, 2008 order whether suspension of this proceeding pending final determination of further litigation in

Opposition No. 91178747

that order indicates that applicant, on November 17, 2008, filed "a motion ... for an order to show cause why [opposer] should not be held in contempt of the permanent injunction entered in this case" ("the November 17, 2008 motion").⁴

The March 10, 2009 order further indicates that, in a December 22, 2008 order ("the December 22, 2008 order"), the district court found that the parties' settlement agreement "did not unambiguously address whether the permanent injunction remained in effect, and ordered additional briefing from the parties on this issue." However, none of the parties' briefing in connection with the November 17, 2008 motion and only applicant's brief in support of the August 20, 2008 application is of record herein. In addition, no copy of the December 22, 2008 order is in the Board file for this proceeding.

To make a full and informed decision on applicant's motion for reconsideration, applicant is hereby ordered to file with the Board within thirty days of the mailing date of this order copies of: (1) all briefing, from both parties, in support of, and in opposition to, the August 20, 2008 application and the November 17, 2008 motion that is not already in the Board file for this proceeding; and (2)

the 2003 case was appropriate under Trademark Rule 2.117(a). See TBMP Section 510.02(a) (2d ed. rev. 2004).

Opposition No. 91178747

any decisions rendered by the district court on the August 20, 2008 application and the November 17, 2008 motion that is not already in the Board file for this proceeding, including a copy of the December 22, 2008 decision.

Consideration of applicant's request for partial reconsideration is deferred pending such filing.

Proceedings herein otherwise remain suspended.

⁴ The March 10, 2009 order does not address applicant's request that the district court order the Board to dismiss this opposition.