

ESTTA Tracking number: **ESTTA256847**

Filing date: **12/22/2008**

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

Proceeding	91178927
Party	Plaintiff Royal Crown Company, Inc.
Correspondence Address	Barbara A. Solomon Fross Zelnick Lehrman & Zissu, P.C. 866 United Nations Plaza New York, NY 10017 UNITED STATES lpopp-rosenberg@fzlz.com,bsolomon@fzlz.com
Submission	Other Motions/Papers
Filer's Name	Laura Popp-Rosenberg
Filer's e-mail	lpopp-rosenberg@fzlz.com,bsolomon@fzlz.com,mortiz@fzlz.com
Signature	/Laura Popp-Rosenberg/
Date	12/22/2008
Attachments	Motion to suspend for AmBev (F0394180).PDF (9 pages)(230017 bytes)

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

-----X
ROYAL CROWN COMPANY, INC., :
 :
 : Opposition No. 91178927
 : Opposer, : Opposition No. 91180771
 : : Opposition No. 91180772
 : : Opposition No. 91183482
 - against - : Opposition No. 91185755
 : : Opposition No. 91186579
 THE COCA-COLA COMPANY, :
 :
 :
 Applicant. :
-----X

—and—

-----X
THE COCA-COLA COMPANY, :
 :
 :
 : Opposer, :
 : : Opposition No. 91184434
 - against - :
 :
 ROYAL CROWN COMPANY, INC., :
 :
 :
 Applicant. :
-----X

MOTION TO SUSPEND PROCEEDINGS

Opposer Royal Crown Company, Inc. (“RCC”), by and through its undersigned counsel, hereby moves the Board under Rule 2.117(a) of the Trademark Rules of Practice, 37 C.F.R. § 2.117(a), for an order to suspend the above referenced consolidated opposition proceedings (collectively, “Royal Crown’s Oppositions”) until a final determination has been made in opposition proceedings filed by a third party against the same applicant in connection with the same applications and on the same basis.

STATEMENT OF FACTS

A. Royal Crown's Oppositions

These seven consolidated oppositions all concern applications for marks including the term “zero” and the meaning of that term when applied to zero calorie beverages: fifteen applications filed by The Coca-Cola Company (“TCCC”) and two applications filed by Royal Crown Company (“Royal Crown”). By Board order dated October 17, 2008, all seven proceedings were consolidated with a joint discovery and trial period. Under that order, the consolidated opposition proceedings are still in the discovery phase. Royal Crown’s trial period in its oppositions against TCCC currently is not set to open until August 1, 2009.¹

B. AmBev's Oppositions

At the same time Royal Crown and TCCC were filing oppositions against each other’s zero-inclusive marks, a third party, Companhia de Bebidas das Americas – AMBEV (“AmBev”), was filing its own series of oppositions against the very same marks of TCCC based on the same claim of descriptiveness asserted by Royal Crown in its own opposition proceedings. Nine of those oppositions (collectively, “AmBev’s Consolidated Proceedings”) were consolidated on July 17, 2008; the remaining five oppositions (collectively, “AmBev’s Non-Consolidated Oppositions”) are currently proceeding individually.²

¹ That date, of course, is subject to change, particularly as Royal Crown intends to file a motion to compel if this Motion to Suspend Proceedings is not granted, as discussed below at 4-5 and 7.

² Royal Crown’s six oppositions against TCCC cover the same applications as AmBev’s fourteen oppositions against TCCC: AmBev opposed each of TCCC’s fourteen zero-inclusive applications separately, while Royal Crown consolidated some of the applications into the same opposition. Royal Crown’s and AmBev’s oppositions proceedings against TCCC match up as follows:

<u>TCCC App. No. / Mark</u>	<u>Royal Crown Opp. No.</u>	<u>AmBev Opp. No.</u>
78580598 / COCA-COLA ZERO	91178927	91178953
78316078 / SPRITE ZERO	91180771	91180442
78664176 / COKE ZERO	91180772	91180439
77097644 / PIBB ZERO	91183482	91183467

All of the various oppositions filed by both Royal Crown and AmBev against TCCC's zero-inclusive marks involve the identical issue: the descriptiveness of the "zero" portion of TCCC's various marks as applied to zero calorie beverages.

1. The Trial Schedule in AmBev's Oppositions

AmBev's Consolidated Proceedings currently are set to proceed to trial well before Royal Crown's Consolidated Proceedings are set to proceed to trial. Under the current schedule in AmBev's Consolidated Oppositions, AmBev's trial period was set to open December 1, 2008. Prior to the opening of its trial period, however, on November 13, 2008, AmBev moved to extend the trial schedule by 45 days ("AmBev's Motion to Extend"). TCCC did not oppose that motion, but in response requested that AmBev's Consolidated and Non-Consolidated Oppositions be combined under a new trial schedule (the "Combination Schedule"). Under AmBev's unopposed Motion to Extend, the trial period in AmBev's Consolidated Oppositions would open January 15, 2009.³ Under TCCC's suggested Combination Schedule, AmBev's Consolidated and Non-

77097644 / PIBB ZERO	91183482	91183467
77175066 / COKE CHERRY ZERO	91183482	91183465
77176108 / COCA-COLA VANILLA ZERO	91183482	91183452
77176127 / CHERRY COKE ZERO	91183482	91183447
77157127 / CHERRY COCA-COLA ZERO	91183482	91183448
76674383 / COKE ZERO BOLD	91185755	91185750
76674382 / COKE ZERO ENERGY	91185755	91185739
77176099 / VANILLA COKE ZERO	91185755	91185734
78620677 / FANTA ZERO	91185755	91185755
77257653 / VANILLA COCA-COLA ZERO	91186579	91186620
77309752 / POWERADE ZERO	91185755	Not yet opposed; extension of time through 1/7/09 granted

³ AmBev's Motion to Extend specifies that the extended trial open date would be January 12, 2009, but this appears to be in error, since the original trial open date was December 1, 2009 and adding 45 days results in a new trial open date of January 15, 2009.

Consolidated Oppositions would move into the trial phase as of March 16, 2009. While AmBev has objected to TCCC's consolidation request in its reply brief in further support of its Motion to Extend, it acknowledges that at least its Consolidated Oppositions should proceed to trial beginning January 15, 2008, and notes that because any decision reached in its Consolidated Proceedings would be determinative of the issues in the Non-Consolidated Oppositions, these latter proceedings should be suspended.

Although the Board has yet to resolve AmBev's Motion to Extend, under either of the respective schedules proposed by the parties, the trial period in AmBev's Consolidation Oppositions would open well prior to the August 1, 2009 trial open date in Royal Crown's Oppositions.

2. The Motion to Compel in AmBev's Oppositions

Shortly after filing its still-pending and unopposed Motion to Extend in its Consolidated Proceedings, AmBev filed a Motion to Compel Applicant to Produce Documents and to Test Sufficiency of Applicant's Response to Opposer's Request for Admission ("Motion to Compel"). AmBev's Motion to Compel, filed December 8, 2008, is based on, *inter alia*, TCCC's failure to produce certain documents underlying TCCC's expert report. TCCC has not yet responded to the Motion to Compel, but its deadline to do so is December 28, 2008.

Just as TCCC has failed to produce to AmBev materials underlying its expert report, so too has it failed to produce those materials to Royal Crown. Royal Crown served document requests on TCCC on April 7, 2008 clearly calling for production of any expert report and all underlying materials (Popp-Rosenberg Decl. at Exh. A (Requests 8, 9, and 14-19; also page 3, definition of "Market Research"). Despite the fact that more than eight months have elapsed since TCCC received Royal Crown's discovery requests, TCCC has yet to produce a copy of the

expert report or any underlying materials to Royal Crown. (*Id.* ¶ 3.) Even after Royal Crown complained to TCCC about the lack of production by letter dated October 2, 2008 (*id.* at Exh. B) and even though counsel conferred by telephone regarding the overdue expert materials, TCCC still has not rectified its discovery failure. (*Id.* ¶¶ 3-7.) During the parties' teleconference concerning the expert materials, TCCC's attorney blithely stated that he expected Royal Crown would get a copy of the expert report from AmBev. (*Id.* ¶ 6.) During the same teleconference, TCCC's counsel represented that he would provide Royal Crown with requested materials underlying the expert report at the same time TCCC produced those materials to AmBev. (*Id.*) Not surprisingly, Royal Crown has yet to receive any expert report or survey materials from TCCC, and does not anticipate receiving such materials absent a Board order – either on AmBev's Motion to Compel already filed, or on a motion to compel that Royal Crown will file. (*Id.* ¶ 7.)

ARGUMENT

Rule 2.117(a) of the Trademark Rules of Practice provides:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in . . . another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

37 C.F.R. § 2.117(a). Here, TCCC is fighting another set of opposition proceedings – with AmBev – involving the exact same marks, the exact same set of facts and the exact same legal questions as are at issue here. As such, if AmBev is successful in proving that the “zero” portion of TCCC's zero-inclusive marks is merely descriptive, then Royal Crown's Oppositions would

be moot.⁴ In such circumstances, to allow Royal Crown's Oppositions to go forward at the same time as AmBev's Consolidated Oppositions would be a waste of the parties' and the Board's resources and could result in inconsistent determinations by the Board as to whether "zero" used in connection with zero calorie soda is merely descriptive.

The Board already has recognized on numerous occasions that it would be most expeditious for both the parties and the Board to try the issue of the descriptiveness of TCCC's zero-inclusive marks at one time rather than piecemeal. The Board has recognized and applied this principal on multiple occasions already:

- by its order of October 17, 2008 consolidating all of Royal Crown's outstanding oppositions against TCCC *and* TCCC's opposition against Royal Crown in which the descriptiveness defense is raised;
- by its order of July 17, 2008 consolidating all of AmBev's outstanding opposition proceedings against TCCC pending as of that date;
- by its order of November 17, 2008 suspending TCCC's opposition against AmBev's own zero-inclusive mark (Opposition No. 91186175) – in which AmBev asserted the defense that TCCC's zero-inclusive marks are merely descriptive – until resolution of certain of AmBev's oppositions against TCCC;⁵ and
- by its order of June 6, 2008, suspending, until resolution of the earlier-filed oppositions by AmBev and Royal Crown, Opposition No. 91181930 – an opposition in which TCCC asserted its zero-inclusive marks in alleging likelihood

⁴ Although the Royal Crown's Oppositions also include TCCC's opposition against Royal Crown's applications involving PURE ZERO, because Royal Crown has asserted the descriptiveness of TCCC's zero-inclusive marks as an affirmative defense in those oppositions, the decision in AmBev's Consolidated Oppositions will also necessarily decide those oppositions as well. TCCC's opposition against Royal Crown's PURE ZERO marks is premised on TCCC having enforceable rights in the zero portion of its zero-inclusive marks.

of confusion against Ben & Jerry's Homemade, Inc.'s CAFE ZERO mark, and in which Ben & Jerry's asserted the defense that the zero-portion of TCCC's marks is merely descriptive.⁶

The Board should continue in these consolidated proceedings its application of the principle that there should not be multiple proceedings on different schedules involving the same applicant, the same marks, the same factual issues and the same legal issues.

TCCC itself likewise has recognized that it would be most expeditious for it and the Board to focus on one proceeding at a time rather than multiple proceedings. Early on, TCCC moved to consolidate oppositions against its zero-inclusive marks filed by AmBev, Royal Crown and a third party, Mayim Tovim (Opposition No. 91177358). *See* Motion of The Coca-Cola Company to Consolidate Proceedings ("TCCC's Consolidation Motion"), *filed in* Opposition Nos. 91177358, 91178927 and 91178953. In TCCC's Consolidation Motion, TCCC argued that allowing the various oppositions filed by three separate parties to proceed piecemeal would result in "duplication of effort, loss of time and added expense." TCCC made a similar admission by not opposing the motion to suspend in Opposition No. 91181930 against Ben & Jerry's, and by not opposing its Opposition No. 91186175 against AmBev. *See* n. 5-6, *supra*. The Board should hold TCCC to its statement.

The fact that a Motion to Compel is currently pending in AmBev's Consolidated Proceedings, which pursuant to Trademark Rule of Practice 2.120(e)(2) will suspend those proceedings, should not affect Royal Crown's instant Motion to Suspend. As explained above and shown in the accompanying Popp-Rosenberg declaration, Royal Crown has the same

⁵ The Board suspended Opposition No. 91186175 on AmBev's motion. Notably, TCCC did not oppose AmBev's motion to suspend that proceeding.

⁶ The Board ordered suspension of Opposition No. 91181930 in response to applicant Ben & Jerry's motion. Notably, TCCC did not oppose that motion.

discovery issue with TCCC as AmBev concerning production of materials underlying TCCC's expert report. Royal Crown could – and will if necessary – file a similar motion to compel as AmBev has, thus likewise suspending Royal Crown's Oppositions while the discovery motion is pending. By granting the requested Motion to Suspend, the Board would save the parties and the Board the time and hassle of a duplicative motion to compel and, potentially, the need for such a motion.

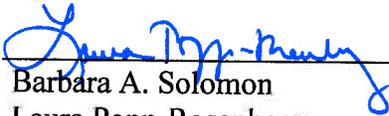
CONCLUSION

For the foregoing reasons, and in the interest of judicial economy, Opposer respectfully requests the Board to grant its Motion to Suspend Proceedings pending final resolution of AmBev's Consolidated Oppositions.

Dated: New York, New York
December 22, 2008

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By:



Barbara A. Solomon

Laura Popp-Rosenberg

866 United Nations Plaza

New York, New York 10017

(212) 813-5900

Attorneys for Opposer Royal Crown Company, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Motion to Suspend Proceedings was served by hand on Applicant's attorney, Bruce Baber, Esq., King & Spalding LLP, 1185 Avenue of the Americas, New York, NY 10036-4003, this 22nd day of December, 2008.



Laura Popp-Rosenberg