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

Proceeding	91191251
Party	Plaintiff Excelled Sheepskin & Leather Coat Corp.
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Date	03/24/2010
Attachments	RML.pdf (26 pages)(1161389 bytes)

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

EXCELLED SHEEPSKIN & LEATHER COAT CORP. :
:
Opposer :
:
v. : Opp. No. 91191251
:
RML JACKSON, LLC :
:
:
Applicant :

OPPOSER’S BRIEF IN OPPOSITION TO APPLICANT’S MOTION TO SUSPEND

Opposer Excelled Sheepskin & Leather Coat Corp (“Excelled”) hereby opposes the Motion to Suspend filed by Applicant RML Jackson, LLC (“RML”).

Excelled asks the Board to deny the motion to suspend, or at least to defer issuing a decision until the United States District Court for the Central District of California (“District Court”) rules on Excelled’s motion to stay the related pending civil action between the parties. A copy of Excelled’s motion to stay the civil action is attached hereto as Exhibit A. That motion is currently pending before the District Court, with oral argument scheduled to take place on April 12, 2010.

FACTS

Excelled has been using marks consisting of or incorporating the term ROGUE on clothing for decades and owns four federal registrations for such marks. RML claims to be wholly-owned by Relativity Media, LLC (“Relativity”), a company engaged in the entertainment business. After Relativity became aware of Excelled’s prior use of various ROGUE marks for clothing products, Relativity and some of its subsidiaries apparently decided to go into the clothing business themselves. However, the only mark incorporating that word ROGUE that

Relativity claims to own (through a subsidiary that is not a party to this action) is the alleged mark ROGUE PICTURES for entertainment services, not clothing.

Initially, Relativity asked Excelled to manufacture clothing products bearing Excelled's ROGUE marks. Subsequently, however, Relativity decided it wanted to take advantage of the goodwill symbolized by the Excelled marks and Relativity refused to take delivery of or to pay for the ROGUE products it had ordered from Excelled. When Excelled complained, Relativity retaliated by filing (through its subsidiary, RML) applications to register ROGUE alone and other marks containing the word ROGUE for clothing.

The PTO has refused to register some of marks for which Relativity / RML has applied to register (ROGUE, BABY ROGUE, and ARE YOU ROGUE?) on the ground that they are likely to cause confusion with marks owned by Excelled. The PTO also refused to register RML's application for the mark BORN ROGUE BY TED BAKER based on likely confusion with the registered mark TED BAKER owned by a British company. Notwithstanding the obvious conflict between RML's marks and the previously registered Excelled marks, RML has not abandoned any of the applications and is still attempting to overcome the refusal to register.

The PTO published for opposition RML's applications to register the marks BORN ROGUE, BORNROGUE, and ROGUE SPORTS. On July 28, 2009, Excelled initiated Opposition No. 91191251 in the TTAB challenging RML's applications to register the marks BORN ROGUE and BORNROGUE. On August 12, 2009, Excelled initiated Opposition No. 91191455 challenging RML's application to register the mark ROGUE SPORTS.

On October 27, 2009, RML filed Civil Action No. CV 09-7823 DSF, *RML Jackson, LLC v. Excelled Sheepskin & Leather Coat Corp*, (hereinafter "Civil Action"), in the United States District Court for the Central District of California seeking a declaration that only the marks

BORN ROGUE and BORNROGUE do not violate Excelled's rights in its ROGUE-based marks, even if used on clothing. This is the same issue that is under consideration before the Board in the opposition proceeding filed in July by Excelled, Opposition No. 91191251. RML made no reference in its Complaint to any of its other marks pending before the PTO. It appears that RML wishes to litigate some of the ROGUE marks in the PTO and others in court, thereby wasting judicial resources and creating the possibility of obtaining inconsistent opinions as to ROGUE, ROGUE SPORTS, ARE YOUR ROGUE, ROGUE BY TED BAKER, and other marks.

After the Civil Action was instituted, RML's Application No. 77/815556, ROGUELIFE for clothing, was published for opposition. Excelled has now filed a notice of opposition against that mark as well. It is likely that all of these oppositions filed by Excelled against the ROGUE applications can be consolidated into a single case, which would result in one decision resolving disputes as to all of the marks. On the other hand, if the civil action is not stayed the disputes will be resolved in a piece meal fashion at greater than necessary expense.

Separately, another company also has opposed RML's applications to register the marks BORN ROGUE and BORNROGUE for clothing. That company, Columbia Insurance Company (a Nebraska company) ("CIC"), claims rights in the mark BORN and initiated Opposition No. 91192707 against RML on November 18, 2009. RML is apparently content to allow the Board to decide the issue of likelihood of confusion in that case.

By filing the Civil Action, RML asked the District Court to decide a few of the same issues that are pending in the previously filed TTAB proceedings, while leaving several other issues to be decided by the Board. This unnecessarily creates a risk of inconsistent decisions and it needlessly wastes the resources of the District Court and the parties. For that reason, on

December 31, 2009, Excelled moved to stay the Civil Action pending the outcome of the proceedings in the TTAB.

ARGUMENT

The Board often will suspend proceedings in a case before it if the final determination of a civil action will have a bearing on the issues before the Board. *See* TBMP § 510.02(a). However, if the District Court “elects to suspend the civil action to await determination of the Board proceeding and the Board is so advised, the Board will go forward with its proceeding.” *Id.* As Excelled explained in its motion to stay the District Court proceeding,¹ the unique circumstances here warrant the latter result. If the court grants the motion to stay, the Board should go forward with this proceeding.

The multiple pending TTAB matters involving the numerous ROGUE clothing marks that RML allegedly intends to use should be sorted out together in the first instance by the TTAB, which is situated to resolve *all of them*. RML’s attempt to involve the District Court prematurely in deciding a small portion of the overall dispute makes no sense from the standpoint of judicial economy. The issues pending before the Board and PTO encompass multiple ROGUE marks and the Board is likely to provide broad guidance concerning all of them.

¹ The Central District Court of California has recognized that in some cases, it is appropriate and serves the core interest of efficiency to stay a federal court action pending the outcome of related TTAB proceedings. *See, e.g., Citicasters Co. v. Country Club Communications*, 44 U.S.P.Q. 2d 1223 (C.D. Cal. 1997). In *Citicasters Co.*, the Court explained that a stay was appropriate for the following reasons: “Because of the lack of demonstrable harm if a stay should be granted, and because of the efficiencies generated by the TTAB first addressing the issues involved in this matter, the court hereby stays the current proceedings. . . . [T]he court finds that any minor delay is countered by the speed at which the court will ultimately be able to decide the issues herein, after the TTAB has offered its essentially advisory opinion. There will be little in the way of new discovery and the legal issues, though not disposed of, will be clearly set out.” *Id.* at 1224; *see also Rhoades v. Avon Products, Inc.*, 504 F.3d 1151, 1165 (9th Cir. 2007) (confirming that, in deciding whether to stay declaratory judgment action pending resolution of related TTAB proceedings, “[t]he deciding factor should be efficiency [.]”).

By contrast, the Civil Action involves the narrow question whether RML's proposed use of only two of the marks (BORNROGUE and BORN ROGUE) is likely to cause confusion. Notably, any decision by the District Court would be rendered meaningless if CIC prevails in its opposition to the same marks with respect to which RML seeks declaratory relief (BORN ROGUE and BORNROGUE).

The following scenarios are just a few examples of the ways in which inefficiency and prejudice may result if the disputes proceed both in the Board and the District Court:

- The Board and the District Court could make inconsistent factual findings on the likelihood of confusion factors that must be considered in determining whether marks may co-exist in the marketplace.
- The Board and the District Court could reach inconsistent conclusions concerning whether use of the marks BORN ROGUE and BORNROGUE on clothing are likely to cause confusion.
- The District Court could find that RML acted in bad faith when adopting the various ROGUE marks and the Board may reach a different conclusion.
- The Board may find that RML committed fraud on the PTO by submitting false sworn statements in connection with its ROGUE applications and the District Court may reach the opposition conclusion.
- Regardless of this Court's decision on RML's claims for declaratory relief, the Board may refuse to allow RML to register the very marks at issue here based on arguments presented by CIC or others in separate opposition proceedings.

This last possibility carries with it an exceptional risk of inefficiency, waste of resources, and prejudice. Aside from the obvious risk of inconsistent judgments, granting this motion

would force New York-based Excelled to litigate over the marks BORN ROGUE and BORNROGUE in California, while the Board separately decides whether to refuse to register those marks based on CIC's rights. Both Excelled and RML might spend enormous resources litigating over marks that the Board may ultimately reject.

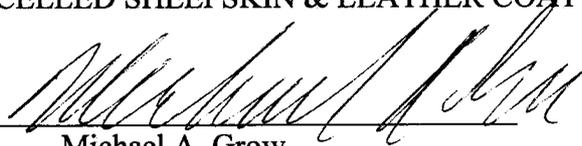
Accordingly, a suspension of this Opposition would only cause unnecessary delay and is unwarranted. Moreover, if the District Court grants Excelled's motion to stay the civil action, the Board will have no basis for suspending this proceeding.

CONCLUSION

For the foregoing reasons, RML's Motion to Suspend the instant proceeding should be denied. In any event, to promote judicial economy and to avoid the risk of inconsistent decisions concerning the suspension of this case, the Board should defer its ruling on this matter until the District Court rules on the motion to stay previously filed by Excelled.

EXCELLED SHEEPSKIN & LEATHER COAT CORP.

By



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CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing is being served upon RML's counsel by first class mail, postage prepaid, on March 24, 2010 at the address shown below

Carol A. Genis
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EXHIBIT A

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EXCELLED SHEEPSKIN &
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12 UNITED STATES DISTRICT COURT
13 CENTRAL DISTRICT OF CALIFORNIA
14 WESTERN DIVISION
15

16 **RML JACKSON, LLC,**
a California limited liability
17 company,

18 Plaintiff,

19 v.

20 **EXCELLED SHEEPSKIN &**
21 **LEATHER COAT CORP., et al.**

22 Defendant.
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Case No. CV 09-7823 DSF (CWx)

**NOTICE OF MOTION AND MOTION
TO STAY BY DEFENDANT
EXCELLED SHEEPSKIN & LEATHER
COAT CORP.**

Date: April 12, 2010
Time: 1:30 p.m.
Courtroom: 840

1 **TO ALL PARTIES TO THIS ACTION AND TO THEIR RESPECTIVE**
2 **ATTORNEYS OF RECORD:**

3 Defendant Excelled Sheepskin & Leather Coat Corp. (“Excelled”), through
4 its attorney of record, will on April 12, 2010 at 1:30 p.m., or as soon thereafter as
5 this matter may be heard in Courtroom 840 of the above-entitled court, move for an
6 order staying this action immediately pending the determination of several related
7 proceedings in the Trademark Trial and Appeal Board of the United States Patent
8 and Trademark Office, including:

- 9 • a trademark opposition initiated by Excelled to prevent the registration of the
10 very marks as to which Defendant RML Jackson, LLC’s (“RML”) seeks
11 declaratory relief here – namely, the marks BORN ROGUE and
12 BORNROGUE for clothing;
- 13 • opposition proceedings initiated by a third party against those same marks;
- 14 • a separate opposition brought by Excelled against another ROGUE-based
15 mark (ROGUE SPORTS for clothing) that RML has applied to register;
- 16 • an additional opposition likely to be initiated by Excelled as soon as the PTO
17 publishes RML’s application to register the mark ROGUELIFE.

18 The multiple opposition proceedings pending in the PTO involve a broader
19 range of issues in addition to the narrow question presented in this case. Thus, the
20 interest in avoiding piecemeal litigation warrants staying this case.

21 A stay is warranted under these circumstances, and such action is within the
22 broad powers and discretion of this Court. *See Clinton v. Jones*, 520 U.S. 681, 706
23 (1997) (recognizing that issuing stay is proper exercise of district court’s discretion
24 as long as court takes into account the effect of delay and the stage of the
25 proceedings).

26 This motion is made following the conference of counsel pursuant to Local
27 Rule 7-3, which took place on December 7, 2009. This Motion is based on this
28 Notice of Motion and Motion, Defendant’s Memorandum of Points and Authorities

1 in Support, the accompanying Declaration of Michael A. Grow and [Proposed]
2 Order, and the complete files and records of this action.

3
4 Date: February 12, 2010

Respectfully submitted,

ARENT FOX LLP

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By: /s/ Jerrold Abeles

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JERROLD ABELES
Attorneys for Defendant
EXCELLED SHEEPSKIN &
LEATHER COAT CORP.

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LEATHER COAT CORP.

12 UNITED STATES DISTRICT COURT
13 CENTRAL DISTRICT OF CALIFORNIA
14 WESTERN DIVISION
15

16 **RML JACKSON, LLC,**
17 a California limited liability
company,

18 Plaintiff,

19 v.

20 **EXCELLED SHEEPSKIN &**
21 **LEATHER COAT CORP., et al.**

22 Defendant.
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27
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Case No. CV 09-7823 DSF (CWx)

**DEFENDANT'S MEMORANDUM OF
POINTS AND AUTHORITIES IN
SUPPORT OF MOTION TO STAY**

Date: April 12, 2010
Time: 1:30 p.m.
Courtroom 840

1 **I. INTRODUCTION**

2 Defendant Excelled Sheepskin & Leather Coat Corp. (“Excelled”) requests
3 that the Court stay this trademark action pending the outcome of several related
4 proceedings in the Trademark Trial and Appeal Board of the United States Patent
5 and Trademark Office (respectively, the “TTAB” and the “PTO”). The related
6 proceedings in question encompass (i) a trademark opposition initiated by Excelled
7 to prevent the registration of the very marks as to which Defendant RML Jackson,
8 LLC’s (“RML”) seeks declaratory relief here – namely, the marks BORN ROGUE
9 and BORNROGUE for clothing; (ii) opposition proceedings initiated by a third
10 party against those same marks; (iii) a separate opposition brought by Excelled
11 against another ROGUE-based mark (ROGUE SPORTS for clothing) that RML has
12 applied to register. Excelled will likely initiate yet another opposition as soon as
13 the PTO publishes RML’s application to register the mark ROGUELIFE.

14 Parties involved in trademark disputes sometimes agree to stay
15 administrative proceedings pending resolution of a related lawsuit, but the unique
16 circumstances here warrant the opposite result. The multiple opposition
17 proceedings pending in the TTAB involve a range of issues in addition to the
18 narrow question presented in this case. Thus, the interest in avoiding piecemeal
19 litigation warrants staying this case. RML has not yet begun using any marks
20 containing the word ROGUE. Thus, RML is asking this Court to decide the same
21 issue presently pending in one of the opposition proceedings – namely, whether any
22 *future* use of BORN ROGUE or BORNROGUE will cause confusion with
23 Excelled’s registered ROGUE marks. A stay is further justified by the fact that a
24 third party claiming rights in the mark BORN has challenged RML’s rights in
25 BORN ROGUE and BORNROGUE, the marks at issue here.

1 The key considerations relevant to a motion to stay – namely, efficiency and
2 the fair and orderly resolution of the dispute – weigh strongly in favor of granting a
3 stay. By contrast, without a stay there is a real risk of inconsistent rulings on the
4 merits and a waste of party and judicial resources. Accordingly, Excelled requests
5 that the Court exercise its discretion to stay this action pending completion of the
6 proceedings referenced above. Excelled would consent to an order requiring the
7 parties to submit periodic status reports concerning the progress of those
8 proceedings so that the Court can remain apprised and periodically reevaluate
9 whether circumstances continue to warrant the stay.

10 11 **II. STATEMENT OF THE FACTS**

12 Excelled has been using marks consisting of or incorporating the term
13 ROGUE on clothing for decades and owns four federal registrations for such marks.
14 RML claims to be wholly-owned by Relativity Media, LLC (“Relativity”), a
15 company engaged in the entertainment business. After Relativity became aware of
16 Excelled’s prior use of various ROGUE marks for clothing products, Relativity and
17 some of its subsidiaries apparently decided to go into the clothing business
18 themselves. However, the only mark incorporating that word ROGUE that
19 Relativity claims to own (through a subsidiary that is not a party to this action) is
20 the alleged mark ROGUE PICTURES for entertainment services.

21 Initially, Relativity asked Excelled to manufacture clothing products bearing
22 Excelled’s ROGUE marks. (*See* Declaration of Michael A. Grow (“Grow Dec.”) ¶
23 3). Subsequently, however, Relativity decided it wanted to take advantage of the
24 goodwill symbolized by the Excelled marks and refused to take delivery of or pay
25 for the ROGUE products it had ordered from Excelled. (*See* Grow Dec. ¶¶ 4-5.)
26 When Excelled complained, Relativity retaliated by having RML file numerous
27 applications to register ROGUE marks for clothing. *Id.*

1 The PTO has refused to register some of the applied-for marks (ROGUE,
2 BABY ROGUE, and ARE YOU ROGUE?) on the ground that they are likely to
3 cause confusion with marks owned by Excelled. (See Grow Dec. ¶ 6.) The PTO
4 also refused to register RML's application for the mark BORN ROGUE BY TED
5 BAKER based on likely confusion with the registered mark TED BAKER owned
6 by a British company. (See Grow Dec. ¶ 7.) Notwithstanding the obvious conflict
7 between RML's marks and the previously registered Excelled marks, RML has not
8 abandoned any of the applications and is still attempting to overcome the refusal to
9 register.

10 The PTO published RML's applications to register the marks BORN
11 ROGUE, BORNROGUE, and ROGUE SPORTS, thereby allowing anyone who
12 objects to those mark to file opposition proceeding. RML's application to register
13 ROGUELIFE for clothing may be published in the near future. (See Grow Dec. ¶
14 8.) On July 28, 2009, Excelled initiated opposition proceeding No. 91191251 in the
15 TTAB challenging RML's applications to register the marks BORN ROGUE and
16 BORNROGUE. On August 12, 2009, Excelled initiated opposition proceeding No.
17 91191455 challenging RML's application to register the mark ROGUE SPORTS.
18 (See Grow Dec. ¶ 9.) If any of RML's other applications for ROGUE marks are
19 published, Excelled will oppose them as well. And it is likely that all of these
20 TTAB proceedings can be consolidated into a case, which would result in one
21 decision addressing all of the marks.

22 On October 27, 2009, RML filed this lawsuit seeking a declaration that only
23 the marks BORN ROGUE and BORNROGUE do not violate Excelled's rights in
24 its ROGUE-based marks, even if used on clothing. This is the same issue that is
25 under consideration before the TTAB in the Opposition proceeding filed in July by
26 Excelled. RML made no reference in its Complaint to any of its other marks
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28

1 pending before the PTO and it appears content to have the TTAB proceed with a
2 decision as to the mark ROGUE SPORTS and the other marks.

3 Separately, another company has also opposed RML's applications to
4 register the marks BORN ROGUE and BORNROGUE for clothing. That
5 company, Columbia Insurance Company (a Nebraska company) ("CIC"), claims
6 rights in the mark BORN and initiated a TTAB proceedings (Opposition No.
7 91192707) against RML on November 18, 2009. (See Grow Dec. ¶ 10.) RML
8 made no mention of that company in its Complaint and it apparently intends to
9 allow the TTAB to decide the issue of likelihood of confusion in that case as well.

10 The Excelled and CIC TTAB oppositions are currently set to proceed along
11 similar schedules, which suggests that the discovery deadlines, dispositive motions,
12 and trials (if necessary) in the separate proceedings may occur at or about the same
13 time. (See Grow Dec. ¶ 11.) By filing this civil action, RML is asking this Court to
14 decide only some of the same issues that are pending in the previously filed TTAB,
15 thereby creating a risk of inconsistent decisions and needlessly wasting the
16 resources of the Court and the parties.

17 18 **III. ARGUMENT**

19 **A. Applicable Legal Principles**

20 The Ninth Circuit has explained that "[a] trial court may, with propriety, find
21 it is efficient for its own docket and the fairest course for the parties to enter a stay
22 of an action before it, pending resolution of independent proceedings which bear
23 upon the case. This rule applies whether the separate proceedings are judicial,
24 administrative, or arbitral in character, and does not require that the issues in such
25 proceedings are necessarily controlling of the action before the court." *Leyva v.*
26 *Certified Grocers of Cal. Ltd.*, 593 F.2d 857, 863-64 (9th Cir. 1979) (court may
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1 issue stay in variety of circumstances based on efficiency and fairness to the
2 parties) (citing *Kerotest Mfg. Co. v. C-O Two Fire Equip. Co.*, 342 U.S. 180
3 (1952)); *see also Landis v. North American Co.*, 299 U.S. 248 (1936).

4 These cases recognize the district court's power and broad discretion in
5 controlling its own docket and calendar, and in providing for a just determination of
6 cases pending before it. *See id.*; *Clinton v. Jones*, 520 U.S. 681, 706 (1997)
7 (recognizing that issuing stay is proper exercise of district court's discretion as long
8 as court takes into account the effect of delay and the stage of the proceedings);
9 *Agcaoili v. Gustafson*, 844 F.2d 620, 624 (9th Cir. 1988), *rev'd on other grounds*
10 870 F.2d 462 (9th Cir. 1989).

11 This Court has recognized that in some cases, it is appropriate and serves the
12 core interest of efficiency to stay a federal court action pending the outcome of
13 related TTAB proceedings. *See, e.g., Citicasters Co. v. Country Club*
14 *Communications*, 44 U.S.P.Q. 2d 1223 (C.D. Cal. 1997). In *Citicasters Co.*, the
15 Court explained that a stay was appropriate for the following reasons: "Because of
16 the lack of demonstrable harm if a stay should be granted, and because of the
17 efficiencies generated by the TTAB first addressing the issues involved in this
18 matter, the court hereby stays the current proceedings. . . . [T]he court finds that
19 any minor delay is countered by the speed at which the court will ultimately be able
20 to decide the issues herein, after the TTAB has offered its essentially advisory
21 opinion. There will be little in the way of new discovery and the legal issues,
22 though not disposed of, will be clearly set out." *Id.* at 1224; *see also Rhoades v.*
23 *Avon Products, Inc.*, 504 F.3d 1151, 1165 (9th Cir. 2007) (confirming that, in
24 deciding whether to stay declaratory judgment action pending resolution of related
25 TTAB proceedings, "[t]he deciding factor should be efficiency[.]").

1 **B. The Court Should Order a Stay In This Case**

2 Granting a stay is fully justified by the unique circumstances of this case.
3 The multiple pending TTAB matters involving the numerous ROGUE clothing
4 marks that RML allegedly intends to use should be sorted out together in the first
5 instance in the TTAB, which is situated to entertain *all of them*. RML's attempt to
6 involve this Court pre-maturely in deciding a small portion of the overall dispute
7 makes no sense from the standpoint of judicial economy. The issues pending
8 before the TTAB and PTO encompass multiple ROGUE marks and the TTAB is
9 likely to provide broad guidance concerning all of them.

10 By contrast, this case involves the narrow question whether RML's proposed
11 use of only two of the ROGUE marks is likely to cause confusion. Notably, any
12 decision by this Court would be rendered meaningless if CIC prevails in its
13 challenge to the same marks with respect to which RML seeks declaratory relief
14 here (BORN ROGUE and BORNROGUE).

15 The following scenarios are just a few examples of the ways in which
16 inefficiency and prejudice may result if the disputes proceed both in this Court and
17 the TTAB:

- 18 • This Court and the TTAB could make inconsistent factual findings on the
19 likelihood of confusion factors that must be considered in determining
20 whether marks may co-exist in the marketplace.
21 • This Court and the TTAB could reach inconsistent conclusions concerning
22 whether use of the marks BORN ROGUE and BORNROGUE on clothing
23 are likely to cause confusion.
24 • This Court could find that RML acted in bad faith when adopting the various
25 ROGUE marks and the TTAB may reach a different conclusion.

- 1 • The TTAB may find that RML committed fraud on the PTO by submitting
2 false sworn statements in connection with its ROGUE applications and this
3 Court may reach the opposition conclusion.
- 4 • Regardless of this Court's decision on RML's claims for declaratory relief,
5 the TTAB may refuse to allow RML to register the very marks at issue here
6 based on arguments presented by CIC or others in separate opposition
7 proceedings.

8 This last possibility carries with it an exceptional risk of inefficiency, waste
9 of resources, and prejudice. Aside from the obvious risk of inconsistent judgments,
10 a denial of this motion would force New York-based Excelled to litigate over the
11 marks BORN ROGUE and BORNROGUE in California, while the TTAB
12 separately decides whether to refuse to register those marks based on CIC's rights.
13 Both Excelled and RML might spend enormous resources litigating over marks that
14 the TTAB may ultimately reject.

15 To properly exercise its discretion here, the Court should take into account
16 the stage of the proceedings and the potential for delay. Neither consideration
17 outweighs the benefits to be gained from issuing a stay. This civil action is in its
18 infancy as Excelled has not yet even answered. The TTAB proceedings have been
19 pending longer and answers have been filed in each of those proceedings. If a stay
20 is granted, there is little risk of delaying the ultimate determination as to all of the
21 marks at issue. To the contrary, a stay will likely expedite a complete decision by
22 precluding piecemeal litigation. Moreover, the Court can issue orders requiring
23 updates from the parties concerning the status of the TTAB proceedings and, as
24 appropriate, modify or lift a stay order as circumstances evolve. *See, e.g., Wrenn v.*
25 *Boy Scouts of America*, No. C 03-04057, 2007 WL 2727146, at *1 (N.D. Cal. Sept.
26 17, 2007) (lifting early-imposed stay after decision by TTAB was delayed).¹

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28 ¹ Excelled cites to this unpublished decision for persuasive, rather than precedential,
purposes.

1 An order staying the case will therefore promote a coherent, streamlined, and
2 complete determination of all of trademark disputes between the parties. As in
3 *Citicasters Co.*, allowing the TTAB to make initial determinations of whether
4 RML's BORN ROGUE, BORNROGUE, ROGUE SPORT, and other ROGUE
5 marks are likely to cause confusion in view of Excelled's and CIC's prior existing
6 rights will facilitate the most prompt and efficient decision on the merits. 44
7 U.S.P.Q. 2d at 1165, 1224 ("There will be little in the way of new discovery and
8 the legal issues, though not disposed of, will be clearly set out.").

9
10 **IV. CONCLUSION**

11 For the foregoing reasons, Excelled respectfully requests that the Court issue
12 an order staying this action pending resolution of the related TTAB proceedings
13 referenced above.

14
15 Date: February 12, 2010

Respectfully submitted,

ARENT FOX LLP

16
17 By: /s/ Jerrold Abeles

18 JERROLD ABELES
19 Attorneys for Defendant
20 EXCELLED SHEEPSKIN &
LEATHER COAT CORP.

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11 EXCELLED SHEEPSKIN &
LEATHER COAT CORP.

12 UNITED STATES DISTRICT COURT
13 CENTRAL DISTRICT OF CALIFORNIA
14 WESTERN DIVISION
15

16 RML JACKSON, LLC,
a California limited liability
17 company,

18 Plaintiff,

19 v.

20 EXCELLED SHEEPSKIN &
21 LEATHER COAT CORP., et al.

22 Defendant.
23

Case No. CV 09-7823 DSF (CWx)

DECLARATION OF MICHAEL A.
GROW IN SUPPORT OF
DEFENDANT'S MOTION TO STAY

Date: April 12, 2010
Time: 1:30 p.m.
Courtroom 840

1 records of the PTO at <http://www.uspto.gov/trademarks/index.jsp>.

2 6. According to these public records, the PTO has refused to register
3 some of RML's applied-for marks (ROGUE, BABY ROGUE, and ARE YOU
4 ROGUE?) on the ground that they are likely to cause confusion with marks owned
5 by Excelled.

6 7. According to the same records, the PTO also refused to register
7 RML's application for the mark BORN ROGUE BY TED BAKER based on likely
8 confusion with the registered mark TED BAKER owned by a British company.

9 8. The PTO records show that RML's applications to register the marks
10 BORN ROGUE, BORNROGUE, and ROGUE SPORTS were published for
11 opposition and that RML's application to register ROGUELIFE for clothing may
12 be published in the near future.

13 9. On July 28, 2009, Excelled initiated opposition proceeding No.
14 91191251 before the Trademark Trial and Appeal Board ("TTAB") challenging
15 RML's applications to register the marks BORN ROGUE and BORNROGUE. On
16 August 12, 2009, Excelled initiated opposition proceeding No. 91191455
17 challenging RML's application to register the mark ROGUE SPORTS. Excelled
18 intends to oppose RML's application to register the mark ROGUELIFE as soon as
19 the PTO publishes it. Information relating to these oppositions may be found by
20 searching and reviewing the public records of the TTAB's website which may be
21 found at <http://ttabvue.uspto.gov/ttabvue/v?pno=91191251&pty=OPP> and at
22 <http://ttabvue.uspto.gov/ttabvue/v?pno=91191455&pty=OPP>.

23 10. Separately, another company has also opposed RML's applications to
24 register the marks BORN ROGUE and BORNROGUE for clothing. See
25 <http://ttabvue.uspto.gov/ttabvue/v?pno=91192707&pty=OPP>. The PTO records
26 show that this company, Columbia Insurance Company ("CIC"), claims rights in
27 the mark BORN for footwear and initiated its TTAB proceeding (Opposition No.
28 91192707) against RML on November 18, 2009. *Id.*

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Case No. CV 09-7823 DSF (CWx)

[PROPOSED]
ORDER GRANTING DEFENDANT'S
MOTION TO STAY

[PROPOSED] ORDER

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This Court has considered Defendant Excelled Sheepskin & Leather Coat Corp.'s ("Excelled") Motion to Stay, Memorandum of Points and Authorities in Support and Declaration of Michael A. Grow, Plaintiff's argument and evidence in opposition, and oral argument.

The Court finds that there is good cause supporting the Motion and therefore GRANTS the same.

It is hereby ORDERED that this action is stayed pending resolution of the related proceedings pending in the Trademark Trial and Appeal Board of the United States Patent and Trademark Officer referenced in the parties' moving papers. Counsel for Excelled shall prepare and file a report on or before September 1, 2010, regarding the status of the related proceedings before the Trademark Trial and Appeal Board of the United States Patent and Trademark Office so the Court can decide whether to lift the stay.

IT IS SO ORDERED.

Dated: _____

The Honorable Dale S. Fischer
Judge of the United States District Court