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

Proceeding	91191251
Party	Defendant RML Jackson, LLC
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Date	04/13/2010
Attachments	RML JACKSON LLC REPLY.pdf (9 pages)(375090 bytes)

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

In the Matter of Application Serial Nos. 77/713,053 and 77/713,054
Filed: April 13, 2009
For the Marks: BORN ROGUE and BORNROGUE in International Class 25
Published in the Official Gazette: July 21, 2009

Excelled Sheepskin & Leather Coat Corp., Opposer, vs. RML Jackson, LLC, Applicant.	Opposition No. 91191251

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

REPLY IN SUPPORT OF RML JACKSON, LLC'S MOTION TO SUSPEND PROCEEDING PENDING OUTCOME OF CIVIL ACTION

Applicant RML Jackson, LLC ("RML" or "Applicant"), by its undersigned counsel, K&L Gates LLP, respectfully submits this reply to Opposer's Brief in Opposition to Applicant's Motion to Suspend.

In support of its reply, Registrant states as follows:

I.
REMARKS

In its response brief, Opposer states that it filed a Motion to Stay the Civil Action with the United States District Court, Central District of California, Los Angeles ("District Court") in *RML Jackson LLC v. Excelled Sheepskin & Leather Coat Corporation et al,* No. CV 09 07823 DSF (CWx) (the "Civil Action"). However, on April 7, 2010, the District Court expressly **denied** Opposer's Motion to Stay the Civil Action. A copy of the Order denying Opposer's

Motion is attached hereto as Exhibit A. Thus, the District Court has agreed with Applicant that the Civil Action is the appropriate forum to litigate the parties' dispute regarding Applicant's rights to the BORN ROGUE and BORNROGUE marks.

Indeed, as set forth in the Order, Opposer's Motion to Stay was denied because "though it may be somewhat useful to have TTAB findings on point, few issues would likely be resolved by the TTAB proceedings because many of the issues are subject to relitigation in this Court with the TTAB findings being given no deference." *See* Exhibit A at pg. 3. As a result, having the Board commit further judicial resources to the subject proceeding is a waste of the Board's limited time and resources.

Moreover, Opposer does not dispute that the Civil Action will have a bearing on the subject opposition proceeding, as evidenced by the Opposer's assertion that the "same issue" is under consideration in both proceedings. Instead, Opposer objects to the Civil Action determining the outcome of the BORN ROGUE / BORNROGUE marks, because allowing the Board to decide issues relating to ***other marks***, namely ROGUE, ROGUE SPORTS, ARE YOU ROGUE and ROGUE BY TED BAKER, will result in inconsistent decisions and wasting of judicial resources.

Opposer's argument is predicated on the fact that the Board will provide "broad guidance" concerning all of Applicant's marks, however such an assertion has no basis in fact or law. As a preliminary matter, Opposer has not moved for consolidation of these proceedings with any other proceeding, and thus, Opposer has no factual basis for its assertion that the Board will be able to provide consistent and "broad guidance" regarding Applicant's marks. Furthermore, as a matter of law, each case is decided on a case-by-case basis. *See Envirotech Corp. v. Solaron Corp.*, 211 U.S.P.Q. 724 (TTAB 1981)(denying consolidation of opposition

proceedings as possibly prejudicial to defendant where defendant's involved marks were not all the same, and also stating that "[i]t is an 'established principle in trademark matters that each case has its own particular personality dictated by the marks and goods of the parties.'"). Applicant's BORN ROGUE and BORNROGUE marks are not the same as its ROGUE, ROGUE SPORTS or any of the other marks referenced by Opposer. Indeed, Applicant would object to any consolidation of the subject proceeding with any other proceeding given the difference in commercial impression of the wording BORN ROGUE and BORNROGUE from the wording ROGUE alone or other ROGUE-formative marks, on the basis that prejudice would result from consolidation of the proceeding due to Applicant's disadvantage with respect to proving alleged lack of similarity with Opposer's mark based on differences between the various marks if the oppositions were consolidated. *See Envirotech Corp.*, 211 U.S.P.Q. at 724. Finally, even if a single decision was rendered regarding all of Applicant's marks, the Board would still obliged to evaluate *each* mark on its own terms and thus, by law, could not provide "broad guidance" regarding Applicant's various marks. *See id.*

Because the outcome of the Civil Action will have a bearing on the subject opposition proceeding (a point that is uncontested by Opposer) and in light of the Civil Action's denial of Opposer's Motion to Stay the Civil Action, suspension of the subject opposition proceeding is appropriate.

II.
CONCLUSION

WHEREFORE, for the reasons stated herein, Applicant respectfully requests that its Motion for the Board to suspend the above-captioned opposition proceeding pending the disposition of the Civil Action be granted.

Dated: April 13, 2010.

RML JACKSON, LLC
Applicant

By: _____
One of Its Attorneys

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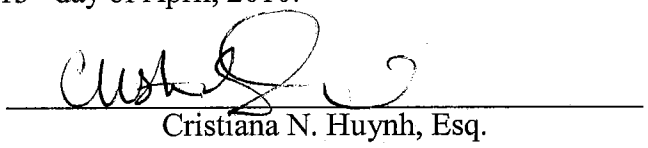
CERTIFICATE OF SERVICE

The undersigned, an attorney, hereby certifies that she caused a copy of RML Jackson, LLC's **REPLY IN SUPPORT OF RML JACKSON, LLC'S MOTION TO SUSPEND PROCEEDING PENDING OUTCOME OF CIVIL ACTION** to be served upon:

Michael A. Grow, Esq.
Arent Fox LLP
1050 Connecticut Avenue, NW
Washington, DC 20036

by first class mail, proper postage prepaid, this 13th day of April, 2010.



Cristiana N. Huynh, Esq.

EXHIBIT A

EXCELLED SHEEPSKIN & LEATHER COAT CORP. V. RML JACKSON, LLC
Opposition No. 91191251
On behalf of RML Jackson, LLC

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

MEMORANDUM

Case No.	CV 09-7823 DSF (CWx)	Date	4/7/10
Title	RML Jackson, LLC v. Excelled Sheepskin & Leather Coat Corporation, et al.		

Present: The Honorable	DALE S. FISCHER, United States District Judge
Debra Plato	Not Present
Deputy Clerk	Court Reporter
Attorneys Present for Plaintiffs:	Attorneys Present for Defendants:
Not Present	Not Present

Proceedings: (In Chambers) Order DENYING Motion to Stay (Docket No. 28)

Defendant Excelled Sheepskin & Leather Coat Corporation has moved to stay this case pending the outcome of several proceedings before the Trademark Trial and Appeal Board ("TTAB") involving the trademarks at issue in this case and other related trademarks. The Court deems this matter appropriate for decision without oral argument. See Fed. R. Civ. P. 78; Local Rule 7-15. The hearing set for April 12, 2010, is removed from the Court's calendar.

The Ninth Circuit has made clear that stays of trademark infringement cases to await the result of TTAB proceedings are disfavored.

> We agree with the Second Circuit that some situations might justify deferring a declaratory judgment case when related TTAB proceedings are pending; specifically, where the "district court action involves only the issue of whether a mark is entitled to registration," it might make more sense to resolve the registration claims at the TTAB first. On the other hand, if, as here, a potential infringement claim "requires the district court to resolve much or all of [the registration issues], it would waste everyone's time not to settle the registration issue now[, in district court]."

Rhoades v. Avon Prod. Inc., 504 F.3d 1151, 1165 (9th Cir. 2007) (quoting Goya Foods, Inc. v. Tropicana Prod., Inc., 846 F.2d 848, 853-84 (2d Cir. 1988) and PHC v. Pioneer Healthcare, 75 F.3d 75, 81 (1st Cir. 1996)) (emphasis added; brackets in original).

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Rhoades holds that "[t]he deciding factor should be efficiency; the district court should exercise jurisdiction if this course is more efficient; otherwise, not." Id. (internal quotation marks omitted). However, the discussion of the relative strengths of district court actions and TTAB actions shows that allowing a district court action to proceed is almost always more efficient than a stay. See generally Rhoades, 504 F.3d at 1162-65.

While stays are not necessarily strictly restricted to cases where only registration is at issue, a proper candidate for a stay has limited issues beyond the registration issues handled by the TTAB such that resolution of the registration issue would, as a practical matter, largely determine the outcome of the district court litigation. The issues here involve infringement, not only registration, and Rhoades directly indicates that such actions should not be stayed to wait for the TTAB:

> [W]here . . . a district court suit concerns infringement, the interest in prompt adjudication far outweighs the value of having the views of the PTO. Whether a litigant is seeking to halt an alleged infringement or, as in this case, seeking a declaration of non-infringement, it is entitled to have the infringement issue resolved promptly so that it may conduct its business affairs in accordance with the court's determination of its rights.

Rhoades, 504 F.3d at 1163 (quoting Goya Foods, 846 F.2d at 853-54).

Defendant presents no compelling argument that would distinguish this case from Rhoades or Goya Foods. Plaintiff seeks a declaration of non-infringement of Defendant's marks. It may be true that the resolution of the TTAB proceedings in favor of Defendant would make it unlikely that Plaintiff would proceed with use of the marks at issue. But this is probably true in most cases with parallel district court and TTAB proceedings. Nonetheless, Rhoades, following Goya Foods and PHC, approves of stays only in narrow circumstances that are not met here.

Plaintiff suggests that the test set out in Lockyer v. Mirant Corp., 398 F.3d 1098 (9th Cir. 2005), should apply to the motion for a stay. Even if the cases were somehow inconsistent, the Court believes that Rhoades governs the limited circumstance of stay requests related to pending TTAB proceedings. In any event, if the Court were to apply the Lockyer test, a stay would still be denied.

> Where it is proposed that a pending proceeding be stayed, the competing interests which will be affected by the granting or refusal to grant a stay must be weighed. Among those competing interests are the possible damage which may result from the granting of a stay, the hardship or inequity which a party

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> may suffer in being required to go forward, and the orderly course of justice measured in terms of the simplifying or complicating of issues, proof, and questions of law which could be expected to result from a stay.

Lockyer, 398 F.3d at 1110 (quoting CMAX, Inc. v. Hall, 300 F.2d 265, 268 (9th Cir. 1962).

As stated in Rhoades and Goya Foods, Plaintiff will suffer harm if forced to stay its declaratory relief action because a stay defeats the entire point of declaratory relief – to relieve the declaratory relief plaintiff from the threat of litigation. TTAB proceedings only determine the registration of marks; they do not prevent a party with a registered mark from being sued for infringement stemming from the use of the registered mark. See Rhoades, 504 F.3d at 1163-64. Therefore, even if Plaintiff were to prevail before the TTAB, it would still potentially require resolution of this suit to determine its rights vis-à-vis Defendant.

"[I]f there is even a fair possibility that the stay will work damage to some one else, the party seeking the stay must make out a clear case of hardship or inequity." Lockyer, 398 F.3d at 1112 (quoting Landis v. North Am. Co., 299 U.S. 248, 255 (1936)) (internal quotation marks omitted). Defendant has not made its case. It only raises the insufficient argument that it would be prejudiced by being forced to defend this suit. See id. at 1112 ("[B]eing required to defend a suit, without more, does not constitute a 'clear case of hardship or inequity.'")

Finally, though it may be somewhat useful to have TTAB findings on point, few issues would likely be resolved by the TTAB proceedings because many of the issues are subject to relitigation in this Court with the TTAB findings being given no deference. See Rhoades, 504 F.3d at 1163-64.

The motion to stay is DENIED.

IT IS SO ORDERED.