

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

MBA

Opposition No. 91198102
Wildfire Interactive, Inc.
v.
Mobilization Labs, LLC

Opposition No. 91198576
Mobilization Labs, LLC
v.
Wildfire Interactive, Inc.

Michael B. Adlin, Interlocutory Attorney:

These cases now come up for consideration of opposer/applicant Wildfire Interactive, Inc.'s ("opposer") motions, filed February 22, 2011 in Opposition No. 91198576 and February 23, 2011 in Opposition No. 91198102, to suspend both proceedings pending final determination of a federal trademark infringement action between the parties, and applicant/opposer Mobilization Labs, LLC's ("applicant") cross-motion for summary judgment in Opposition No. 91198102, filed March 14, 2011. Opposer's motion to suspend in Opposition No. 91198576 is uncontested. Applicant's cross-motion for summary judgment includes applicant's

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opposition to opposer's motion to suspend in Opposition No. 91198102.¹

Background

Applicant seeks registration of WILDFIRE, in standard characters, for computer services,² and in Opposition No. 91198102, opposer alleges use of an identical mark for computer services, ownership of applications to register the mark³ which may be refused based on applicant's involved application and that applicant's involved mark "was not in use in commerce in connection with all the services listed" as of the filing date of the involved use-based application. In its answer, applicant denies the salient allegations in the notice of opposition. In Opposition No. 91198576, applicant is the opposer, and therein is challenging one of opposer's applications pleaded in Opposition No. 91198102,⁴ alleging priority of use and likelihood of confusion. Opposer has not yet filed an answer in Opposition No. 91198576.

The parties are also involved in a federal trademark infringement action, in which applicant is the plaintiff: Mobilization Labs, LLC v. Wildfire Interactive, Inc., Case 1:10-cv-03043-TWT, pending in the U.S. District Court for

¹ Opposer's change of address (filed February 14, 2011 in Opposition No. 91198576) is noted and made of record.

² Application Serial No. 77921906.

³ Application Serial Nos. 77926726 and 77979726.

⁴ Application Serial No. 77926726.

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the Northern District of Georgia (the "Federal Case"). Applicant filed the Federal Case months prior to the commencement of either of these opposition proceedings.

In its First Amended Complaint in the Federal Case, applicant alleges prior use of WILDFIRE, that use of opposer's mark is likely to cause confusion with applicant's mark, unfair competition, trademark infringement and deceptive trade practices. In addition, and more importantly for purposes of the pending motions, in Count Five of the First Amended Complaint, applicant alleges priority of use and likelihood of confusion, and prays that the Court issue "an order to the [Board] canceling [opposer's pleaded] applications." Discovery in the Federal Case is ongoing.

Consolidation

Before addressing the parties' motions, it is clear that Opposition Nos. 91198102 and 91198576 involve the same parties, similar marks, and common questions of law and fact. It is therefore appropriate to consolidate these proceedings pursuant to Fed. R. Civ. P. 42(a).

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. See, e.g., Wright & Miller, Federal Practice and Procedure: Civil §2383 (2004); Regatta

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Sport Ltd. v. Telux-Pioneer Inc., 20 USPQ2d 1154 (TTAB 1991)
(Board's initiative).

Accordingly, the above-referenced opposition proceedings are hereby consolidated and may be presented on the same record and briefs. See Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618 (TTAB 1989), and Hilson Research Inc. v. Society for Human Resource Management, 26 USPQ2d 1432 (TTAB 1993). These proceedings shall be scheduled in the same manner as an opposition proceeding with a counterclaim.

The Board file will be maintained in **Opposition No. 91198102** as the "parent" case. The parties should no longer file separate papers (except for the answer in Opposition No. 91198576) in connection with each proceeding. Instead, only a single copy of each paper should be filed by the parties in the parent case, and each paper should bear the case caption as set forth above.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

If the parties to these proceedings are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, become parties to such

proceedings, they should notify the Board immediately, so that the Board can consider further consolidation of proceedings.

Applicant's Cross-Motion for Summary Judgment

Applicant's cross-motion for summary judgment is premature. Trademark Rule 2.127(e)(1) ("A party may not file a motion for summary judgment until the party has made its initial disclosures ..."). It will therefore be given no consideration.⁵

Opposer's Motions to Suspend

Opposer argues that the Federal Case will "dispose entirely of the issues raised" in these proceedings, including because there, as here, priority is an issue. Opposer further argues that "[r]equiring the parties to litigate these issues in two forums simultaneously is a waste of the parties' time and resources and a needless imposition on the Board."

In its cross-motion, applicant argues that the Board should decide applicant's cross-motion for summary judgment prior to opposer's motion for suspension. Applicant does

⁵ In any event, it appears that the cross-motion is unsupported by any competent, admissible evidence, as the exhibits to the cross-motion are unauthenticated and the statements in applicant's involved application are not evidence. See e.g., Trademark Rule 2.122(b)(2) ("The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant ..."); Paris Glove of Canada Ltd. v. SBC/Sporto Corp., 84 USPQ2d 1856, 1858 (TTAB 2007) (Internet Archive "is not self-authenticating and there is no reason to treat its existence as authenticating the pages in its historical record").

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not deny, however, that the Federal Case may have a bearing on this one.

As a preliminary matter, even if applicant's cross-motion for summary judgment was not premature, which it is, and was supported by evidence, which it is not, it would be inappropriate to consider it prior to opposer's earlier-filed motion to suspend. TBMP § 510.02(a) (2d ed. rev. 2004) ("If there is pending, at the time when the question of suspension of proceedings before the Board is raised, a motion which is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered.") (emphasis supplied). Here, applicant filed its cross-motion after opposer filed its motions to suspend.

In any event, the Board's well-settled policy is to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case. Trademark Rule 2.117(a); General Motors Corp. v. Cadillac Club Fashions Inc., 22 USPQ2d 1933, 1937 (TTAB 1992). Here, there is no dispute that the Federal Case may at least have a bearing on these proceedings. Nor could there be, as the relief applicant seeks as plaintiff in the Federal Case includes the relief applicant seeks as opposer in Opposition No. 91198576. Furthermore, in the Federal Case, as here, priority of use is at issue, and it seems

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likely, if not inevitable, that the Federal Case will decide whether applicant was using its mark, and if so for which goods or services, as of the filing date of its involved application. And in the Federal Case, as here, likelihood of confusion is at issue. As a result, suspension is appropriate.

Suspension is particularly appropriate here, because discovery is already underway in the Federal Case, and the decision in the Federal Case may be "binding upon the Board, while the decision of the Board is not binding upon the court." TBMP § 510.02(a) (2d ed. rev. 2004); see also, The Other Telephone Co. v. Connecticut National Telephone Co., Inc., 181 USPQ 779 (Comr. 1974); Whopper-Burger, Inc. v. Burger King Corp., 171 USPQ 805 (TTAB 1971). Quite simply, having initiated this litigation, and having chosen to litigate in federal court, applicant cannot fairly complain about having to pursue its claims in its chosen forum, prior to litigating partially duplicative claims in another forum.

For all of these reasons, suspension is appropriate and opposer's motion to suspend is hereby **GRANTED**.⁶ Proceedings herein are suspended pending final disposition of the Federal Case. Within twenty days after the final determination of the Federal Case, the parties shall so

⁶ Furthermore, opposer's motion to suspend in Opposition No. 91198576 would and could be granted as conceded, because applicant failed to respond thereto. Trademark Rule 2.127(a).

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notify the Board and call this case up for any appropriate action. During the suspension period the Board shall be notified of any address changes for the parties or their attorneys.
