

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

Mailed: July 5, 2012

Opposition Nos. 91199706 (parent)
91201702
91204185

R.J. Reynolds Tobacco Company

v.

Lorillard Licensing Company, LLC

**Robert H. Coggins,
Interlocutory Attorney:**

Pending before the Board in Opposition No. 91204185 are (1) opposer's combined motion to consolidate and suspend, filed May 21, 2012; (2) applicant's motion for summary judgment, filed May 22, 2012; (3) applicant's motion for an extension of time to file a brief in opposition to the motion to consolidate and suspend, filed June 11, 2012; (4) and opposer's motion for an extension of time to file a brief in opposition to the motion for summary judgment.

Applicant's Motion to Extend

Applicant's consented motion to extend time to file a brief in opposition to the motion to consolidate and suspend

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is granted. In view thereof, applicant's brief (filed June 18, 2012) is noted.

Motion to Consolidate and Suspend

By way of its motion, opposer moves to consolidate Opposition No. 91204185 with Opposition No. 91199706 (which is the parent case of, and has been previously consolidated with, Opposition No. 91201702; and which is currently suspended pending disposition of a civil action between the parties), and to suspend proceedings pending determination of the motion. In response to the motion, applicant argues that Opposition Nos. 91199706 and 91204185 differ materially in that opposer lacks standing in Opposition No. 91204185, applicant has moved for summary judgment in Opposition No. 91204185 on that issue, and the only appropriate suspension would be for the motion for summary judgment.

The Board has reviewed the pleadings in Opposition Nos. 91199706 and 91204185 and has determined that these cases involve the same parties, similar marks, related goods and services, and similar legal issues. The Board notes that the settlement agreement which is the basis for the motion for summary judgment in Opposition No. 91204185 is at issue in the civil action between the parties. On that point, applicant argues that the portion of the agreement on which it relies for summary judgment in Opposition No. 91204185 is not at issue in the civil action; however, the Board notes

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that (1) it was applicant itself who moved to suspend Opposition No. 91199706, (2) in support of suspension in Opposition No. 91199706, applicant stated that the civil action involves the scope of opposer's rights to use the term "pleasure" and whether "pleasure" is descriptive for tobacco products, (3) in support of suspension in Opposition No. 91199706, applicant stated that opposer had made various allegations in the notice of opposition for Opposition No. 91199706, particularly in paragraphs 10, 15, and 20, (4) opposer has made similar allegations in the notice of opposition for Opposition No. 91204185 at paragraphs 10, 15, and 20 therein, and (5) paragraphs 17 and 18 of applicant's civil action complaint, and paragraphs 20, 21, and 22 of opposer's civil action counterclaim, recite the very portion of the settlement agreement upon which applicant relies (and emphasizes) in the motion for summary judgment.

In view of the similarities between Opposition Nos. 91199706 and 91204185, and the reliance on the settlement agreement which is at issue in the civil action between the parties, it is appropriate to consolidate Opposition Nos. 91199706 and 91204185 and to bring Opposition No. 91204185 under the suspension which is in effect pending final determination of the civil action between the parties. See TBMP § 511 (3d ed. rev. 2012). Accordingly, opposer's motion is granted to the extent that proceedings are consolidated.

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The Board file will be maintained in Opposition No. 91199706 as the "parent" case. The parties should no longer file separate papers in connection with each proceeding. Only a single copy of each paper should be filed by the parties and each paper should bear all proceeding numbers in the caption shown hereinabove.

To the extent the motion to consolidate seeks to suspend proceedings as of the date the motion to compel was filed, the motion is denied; however, as noted above, the consolidated cases are now suspended pending disposition of the civil action between the parties.

Motion for Summary Judgment

Proceedings are also suspended pending disposition of applicant's motion for summary judgment (filed May 22, 2012). Trademark Rule 2.127(d). However, in view of the consolidation and suspension for the parties' civil action, briefing for and consideration of applicant's motion for summary judgment are suspended pending disposition of the civil action. Trademark Rule 2.117(a).

Opposer's Motion to Extend

Opposer's consented motion to extend time to file a brief in opposition to the motion for summary judgment is granted. In view thereof, applicant's brief (filed July 3, 2012) is noted. However, in view of the consolidation and suspension for the parties' civil action, briefing on the

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motion for summary judgment is suspended and applicant should not file a reply brief in support of summary judgment at this time.

The Board may, if appropriate, reset applicant's reply brief deadline once briefing and consideration of the motion for summary judgment are resumed after final disposition of the civil action. At that time, the Board may also direct applicant to further brief its argument that "standing is jurisdictional" (see Motion, pp. 2-3) and therefore the motion asserts lack of jurisdiction by the Board and it was unnecessary for applicant to make initial disclosures prior to filing the motion.