

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

Mailed: October 7, 2011

Opposition No. 91201139

O2 Holdings, Ltd.

v.

O2 Développement

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of applicant's motion (filed September 21, 2011) to suspend this opposition proceeding and to extend its time to answer. The motion has been fully briefed.

Applicant's answer was due September 21, 2011, on which date applicant moved to suspend and to extend its time to answer. With respect to suspension, applicant argues, inter alia, that three of the properties asserted by opposer in support of its priority and likelihood of confusion claim herein, namely, Registration No. 2231093, applications Serial Nos. 78618164 and 78618311, are at issue in two prior-filed Board proceedings. Specifically, in Cancellation No. 92051170 opposer's Registration No. 2231093 is subject to fraud and abandonment claims, and in Opposition No. 91200633 opposer's applications Serial Nos. 78618164 and 78618311 are subject to

priority and likelihood of confusion claims; in both proceedings, opposer is O2Micro International Limited, which is not a party herein. Applicant argues that the disposition of the two proceedings may bear on opposer's rights, if any, in the marks asserted herein.

In response, opposer argues, inter alia, that the other two proceedings to which it is a party involve only three of the eight properties that opposer asserts and intends to rely on herein, do not involve duplicates of the claims asserted herein, and do not involve the application opposed herein. Opposer also argues that it will be prejudiced because evidence or witnesses may be lost, and the extent of the delay in awaiting disposition of the other two proceedings cannot be known at this time and may be lengthy.

Pursuant to the Board's governing authority, namely, Trademark Rule 2.117(a),

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 a civil action or 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.

Accordingly, it is the policy of the Board, and is within its discretion, to suspend a proceeding pending the outcome of another proceeding(s); the Board will ordinarily do so if said outcome may have a bearing on the issues before it. See TBMP § 510.02(a) (3d ed. 2011). The Board usually does not require

that an answer be filed before considering the appropriateness of suspension, unless it is not possible for the Board to ascertain, prior to the filing of an answer, whether the final determination of the other proceeding(s) may have a bearing on the case before it. *Id.* Furthermore, the Board has the inherent authority to schedule the disposition of cases on its docket. See TBMP § 510.01 (3d ed. 2011).

From a review of the pleading in this proceeding, the Board ascertains that the issue before it is applicant's registrability (request for extension of protection under Trademark Act Section 66(a)) of the mark



("HOME SERVICES" disclaimed, color claimed) for the services it has identified therein in International Classes 37, 39, 40, 41, 43, 44 and 45,¹ under Trademark Act Section 2(d), in view of opposer's pleaded common law rights as well as opposer's pleaded rights in three registrations and five applications. The other two Board proceedings against opposer's Registration No. 2231093 based on fraud and abandonment, and against its application Serial Nos. 78618164 and 78618311 based on priority and likelihood of confusion, clearly involve three of opposer's

¹ Application Serial No. 79087506, filed March 11, 2010.

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pleaded marks, and the outcome or settlement of said claims could affect opposer's rights or continued rights in those marks as asserted and relied on herein. Under these circumstances, the Board finds that a determination of opposer's rights in one or more of these three pleaded marks may have a bearing on the analysis of the merits of this opposition proceeding.

In view thereof, applicant's motion to suspend under Trademark Rule 2.117(a) is granted, and proceedings are hereby suspended pending final determination of Cancellation No. 92051170 and Opposition No. 91200633. By virtue of imposition of the suspension period, applicant's extension of time to answer is also granted.

Within twenty (20) days after the final determination of Cancellation No. 92051170 and Opposition No. 91200633, the parties shall so notify the Board by filing notification(s) of said determination(s) herein, so that the Board can call up Opposition No. 91201139 for any appropriate action, including the resetting of applicant's time to file its answer, as appropriate.

During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.

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