

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

RK

Mailed: November 27, 2013

Opposition No. 91208003

Red Bull GmbH

v.

Michael F. Ball

Yong Oh (Richard) Kim, Interlocutory Attorney:

This matter comes up on opposer's renewed motion¹ (filed July 26, 2013) to suspend this proceeding in favor of two *ex parte* appeals of application Serial Nos. 85351186 and 85346334. Those appeals were suspended on June 20, 2013, pending disposition of this opposition proceeding. The motion is fully briefed.

As a preliminary matter, and to address the parties' arguments regarding the timeliness of opposer's motion, the Board does not consider the motion premature as briefing on the motion, and therefore Board consideration, was completed after applicant's filing of its answer to opposer's amended notice of opposition.²

¹ Opposer previously sought suspension of this opposition proceeding on June 19, 2013. That motion was not considered as it contravened the Board's suspension order of February 27, 2013.

² See Board Order of June 28, 2013, n.1.

Turning then to the merits of the motion, opposer seeks to resume the *ex parte* proceedings and suspend this opposition "for reasons of judicial economy," arguing that "both matters before the Board are dispositive of the central issue of likelihood of confusion" and that the *ex parte* process "is less costly to and uses less resources of the Board (as well as both parties), does not include extensive discovery and trial periods, and essentially will be decided on briefs in a matter of months." *Opposer's Motion to Suspend*, p. 2. While it is generally true that an *ex parte* proceeding is less costly for an applicant to prosecute as compared to an *inter partes* proceeding, that merely reflects the differences between the two types of proceedings, including the discovery and evidentiary limitations inherent in an *ex parte* proceeding, but does not suggest that initial disposition of a related *ex parte* proceeding over an *inter partes* proceeding will serve the interests of judicial economy.

The Board has previously observed that "an *ex parte* appeal is not analogous to an opposition." *In re Sela Products, LLC*, 107 USPQ2d 1580 (TTAB 2013). Thus, opposer's contention that a disposition in the *ex parte* proceedings will be dispositive of the likelihood of confusion issue in this proceeding, is not well taken. Each case "stands on its own facts, and prior decisions are of little value." *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). This is

particularly true when comparing an *ex parte* to an *inter partes* proceeding, considering that in *ex parte* prosecution, the burden is initially on the Patent and Trademark Office to put forth sufficient evidence to demonstrate unregistrability. However, due to the Office's limited resources, the record in an *ex parte* proceeding will necessarily be less extensive and less comprehensive than the record that might otherwise be adduced in an *inter partes* proceeding and which evidence is subject to cross examination and closer scrutiny. As such, the Board generally adopts a "more permissive stance with respect to the admissibility and probative value of evidence" in an *ex parte* proceeding than it does in an *inter partes* proceeding. TBMP § 1208 (2013); see also *In re Loew's Theatres, Inc.*, 769 F.2d 764, 768, 226 USPQ 865, 868 (Fed. Cir. 1985).

Additionally, as the Section 2(d) refusals in the *ex parte* appeals do not involve two of the three pleaded registrations in this opposition as well as opposer's alleged common law rights, it is unlikely that a favorable decision for applicant in the *ex parte* proceedings will result in the conclusion of this *inter partes* proceeding. On the other hand, a disposition in applicant's favor of its counterclaims³ against pleaded Registration No. 3939863 would obviate the *ex parte* appeals.

³ As part of its answer (filed August 14, 2013) to opposer's amended notice of opposition, applicant has counterclaimed against pleaded Registration No. 3939863 on grounds of abandonment and mere descriptiveness.

Finally, it is the general practice of the Board to suspend an *ex parte* appeal upon written request by the applicant showing good cause which includes, *inter alia*, applicant's involvement in a Board *inter partes* proceeding that may be dispositive of the issues involved in the *ex parte* appeal. TBMP § 1213.

In view of these considerations, it is unlikely that judicial economy would be served by suspending this opposition proceeding in favor of the *ex parte* proceedings. Accordingly, opposer's motion to suspend is hereby **DENIED**. Proceedings herein are **RESUMED** and dates are **RESET** as follows:

Answer to Counterclaim Due	1/10/2014
Deadline for Discovery Conference	2/9/2014
Discovery Opens	2/9/2014
Initial Disclosures Due	3/11/2014
Expert Disclosures Due	7/9/2014
Discovery Closes	8/8/2014
Plaintiff's Pretrial Disclosures	9/22/2014
30-day testimony period for plaintiff's testimony to close	11/6/2014
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	11/21/2014
30-day testimony period for defendant and plaintiff in the counterclaim to close	1/5/2015
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	1/20/2015
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	3/6/2015
Counterclaim Plaintiff's Rebuttal Disclosures Due	3/21/2015
15-day rebuttal period for plaintiff in the counterclaim to close	4/20/2015
Brief for plaintiff due	6/19/2015
Brief for defendant and plaintiff in the counterclaim due	7/19/2015

Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	8/18/2015
Reply brief, if any, for plaintiff in the counterclaim due	9/2/2015

IN EACH INSTANCE, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within **thirty days** after completion of taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

* * *