

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

DUNN

Mailed: September 9, 2014

Opposition No. 91213097

LUXCO, INC.

v.

JOSE ADRIAN CORONA RADILLO

Elizabeth A. Dunn, Attorney (571-272-4267):

This case comes up on Applicant's motion to suspend this proceeding pending the disposition of Cancellation No. 92058411. The motion is contested.

On October 21, 2013, Opposer filed a notice of opposition against Application Serial No 77752452 for the mark GENERACION REBELDE for "tequila" alleging claims of lack of bona fide intent to use, and likelihood of confusion with its marks, the subject of both common law use and three pleaded registrations<sup>1</sup>

Registration No. 727786 issued February 20, 1962	REBEL YELL	straight bourbon whiskey
--	------------	--------------------------

<sup>1</sup> Opposer also pleaded then-pending application Serial No. 7758725 which was abandoned on June 30, 2014.

Registration No. 3632812 issued June 2, 2009	REBEL RESERVE	liquors and distilled spirits
Registration No. 4584626 issued August 12, 2014	4 REBELS	vodka

Applicant filed an answer denying the salient allegations of the notice of opposition. As set by the Board, discovery was scheduled to commence December 30, 2013 and close June 28, 2014.

On December 10, 2013, Opposer's petition to cancel a registration owned by a third party, which pleaded the same three registrations in support of its likelihood of confusion claim, was instituted as Cancellation No. 92058411. On January 28, 2014, the third party registrant filed counterclaims to cancel two of Opposer pleaded registrations. On April 3, 2014, Applicant moved to suspend this opposition pending the disposition of the cancellation, including pendency of all deadlines in this proceeding until the Board issues a decision on the motion, contending that cancellation of the pleaded registrations "will impact Opposer allegations" in this proceeding.<sup>2</sup>

Opposer opposes suspension, contending that the allegation of "impact" falls far short of good cause because, even if the registrations were cancelled, Opposer would still have the benefits of the third registration as well as its common law rights in this proceeding, and suspension pending disposition of a proceedings brought by unrelated plaintiffs runs counter to Board practice.

---

<sup>2</sup> On July 29, 2014 in Cancellation No. 92058, the Board granted Petitioner's motion to dismiss the counterclaims.

Opposer alleges that Applicant filed the motion in a bad faith effort to avoid supplementing its discovery responses, which have been the subject of Opposer's multiple unsuccessful attempts to obtain supplements. Applicant's reply denies any bad faith, and notes that supplemental discovery responses have been served.

Suspension of a Board proceeding is solely within the discretion of the Board. *The Other Telephone Company v. Connecticut National Telephone Company, Inc.*, 181 USPQ 779, 782 (Comm'r Pat. 1974). Whenever it comes to the attention of the Board that a party or parties to a case pending before it are involved in a civil action which may have a bearing on the Board case, proceedings before the Board may be suspended until final determination of the civil action. Trademark Rule 2.117(a). Most commonly, a request to suspend pending the outcome of another proceeding seeks suspension because of a civil action pending between the same parties in a federal district court. The circumstance in which the Board will suspend a proceeding pending the disposition of a civil action in which only one of the parties is involved is usually limited to a proceeding whose outcome would be dispositive of the Board proceeding. *See Argo & Co. v. Carpetsheen Manufacturing, Inc.*, 187 USPQ 366, 367 (TTAB 1975) ("If it is determined in the civil action that applicant's interest in the mark was insufficient to clothe it with the authority and right to file the application, same will be declared

void ab initio; in which event, the opposition will be dismissed without prejudice and registration to applicant will be refused.”).

"All motions to suspend, regardless of circumstances, . . . are subject to the 'good cause' standard." *National Football League v. DNH Management LLC*, 85 USPQ2d 1852, 1855, n.8 (TTAB 2008) *citing* Trademark Rule 2.117(c). The Board seldom grants a motion to suspend a particular proceeding pending disposition of other opposition or cancellation proceedings brought by unrelated plaintiffs against the same application or registration, and asserting unrelated claims, absent the consent of the other parties. An exception may be made for purposes of consistency and economy where there are common claims in the separate proceedings. *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1551 (TTAB 2011); Trademark Trial and Appeal Board Manual of Procedure (TBMP) §510.02 (2014).

Here, the other Board proceeding involving Opposer's registrations did not involve the same parties, had no possibility of being dispositive of this opposition, and did not involve common claims. As Opposer points out, the Board's practice of not suspending in such circumstances is easily learned by consulting the Board's manual of procedure, and has also been the subject of precedential cases. Applicant having failed to show good cause, its motion to suspend is DENIED.

In the usual case, the denial of a motion to suspend would result in the Board's last trial schedule remaining in effect. Here, the usual practice would result in discovery remaining closed. However, due to an inadvertence, a paralegal order issued May 24, 2014 which suspended proceedings. Since the Board action shortened discovery, the Board will reset a brief discovery period which will allow, if the parties act expeditiously, follow-up discovery.

The parties are advised that, unless the Board's rules call for suspension, the filing of a motion will NOT result in the suspension of proceedings. If a party believes the motion to be time-critical, the party should telephone the attorney listed at the top of the order to request that the motion be argued by phone.

Proceedings herein are resumed. The parties have **THIRTY DAYS** from the mailing date of this order to serve responses and responsive documents to any outstanding discovery requests **BY EMAIL OR OVERNIGHT DELIVERY**. Any new discovery requests must be served by **BY EMAIL OR OVERNIGHT DELIVERY**.

Dates are reset below.

Expert Disclosures Due	<b>9/24/2014</b>
Discovery Closes	<b>10/24/2014</b>
Plaintiff's Pretrial Disclosures	<b>12/8/2014</b>
Plaintiff's 30-day Trial Period Ends	<b>1/22/2015</b>
Defendant's Pretrial Disclosures	<b>2/6/2015</b>
Defendant's 30-day Trial Period Ends	<b>3/23/2015</b>
Plaintiff's Rebuttal Disclosures	<b>4/7/2015</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>5/7/2015</b>

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 the taking of testimony. Trademark Rule 2.125.

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