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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|------------------------|---|
| Proceeding | 91219179 |
| Party | Plaintiff Spliethoff's Bevrachtungskantoor B.V. |
| Correspondence Address | J MICHAEL PENNEKAMP FOWLER WHITE BURNETT PA 1395 BRICKELL AVENUE, 14TH FLOOR, ESPIRITO SANTO PLAZA MIAMI, FL 33131 UNITED STATES jpennekamp@fowler-white.com, bhackney@fowler-white.com, start@fowler-white.com, lparker@fowler-white.com, jmp@fowler-white.com |
| Submission | Other Motions/Papers |
| Filer's Name | J. Michael Pennekamp, Esquire |
| Filer's e-mail | jpennekamp@fowler-white.com, bhackney@fowler-white.com, start@fowler-white.com, lparker@fowler-white.com, jmp@fowler-white.com |
| Signature | /J. Michael Pennekamp, Esquire/ |
| Date | 11/04/2015 |
| Attachments | Opposer's Motion to Suspend and Supporting Memorandum of Law.pdf(31291 bytes) Composite Ex A to Opposer's Motion to Suspend 4825-2064-7210.pdf(124537 bytes) |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Opposition No. 91219179

Serial No. 86031633

SPLIETHOFF'S BEVRACHTINGSKANTOOR B.V.,

Opposer,

v.

UNITED YACHT TRANSPORT LLC.,

Applicant.

**OPPOSER'S MOTION TO SUSPEND AND
SUPPORTING MEMORANDUM OF LAW**

MOTION

Opposer SPLIETHOFF'S BEVRACHTINGSKANTOOR B.V. ("Spliethoff"), by and through its undersigned counsel, pursuant to 37 C.F.R. § 2.117(c), hereby requests that the instant Opposition Proceeding be suspended pending the decision on Spliethoff's Motion for Leave to File amended Notice of Opposition filed on November 4, 2015, concurrently herewith. In addition, Spliethoff requests that the discovery period be reset to allow the same amount of time for discovery as is currently remaining in the discovery period at the time of the filing of the present motion. In support hereof, Spliethoff respectfully submits the following Memorandum of Law.

MEMORANDUM OF LAW

I. INTRODUCTION

Pursuant to 37 C.F.R. § 2.117(c), Spliethoff hereby requests that the Board enter an Order that: (1) suspends the instant Opposition proceedings pending the Board's decision on Spliethoff's

Motion for Leave to File Amended Notice of Opposition ("Motion for Leave to Amend" or "Motion") filed on November 4, 2015, concurrently herewith; and (2) resets the discovery schedule to provide for the same amount of time to complete discovery as is currently remaining in the discovery period at the time of the filing of the present motion (*i.e.* the period of time from November 4, 2015 through January 12, 2016).

As set forth in Spliethoff's Motion for Leave to Amend, Spliethoff seeks leave to amend its Notice of Opposition to add the opposition basis that Application Serial No. 86031633 is invalid and void *ab initio* because Applicant knowingly made material misrepresentations to the USPTO in its Application and in its subsequent prosecution of its Application, including Applicant's filing on April 22, 2015 of a Motion to Amend Application (seeking to amend basis from Section 1(a) to Section 1(b)). (*see generally* Spliethoff's *Motion for Leave to File Amended Notice of Opposition*).

Objections on the ground of relevancy are anticipated to any Spliethoff discovery aimed at discovering additional facts to support its proposed claim of fraud by Applicant in the filing and prosecution of the Application until the Board rules on Spliethoff's Motion for Leave to Amend. Therefore, Spliethoff respectfully requests that the Board suspend the present Opposition proceedings until the Board issues its decision on Opposer's Motion and thereafter reset the Scheduling Order deadlines when the proceeding resumes.

II. ARGUMENT

A. The Board May Suspend Proceedings for Good Cause

Opposition "[p]roceedings may ... be suspended, for good cause, upon motion or a stipulation of the parties approved by the Board." C.F.R. § 2.117(c); *see generally* TBMP § 510.01. The power to stay proceedings flows from the Board's inherent power to control the scheduling of cases on its docket in furtherance of the policy goal of promoting fair and efficient adjudication.

In prior cases,¹ the Board has suspended proceedings and reset the discovery period in connection with the filing of a motion for leave to amend a notice of opposition to add grounds for opposition which might alter the scope of the discovery. *See e.g. Sinclair Oil Corp. v. Sumatra Kendrick*, Opposition No. 91152940, unpublished Order mailed September 28, 2005 ("Opposer's motion (filed September 19, 2005) to suspend pending disposition of its motion for leave to file an amended notice of opposition is hereby granted as well-taken. See Trademark Rule 2.117(c)"); *Yahoo! Inc. v. JRS Industries, Inc.*, Opposition No. 91197599, unpublished Order mailed October 20, 2011 ("Proceedings are suspending pending disposition of opposer's motions (filed October 4, 2011) to compel and to test the sufficiency, and to amend the notice of opposition."); *SDT, Inc. v. Patterson Dental Company*, 1994 TTAB LEXIS 10, 30 U.S.P.Q.2d (BNA) 1707 (TTAB 1994). In issuing its Suspension Order in *SDT, Inc.*, the Board noted the reasonableness of suspending the proceeding and resetting discovery due to the pending Opposer's motion for leave to amend notice of opposition, stating:

... we believe it is in both parties' interest to have the motion for leave to amend settled before the parties engage in significant discovery and trial activities. Indeed, in view of the nature of the issue raised by opposer's motion to amend, it would be unreasonable to expect either party to take discovery or offer evidence prior to the determination of the motion. Thus, we find good and sufficient cause to reset discovery and testimony periods, and we have done so *infra*. See *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067 (TTAB 1987).

30 U.S.P.Q.2d (BNA) at 1708.

¹ Copies of the two unpublished Orders cited herein are attached hereto as Composite Exhibit "A."

B. Spliethoff has Demonstrated Good Cause for Requesting a Suspension of the Proceedings

During the written discovery process, Spliethoff learned that Applicant, with intent to deceive the USPTO, knowingly made false, material representations to the USPTO (1) regarding Applicant's use of the mark UNITED YACHT TRANSPORT in commerce for the specified International Class 039 services (transportation of yachts by boat) at the time of filing its Application, and (2) in connection with the subsequent prosecution of its Application. As a result of learning such facts evidencing fraud on the USPTO by Applicant, Spliethoff filed its motion for leave to amend to assert fraud as a new ground for opposition and for refusal of the Application and to add factual allegations demonstrating Applicant's bad faith.

Spliethoff respectfully submits that the Board's suspension of these proceedings is a reasonable method of charting the future course of this action. Discovery closes on January 12, 2016. The parties have exchanged written discovery (interrogatories and requests for admission) and produced documents but no depositions have been taken as yet by any party. In order to allow time for briefing of Spliethoff's Motion for Leave to File Amended Notice of Opposition and the Board to issue its decision, an extension of the discovery period may and will likely be necessary. If its amendment motion is granted, Spliethoff may need additional time to obtain discovery relevant to its proposed fraud claim. To avoid objections from Applicant regarding the scope of discovery, Spliethoff needs the Board to rule upon its pending Motion for Leave to Amend prior to discovery moving forward. Once the Board has ruled upon Spliethoff's Motion, the parties can proceed to complete discovery in an orderly fashion.

C. Applicant Will Not Be Prejudiced by a Suspension of the Proceedings

Applicant's own conduct, disclosed in discovery to Spliethoff, form the grounds of Spliethoff's pending Motion for Leave to Amend. Therefore, as a threshold matter, any assertion of

prejudice in relation to either Spliethoff's Motion for Leave to Amend or the instant suspension motion should not be entertained. Since Applicant's own admissions and disclosures to Spliethoff in discovery evidence knowing false representations by Applicant to the USPTO, justice requires that (a) the Board grant the instant motion, as well as Spliethoff's amendment motion, (b) the proceedings be suspended until the Board has ruled on the amendment motion and (c) the Scheduling Order be modified by the Board after the proceedings resume to enable Spliethoff have the opportunity to utilize the entire remaining discovery period to seek discovery relevant to Spliethoff's proposed claim of fraud against Applicant and issues pertaining to Applicant's bad faith.

By the instant motion, Spliethoff seeks only to maintain the *status quo* of remaining discovery days (approximately 6 weeks) and to allow discovery on all issues to be completed after receiving the Board's ruling. Spliethoff respectfully submits that there are no facts to support any allegation of bad faith or dilatory motive on Spliethoff's part in seeking a suspension of the proceedings. To the contrary, as represented herein and in Spliethoff's Motion for Leave to Amend, these motions both are filed prior to the close of discovery and are based on Applicant's disclosures and admissions in discovery which Spliethoff could not have foreseen.

IV. CONCLUSION

For the foregoing reasons and authorities, Spliethoff respectfully requests the Board to grant the instant Motion and suspend the instant Opposition proceeding until the Board rules upon Spliethoff's Motion for Leave to File Amended Notice of Opposition and further requests that the Scheduling Order be reset upon issuance of the Board's decision as outlined herein.

Dated: November 4, 2015

Respectfully submitted,

/s/ J. Michael Pennekamp

J. Michael Pennekamp

Fla. Bar No. 983454

Email: jpennekamp@fowler-white.com

Sandra I. Tart

Fla. Bar No. 358134

Email: sttart@fowler-white.com

FOWLER WHITE BURNETT, P.A.
Espirito Santo Plaza, Fourteenth Floor
1395 Brickell Avenue
Miami, Florida 33131
Telephone: (305) 789-9200
Facsimile: (305) 789-9201

Counsel for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Opposer's Motion to Suspend and Supporting Memorandum of Law has been e-filed with the USPTO via ESTTA and served upon Bryan D. Hull, Esquire, counsel for Applicant United Yacht Transport, LLC, by email to bhull@bushross.com, this 4th day of November, 2015.

/s/ Sandra I. Tart

Sandra I. Tart

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

Mailed: October 20, 2011

Opposition No. 91197599

Yahoo! Inc.

v.

JRS Industries, Inc.

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

Proceedings are suspended pending disposition of opposer's motions (filed October 4, 2011) to compel and to test the sufficiency, and to amend the notice of opposition. The parties should not file any paper which is not germane to these motions. See Trademark Rules 2.120(e)(2) and (h)(2), and 2.127(a).

EXHIBIT A

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

Baxley

Mailed: September 28, 2005

Opposition No. **91152940**

Sinclair Oil Corporation

v.

Sumatra Kendrick

Andrew P. Baxley, Interlocutory Attorney:

Opposer's motion (filed September 19, 2005) to suspend pending disposition of its motion for leave to file an amended notice of opposition is hereby granted as well-taken. See Trademark Rule 2.117(c).

Proceedings herein are suspended retroactive to September 13, 2005 pending disposition of opposer's motion for leave to file an amended notice of opposition.

Any paper filed during the pendency of applicant's motion for leave to file an amended notice of opposition which is not relevant thereto will be given no consideration.