

ESTTA Tracking number: **ESTTA750669**

Filing date: **06/07/2016**

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

Proceeding	91219179
Party	Plaintiff Spliethoff's Bevrachtungskantoor B.V.
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Date	06/07/2016
Attachments	Motion to Suspend Pending Decision on Opposer M Leave Amend and Supporting Memorandum of Law.pdf(30887 bytes) Composite Ex A to Motion to Suspend - unpublished opinions 4825-2064-7210.pdf(124537 bytes)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 Third Amended Notice of Opposition filed on June 7, 2017, concurrently herewith. In addition, Spliethoff requests that the discovery period be reset to allow Spliethoff an additional 120 days for discovery following the Board's decision on Spliethoff's motion to amend. 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 Third Amended Notice of Opposition ("Motion for Leave to Amend" or "Motion") filed on June 7, 2016, concurrently herewith; and (2) resets the pretrial deadlines to provide for 120 additional days of discovery after the Board's decision to allow Spliethoff sufficient time to complete its discovery of Applicant regarding the "unlawful use" ground for opposition that is the subject of Spliethoff's Motion for Leave to Amend.

As set forth in Spliethoff's Motion for Leave to Amend, Spliethoff seeks leave to amend its Second Amended Notice of Opposition filed on March 21, 2016 to add the opposition basis that Application Serial No. 86031633 should be refused because Applicant's use of the mark to provide yacht transport services prior to February 8, 2016 constituted the unlicensed provision of "ocean transport intermediary" services in violation of the Shipping Act of 1984. Applicant's unlawful use of the mark does not constitute "use in commerce" under the Lanham Act which could establish any trademark rights or priority. (*see generally* Spliethoff's *Motion for Leave to File Third Amended Notice of Opposition*).

Spliethoff served written discovery on Applicant regarding the proposed "unlawful use" opposition ground on March 25, 2016, April 7, 2016 and April 22, 2016. Applicant objected on relevancy grounds to the foregoing discovery. Spliethoff respectfully requests that the Board suspend the present Opposition proceedings until the Board issues its decision on Opposer's Motion for Leave to Amend and thereafter reset the Scheduling Order deadlines to allow 120 additional days of discovery 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

In April and May 2016, Spliethoff obtained documents from the Federal Maritime Commission which supports the opposition ground of "unlawful use." (See Declaration of Tart, concurrently filed herewith, and Composite Exhibits "B" and "C" thereto). These documents establish that prior to February 8, 2016, Applicant was providing yacht transport services using the mark as an unlicensed "ocean transport intermediary" in violation of the Shipping Act of 1984. Based on such evidence, Spliethoff has filed its Motion for Leave to Amend to add the opposition ground of "unlawful use" and for refusal of the Application.

Spliethoff respectfully submits that the Board's suspension of these proceedings is appropriate until the Board issues its decision on Spliethoff's Motion for Leave to Amend. Discovery closes on June 29, 2016. Objections have already been raised by Applicant to Opposer's written discovery seeking information concerning whether Applicant's use of the mark in commerce was "lawful." 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 belated licensure as an "ocean transport intermediary," which was only published on Applicant's website sometime after the February 8, 2016 effective date of its NVOCC license forms the grounds of Spliethoff's pending Motion for Leave to Amend. Therefore, any assertion of prejudice in relation to either Spliethoff's Motion for Leave to Amend or the instant suspension motion should not be entertained.

Spliethoff acted diligently to investigate the opposition ground of unlawful use by making a Freedom of Information Request to the Federal Maritime Commission in early April 2016 for

documents relating to Applicant's NVOCC license and by serving written discovery on Applicant in March and April 2016 which focused on the "unlawful use/lack of priority" opposition ground. 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 belated licensure on February 8, 2016 as an "ocean transport intermediary" and subsequent publication of its NVOCC license on Applicant's website.

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 Third Amended Notice of Opposition and further requests that the Scheduling Order be reset upon issuance of the Board's decision as outlined herein.

Dated: June 7, 2016

Respectfully submitted,

/s/ J. Michael Pennekamp

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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 7th day of June 2016.

/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.