

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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DUNN

Mailed: October 20, 2016

Opposition No. 91219312

Karen Millen Fashions Limited

v.

Karen Millen

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

The Board's suspension order of August 26, 2016 is VACATED.

The order approved what it erroneously described as a stipulation to suspend proceedings for settlement. In fact, the parties sought suspension based on the actions of a foreign tribunal, and there is no showing on the present record that suspension is appropriate.

DISCOVERY ISSUES

Before turning to the issue of suspension, the Board addresses the current status of this proceeding, which commenced November 12, 2014. By agreement, the parties deferred the opening of discovery until October 18, 2015 and then extended discovery to close July 14, 2016. The parties' consented motion filed June 13, 2016 to extend dates indicates that Opposer served expert discovery May 16, 2016, and that the extension would allow the parties to conclude discovery related to that

disclosure. While it would have been the better practice to notify the Board of the expert disclosure, the parties may agree to conclude expert discovery within the existing discovery period, and the Board assumes that the parties followed that course here. The Board considers discovery related to the expert to be concluded.¹ The parties' consented motion filed August 23, 2016 indicates that the sufficiency of documents produced by Opposer after the close of discovery is disputed.

SUSPENSION

The fact that the parties agreed to suspension is not determinative where, as here, the parties already have been granted a prolonged suspension of proceedings to negotiate settlement and address discovery issues. *See Shen Manufacturing Co. v. Ritz Hotel Ltd*, 393 F.3d 1238, 73 USPQ2d 1350, 1353 n.2 (Fed. Cir.2004) and TBMP 510.03(A0 (“the Board may, in its discretion, deny further suspension when the parties have already been granted a reasonable time to settle the case and it does not appear that further suspension is likely to result in resolution of the dispute. While parties are encouraged to settle their cases, the Board has an interest in seeing its cases conclude in a timely manner.”).

While the Board may also, in its discretion, suspend a proceeding pending the final determination of a foreign action between the parties, this generally is limited

¹ *See RTX Scientific Inc. v. Nu-Calgon Wholesaler Inc.*, 106 USPQ2d1492, 1493 n.3 (TTAB 2013) (a party must the notify the Board of its plan to use an expert (without including copies of expert disclosures), and that it has made required expert disclosures to adversary; the best practice is to notify the Board concurrently with the expert disclosures to adverse party). *But see General Council of the Assemblies of God v. Heritage Music Foundation*, 97 USPQ2d 1890, 1893 (TTAB 2011) (Trademark Rule 2.120(a)(2) does not mandate that a disclosing party inform the Board that an expert disclosure has been made; disclosing party's failure to notify the Board is not a ground to exclude the testimony).

to those instances in which one party challenges the validity of a foreign registration upon which the other party's subject U.S. application is based. *See Birlinn Ltd. v. Stewart*, 111 USPQ2d 1905, 1909 (TTAB 2014) (Board suspended proceedings pending receipt of pleadings and other documentation to determine whether proceeding in the United Kingdom may have a bearing in Board proceeding). While applicant is a citizen of the United Kingdom, the opposed application is not based on foreign or international application or registration, but Applicant's averment of an intent to use the mark in United State commerce.

Here, the parties allege that a foreign tribunal "will finally determine whether Applicant has the right to pursue registration of the applied-for mark." It is not clear how the UK court could bar Applicant from seeking registration in the United States, or, if the parties meant that the UK court will determine the right to register in the UK, how that would affect Applicant's intent to use the mark in the United States. If there is a separate written agreement providing that the parties will give effect in the United States to a finding by the UK court, it must be specifically stated.

Action on the consented motion to suspend proceedings pending final determination of the United Kingdom litigation (*Karen Denise Millen v. Karen Millen Fashions Limited and Mosaic Fashions US Limited*, Claim No: HC-2014-000808) now pending before the High Court of Justice, Chancery Division, Intellectual Property is DEFERRED.

Within THIRTY DAYS from the mailing date of this order, the parties must take the following action²:

Opposer is ordered to file the operative pleadings and the September 13, 2016 final order which issued in *Karen Denise Millen v. Karen Millen Fashions Limited and Mosaic Fashions US Limited*, Claim No: HC-2014-000808.

Applicant is ordered to file any appeal of the September 13, 2016 final decision, and an explanation whether any appeal from the present appeal is possible under the United Kingdom judicial scheme.

The parties must supplement the motion to suspend by clarifying how the UK proceeding will have a bearing on this opposition. The parties may do so by stipulation or in separate filings.

In the event that suspension is denied, the Board also may order Applicant to file any motion to compel responsive documents within thirty days. If there is any reason why the obligation to make a good faith effort to resolve the dispute regarding the sufficiency of documents served in July 2016 cannot be met within that time, the parties also should provide those reasons, with a proposed deadline for filing the motion.

Proceedings are SUSPENDED pending the parties' compliance with this order.

² Absent extraordinary circumstance, this deadline will not be extended. The parties are barred from using ESTTA consent motions and must seek permission by phone from the Board (by calling the attorney listed at the top of this order) before filing any paper unrelated to the issues discussed in this order.