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

Proceeding	91221038
Party	Plaintiff Abercrombie & Fitch Trading Co.
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Submission	Motion to Suspend for Civil Action
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Attachments	Opposers Motion to Suspend the Proceedings Pending Civil Litigation.pdf(136867 bytes )

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ABERCROMBIE & FITCH TRADING	§	
CO.,	§	
	§	
Opposer,	§	
	§	
	§	
	§	Opposition No.: 91221038
v.	§	
	§	
WESTERN RISE, LLC,	§	
	§	
Applicant.	§	

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**OPPOSER’S MOTION TO SUSPEND THE PROCEEDINGS PENDING CIVIL  
LITIGATION**

Opposer, Abercrombie & Fitch Trading Co. (hereinafter, “Opposer”), pursuant to 37 CFR § 2.117(a) and TBMP § 510.02(a), hereby requests that the Trademark Trial and Appeal Board (hereinafter, the “TTAB” or the “Board”) suspend the present opposition proceeding until the final determination of *Abercrombie & Fitch Co. et. al. v. Western Rise, LLC*, Case No. 2:16-cv-01034 (S.D. Ohio Oct. 27, 2016), a civil action before the United States District Court for the Southern District of Ohio (hereinafter, “Civil Action”), because the Civil Action will have a direct bearing on the instant proceeding.

**STATEMENT OF FACTS**

On March 12, 2015, Opposer filed a Notice of Opposition seeking to prevent registration of Application Serial Nos. 86/293,112 and 86/292,364, and on December 14, 2015, Opposer filed a Petition of Cancellation seeking to cancel the registration of Applicant’s United States Registration No. 4,800,735 (hereinafter, collectively, the “Infringing Moose Marks”) on the

grounds of likelihood of confusion with and dilution of Opposer's famous A&F Moose Marks. These proceedings were consolidated under parent Opposition No. 91221038 by the Board on July 6, 2016 (23 TTABVUE). When the Opposition began, Applicant had not yet begun use of the Infringing Moose Marks on clothing. Applicant's use has since begun and is now expanding rapidly. Accordingly, Opposer filed the Civil Action.

In the Civil Action, Opposer claims the following based on Applicant's use of the Infringing Moose Marks: (1) infringement of the A&F Moose Marks due to likelihood of confusion, mistake, and/or deception as to the affiliation, connection, association, origin, sponsorship, approval, commercial activities, nature, characteristics, and qualities of the goods and series offered by Applicant, all to the detriment of Opposer, under Federal Trademark Law (The Lanham Act); (2) dilution of the A&F Moose Marks under Federal Law (The Federal Dilution Act); (3) unfair competition under Federal Trademark Law (The Lanham Act) and Ohio State Common Law; and (4) deceptive trade practices under Ohio State Law. Opposer seeks relief in the Civil Action in the form of injunctive relief, damages, and attorney's fees, none of which are available in a TTAB proceeding. Because the issues in the Civil Action overlap with those in the Opposition and both Opposer and Applicant are the parties involved, Opposer respectfully requests that the TTAB grant this motion to suspend the proceedings pending the final determination of the Civil Action.

Opposer provided a courtesy copy of the filed Complaint to Applicant's counsel the same day the Complaint was filed (October 27, 2016) and requested Applicant to advise if they consented to said Motion. Opposer also informed Applicant of its intention to file said Motion the next day. As of 6:00 PM ET on October 28, 2016, Applicant had not indicated if it consented

or not. Accordingly, Opposer is proceeding with this filing and will update the Board if Applicant advises that it consents to the Motion.

### **ARGUMENT**

When a party to a case pending before the Board is also involved in a civil action that may have a bearing on the TTAB matter, the Board may suspend the proceeding until the final determination of the civil action. 37 CFR § 2.117(a); TBMP § 510.02(a). “It is the policy of the Board to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case.” *Arcadia Group Brands Ltd. v. Studio Moderna SA*, 99 U.S.P.Q.2d 1134, 1136 (TTAB 2011). The current opposition should be suspended because the determination in *Abercrombie & Fitch Co. et. al. v. Western Rise, LLC*, Case No. 2:16-cv-01034 (S.D. Ohio Oct. 27, 2016), will have a direct bearing on the issues before the Board.

Opposer and Applicant are both parties to the Civil Action, with Opposer in the position of Plaintiff and Applicant in the position of the Defendant.<sup>1</sup> The Civil Action is a live and ongoing litigation which at the present time is currently pending before the Southern District of Ohio. At the time of the submission of the present Motion, the Plaintiff has filed the Civil Action in the District Court and is awaiting confirmation of service upon the proper legal representative for the Defendant.

A final determination by a District Court in a trademark infringement litigation can take a matter of months or a matter of years. Given that the outcome of the Civil Action will have a direct bearing on the instant proceeding because it involves the same marks at issue here, Opposer believes that the most effective course of action for the Board at this time would be to

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<sup>1</sup> Opposer’s parent company, Abercrombie & Fitch Co., is also named as a Plaintiff in the Civil Action.

suspend the present proceeding until such a time that the District Court renders a final judgment or sends instructions to the Board to proceed in order to minimize the time, money, and resources expended by both parties, as well as the governmental agencies at the TTAB and District Court. Suspension of the opposition proceedings will avoid duplication of effort and possible inconsistency, which Opposer believes would benefit both the parties and the Board. *Arcadia Group Brands Ltd. v. Studio Moderna SA*, 99 U.S.P.Q.2d at 1136 (“the Board wishes to avoid duplication of effort and possible inconsistency in result which would result on the Board being overruled.”).

It is clear that in both the opposition proceeding at the TTAB and the Civil Action in District Court the same parties are involved and there can be little dispute that the issues involved are highly similar, if not identical. Specifically, similar allegations for likelihood of confusion and dilution are at issue in the two proceedings and the same relevant facts will likely be cited by both parties to support their positions.

Moreover, The District Court and the TTAB will rely on the same Federal Trademark Law in both respective proceedings. As the primary issues, likelihood of confusion and dilution, are the same, it will be determinative of the outcome of both proceedings. If the District Court were to rule in favor of either party, the Board would be bound to reflect such a ruling when moving to issue a final judgment in the opposition proceeding. *In re Alfred Dunhill*, 224 U.S.P.Q. at 503 (“A federal court determination of a trademark issue normally has a binding effect in subsequent proceedings before the Board involving the same parties and issue.”).

Additionally, as the Plaintiff has requested, among other things, relief in the form of injunctive relief, damages, and attorney’s fees, it is not possible for the issues now present in the Civil Action to be adjudicated by the Board. Moreover, any continued participation by the

parties in the present opposition would be redundant and wasteful of the limited resources provided to the TTAB. *Arcadia Group Brands Ltd. v. Studio Moderna SA*, 99 U.S.P.Q.2d at 1136.

As such, and taking into consideration the binding effect of any judgment made by the District Court in the Civil Action, Opposer believes that it is in the best interests of the parties and for judicial efficiency to allow for the Civil Action to proceed while the present opposition proceeding is suspended pending the outcome of the Civil Action. Once there is a final ruling, the parties will inform the Board of the District Court's decision, and the Board can then decide the appropriate manner with which to proceed at that time.

Opposer believes that the motion to suspend the proceedings should be granted based on foregoing, as well as the fact that a decision by the District Court will be dispositive of the issues before the TTAB. *General Motors Corp. v. Cadillac Club Fashions, Inc.*, 22 U.S.P.Q.2d 1933, 1936-37 (TTAB 1992) (granting Petitioner's motion to suspend proceedings because "[a] decision by the district court will be dispositive of the issues before the Board.>").

### **CONCLUSION**

Based on the foregoing, Opposer respectfully requests that the Board suspend this proceeding pending the final determination of the Civil Action.

Dated: October 28, 2016

Respectfully submitted,

/s/ Susan M. Kayser

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing OPPOSER’S MOTION TO SUSPEND THE PROCEEDINGS PENDING CIVIL LITIGATION has been served on Applicant, Western Rise, LLC, on October 28, 2016, via email at tucker.barr@agg.com, scott.taylor@agg.com, and trademarks@agg.com, pursuant to agreement of the parties.

/s/ Aryane R. A. Garansi  
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Aryane R. A. Garansi