

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

mw/gcp

Mailed: July 27, 2015

Opposition No. 91221050
(Parent Case)
Cancellation No. 92060077

Arduino S.R.L.

v.

Arduino, LLC

**George C. Pologeorgis,
Interlocutory Attorney:**

On April 22, 2015, Arduino, LLC (“Applicant/Respondent”) filed a combined motion (1) to consolidate Opposition No. 91221050 and Cancellation No. 92060077, and (2) to suspend the consolidated proceedings pending the final determination of a civil action between the parties herein. Arduino S.R.L. (“Opposer/Petitioner”) filed a timely response to the combined motion on May 12, 2015.

Motion to Consolidate

The Board first turns to Applicant’s/Respondent’s motion to consolidate.¹ When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. *See Fed. R. Civ. P. 42(a); Regatta Sport*

¹ The Board notes that Opposer/Petitioner does not oppose the motion to consolidate, but requests that, “should the proceedings be consolidated, the Board consider separately the issues raised in each proceeding that could have a bearing on the outcome of the cases.”

Opposition No. 91221050
Cancellation No. 92060077

Ltd. v. Telux-Pioneer Inc., 20 USPQ2d 1154 (TTAB 1991); and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby.

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See, e.g., Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991).

It is noted that the parties to Opposition No. 91221050 and Cancellation No. 92060077 are identical and the issues in these proceedings involve common questions of law and fact. Accordingly, the motion to consolidate is **GRANTED** as well taken. In view thereof, Opposition No. 91221050 and Cancellation No. 92060077 are hereby consolidated and may be presented on the same record and briefs. *See Hilson Research Inc. v. Society for Human Resource Management, supra;* and *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

The Board file for these consolidated cases will be maintained in Opposition No. 91221050 as the "parent case." From this point on, only a single copy of any motion and any paper should be filed, and each such motion or paper should be filed in the parent case of the consolidated proceedings (except that an answer should be filed

Opposition No. 91221050
Cancellation No. 92060077

in the corresponding proceeding), but caption all consolidated proceeding numbers, listing the parent case first.²

The parties are further advised that, despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

Motion to Suspend for Civil Action

The Board next turns to Applicant's/Respondent's motion to suspend the consolidated proceedings pending the final disposition of a civil action between the parties herein.³ 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. *See* Trademark Rule 2.117(a).

A review of the notice of opposition in this now consolidated proceeding reveals that the opposition involves the following asserted grounds: 1) priority and likelihood of confusion between Applicant's subject design mark described as "an infinity symbol with a minus symbol within the left circle and a plus symbol within the right circle" and Opposer's design mark consisting of "an infinity symbol with a negative sign inside of the left loop and a positive sign inside of the right loop"; 2) that Applicant is not the lawful owner of the subject mark; and 3) that Applicant

² The parties should promptly inform the Board of any other Board proceedings or related cases within the meaning of Fed. R. Civ. P. 42, so that the Board can consider whether further consolidation is appropriate.

³ Case No. 1:15-cv-10181, styled *Arduino, LLC v. Arduino S.R.L., et al.*, filed on or about January 23, 2015 in the United States District Court for the District of Massachusetts.

Opposition No. 91221050
Cancellation No. 92060077

did not use the involved mark in commerce prior to the filing date of the Applicant's use-based application.

With regard to the cancellation proceeding consolidated herein, the cancellation involves the following claims: 1) priority and likelihood of confusion; 2) that Respondent is not the lawful owner of the subject marks; 3) that Respondent did not use the marks in commerce prior to the filing date of the underlying use-based application for registration; 4) abandonment; and 5) fraud. Respondent's subject registrations consist of the marks ARDUINO in standard characters, and ARDUINO and design⁴. Petitioner has pleaded the same infinity symbol design mark as in the opposition proceeding in addition to the mark ARDUINO in standard characters in support of its asserted claims in the cancellation proceeding.

A review of the civil action pleading reveals that both Applicant/Respondent and Opposer/Respondent are parties to the civil action. Additionally, the civil action complaint includes, among other things, claims regarding (1) ownership of the same marks subject to these now consolidated proceedings; (2) federal trademark infringement and unfair competition; and (3) state trademark infringement and unfair business practices.

Opposer/Petitioner, states in its brief in opposition to the motion to suspend that Opposer/Petitioner, as defendant in the civil action, has not yet been served in that proceeding and, as a result, "may never litigate trademark ownership in that

⁴ The mark description in Registration No. 4113794 states, "[t]he mark consists of the word "ARDUINO" in stylized lettering above which is the infinity symbol with a minus symbol within the left circle and a plus symbol within the right circle."

Opposition No. 91221050
Cancellation No. 92060077

Court.” In the alternative to an indefinite suspension, Opposer/Petitioner suggests that the Board “consider granting a suspension for a specific period of time.”

After careful comparison of the Board proceedings and the pleading in the civil action, the Board finds that a decision by the district court would have a bearing on the issues in this consolidated case. Specifically, if the district court finds that Applicant/Respondent is the rightful owner of the marks at issue in the civil action, such a finding would clearly have a bearing on Opposer’s/Petitioner’s claim in this consolidated case that Applicant/Respondent is not the owner of the involved marks. Additionally, the district court’s findings with regard to the claim of trademark infringement asserted in the civil action would similarly have a bearing on the likelihood of confusion claims asserted in the consolidated Board proceedings.

The Board further notes that, to the extent that a civil action in a Federal district court involves issues in common with those in a Board proceeding (which the Board has found in this instance), the district court decision would be binding on the Board. *See American Bakeries Co. v. Pan-O-Gold Baking Co.*, 2 USPQ2d 1208 (D.C. Minn. 1986). Further, Board decisions are appealable to the district court. *See* Section 21 of the Trademark Act, and *Goya Foods, Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1953 (2d Cir. 1988). Moreover, suspending this matter pending the final determination of the civil action will serve the interests of judicial economy.

Finally, Opposer’s/Petitioner’s argument that these proceedings should not be suspended because Opposer/Petitioner has not yet been served with the complaint

Opposition No. 91221050
Cancellation No. 92060077

in the civil action is without merit. To the extent Opposer/Petitioner is not properly served with the complaint in the civil action and the civil action is dismissed with regard to Opposer/Petitioner for lack of service, Opposer/Petitioner, at such time, may move to resume these consolidated proceedings.

Accordingly, Applicant's/Respondent's motion to suspend for civil action is **GRANTED** as well taken and proceedings herein are **suspended** pending the dismissal or final disposition of the civil action between the parties, including all appeals.⁵

Within twenty days after the final determination of the civil action, the interested party should notify the Board so that this case may be called up for appropriate action. In the event proceedings are resumed, trial dates will be reset as necessary.

During the suspension period, the parties must notify the Board of any address changes for the parties or their attorneys. In addition, the parties are to promptly inform the Board of any other related cases, even if they become aware of such cases during the suspension period.⁶

⁵ A proceeding is considered to have been finally determined when a decision on the merits of the case (*i.e.*, a dispositive ruling that ends litigation on the merits) has been rendered, and no appeal has been filed therefrom, or all appeals filed have been decided. *See* TBMP § 510.02(b).

⁶ In light of this order, Opposer's/Petitioner's motion (filed May 13, 2015) to suspend pending the disposition of Applicant's/Respondent's combined motion to consolidate and suspend is **GRANTED** to the extent that these consolidated proceedings are deemed to have been suspended as of the filing date of Applicant's/Respondent's combined motion.