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

Proceeding	91221438
Party	Defendant YLD Limited
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

Application Serial. No.: 86/174,797

Mark: THE NODE FIRM

IC: 042

Applicant: YLD Limited

Filed: January 24, 2014

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THE NODE FIRM, LLC

Opposer,

Opposition No.: 91221438

Serial No.: 86174797

v.

YLD LIMITED,

Applicant.

-----X

**APPLICANT'S RESPONSE TO OPPOSER'S
MOTION TO SUSPEND PROCEEDINGS**

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Applicant YLD Limited (“Applicant” or “YLD”), hereby submits its response to Opposer’s Motion to Suspend Proceedings. As set forth herein, Applicant respectfully requests that the Trademark Trial and Appeal Board (the “Board”) decide Applicant’s previously filed motion to dismiss, which was subsequently converted to a motion for summary judgment (“Applicant’s Motion for Summary Judgment”), prior to ruling on Opposer’s motion to suspend. In the event Applicant’s Motion for Summary Judgment is granted, a decision on the instant motion to suspend and any further decisions in this Opposition proceeding will be moot, as the proceeding will be dismissed. As such, and as consistent with the Board’s policy, it is in the interests of economy and justice to decide Applicant’s Motion for Summary Judgment before ruling on Opposer’s request to suspend these proceedings.

STATEMENT OF FACTS

As set forth in Applicant’s Motion for Summary Judgment, on or about January 24, 2014, Applicant filed an application for the “THE NODE FIRM” word mark, Serial No. 86174797 (the “Application”). Following the Application being published for opposition, non-party Node Source, LLC requested and was granted two (2) extensions of time to file a notice of opposition to oppose the Application. *See* TTABVUE 6, Matz Decl., Ex. 1-4. Thereafter on or about February 4, 2015, Opposer The Node Firm, LLC filed the instant Notice of Opposition (the “Opposition”). *See* TTABVUE 6, Matz Decl., Ex. 5.

On May 19, 2015, Applicant filed its motion to dismiss pursuant to Fed. R. Civ. P. 12(b)(1), *inter alia*, on the grounds that Opposer The Node Firm, LLC’s opposition was untimely as it had never obtained an extension of time to oppose the Application, and as there were no facts pled in the Opposition that would allow the Board to find that there was a sufficient showing that privity exists between Opposer The Node Firm, LLC and Node Source, LLC, the entity that filed and was

granted extensions, the Opposition should be dismissed on the basis that the Opposition was untimely and the Board lacks jurisdiction. *See* TTABVUE 6. Following, Opposer's opposition brief and Applicant's reply (TTABVUE 8 and 9), the Board converted Applicant's motion to dismiss to a motion for summary judgment and allowed the parties until October 9, 2015, to supply evidence (and supplemental briefing) in support of their respective positions under the summary judgment standard. *See* TTABVUE 10. Applicant's Motion for Summary Judgment has now been fully briefed and is currently pending before the Board.

ARGUMENT

As is consistent with the Board's policy, Applicant respectfully requests that the Board decide Applicant's Motion for Summary Judgment prior to ruling on Opposer's instant motion to suspend these proceedings.

The Board has a long standing policy of deferring consideration of a motion for suspension until any dispositive motions are determined. *See, e.g., Allegro High Fid., Inc., v. Zenith Radio Corporation*, 197 U.S.P.Q. 550 (PTO Oct. 27, 1977) ("With respect to the motion to suspend proceedings pending final disposition of the civil suit, it is the policy of the Board, when presented with a motion to suspend, to determine any outstanding motions which may be dispositive of the case prior to consideration of the question of suspension . . . [a]ccordingly, petitioner's motion for summary judgment . . . must be determined before the question of suspension can be considered"); *Chicopee Manufacturing Corp. v. Madison Research & Dev. Corp.*, 134 U.S.P.Q. 261 (Comr., July 6, 1962) (ruling that potentially dispositive matters "of any inter partes proceeding in this Office should be considered before the question of suspension of proceeding is considered" and vacating the Board's order suspending proceedings and directing the Board to complete its consideration of the motion for summary judgment); *The Mgt. Publ'g*

Group, Inc., v. Bill Brothers Publications, Inc., 154 U.S.P.Q. 445 (PTO June 6, 1967)

(“consideration of the question of suspension is deferred pending determination by the Board of petitioner's motion for summary judgment.”).

Specifically the Board has previously held that its policy is “in the interests of judicial economy . . . that any such outstanding matter potentially dispositive of the case should be considered before the question of suspension of proceedings is considered”. *Chicopee Mfg. Corp.*, 134 U.S.P.Q. 261.

Applicant’s Motion for Summary Judgment has been fully briefed and is pending before the Board. It is Applicant’s position that Opposer’s supplemental briefing did not present any evidence that Opposer The Node Firm, LLC is in privity with Node Source, LLC, the entity that requested the extensions of time to oppose the Application, and as such the Opposition should be dismissed for the reasons set forth therein. *See e.g. Renaissance Rialto Inc. v Ky Boyd*, 107 U.S.P.Q.2d 1083 (PTO May 31, 2013) (“[T]he concept of privity generally includes, *inter alia*, the relationship of successive ownership of a mark (e.g., assignor, assignee)....”) (internal citations omitted); *Sdt Inc. v. Patterson Dental Co.*, 30 U.S.P.Q.2d 1707 (PTO Mar. 7, 1994) (“the right to go forward with an opposition may be transferred when the opposer, or its pleaded mark and the goodwill associated therewith, has been acquired by another party”).

Here Opposer’s supplemental brief did not proffer any assignment, license or other evidence that THE NODE FIRM mark and any goodwill associated therewith¹ were transferred between the Opposer The Node Firm, LLC and Node Source LLC.² Opposer’s supplemental

¹ Opposer claims to have rights in THE NODE FIRM name. Applicant does not concede that Opposer has any such rights to use THE NODE FIRM name nor does Applicant concede that Opposer owns any goodwill in same.

² Nor did Opposer’s supplemental brief present any evidence that Node Source, LLC, the entity that requested the extensions of time to oppose the Application, is even using the mark at issue, to the contrary it confirmed that Node Source, LLC is not using THE NODE FIRM name.

brief merely stated that Shaw and McCann control both Opposer and Node Source LLC, and implied that such a license could be given. As such it is Applicant's position that there has been no showing of privity by Opposer, that summary judgment is appropriate and that the instant Opposition should be dismissed for the reasons set forth in Applicant's Motion for Summary Judgment.

In the event Applicant's Motion for Summary Judgment is granted, it will be dispositive of all of the issues pending before the Board, and the Opposition will be dismissed. As such, it is in the interests of judicial economy here for the Board to decide Applicant's Motion for Summary Judgment, prior to ruling on Opposer's request to suspend these proceedings.

In the alternative event that Applicant's Motion for Summary Judgment is denied, Applicant has no objection to the suspension of the Opposition proceeding, as the litigation that is currently pending in the Southern District of New York entitled *YLD Limited v. The Node Firm, LLC et al.*, Civil Action No. 1:15-cv-00855 (the "Pending Civil Action"), presents issues that are similar to the issues presented in this Opposition proceeding.

CONCLUSION

Based upon the foregoing, Applicant's Motion for Summary Judgment should be decided prior to Opposer's Motion to Suspend. In the event that Applicant's Motion for Summary Judgment is granted, Opposer's application will be moot. In the alternative event that summary judgment is denied, Applicant does not oppose the suspension of this proceeding pending the outcome of the Pending Civil Action.

Dated: New York, New York
October 29, 2015

Respectfully Submitted,

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THE NODE FIRM, LLC

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the 29th day of October, 2015, a true and accurate copy of the foregoing **APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO SUSPEND PROCEEDINGS** was served within the time permitted by the Board rules *via* first class mail to the following addressee(s):

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New York, NY 10036
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Dated: _____

10/29/15

Signature: _____


LAURA LAGONE