

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

Mailed: January 31, 2016

Opposition No. 91221438

*The Node Firm, LLC*

v.

*YLD Limited*

George C. Pologeorgis,  
Administrative Trademark Judge:

This proceeding now comes before the Board for consideration of YLD Limited's ("Applicant") converted motion (filed May 19, 2015) for summary judgment; and (2) The Node Firm, LLC's ("Opposer") motion (filed October 9, 2015) to suspend this proceeding pending the disposition of a civil action between the parties herein. Both motions are briefed.

### **Background**

On January 24, 2014, Applicant filed an application seeking to register the mark THE NODE FIRM, in standard characters, for "Computer programming; Computer programming consultancy; Computer software consulting; Computer software development and computer programming development for others; Creating of computer programs" in International Class 42.<sup>1</sup> Applicant's application was

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<sup>1</sup> Application Serial No. 86174797, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming November 28, 2011 as both the date of first use and the date of first use in commerce. The term FIRM is disclaimed.

published for opposition on October 7, 2014. On November 5, 2014, an entity known as Node Source, LLC filed a request to extend its time to oppose Applicant's involved application until February 4, 2015. On November 5, 2014, the Board granted the request. Then again on February 4, 2015, Node Source, LLC filed another request to extend its time to oppose Applicant's involved application until April 5, 2015. The request was once again granted by the Board.

On April 6, 2015,<sup>2</sup> Opposer filed a notice of opposition opposing the registration of Applicant's involved mark on the following grounds: (1) Applicant's involved application is void *ab initio* because Applicant was not using its applied-for mark in commerce as of the filing date of its use-based application; (2) Applicant's involved application is void *ab initio* because the identified services relied upon to support Applicant's use-based application were performed for the benefit of Opposer; (3) fraud; (4) Applicant's involved mark is merely descriptive of the identified services and has not acquired distinctiveness. 15 U.S.C. §§ 1152(e)(1) and 1152(f); (5) abandonment under Section 45 of the Trademark Act, 15 U.S.C. § 1127; (6) false suggestion of a connection under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a); and (7) likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

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<sup>2</sup> The Board notes that the extension expiration date for filing a notice of opposition regarding Applicant's involved application, i.e., April 5, 2015, fell on a Sunday. The Board further notes that if the expiration date falls on a Saturday, Sunday, or a federal holiday within the District of Columbia, an opposition, or a request for a further extension, filed by the potential opposer on the next succeeding day which is not a Saturday, Sunday, or a federal holiday will be considered timely. *See* Trademark Rule 2.196; TBMP § 209.02 (2015).

In lieu of filing an answer to the notice of opposition, Applicant filed a motion to dismiss the opposition under Fed. R. Civ. P. 12(b)(1) on the ground that the opposition was untimely and as such the Board lacks jurisdiction over this proceeding. Specifically, Applicant maintains that Opposer did not request any extension of time to oppose Applicant's involved application, nor was it granted any such extension. Additionally, Applicant contends that although Opposer has made the conclusory allegation in its notice of opposition that it is in privity with the entity that did request and was granted the two extensions of time to oppose, i.e., The Node Source, LLC, there has been no showing of such privity here, nor are there facts pleaded in Opposer's notice of opposition that would satisfy the standard of making a "showing" of privity. Because Opposer has failed to make this showing, through its pleading or otherwise, Applicant argues that Opposer cannot claim that it should be entitled to the benefits of the extensions granted to the non-party The Node Source, LLC and, therefore, the opposition is untimely and should be dismissed as the Board does not have jurisdiction to entertain the matter.

By order dated September 9, 2015, the Board converted Applicant's motion to dismiss to a motion for summary judgment and allowed the parties time to brief further the issues presented in Applicant's motion. Opposer filed a supplemental brief in support of its opposition to Applicant's converted motion for summary judgment on October 9, 2015. Applicant, however, did not file a supplemental brief in support of its converted motion. Opposer also filed its motion to suspend for civil

action on October 9, 2015. Applicant filed a timely response to Opposer's motion to suspend on October 29, 2015.

**Opposer's Motion To Suspend For Civil Action**

Trademark Rule 2.117(b) provides as follows:

Whenever there is pending before the Board both a motion to suspend and a motion which is potentially dispositive of the case, the potentially dispositive motion *may* be decided before the question of suspension is considered regardless of the order in which the motions were filed.

(emphasis added).

While the Board acknowledges that Applicant's converted motion for summary judgment is potentially dispositive of this case, Trademark Rule 2.117(b) does not mandate that the Board entertain Applicant's motion prior to Opposer's motion to suspend for civil action. *See* TBMP § 510.02(a) (the Board, in its discretion, may elect to suspend without first deciding the potentially dispositive motion.). In this instance, the Board, pursuant to its inherent authority to manage its own docket and in the interest of judicial economy, elects to entertain Opposer's motion to suspend for civil action first because, as noted below, the Board finds that the final disposition of the civil action will have a direct bearing on this issues in this case, including the issues raised in Applicant's converted motion for summary judgment.

The Board now turns to Opposer's motion to suspend for civil action. In support thereof, Opposer contends that Applicant filed a civil action in the United States District Court for the Southern District of New York which names both Opposer and the entity that filed the extensions of time to oppose Applicant's involved

application, namely, The Node Source, LLC, as party defendants.<sup>3</sup> Opposer further maintains that because this opposition and the pending civil action involve several material issues in common, including issues of ownership rights in the mark THE NODE FIRM, suspension of this case pending the disposition of the civil action is warranted.

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).

The Board has carefully reviewed the amended civil action complaint, as well as the answer to the amended complaint and corresponding counterclaims, that Opposer submitted concurrently with its motion to suspend. By way of its amended civil complaint, Applicant seeks, *inter alia*, an injunction (1) enjoining Opposer, as well as the entity which filed the extensions of time to oppose Applicant's involved application, i.e., Node Source LLC, from using "THE NODE FIRM" name as a trademark/service mark, and (2) enjoining Opposer and Node Source, LLC from opposing the application for, or petitioning for the cancellation of, any registration for "The Node Firm" that Applicant has applied for or may apply for in the future.

By way of their civil action counterclaim, Opposer and Node Source LLC seek, among other things, a declaratory judgment that they have not infringed Applicant's alleged trademark rights in the mark THE NODE FIRM. Additionally, Opposer and Node Source, LLC have asserted a counterclaim contending, *inter alia*,

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<sup>3</sup> Case No. 15-cv-00855, styled *YLD Limited v. The Node Firm, LLC, Node Source, LLC, NodeSource, Inc., Daniel Shaw, and Joe McCann*, filed on or about May 28, 2015.

that (1) Applicant's pleaded THE NODE FIRM mark is merely descriptive and has not acquired distinctiveness and, therefore, the trademark is invalid; and (2) Applicant's use of the mark THE NODE FIRM is likely to cause confusion with Opposer and Node Source LLC's use of the same mark.

Based upon the foregoing, the Board finds that a decision by the district court would have a direct bearing on the issues in this opposition proceeding, including, at a minimum, Opposer's standing to pursue this opposition proceeding, as well as issues concerning Opposer's asserted claim of likelihood of confusion. 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.

Accordingly, Opposer's motion to suspend this proceeding pending the final disposition of the civil action between the parties herein is **GRANTED**.

Proceedings are therefore **suspended** pending the final disposition of the civil action, including all appeals.<sup>4</sup> In view of this suspension, Applicant's converted motion for summary judgment is denied **without prejudice**.

Within twenty days after the final determination of the civil action, the parties shall so notify the Board in writing, including a copy of the court's final order.

If Applicant believes its converted motion for summary judgment at the time of suspension and denied without prejudice by this order was not resolved or made moot by the civil action, Applicant may renew the motion by citing its title, date of

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<sup>4</sup> A proceeding is considered to have been finally determined when an order or ruling that ends the litigation has been rendered, and no appeal has been filed, or all appeals filed have been decided. TBMP § 510.02(b) (2015).

filing, and docket entry in the Board's electronic proceeding file. Any motion renewed must be accompanied by a signed statement that the motion has been reviewed in its entirety and concerns matters still disputed between the parties.

If the renewed motion was contested at the time of suspension, as is the case here, and Opposer, as the non-moving party, believes that its original response requires supplementation in view of events since suspension, Opposer has FIFTEEN DAYS from the date of service of the renewal of the motion to file a supplemental response.

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

### **Pleading Issues**

As a final matter, the Board finds that Opposer has not properly pleaded its asserted claims of false suggestion of a connection or abandonment for the reasons set forth below. Additionally, Opposer has not set forth sufficient allegations in its pleading which demonstrate a showing that Opposer is in privity with the entity that filed the two extensions of time to oppose Applicant's involved application.

#### *False Suggestion of A Connection*

In order to assert properly a ground of false suggestion of a connection under Section 2(a) of the Trademark Act, Opposer must plead that (1) Applicant's mark is

the same or a close approximation of Opposer's previously used name or identity; (2) that the mark would be recognized as such, in that it points uniquely and unmistakably to Opposer; (3) that Opposer is not connected with the services rendered under Applicant's mark; and (4) that Opposer's name or identity is of sufficient fame or reputation that when Applicant's mark is used on its identified services, a connection with Opposer would be presumed. *Petróleos Mexicanos V. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008).

In its notice of opposition, Opposer alleges the following:

Paragraph 42

Through Opposer's use of THE NODE FIRM to identify Opposer's services such mark has acquired significant value and goodwill as a source of Opposer's services, and is closely associated with Opposer, its owners and employees, and work performed by them or on their behalf.

Paragraph 43

Opposer alleges in the alternative that, if Applicant, or any predecessor thereof, has at any time used the Offending Mark in connection with the Offending Services on Applicant's behalf, such use falsely suggests a connection with Opposer, and therefore violates the rights of Opposer under Section 2(a) of the Trademark Act.

The foregoing allegations do not properly state a claim of false suggestion of a connection. Specifically, Opposer has failed to allege that Applicant's mark is the same or close approximation of Opposer's *identity* and that Applicant's involved mark would be recognized as such, i.e., that it points uniquely and unmistakably to Opposer's persona and/or identity. Further, Opposer has failed to allege that

Opposer's identity and/or persona (not its pleaded mark, unless Opposer also claims that its pleaded mark *is* its identity) is of sufficient fame or reputation that when Applicant's mark is used on Applicant's identified services, a connection with Opposer would be presumed. Finally, Opposer has not alleged that it is not connected with the services rendered by Applicant under Applicant's involved mark.

In view of the foregoing, the Board finds that Opposer's claim of false suggestion of a connection is deficiently pleaded.

*Abandonment*

Opposer has asserted the following allegations to support its claim of abandonment:

“Opposer alleges in the alternative that, if Applicant, or any predecessor thereof, has at any time used the Offending Mark in connection with the Offending Services on Applicant's behalf: (a) the Offending Mark has not been used in connection with the Offending services by or on behalf of Applicant or any predecessor thereof for several years; and (b) Applicant has an intent not to resume use of the Offending Mark in connection with the Offending Services.”

See ¶ 40 of Opposer's notice of opposition.

In order to set forth a sufficient claim of abandonment, the plaintiff must plead ultimate facts pertaining to the alleged abandonment, thus providing fair notice to the defendant of plaintiff's theory of abandonment. *Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007). In this context, a mark is abandoned “[w]hen its use has been discontinued with intent not to resume such use. ... Nonuse for 3 consecutive years shall be prima facie evidence of abandonment.” Trademark Act Section 45, 15 U.S.C. § 1127. Therefore, to adequately plead such a claim, a plaintiff must recite facts which, if proven, would establish at least three consecutive years of nonuse, or alternatively, a period of nonuse less than three

years coupled with proof of intent not to resume use. *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990).

In this instance, Opposer has not pleaded any ultimate facts to support its allegations that Applicant has abandoned use of its involved THE NODE FIRM mark. Specifically, Opposer's pleading fails to set forth any facts regarding when the purported abandonment took place and/or a course of conduct that has resulted in an abandonment of Applicant's involved mark over a certain time period. Accordingly, the Board finds that Opposer has failed to plead properly a claim of abandonment.

The Board will reset trial dates upon resumption of the proceeding, if necessary and appropriate, including time for Opposer to file an amended pleading, pursuant to the guidelines set forth herein, which properly states a claim of abandonment and false suggestion of a connection, failing which these claims will be dismissed. Additionally, the Board will allow Opposer to include in its amended pleading allegations which provide a sufficient showing that Opposer is in privity with the entity that filed the two extensions of time to oppose Applicant's involved application.