

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: November 30, 2015

Opposition No. 91223243

DCS Investment Holdings, LLC

v.

Bella Collina Events LLC

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

Bella Collina Events LLC (“Applicant”) seeks to register the mark BELLA COLLINA EVENTS, in standard characters, for “Planning and arranging of wedding ceremonies; Providing facilities for wedding ceremonies; Wedding ceremony planning and arranging consultation services” in International Class 45.¹

On August 11, 2015, DCS Investment Holdings, LLC (“Opposer”) filed a notice of opposition opposing the registration of Applicant’s mark on the following grounds: (1) likelihood of confusion, (2) dilution, and (3) fraud. In support of its asserted claims, Opposer alleges, *inter alia*, prior common law use of the mark BELLA COLLINA used in connection with the development, marketing, promotion, and sale of wedding services and facilities. Additionally, Opposer has claimed ownership

¹ Application Serial No. 86362378, filed on August 11, 2014, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, claiming February 16, 2013 as both the date of first use and the date of first use in commerce. The term “EVENTS” is disclaimed.

of two pending applications, one for the mark BC BELLA COLLINA and design and the other for BELLA COLLINA, both for “Party and wedding reception planning, coordination and consultation services; Special event planning for social entertainment purposes; Providing country club and golf facilities.”²

Pursuant to the Board’s August 11, 2015, institution order, the deadline for Applicant to file an answer to the notice of opposition was set for September 20, 2015. In lieu of filing an answer, Applicant filed a motion to suspend this opposition pending the disposition of two civil actions on September 3, 2015.

This proceeding now comes before the Board for consideration of (1) Applicant’s motion (filed September 3, 2015) to suspend this proceeding pending the final disposition of a civil action between Applicant and a related company of Opposer filed in the U.S. District Court for the Middle District of North Carolina,³ as well as a civil action between the same parties in the U.S. District Court for the Middle District of Florida, Ocala Division,⁴ and (2) Applicant’s motion (filed September 17, 2015) to extend its time to answer. Applicant included copies of the civil action complaints for the North Carolina and Florida federal litigations, as well as the answer and counterclaim filed by Opposer’s alleged related company in the federal

² The Board notes that Opposer also pleaded ownership of Registration No. 2936715 for the mark BELLA COLINA, in standard characters, for “real estate development and construction services, namely, planning and developing an upscale residential golf community and resort.” The Board notes, however, that this registration was canceled on October 30, 2015 for failure to file a timely Section 8 affidavit. In view thereof, Opposer may not rely on this pleaded registration in support of its pleaded claims for opposition.

³ Civil Action No. 1:15-cv-00007, styled *Bella Collina Events, LLC v. DCS Real Estate Investments, LLC*, filed on or about January 7, 2015.

⁴ Civil Action No. 5:14-cv-00678, styled, *DCS Real Estate Investments, LLC v. Bella Collina Events, LLC*, filed on or about December 11, 2014.

civil action in North Carolina. Applicant's motion to suspend for civil action is fully briefed.⁵

Applicant's Motion To Suspend For Civil Action

In support of its motion, Applicant maintains that suspension of this opposition proceeding is warranted because the civil actions involve Applicant and an alleged related company to Opposer, the same trademarks, and common issues of law and fact. Additionally, Applicant argues that although two different DCS entities are involved in the Board case and the civil actions, it is clear from the similarities of each entity's allegations that the underlying ownership, rights, and alleged uses are identical, i.e., the rights in the registered BELLA COLLINA mark, common law rights, and the pending applications for the BELLA COLLINA and BC BELLA COLLINA marks. In view thereof, Applicant contends that any determination made by either of the district courts would have a bearing on this proceeding.

In response, Opposer argues that the issues in this proceeding differ substantially from the issues in the pending civil actions, namely, Applicant, in the North Carolina district court action, seeks a declaratory judgment regarding Applicant's involved mark within a limited geographic area while this opposition proceeding addresses Applicant's alleged nationwide rights in the BELLA

⁵ The Board notes that Opposer filed an unopposed motion to extend its time to respond to Applicant's motion up to and including September 23, 2015. As noted above, Applicant filed and served its motion to suspend on September 3, 2015 which made Opposer's response to the motion due on September 23, 2015. *See* Trademark Rules 2.127 and 2.119(c). Accordingly, Opposer's motion to extend is deemed unnecessary and has therefore been given no consideration.

COLLINA EVENTS mark. Moreover, Opposer maintains that fraud is not an issue in the district court actions.

In reply, Applicant reiterates its position that there are common issues of law and fact that will be addressed by both the district courts and the Board. Additionally and contrary to Opposer's contentions, Applicant argues that the issue of fraud is asserted by Opposer's alleged related company, as a counterclaim, in the federal civil action in North Carolina.

Decision

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 civil action pleadings in both federal litigations and finds that a decision by either district court would have a bearing on the issues in this opposition proceeding. Specifically, the Board notes that Opposer's alleged related company, i.e., DCS Real Estate Investments, LLC, seeks to, among other things, permanently enjoin Applicant from using its involved BELLA COLLINA EVENTS mark as a requested relief in both the Florida and North Carolina district court actions. Additionally, Opposer's alleged related company has interposed, in the North Carolina civil action, a claim that Applicant is fraudulently attempting to register its involved mark. Lastly, Applicant is seeking a declaratory judgment in the North Carolina civil action that Applicant has not infringed and has not violated Opposer's alleged related company's rights to the BELLA

COLLINA mark. Clearly, the resolution of the aforementioned claims will have a bearing on the issues in this opposition proceeding.

Furthermore, Board decisions are appealable to the district court. *See* Section 21(b) of the Trademark Act, 15 U.S.C. § 1071(b). Finally, suspending this matter pending the final determination of the civil actions will serve the interests of judicial economy.

Accordingly, Applicant's motion to suspend this proceeding for civil action is **GRANTED** as well taken and this proceeding is, therefore, **suspended** pending the final disposition of both civil actions, including all appeals.⁶

Within twenty days after the final determination of the civil actions, the parties shall so notify the Board so that this proceeding may be called up for appropriate action.⁷ Such notification to the Board should include a copy of any final order or final judgment which issued in each of the civil actions.

The Board will reset trial dates upon resumption of the proceeding, if necessary and appropriate. 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

⁶ In light of the Board's ruling herein and because proceedings are deemed suspended as of the filing date of Applicant's motion to suspend for civil action, Applicant's motion (filed September 17, 2015) to extend its time to answer the notice of opposition is **deemed moot** and will be given no further consideration. Notwithstanding, the Board notes that Applicant already filed its answer on October 20, 2015 and therefore the answer is noted and accepted. Moreover, Applicant's consented motion to extend trial dates filed on October 20, 2015 is also deemed moot. In view thereof, the Board's October 20, 2015, order granting Applicant's consented motion to extend is hereby **VACATED** in light of this order.

⁷ 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) (2015).

Opposition No. 91223243

to promptly inform 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.