UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

EJW

Mailed: February 28, 2010

Opposition No.	**91179064**
Opposition No.	91182358
Opposition No.	91183644
Opposition No.	91186026
Opposition No.	91187261
Opposition No.	91188860
Opposition No.	91191230
Opposition No.	91192691
Cancellation No.	92046853

Stephen Slesinger, Inc.

v.

Disney Enterprises, Inc.

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

Applicant's Requests/Motion to Dismiss and other Pending Matters

On October 18, 2009, applicant filed a "notice of final determination of civil action" in eight of the nine above-referenced cases, which includes a request that these proceedings be dismissed in view of the assertedly final determination by the U.S. District Court. In Opposition No. 91192691, the most recently-instituted of these proceedings, applicant filed a motion to dismiss on

December 23, 2009.[1] In all proceedings, opposer has filed a brief opposing the respective requests and motion to dismiss and, in the alternative to proceeding forward in these proceedings, opposer requests that the Board continue the suspension of these proceedings[2] pending the outcome of opposer's appeal of the final decision in the civil action. For the reasons discussed herein, **consideration of applicant's notices requesting dismissal and motion to dismiss is deferred.**[3] *See* TBMP § 510.02(a) ("… the Board, in its discretion, may elect to suspend without first deciding the potentially dispositive motion"). Nonetheless, the Board now considers opposer's alternative cross-motion to continue the suspension of these proceedings. Also under consideration are the parties'

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[1] Whereas Opposition No. 91192691 has been suspended pending consideration of the motion to dismiss, all other proceedings herein have previously been suspended pending the resolution of the civil action pending in the U.S. District Court for the Central District of California, Western Division, Case no. CV-02-08508 FMC (PLAx).

[2] Opposition No. 91187261 has already been suspended pending the appeal (see Board's order mailed December 18, 2009).

[3] The Board will address its construction of the requests to dismiss these proceedings set forth in the notices of final determination upon consideration of applicant's motion to dismiss filed in Opposition No. 91192691 (see Board's order mailed in Opposition No. 91187261 on December 18, 2009, note 3) upon resumption of these consolidated proceedings.

respective uncontested motions to consolidate these proceedings.

Consolidation

The Board notes that on January 15, 2010, applicant separately-filed in Opposition No. 91179064 a "notice of filing motion to consolidate" and a motion to consolidate the above-identified proceedings; and that on January 21, 2010, instead of filing a responsive brief thereto, opposer filed a motion to consolidate the above-referenced proceedings.

Similarly, in Opposition No. 91187261, opposer and applicant filed on January 15, 2010 separate motions to consolidate all referenced proceedings; and in Opposition Nos. 91182358, 91183644, 91186026, 91188860, 91191230, 91192691, and Cancellation No. 92046853, applicant filed the same "notice of filing motion to consolidate" discussed above. Opposer has not filed responses in connection with the notices filed in the seven other proceedings.

When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. *See* Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154

(TTAB 1991); and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991).

The Board has reviewed the records in the above-referenced cases and finds that Opposition Nos. 91179064, 91182358, 91183644, 91186026, 91187261, 91188860, 91191230, 91192691, and Cancellation No. 92046853 all involve the same parties and common questions of law and fact. Additionally, the parties agree that consolidation is appropriate. In view of the foregoing, the respective motions to consolidate are hereby granted. *See* Fed. R. Civ. P. 42(a); and Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a). *See also* TBMP § 511 (2d ed. rev. 2004).

Accordingly, **the above-noted oppositions and cancellation proceedings are hereby consolidated** and may be presented on the same record and briefs; that is, the parties must file a *single copy* of any document submitted to the Board, bearing the number of each consolidated case in ascending order as set forth above. The Board file for these consolidated proceedings will be maintained in Opposition No. 91179064 as the "parent case," and the parties hereafter should no longer file separate papers in connection with each proceeding. However, should the

requests/motion to dismiss be denied, an answer must be filed in each proceeding.

The parties are reminded that consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment. *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). *See also* Wright & Miller, 9A Fed. Prac. & Proc. Civ. § 2382 (3d ed. 2009). 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.

Suspension of Proceedings

In response to applicant's "notice of final determination of civil action" (including a request for dismissal) and motion to dismiss filed in the respective proceedings (as outlined above), and in the alternative to the Board going forward with the proceedings, opposer requests that the Board maintain the suspension of the eight proceedings (response to notice, pp. 2 and 4) and suspend Opposition No. 91192691 (response to motion to dismiss, p. 5) pending final determination of the

referenced civil action. In the earlier-filed proceedings, opposer argues that the final disposition of the civil action has not yet occurred; that the civil action will not be concluded "until such time as all appeals have been exhausted or the matter has been settled" (response to notice, p. 4); and that in accordance with Trademark Rule 2.117(a), these proceedings should remain suspended until termination of the civil action.

Applicant asserts that the District Court's order is "immediately final and preclusive on the issue of ownership, regardless of [opposer's] appeal to the Ninth Circuit" (reply brief in support of notice/motion to dismiss, p. 3); that the asserted preclusive effects of the District Court judgment cannot be suspended simply by opposer's undecided appeal; and that the Board should now consider applicant's motion to dismiss.

The Board generally maintains the suspension of a proceeding until the civil action which occasioned the suspension of the Board proceeding is considered to have been finally determined, that is, when a decision on the merits of the case has been rendered, and no appeal has been filed therefrom, or all appeals filed have been decided. *See* TBMP § 510.02(b) (2d ed. rev. 2004).

Likewise, in regard to Opposition No. 91192691 which has been suspended only in connection with applicant's motion to dismiss, it is the policy of the Board to suspend proceedings when the parties are involved in a civil action that may be dispositive of or have a bearing on the Board case. *See General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992); and Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a).

Here, opposer has filed a notice of appeal in regard to the final judgment of the District Court entered on October 7, 2009 and with regard to other interlocutory orders therein (see Exh. N to applicant's motion to consolidate filed in Opposition Nos. 91179064 and 91187261); and the parties have not informed the Board that the appeal is no longer pending. Thus, clearly, in accordance with Trademark Rule 2.117(a), well-established Board policy, and the Board's order mailed on December 18, 2009 in Opposition No. 91187621, the suspension of the eight already suspended proceedings must be maintained while opposer's appeal of the civil action remains pending. Additionally, at issue in the civil action are, *inter alia*, the respective parties' ownership rights in the various

"Pooh trademarks".[4] Therefore, it is equally clear that the outcome of the civil action discussed herein may be dispositive of or have a bearing on Opposition No. 91192691 and that it should also be suspended under Trademark Rule 2.117(a).

Accordingly, because the civil action pending between the parties (see note 1, *supra*) has not yet been finally resolved, **these consolidated proceedings remain and are SUSPENDED pending the final determination of said civil action**. Applicant's notices requesting dismissal and its motion to dismiss will be considered upon resumption of these consolidated proceedings.

Within twenty days after such final determination, the parties shall so notify the Board and call up this

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[4] In the Board's order mailed March 5, 2008 in Opposition No. 91179064, the Board noted as follows:

> In paragraph 126 of its fourth amended answer and counterclaims in the civil action, opposer herein (as the defendant/counterclaim plaintiff in the civil action) alleges *inter alia* that it is "an owner of rights in and to the Pooh trademarks." Opposer further alleges in paragraph 130 thereof that "all use by Disney has been pursuant to a license." This opposition proceeding likewise directly concerns opposer's rights in the "Pooh marks" (see ¶¶ 2, 3 and 14 of the notice of opposition).

Paragraphs 2, 3, 15, and 16 of the notice of opposition in Opposition No. 91192691 contain the same or similar allegations.

proceeding for appropriate action.[5] During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.

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[5] The parties are reminded that, should these proceedings resume, the parties will be expected to address, as appropriate, the issue of the sufficiency of the present pleadings of fraud on the USPTO (see Board's order mailed December 18, 2009 in Opposition No. 91187261). *See In re Bose Corporation*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009). *See also Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478 (TTAB 2009).