

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

Mailed: January 15, 2009

Opposition No. 91187346 (parent)
Cancellation No. 92050154

Spirits International B.V.,
and S.P.I. Spirits (Cyprus)
Limited

v.

Roust Trading Limited

**Robert H. Coggins,
Interlocutory Attorney:**

These cases now come up on opposers/petitioners' motion (filed January 2, 2009 in each proceeding) for summary judgment on the grounds of *res judicata*, and on applicant/respondent's motion (filed January 7, 2009 in each proceeding) to suspend proceedings pending disposition of a civil action between the parties.

Consolidation

Before addressing the outstanding motions the Board addresses the issue of consolidation *sua sponte*. It has come to the attention of the Board that Opposition No. 91187346 and Cancellation No. 92050154 involve the same parties, identical goods, and common questions of law and

fact. It would therefore be appropriate to consolidate these proceedings pursuant to Fed. R. Civ. P. 42(a).

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, for example, Wright & Miller, Federal Practice and Procedure: Civil* § 2383 (2004); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) (Board's initiative).

Accordingly, the above-noted opposition and cancellation proceedings are hereby consolidated and may be presented on the same record and briefs. *See Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989), and *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1432 (TTAB 1993).

The Board file will be maintained in Opposition No. 91187346 as the "parent" case. The parties should no longer file separate papers (except for the answers) in connection with each proceeding. Only a single copy of each paper should be filed by the parties in the parent case, and each paper should bear the case caption as set forth above. An exception to this general rule will be the answers which should be filed separately at the appropriate time.

Motion to Suspend for Civil Action

The Board exercises its discretion to determine the motion prior to the expiration of opposers/petitioners' time for filing a brief in opposition thereto. The Board is aware that the issue of suspension of Board proceedings involving the instant parties and based on the same civil action has previously come before the Board in related Board proceeding Cancellation No. 92047125. It will come as no surprise to any of the parties that the Board may, in its discretion, suspend proceedings for a civil action even when one party, as in each of these consolidated proceedings, has previously filed a motion for summary judgment. See Trademark Rule 2.117(b) (Using the word "may" which inherently implies the Board's authority to conclude that a potentially dispositive motion should not be decided, and instead that the case should be suspended); *see also* the Director's January 31, 2008 petition decision for Cancellation No. 92047125. The Board notes that the civil action was filed prior to filing of either of the consolidated opposition or cancellation proceedings.

Inasmuch as the parties to the instant cancellation proceeding are also parties to Civil Action No. 06-CIV-9915 in the United States District Court for the Southern District of New York, the issues before the court in the civil action include issues in common with those in the consolidated opposition and cancellation proceedings, and

the issues before the court in the civil action may have a bearing on the rights of the parties in the Board cases even if such bearing may not be dispositive of the Board cases, applicant/respondent's motion to suspend Board proceedings pending final determination of a civil action between the parties is hereby granted as well taken. See Trademark Rule 2.117(a) and *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992). Accordingly, proceedings are suspended pending final disposition of the civil action between the parties.

Within twenty days after the final determination of the civil action, the parties shall so notify the Board so these consolidated proceedings may be called up for appropriate action (including resetting applicant/respondent's time in which to file a brief in opposition to the motions for summary judgment). During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.

Motion for Summary Judgment

Inasmuch as proceedings are suspended herein, determination of the motions for summary judgment is deferred. Upon resumption of proceedings, applicant/respondent's time in which to file a brief in opposition to the motions for summary judgment will be reset, if appropriate.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>