

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

Mailed: August 23, 2010

**Opposition No. 91194803  
(parent case)**

**Cancellation No. 92052525**

Kohl's Department Stores,  
Inc.

v.

Peace & Love Jewelry By Nancy  
Davis LLC

Jennifer Krisp, Interlocutory Attorney:

Consolidation

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

Upon review, consolidation is appropriate with respect to Opposition No. 91194803 and Cancellation No. 92052525. Accordingly, these 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); *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993).

The consolidated proceeding file will be maintained in Opposition No. 91194803 as the "parent case." From this

Opposition No. 91194803  
Cancellation No. 92052525

point on, only a single copy of all motions and papers should be filed in the parent case, and must caption both consolidated proceedings, listing and identifying the parent case first, as in the caption to this order.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings, and a copy of the decision shall be filed in each proceeding.

Respondent's motion to suspend Cancellation No. 92052525

Cancellation No. 92052525 is before the Board for consideration of Peace & Love Jewelry by Nancy Davis LLC's ("respondent") motion (filed July 15, 2010) to suspend proceedings pending disposition of a civil action, namely, *Peace & Love Jewelry by Nancy Davis LLC vs. Kohl's Department Stores, Inc.*, Case No. 2:10-cv-004170, which is currently pending before the United States District Court for the Central District of California. The motion has been fully briefed.

With its motion, respondent filed a copy of the pleadings from the civil action, in compliance with TBMP § 510.02(a) (2d ed. rev. 2004). Respondent argues, inter alia, that the infringement, unfair competition and other claims set forth in the civil action bear directly on Cancellation No. 92052525 inasmuch as they concern the same marks. It notes that the District Court action, by way of the granting therein of respondent's motion for leave to file a supplemental complaint, involves respondent's recently-issued Registrations Nos.

Opposition No. 91194803  
Cancellation No. 92052525

3779506 and 3779507, the two registrations which are subject to cancellation in this Board proceeding.

In response, Kohl's Department Stores, Inc. ("petitioner") argues, inter alia, that the trademarks and the goods at issue in the civil case, as originally filed, are not the same as, and should not be deemed to be dispositive of or to have a bearing on the cancellation proceeding because trademark rights for one category of goods are not dispositive of such rights in a different category of goods. Petitioner also argues that the Board has particular expertise in adjudicating the disputes at issue in the proceeding.

It is generally the policy of the Board to suspend proceedings before it when the parties are involved in a civil action which may be dispositive of or may have a bearing on the Board case, until the termination of such civil action. See Trademark Rule 2.117(a). To the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the district court is often binding on the Board, while the decision of the Board is not binding on the district court. See, e.g., *Goya Foods Inv. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir. 1988); *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F Supp 563, 2 USPQ2d 1208 (D.Minn 1986). See also TBMP § 510.02(a) (2d ed. rev. 2004). Suspension of a Board proceeding pending the final determination of another

proceeding is solely within the discretion of the Board.

*Id.*

It is noted that the Board is an administrative tribunal with limited jurisdiction, and that said jurisdiction does not include claims for infringement. The Board is empowered to determine only the right to register, and is not empowered to determine the right to use, or broader issues of infringement or unfair competition, see TBMP § 102.01 (2d ed. rev. 2004), nor is the Board empowered to render declaratory judgment. *See, e.g., Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460, 1464 (TTAB 1992).

At a minimum, the outcome of the infringement claims now pending before the District Court may have a bearing on either party's continued use of one or more of its marks, with respect to all or certain of the involved or pleaded goods. Here, both parties have raised the issue of infringement before the District Court. Furthermore, petitioner's counterclaim before the District Court seeks declaratory judgment with respect to non-infringement, and respondent's alleged descriptive and ornamental use, and thereby raises issues that are either identical to or similar to some of the issues which petitioner has raised by way of its petition to cancel which is before the Board.

Upon thorough review of the pleadings filed in the District Court case, the Board finds that suspension of

Opposition No. 91194803  
Cancellation No. 92052525

these consolidated proceedings under Trademark Rule 2.117(a) is appropriate.

Accordingly, respondent's motion for suspension is granted. These consolidated proceedings are hereby suspended pending final disposition of the District Court case.<sup>1</sup>

Within twenty (20) days after the final determination of the civil action, the parties shall so notify the Board and call this case up for any appropriate action.<sup>2</sup>

During the suspension period, the parties shall notify the Board of any street or electronic mail address changes for the parties or their attorneys.

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<sup>1</sup> It is noted that proceedings were previously suspended in Opposition No. 91194803.

<sup>2</sup> 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 therefrom have been decided. See TBMP § 510.02(b) (2d ed. rev. 2004).