

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

MBA

Mailed: May 3, 2011

Opposition No. 91167875
Opposition No. 91190567
Opposition No. 91190574
Opposition No. 91192163
Opposition No. 91192164
Cancellation No. 92053414

Gilmar S.p.A.

v.

Icebreaker Limited

Michael B. Adlin, Interlocutory Attorney:

This case now comes up for consideration of applicant/petitioner's ("applicant") motion, filed March 15, 2011, to suspend this proceeding pending final resolution of a filed, but not-yet-served, civil action between the parties (Icebreaker Limited v. Gilmar S.p.A., Case No. 3:11-cv-309-BR, pending in the U.S. District Court for the District of Oregon) (the "Federal Case"). The motion is fully briefed.

This Case

Applicant seeks registration of ICEBREAKER, and variations thereof, for a variety of apparel products and

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related services,¹ and in its notices of opposition, opposer/respondent ("opposer") alleges prior use and registration² of ICE, ICEBERG and variations thereof for apparel products, and that use of applicant's marks is likely to cause confusion with opposer's marks. In its answer, applicant denies the salient allegations in the notices of opposition and counterclaims for cancellation of eight of opposer's pleaded registrations based on abandonment. Opposer denies the salient allegations in the counterclaims.

While the oldest of these proceedings has been pending for over five years, applicant filed its counterclaims for abandonment very recently. Pursuant to the Board's order of March 1, 2011, discovery is scheduled to close on October 20, 2011.

The Federal Case

Applicant is the plaintiff in the Federal Case, and therein seeks a declaratory judgment that its use of ICEBREAKER for apparel and related services does not infringe on opposer's ICE and ICEBERG marks, including some of the marks opposer relies on in this consolidated proceeding. Applicant specifically alleges in the Federal

¹ Application Serial Nos. 76528102, 78683671, 78683696, 77212963 and 77212966.

² Registration Nos. 1269297, 1850734, 1477299, 2222782, 1477298, 1595934, 2518973 and 2909353.

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Case that "[t]here is no likelihood of confusion" between the parties' marks which are involved in both this consolidated proceeding and the Federal Case. In addition, in the Federal Case applicant seeks cancellation of the same eight registrations which applicant counterclaims to cancel in this proceeding, also based on alleged abandonment.

Motion to Suspend

Applicant argues that the "outcome" of its claims in the Federal Case will "have significant bearing" on this proceeding, if not be dispositive of this proceeding. Applicant specifically claims that the parties have not conducted any discovery in this proceeding regarding applicant's counterclaims.

Opposer argues, however, that the Federal Case is "merely a tactic to further delay the already long-overdue adjudication" of opposer's claims here.³ According to opposer, this case "is finally nearing its end," discovery herein is complete, and even if applicant prevails on its counterclaims, one of opposer's pleaded but unchallenged registrations would "provide sufficient basis for [opposer] to prevail in this proceeding." Finally, opposer argues

³ Applicant alleges that opposer's opposition to the motion to suspend was not properly served, but it is clear from applicant's reply brief that applicant received opposer's opposition and was able to respond to it. Disregarding opposer's opposition for improper service would elevate form over substance and be inappropriate under the circumstances. Opposer is reminded, however, of its obligation to comply with Trademark Rule 2.119.

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that because applicant has yet to serve the Complaint in the Federal Case, that proceeding is not "even truly underway."

The Board's well-settled policy is 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. Trademark Rule 2.117(a); General Motors Corp. v. Cadillac Club Fashions Inc., 22 USPQ2d 1933, 1937 (TTAB 1992). Here, because the issues in the Federal Case overlap with those here, the Federal Case "may have a bearing" on this one, and deviating from the Board's normal policy is not warranted.

In fact, while applicant has not yet served the Complaint in the Federal Case, that is simply not relevant. The Federal Case will not remain in limbo forever. Fed. R. Civ. P. 4(m). If applicant does not ultimately serve the Complaint therein, this case will be promptly resumed upon the Federal Case's dismissal, and the resulting delay in this case will be relatively brief. If applicant does ultimately serve the Complaint, proceeding here prior to termination of the Federal Case would be inappropriate, because the parties' claims here are at issue in the Federal Case.

Indeed, the issues in the Federal Case are largely the same as those here, to the point that the Court may very well be called upon to decide whether the parties' marks are

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confusingly similar and whether opposer abandoned the marks in its involved registrations. In other words, it seems likely, if not inevitable, that the Federal Case may have a bearing on this one, and opposer effectively concedes the point.

While opposer's frustration with the timing of applicant's filing of the Federal Case is understandable, the fact remains that discovery in this consolidated proceeding is not complete, and any remaining discovery on applicant's counterclaims or other issues should be conducted in the Federal Case, rather than here. Opposer's argument that the mere existence of its unchallenged registrations would result in opposer prevailing even if applicant succeeds in its counterclaims is not well-taken. That is mere supposition, and premature prior to trial or summary judgment. The point is, it is the Court, rather than the Board, which should determine the merits of the parties' dispute, because the decision in the Federal Case may be "binding upon the Board, while the decision of the Board is not binding upon the court." TBMP § 510.02(a) (2d ed. rev. 2004); see also, The Other Telephone Co. v. Connecticut National Telephone Co., Inc., 181 USPQ 779 (Comr. 1974); Whopper-Burger, Inc. v. Burger King Corp., 171 USPQ 805 (TTAB 1971). In other words, proceeding here prior

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to termination of the Federal Case would be inefficient and pose a risk of inconsistent judgments.

For all of these reasons, suspension is appropriate and applicant's motion to suspend is hereby **GRANTED**.

Proceedings herein are suspended pending final disposition of the Federal Case. Within **twenty days** after the final determination of the Federal Case, the parties shall so notify the Board and call this case up for any appropriate action. If necessary and appropriate upon resumption, the Board will reset appropriate dates. During the suspension period the Board shall be notified of any address changes for the parties or their attorneys.
