

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

CME

Mailed: July 19, 2013

Opposition No. 91205200
(parent)

Cancellation No. 92055679

Your Photo On Canvas, LLC

v.

Malovani Design Corp. d/b/a
Your Photo On Canvas

Christen M. English, Interlocutory Attorney:

This case now comes up for consideration of opposer/petitioner's motions for summary judgment, filed January 11, 2013 in Opposition No. 91205200 and Cancellation No. 92055679, and applicant/respondent's cross-motion, filed February 7, 2013, to consolidate Opposition No. 91205200 and Cancellation No. 92055679, to suspend these proceedings in favor of a pending federal court action (*Malovani, et. al. v. Doe, et. al.*, Case No. 8:11-cv-00787-AG-MLG, pending in the U.S. District Court for the Central District of California) (the "Federal Case") and to extend applicant/respondent's time to respond to opposer/petitioner's motion for summary judgment. Applicant/respondent's cross-motion is fully briefed.

Motion to Consolidate

We address first applicant/respondent's motion to consolidate. When cases involving common questions of law or fact are pending before the Board, the Board may consolidate them. 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 Fed. R. Civ. P. 42(a); TBMP § 511 (3d ed. rev.2 2013). Inasmuch as the parties to Opposition No. 91205200 are the same as the parties in Cancellation No. 92055679, and the proceedings involve common questions of law and fact, the Board finds that consolidating the proceedings is appropriate. Consolidation will avoid duplication of effort concerning the factual issues and will thereby avoid unnecessary costs and delays.

Accordingly, Opposition No. 91205200 and Cancellation No. 92055679 are hereby consolidated and may be presented on the same record and briefs. The record will be maintained in Opposition No. 91205200 as the "parent" case. The parties should no longer file separate papers in connection with each proceeding, but should instead file only a single copy of each paper in the parent case. Each paper filed should bear the numbers of the consolidated proceedings in ascending order, and the parent case should be designated as the parent case by

following it with: "(parent)," as in the case caption set forth above.

Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment. 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 final decision shall be placed in each proceeding file. *See Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010).

Motion to Suspend for Civil Action

We next address applicant/respondent's motion to suspend. By way of background, applicant/respondent seeks registration of the following mark:



for "Art prints; Art prints comprised of digital illustrations originating from photographs; Art prints on canvas; Canvas for printing; Color prints; Giclee prints; Photographic prints; Photographs; Photographs that have been computer manipulated and enhanced to look like

Opposition No. 91205200 and Cancellation No. 92055679

paintings.”¹ Applicant/respondent also owns involved Registration No. 4151869 on the Supplemental Register for the mark YOUR PHOTO ON CANVAS, in standard characters, for “Art prints; Art prints on canvas; Canvas for printing; Color prints; Giclee prints; Photographic prints; Photographs; Photographs that have been computer manipulated and enhanced to look like paintings; Prints; Prints in the nature of photographs.”²

In both its notice of opposition and petition for cancellation, opposer/petitioner alleges that applicant/respondent was not the owner of the involved marks as of the filing dates of the involved applications. Specifically, opposer/petitioner alleges that the pleaded marks were owned by Adam Malovani. Additionally, in Cancellation No. 92055679, opposer/petitioner pleads fraud. In its answers, applicant/respondent denies the salient allegations in the notice of opposition and petition for cancellation and asserts an affirmative defense that opposer/petitioner is “estopped from bringing and/or maintaining” the above-captioned proceedings in view of rulings in the Federal Case.

¹ Application Serial No. 85252823, filed February 27, 2011, based on a claim of use in commerce on October 19, 2007.

² Filed on February 23, 2011 and issued on May 29, 2012, based on a claim of use in commerce on October 14, 2007.

In its motion to suspend, applicant/respondent argues that the Federal Case "was brought by and between the same parties as those [in the consolidated cases here] and relates to the same trademark...", Cross-Motion, p. 1, and "will be entirely dispositive" of these consolidated cases. *Id.* at p. 13. Applicant/respondent further asserts that opposer/petitioner brought a motion for summary judgment in the Federal Case, "on grounds almost identical" to the grounds asserted in the consolidated cases here, namely, that the plaintiff in the Federal Case, Mr. Malovani, "lack[s] standing because he does not own the 'Your Photo on Canvas' trademark, Malovani Design [Corp.] does." *Id.* p. 6. Applicant/respondent contends that in denying the motion for summary judgment, the District Court held "that Malovani is the sole controller of Malovani Design and, as such, actions taken by either Malovani or Malovani Design on behalf of the entity are considered one and the same." *Id.* at p. 7.

In opposition to the motion, opposer/petitioner argues (i) the merits of its motion for summary judgment and asserts that applicant/respondent filed the motion to suspend "to escape the consequences that will inevitably follow" from opposer/petitioner's motion for summary judgment, Response, p. 1, (ii) that the Federal Case does

not involve whether the involved application and registration should be refused/cancelled, *see id.* at p. 3, (iii) that applicant/respondent is not a party to the Federal Case, *see id.* at p. 3, and (iv) that opposer/petitioner's motion for summary judgment in the Federal Case did not involve the same issues raised in the consolidated cases here. *See id.* at p. 4.

The Board's well-settled policy is to suspend proceedings when *one* or both parties are involved in a civil action that *may* be dispositive of or *have a bearing* on the Board case. Trademark Rule 2.117(a); TBMP § 510.02(a) (3d ed. rev.2 2012) (emphasis added); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1937 (TTAB 1992). Moreover, "the Board in its discretion, may elect to suspend without first deciding [a] potentially dispositive motion." TBMP § 510.02(a).

The Federal Case involves the same marks at issue here and opposer/petitioner is one of the defendants in the Federal Case. Although applicant/respondent is not a party to the Federal Case, the president of applicant/respondent is a plaintiff in the Federal Case. Moreover, the issue of applicant/respondent's ownership of the pleaded marks in these consolidated cases is at issue in the Federal Case. To this end, opposer/petitioner concedes that the District

Court's decision on summary judgment in the Federal Case "actually supports [opposer/petitioner's] summary judgment motions in these proceedings. That is, if the assignment effectively transferred ownership of the marks to Mr. Malovani, individually, as of October 1, 2007, as the District Court ostensibly concluded, then [applicant/respondent] could not have been the owner of the mark when each of the applications in these proceedings was filed..." Response, p. 4. Indeed, in denying opposer/petitioner's motion for summary judgment in the Federal Case, the District Court concluded that "whether or not [Malovani Design Corp.] did, in fact, validly transfer [the] goodwill [in the YOUR PHOTO ON CANVAS mark to Mr. Malovani] raises a triable issue of fact that precludes summary judgment." Cross-Motion, Exhibit I, p. 9.

For these reasons, the Federal Case "may have a bearing" on these consolidated cases and applicant/respondent'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. During the suspension period the Board shall be notified of any address changes for the parties or their attorneys.

Opposer/Petitioner's Motions for Summary Judgment

In view of suspension of the above-captioned proceedings, opposer/petitioner's pending motions for summary judgment will be given no consideration and are **denied without prejudice**.³ Upon resumption of this proceeding, if opposer/petitioner believes that its motions for summary judgment denied by this order were not resolved or made moot as a result of the final disposition of the Federal Case, opposer/petitioner may renew the motions by written request to the Board citing the title, date of filing, and docket entry of the motion in the Board's electronic proceeding.⁴ Any renewed motion must be accompanied by a signed statement that the motion has been reviewed in its entirety and concerns matters still disputed between the parties. If the motion is renewed, applicant/respondent's response and any reply brief are due in accordance with Trademark Rule 2.127(e).

³ Applicant/respondent's motion to extend its time to answer opposer/petitioner's motions for summary judgment is moot.

⁴ Because the cases have been consolidated, any renewed motion should be filed in the parent case only.