

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

CME

Mailed: February 28, 2014

Cancellation No. 92058417

Cancellation No. 92058432

Lithera, Inc.

v.

Kythera Biopharmaceuticals,
Inc.

Christen M. English, Interlocutory Attorney:

This case now comes up for consideration of respondent's "corrected" motion, filed January 23, 2014, to suspend this proceeding in favor of a pending federal court action (*Kythera Pharmaceuticals, Inc. v. Lithera, Inc.*, Case No. CV13-6338 RSWL, pending in the U.S. District Court for the Central District of California) (the "Federal Case"). Petitioner opposes the motion.

Before addressing respondent's motion, it has come to the Board's attention that the parties also are involved in Cancellation No. 92058432 involving the identical mark covering related services and common questions of law and fact. 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; see also *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) (Board's initiative). Inasmuch as the parties to Cancellation Nos. 92058417 and 92058432 are identical, the marks are identical and the services related, 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, the above-referenced 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 record will be maintained in Cancellation No. 92058417 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 all 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.

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; a copy of the decision shall be placed in each proceeding file. See *Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010).

The Board now turns to respondent's "corrected" motion¹ seeking to suspend these consolidated proceedings pending final disposition of the Federal Case. In support of its motion, respondent argues that the Federal case "has a direct bearing on this proceeding" because respondent alleges in the Federal Case that petitioner's pleaded mark infringes respondent's involved mark. Petitioner argues that these consolidated proceedings should not be suspended because it has moved to dismiss the Federal Case and suspension prior to a ruling on the motion to dismiss would be premature. Response, pp. 1-2. Petitioner further argues that suspension is not appropriate because the cases before the Board concern cancellation of respondent's involved mark while such relief is not sought in the Federal Case. See *id.*

¹ Respondent's motion and petitioner's response thereto are substantively identical in each of the consolidated proceedings.

It is the Board's well-settled policy to suspend proceedings when one or both parties are involved in a civil action which **may have a bearing on** the Board case. See Trademark Rule 2.117(a) (emphasis added); TBMP § 510.02(a) (3d ed. rev.2 2013). As such, the Federal Case need not be dispositive of the Board proceeding to warrant suspension as petitioner implies in its response brief. *New Orleans Louisiana Saints LLC v. Who Dat?*, 99 USPQ2d 1550, 1552 (TTAB 2011). Here, the consolidated proceedings involve the same parties and the same marks at issue in the Federal Case. Moreover, the rights, if any, that respondent has acquired in the involved mark is squarely at issue in both proceedings. As such, the Federal Case may have a bearing on these consolidated cases.

Even if petitioner's motion to dismiss the Federal Case were granted, this would not be a sufficient basis to deny respondent's motion because such a decision would not finally dispose of the Federal Case as respondent would have an opportunity to appeal the decision. Proceeding here prior to **final** termination of the Federal Case would be inefficient and pose a risk of inconsistent judgments.²

² Moreover, "[t]he decision of the Federal district court is often binding upon the Board, while the decision of the Board is not binding upon the court." TBMP § 510.02(a); see also, *The Other Telephone Co. v. Connecticut Nat'l Telephone Co., Inc.*, 181 USPQ 779 (Comr. 1974); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805, 807 (TTAB 1971).

In view of the foregoing, respondent's motion to suspend is **GRANTED** and proceedings herein are suspended pending **final** disposition of the Federal Case.³ Within **TWENTY DAYS** after the final determination of the Federal Case, the parties shall so notify the Board, including copies of the court's final orders, 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.

³ Because respondent's motion has been granted, respondent's filing of February 24, 2014 is moot and will be given no consideration.