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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92058861
Party	Plaintiff Brian S. Gluckstein
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BRIAN STEVEN GLUCKSTEIN, an individual,	)	
	)	
Petitioner,	)	
	)	
vs.	)	
	)	Cancellation No. 92-058,861
GLUCKSTEINHOME INC., a Canadian corporation,	)	
	)	
Respondent.	)	
	)	
	)	
	)	

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**REPLY TO RESPONDENT’S RESPONSE TO MOTION**

Petitioner BRIAN STEVEN GLUCKSTEIN (“Petitioner”), by and through undersigned counsel, hereby replies to Respondent GLUCKSTEINHOME INC.’s (“Respondent”) Response to Motion, filed on May 30, 2014 (the “Respondent’s Response”). Despite Respondent’s numerous arguments attempting to support its position that these proceedings should remain suspended pending disposition of two foreign civil actions in Canada, noticeably absent, however, is a single case or authority that controverts Petitioner’s position. In fact, Respondent did not dispute any of the points made in Petitioner’s Motion for Reconsideration (the “Petitioner’s Motion”), namely, that: 1) when trademark rights within the United States are being litigated in an American court, the decisions of foreign courts concerning the respective trademark rights of the parties are irrelevant and inadmissible; and 2) once a trademark has registered in the United States, its status is independent of the validity of its registration abroad, and its duration, validity, and transfer in the United States are governed solely by the Lanham Act. Not only did Respondent fail to rebut Petitioner’s Motion, Respondent did not present a single case or authority that supports that these proceedings be suspended pending disposition of any foreign civil actions. In view of the foregoing, and for the reasons further detailed below, Petitioner respectfully requests that the Board resume these proceedings.

**I. The Decisions of the Canadian Courts Are Irrelevant and Inadmissible, and Therefore, Can Have No Bearing on the Issues Before the Board.**

Petitioner does not dispute that the Board may suspend proceedings if the final determination of another U.S. federal or state proceeding may have bearing on the issues before the Board. Petitioner submits, however, that the outcome of civil actions in foreign courts, such as in Canada, cannot “have a bearing” on the issues before the Board. Respondent failed to proffer a single case or authority to support its position that Board proceedings should be suspended pending civil action in a foreign court. On the contrary, U.S. courts have consistently held that “when trademark rights within the United States are being litigated in an American court, the decisions of foreign courts concerning the respective trademark rights of the parties are irrelevant and inadmissible.” *Vanity Fair Mills, Inc. v. T. Eaton Co.*, 109 U.S.P.Q. 438 (2d Cir. 1956) (emphasis added), citing *George W. Luft Co. v. Zande Cosmetic Co.*, 142 F.2d 536, 539, 61 U.S.P.Q. 424 (2d Cir. 1944); see, e.g., *Calzaturificio Rangoni S.p.A. v. U.S. Shoe Corp.*, 33 U.S.P.Q.2d 1345 (S.D.N.Y. 1994) (“There is specific United States case law stating that foreign judgments should not be regarded in Lanham Act cases.”); see also, *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 180 U.S.P.Q. 506 (S.D.N.Y. 1973), modified on other grounds, 186 U.S.P.Q. 436 (2d Cir. 1975); *C-Cure Chemical Co. v. Secure Adhesives Corp.*, 220 U.S.P.Q. 545 (W.D.N.Y. 1983), disagreed with on other grounds, 6 U.S.P.Q.2d 1950; see also *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 180 U.S.P.Q. 506 (S.D.N.Y. 1973), modified on other grounds, 186 U.S.P.Q. 436 (2d Cir. 1975) (rights within U.S. not affected by German decisions about the rights of the parties); *Fuji Photo Film Co. Inc. v. Shinohara Shoji Kabushiki Kaisha*, 225 U.S.P.Q. 540 (5th Cir. 1985) (“It is equally well settled that ‘when trademark rights within the U.S. are being litigated in an American court, the decisions of foreign courts concerning the respective trademark rights of the parties are irrelevant and inadmissible.’”).

Indeed, in every single instance of every case cited in Respondent’s Response, the “other proceeding” consisted of civil action in the United States and not in a foreign territory. See, *NY-Exotics, Inc. v. Exotics.com, Inc.*, 2004 WL 950921 (T.T.A.B. 2004) (civil action pending in Los Angeles County

Superior Court); *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 U.S.P.Q.2d 1550 (T.T.A.B. 2011) (civil action pending in the District Court for the Eastern District of Louisiana); *General Motors Corp. v. Cadillac Club Fashions, Inc.*, 22 U.S.P.Q.2d 1933 (T.T.A.B. 1992) (civil action pending in U.S. District Court for the Southern District of Florida); *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 U.S.P.Q. 125 (T.T.A.B. 1974) (civil action pending in U.S. District Court for the Eastern District of Missouri); *Tokaido v. Honda Associates Inc.*, 179 U.S.P.Q. 861 (T.T.A.B. 1973) (pending civil action in U.S. District Court for the Southern District of New York); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805 (T.T.A.B. 1971) (civil action pending in U.S. District Court for the Southern District of Texas); *Martin Beverage Co., v. Colita Beverage Corp.*, 169 U.S.P.Q. 568 (T.T.A.B. 1971) (civil action in the Supreme Court of the State of New York).

Any decision in the Canadian proceedings is irrelevant and inadmissible to the issues currently before the Board. Accordingly, it is clear that any determination of the Canadian courts in the Canadian proceedings will not, regardless of outcome, “have a bearing” on and cannot in any way be dispositive of the issues raised in these proceedings. Therefore, a suspension is inappropriate in this case.

## **II. The Board Must Make an Independent Determination Concerning the U.S. Registration Based on U.S. Trademark Laws.**

The law is clear. Once a trademark has been registered in the United States, “its status... is independent of the continued validity of its registration abroad, and its duration, validity, and transfer in the United States are governed by” the Lanham Act. *Calzaturificio Rangoni SpA v. United States Shoe Corporation*, 868 F. Supp. 1414, 33 U.S.P.Q.2d 1345 (1994), citing *Vanity Fair Mills, Inc. v. T. Eaton Co.*, 109 U.S.P.Q. 438 (2d Cir. 1956), cert. denied, 352 U.S. 871, 111 U.S.P.Q. 468 (1956); see also, *Marie Claire Album S.A. v. Kruger GmbH & Co. KG*, 29 U.S.P.Q.2d 1792 (T.T.A.B. 1993)(“The U.S. application is dependent upon the validity of the foreign registration up until the time the U.S. registration based thereon is issued...Only once issued is a registration secured under Sections 44(c) and 44(e) independent of the foreign registration and subject only to the requirement of United States law.”) (emphasis added).

Canadian court decisions have no “bearing” whatsoever on the issues before the Board in these proceedings; nor should they as trademarks are inherently territorial and they exist in each country solely according to that particular country’s statutory scheme. See *Fuji Photo Film Co., Inc. v. Shinohara Shoji Kabushiki Kaisha*, 225 U.S.P.Q. 540 (5th Cir. 1985). The Registration that is the subject of these proceedings is therefore no longer dependent upon the validity and/or ownership of any foreign registration. Once the mark was registered, it became subject to the requirements of U.S. trademark laws only and its continued validity and ownership can only properly be assessed by the Board (or U.S. District Courts) under the Lanham Act. It would be wholly inappropriate for the Canadian courts to apply Canadian trademark law to determine ownership rights and the disposition of a U.S. registration.

Regardless of the outcome of the Canadian proceedings, therefore, the Board must independently review the status, ownership, and continued validity of a U.S. registration under the Lanham Act; a Canadian court cannot order the Board to assign or cancel a U.S. registration. It does not matter where the underlying facts took place or where the parties reside, at issue here is the continued validity of a U.S. registration, and the parties’ ownership rights thereto. The law concerning this issue is clear. Once a mark registers in the U.S., its duration and continued validity is governed by the Lanham Act. *Marie Claire Album S.A. v. Kruger GmbH & Co. KG*, 29 U.S.P.Q.2d 1792 (T.T.A.B. 1993).

The Board must determine the continued validity of this U.S. Registration under the Lanham Act and cannot allow a Canadian court to make such a determination under Canadian laws. To do so would directly contravene U.S. case law stating that foreign judgments should not be regarded in Lanham Act cases. Accordingly, a suspension is inappropriate in this case.

### **III. Conclusion**

The Board should allow these proceedings to move forward so that it may properly determine the validity of the Registration under the Lanham Act. Allowing the continued suspension of these proceedings pending the disposition of the Canadian proceedings would unfairly prejudice Petitioner.

For the reasons stated above, Petitioner respectfully requests that the Board reconsider its grant of Respondent's Motion to Suspend and order the resumption of these proceedings.

Respectfully submitted,

Dated: June 17, 2014

By: 

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**CERTIFICATE OF SERVICE**

I hereby certify that I served a copy of the foregoing REPLY TO RESPONDENT'S RESPONSE TO MOTION upon Respondent by depositing one copy thereof in the U.S. Mail, First-Class, postage prepaid, on June 17, 2014 addressed as follows:

Susan B. Flohr  
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