

ESTTA Tracking number: **ESTTA681274**

Filing date: **07/01/2015**

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

|  |   |
|--|---|
| Proceeding.  | 92061595                                      |
| Applicant  | Plaintiff<br>Macy's Merchandising Group, Inc. |
| Other Party  | Defendant<br>Joules Limited                   |
| Have the parties held their discovery conference as required under Trademark Rules 2.120(a)(1) and (a)(2)? | No  |

### **Motion for Suspension in View of Civil Proceeding With Consent**

The parties are engaged in a civil action which may have a bearing on this proceeding. Accordingly, Macy's Merchandising Group, Inc. hereby requests suspension of this proceeding pending a final determination of the civil action. Trademark Rule 2.117.

Macy's Merchandising Group, Inc. has secured the express consent of all other parties to this proceeding for the suspension and resetting of dates requested herein.

Macy's Merchandising Group, Inc. has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Respectfully submitted,  
/Anthony F. Lo Cicero/  
Anthony F. Lo Cicero  
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07/01/2015

**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

*In the Matter of Registration No. 3,696,021  
of Joules Limited  
for the mark JOULES  
Registered on October 13, 2009*

|                                   |   |                           |
|-----------------------------------|---|---------------------------|
| -----                             | X |                           |
| MACY’S MERCHANDISING GROUP, INC., | : |                           |
|                                   | : |                           |
| Petitioner,                       | : |                           |
|                                   | : |                           |
| v.                                | : | Cancellation No. 92061595 |
|                                   | : |                           |
| JOULES LIMITED,                   | : |                           |
|                                   | : |                           |
| Registrant.                       | : |                           |
| -----                             | X |                           |

**MOTION TO SUSPEND CANCELLATION WITH CONSENT**

Pursuant to 37 C.F.R. § 2.117(a) and T.B.M.P. §510.02(a), Petitioner Macy’s Merchandising Group, Inc. (“MMG”), with the consent of Registrant Joules Limited (“Joules”), hereby moves to suspend Cancellation No. 92061595 until final resolution of a civil action currently pending in the U.S. District Court for the Southern District of New York between the above-captioned parties. The Civil Action, entitled *Joules Limited v. Macy’s Merchandising Group, Inc.*, No. 1:15-cv-03645-KMW, is expected to have a bearing on this proceeding.

The complaint, filed on May 11, 2015, alleges that MMG infringes three trademark registrations owned by Joules, namely: (i) U.S. Registration No. 3,382,886 for the mark JOULE; (ii) U.S. Registration No. 3,696,021 for the mark JOULES, which is the subject of the present Cancellation; and (iii) U.S. Registration No. 4,651,278 for the mark LITTLE JOULE. Because the Civil Action overlaps with and is certain to have a bearing on the issues of the present Cancellation, MMG requests that this Cancellation be suspended pending resolution of the Civil

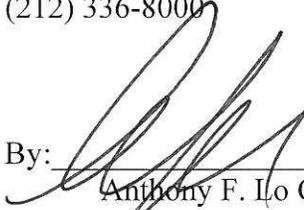
Action. *See New Orleans Louisiana Saints LLC v. Who Dat?, Inc.*, 2011 TTAB LEXIS 208, at \*6-8 (T.T.A.B. July 22, 2011) (“[T]he civil action does not have to be dispositive of the Board proceeding to warrant suspension, it need only have a bearing on the issues before the Board.”).

Based on the foregoing, MMG respectfully requests that this motion be granted and that the present Cancellation proceeding be suspended pending final disposition of the Civil Action.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN LLP  
Attorneys for Petitioner  
90 Park Avenue  
New York, New York 10016  
(212) 336-8000

Dated: New York, New York  
July 1, 2015

By:   
Anthony F. Ilo Cicero  
Chester Rothstein  
David P. Goldberg  
Reena Jain

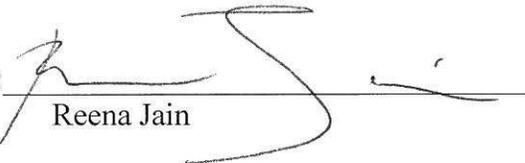
**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that she is one of the attorneys for Petitioner in the above-captioned Cancellation proceeding and that on the date which appears below, she caused copies of the foregoing MOTION TO SUSPEND to be served on Registrant's counsel via first class mail to the following addresses:

C.J. Veverka  
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Michael M. Yi  
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New York, New York 10010

Dated: New York, New York  
July 1, 2015

By:   
Reena Jain