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

Proceeding	92062224
Party	Plaintiff Emm. Kokologiannis and Sons, Societe Anonyme of Trade, Hotels and Tourism S.A.
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**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

EMM. KOKOLOGIANIS AND SONS,
SOCIETE ANONYME OF TRADE,
HOTELS AND TOURISM S.A.,

Petitioner,

v.

PROVEEDORES Y
SOLUCIONES DAC S.A.,

Respondent.

Cancellation No. 92062224

Registration No. 3,846,482

PETITIONER'S OPPOSITION TO RESPONDENT'S MOTION FOR SUSPENSION

Petitioner Emm. Kokologiannis and Sons, Societe Anonyme of Trade, Hotels and Tourism S.A. ("Kokologiannis"), by its attorneys Leason Ellis LLP, hereby opposes the Motion for Suspension filed by Respondent, Proveedores y Soluciones DAC S.A. ("Proveedores") on October 23, 2015.

I. STATEMENT OF FACTS

Proveedores argues that the instant proceeding must be suspended because its purported licensee, Economy Rent-A-Car, Inc. ("ERAC"), and Petitioner Kokologiannis are adversaries in pending cancellation action No. 92055558 (the "'558 Action") and in pending cancellation action No. 92061413 (the "'413 Action"). In the '558 Action, where both parties have already filed trial briefs, ERAC seeks to cancel Kokologiannis' Registration No. 3,256,667 of the mark ECONOMY CAR RENTALS RENTAL-HIRE-RENT A CAR-AUTOVERMIETUNG-MIETWAGEN and Design (the "'667 Registration"). In the '413

Action, filed by Kokologiannis on May 1, 2015, Kokologiannis has petitioned to cancel Proveedores' Registration No. 3,786,010 of the mark ECONOMY RENT A CAR and Design. On August 3, 2015, Proveedores moved to suspend the '413 Action pending the Board's decision in the '558 Action. Kokologiannis opposed that motion, which has now been fully briefed and awaits decision by the Board.

Proveedores argues that because the '667 Registration owned by Kokologiannis is the object of the '558 Action brought by ERAC, and because Kokologiannis asserts that same registration in the instant proceeding, the outcome of the '558 Action "may have a material bearing on this case." No argument (or mention) is made by Proveedores concerning Kokologiannis' common law trademark rights to the mark at issue in the '558 Action. Nor does Proveedores explain how the outcome of the '413 Action could have any bearing on the instant proceeding.

II. LEGAL STANDARD

Pursuant to C.F.R. §2.117(a), "whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in . . . another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of . . . the other Board proceeding."

Suspension of a Board proceeding is solely within the discretion of the Board. *The Other Telephone Company v. Connecticut National Telephone Company, Inc.*, 181 U.S.P.Q. 779, 782 (Comm'r Pat. 1974). "All motions to suspend, regardless of circumstances, . . . are subject to the 'good cause' standard." *National Football League v. DNH Management LLC*, 85 U.S.P.Q.2d 1852, 1855, n.8 (TTAB 2008) citing Trademark Rule 2.117(c). "[B]oth the permissive language of Trademark Rule 2.117(a) . . . and the

explicit provisions of Trademark Rule 2.117(b) make clear that suspension is not the necessary result in all cases." *Boyd's Collection Ltd. v. Herrington & Co.*, 65 U.S.P.Q.2d 2017, 2018 (TTAB 2003).

III. ARGUMENT

A. Both Parties and Claims Are Different in the Two Cancellation Actions

As an initial matter, Proveedores' motion should be denied as meritless because both the parties and claims are different between the present proceeding and the '558 Action. Specifically, ERAC is *not* a party here and Proveedores is *not* a party to the '558 Action. According to T.B.M.P. § 510.02, the Board seldom grants a motion to suspend a particular proceeding pending disposition of other cancellation proceedings brought by unrelated plaintiffs against the same registration, and asserting unrelated claims, absent the consent of the other parties. Here, Proveedores has not asserted any facts in support of its motion to suspend to demonstrate that ERAC is a "related" party beyond identifying it as a mere licensee (and potentially one of many).

Moreover, the claims at issue and legal theories at play in each cancellation proceeding only share a single common cause of action: likelihood of confusion. Beyond that common claim, the two cases could not be more different. ERAC seeks to cancel Petitioner's registration of the mark ECONOMY CAR RENTALS RENTAL-HIRE - RENT A CAR - AUTOVERMIETUNG-MIETWAGEN and Design in the '558 Action based upon an abandonment theory. The present proceeding, in sharp contrast, has Kokologiannis seeking cancellation of the mark ECONOMY and Design on the grounds of priority, likelihood of confusion, and mere descriptiveness.

Provedores' motion fails to address what bearing, if any, resolution of any disputed issue in the '558 Action or the '413 Action would have on the instant case. This failure is not surprising, as the issue of whether the '667 Registration should be cancelled for, *inter alia*, abandonment, has no bearing whatsoever on whether a different registration for a different mark in a different proceeding should be cancelled for different grounds (*e.g.*, descriptiveness, or fraud, or failure to prove priority). *See New Orleans Louisiana Saints LLC and NFL Properties LLC*, 99 U.S.P.Q.2d 1550 (TTAB 2011) (stating that if the applicant successfully defends against the opposers' claims of likelihood of confusion, deceptiveness, and false association, this will have no bearing on the ability of the other opposers to bring their claims that the mark is merely descriptive, functional, and generic).

Furthermore, in addition to asserting the '667 Registration as a basis for alleging priority and a likelihood of confusion in the present action, Kokologiannis has alleged common law rights in the mark ECONOMY CAR RENTALS through longtime use. As it is beyond cavil that trademark rights are acquired through use under the common law, *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 413, 36 S.Ct. 357, 60 L.Ed. 713 (1916), Kokologiannis will retain its common law rights even if the Board finds that the '667 Registration should be cancelled. *See Crash Dummy Movie, LLC v. Mattel, Inc.*, 601 F.3d 1387, 94 U.S.P.Q.2d 1315 (Fed. Cir. 2010) (stating that registration cancellation does not mean loss of common law rights in a trademark). Thus, even if the '667 Registration is cancelled in the earlier action, the instant proceeding would nevertheless continue, thereby rendering the requested suspension pointless and futile.

Provedores points out in its motion that Kokologiannis' '667 Registration is also the object of a counterclaim by Provedores in the '413 Action. Provedores does not, however,

explain how the Board's eventual decision on that counterclaim could have a bearing on the instant proceeding. Indeed, Kokologiannis has moved to strike or dismiss Proveedores' counterclaim in the '413 Action, and the parties' respective motions are pending before the Board.

B. Proveedores Failed to Allege Good Cause for Suspension

While exceptions may be made under TBMP § 510.02 where only one of the parties to a proceeding is involved in another, different proceeding, good cause must still be shown for the Board to exercise its discretion to delay one proceeding in favor of another. Here, Proveedores fails to meet its burden of showing good cause and, indeed, does not even argue or allege in its moving papers that good cause exists. Instead, the Board is respectfully requested to consider that the '558 Action, which was filed in April of 2012, will be decided long before it renders any decision in the instant proceeding. Both parties have now filed their trial briefs in the '558 Action. Even if the Board denies both of Proveedores' motions for suspension (in the '413 Action and in the present proceeding), and the two cases move forward with all deliberate speed, it seems likely that the Board will render a decision in the '558 Action before the close of discovery in the instant proceeding.

In other words, the status of the '667 Registration (and the extent to which Kokologiannis can rely upon it in this case) will be determined soon enough so that there is no good cause for suspending the instant proceeding, which is still in its infancy. Moreover, in the highly unlikely event that the prior action is not resolved by the time this case is ready for final determination, Proveedores can always renew its motion to suspend at a more appropriate time, *i.e.*, when a record has been developed sufficient to show the

requisite just cause that was not shown here.¹

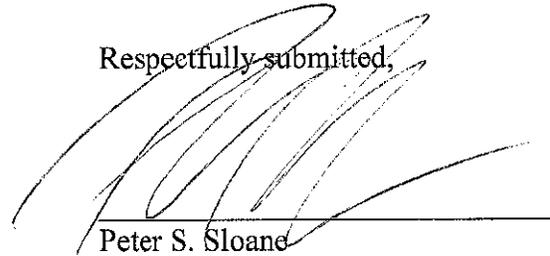
In sum, Proveedores does not allege any basis for "good cause" above and beyond the mere fact that Petitioner's registration asserted in this cancellation action is involved in another cancellation action. Proveedores has not cited any case law in support of its position and unsupported, rote recitation of good cause does not make it so.

IV. CONCLUSION

Based upon the foregoing, Petitioner respectfully requests that the Board deny Respondent's unsupported motion to suspend the instant proceeding.

Dated: November 12, 2015

Respectfully submitted,



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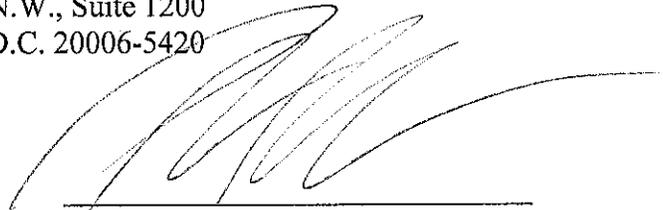
Attorneys for Petitioner

¹ Indeed, allowing the instant proceeding to proceed will not result in any additional time or expense during discovery. That is, to the extent that Proveedores may later claim that it is somehow "related" to ERAC, the latter has already taken discovery on the '667 Registration in the '558 Action. As such, any additional discovery here would be inefficient on its part and only serve to give the Respondent here another at the proverbial apple.

CERTIFICATE OF SERVICE

I hereby certify that on the date set forth below a true and correct copy of **PETITIONER'S OPPOSITION TO RESPONDENT'S MOTION FOR SUSPENSION** was served by First-Class Mail, postage prepaid, upon the attorneys for Respondent, this 12th day of November, 2015, addressed as follows:

Samuel Littlepage, Esq.
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Peter S. Sloane