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

Proceeding	92062224
Party	Defendant Proveedores y Soluciones DAC S.A.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

EMM. KOKOLOGIANNIS 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

**RESPONDENT’S REPLY IN SUPPORT OF
MOTION TO SUSPEND PROCEEDINGS**

Proveedores y Soluciones DAC S.A. (hereinafter “Proveedores”), through its undersigned attorneys, hereby submits its Reply memorandum in support of its previously-filed motion to suspend the above-styled proceeding and responds to the opposition filed by Emm. Kokologiannis And Sons, Societe Anonyme Of Trade, Hotels, And Tourism, S.A. (hereinafter “Kokologiannis”) regarding that motion.

Response To Kokologiannis’ Misstatement Of Facts

Kokologiannis begins its “Statement of Facts” with the incorrect assertion that Proveedores argues that the present case “must be suspended because its purported licensee...and Kokologiannis are adversaries in pending cancellation action No. 92055558 (the ‘558 Action’) and in pending cancellation action No. 92061413 (the ‘413

Action’).” That assertion is simply incorrect. Any review of the “Respondent’s Motion For Suspension” plainly demonstrates that it is based on the claim that the outcome in the ‘558 Action may have a material bearing on the present case because the previously-filed (but still pending) ‘558 proceeding involves Kokologiannis’ alleged rights in and to Trademark Registration No. 3,256,667 (the “‘667 Registration”)—the same registration now expressly cited and relied upon by Petitioner in its present Petition for Cancellation. In addition, Kokologiannis’ alleged rights in and to the ‘667 Registration are directly involved in the previously-filed, and still pending, ‘413 proceeding (which seeks cancellation of that same registration).

Kokologiannis next makes the irrelevant observation that “no argument is made by Proveedores concerning Kokologiannis’ common law trademark rights to the mark at issue in the ‘558 Action.” In fact, there are no “common law rights held by Kokologiannis” that are at issue in that previously-filed proceeding. Instead, the only issue in the ‘558 Action is the validity and continued registration of Reg. No. 3,256,667.¹

Argument

At page 3 of its opposition brief, Kokologiannis contends that the motion for suspension should be denied “as meritless” because the parties and claims are different in this proceeding and the ‘558 Action. It is, however, that contention which is “meritless”. There is no requirement that there be complete identity of parties and issues in two proceedings in order to suspend the later-filed proceeding (and

¹ Kokologiannis argues that because it relies on its common law rights in addition to the ‘667 Registration for priority in the present proceeding, this proceeding would still continue even if the ‘667 Registration were cancelled in the ‘558 Action and, thus, the ‘558 Action has no bearing on the case at bar. Kokologiannis, however, ignores the fact that cancellation of the ‘667 Registration in the ‘558 Action and/or ‘413 Action would materially affect its burden of proof in this proceeding.

Kokologiannis cites no authority that mandates such a requirement). Indeed, it is well-settled that the Board's suspension practice applies even with respect to "another proceeding in which only one of the parties is involved." See, TMEP, §510.02(a).

Kokologiannis next argues that the prior proceeding was brought by Proveedores' licensee against Kokologiannis and that there is no showing that the licensee is "related" to Proveedores. This is certainly a strange and curious argument in light of the Motion To Dismiss Counterclaims filed in the '413 Action by Kokologiannis. In that motion, Kokologiannis argued that the licensee and Proveedores were "related" companies in "privity" with each other.² For Kokologiannis to ignore its previously-stated position in the '413 Action indicates that either its present argument is meritless or its motion to dismiss in the '413 Action is meritless.

Kokologiannis concedes, at page 3 of its opposition brief, that "the claims at issue and legal theories at play in each cancellation proceeding only share a single common cause of action: likelihood of confusion." For some inexplicable reason, Kokologiannis then opines that such commonality is insufficient to support suspension of the later-filed proceeding. Rather than focusing on the claim that is common to both cancellation proceedings and the fact that a cancellation of the '667 Registration in the '558 Action would have a material bearing on the claims in the present case, Kokologiannis attempts to redirect the Board's attention to only those claims that are different (*i.e.*, the mere descriptiveness and fraud claims). That is an improper approach and ignores the very claims asserted by Kokologiannis which are based, in part, on its Registration No. 3,256,667.

² See "Petitioner And Counterclaim-Respondent's Motion To Dismiss And/Or Strike Respondent's And Counterclaim-Petitioner's Counterclaims" (TTABVUE No. 6) in the '413 Action, at page 3.

In seeking to create a distinction between this case and the pending '558 Action, Kokologiannis relies on an artificial “red herring” argument³--namely, that it is unimportant that “a different registration for a different mark in a different proceeding should be cancelled for different grounds.” See Opposition Brief, at p. 4. Such an argument ignores, of course, the critical fact that both proceedings at issue directly involve the *identical* registration for the *identical* mark. Likewise, the registration that is being asserted by Kokologiannis in this case is the subject of Respondent’s counterclaim for cancellation in the ‘413 Action. Thus, a decision in both the ‘558 Action and the ‘413 Action on the claims asserted against Kokologiannis’ ‘667 Registration will have a material bearing on the outcome of this case. The validity of the cited registration is not merely a “sideshow”; on the contrary, it is important because that registration provides certain evidentiary presumptions to Kokologiannis and if the registration is invalidated in either the ‘558 and/or ‘413 Actions, then Kokologiannis’ burden of proof in this case will be materially altered. See 15 U.S.C. § 1057(b) (setting forth presumptions conferred by federal registration).

Kokologiannis, at page 5 of its opposition brief, argues that the present action should go forward because the prior ‘558 proceeding is at an advanced stage of litigation. However, that difference in the litigation stages between the two proceedings is an argument *for*, not *against*, suspension. Clearly, judicial economy is achieved by suspension since a decision in the ‘558 (which Kokologiannis concedes “will be decided

³ Wikipedia defines a “red herring” argument as “something that misleads or distracts from a relevant or important issue. It is an argument that falls into a class of relevance fallacies and is an irrelevant diversionary tactic.

