



TTAB

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451  
www.uspto.gov

Allied Domecq International Holdings BV

v.

Russian Federal Treasury Enterprise Sojuzplodoimport

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Opposition No. 91165999  
On Petition to the Director  
Filed November 13, 2006

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Decision

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Russian Federal Treasury Enterprise Sojuzplodoimport (petitioner), applicant in the above-referenced opposition proceeding (Allied Domecq proceeding), has petitioned the Director to reverse an order by the Trademark Trial and Appeal Board (Board), dated October 12, 2006, to suspend proceedings pending the outcome of a civil action.<sup>1</sup> The Director has authority to review the petition under Trademark Rule 2.146(a)(3), 37 C.F.R. §2.146(a)(3). The petition is denied.

## FACTS

This case has a lengthy factual and procedural history that began on July 25, 2005, when petitioner filed a Notice of Opposition with the Board. The Board instituted the Allied Domecq opposition proceeding, and since that time the proceeding has been filled with numerous motions, responses to motions and Board orders. Relevant to this petition is a motion to suspend the Allied Domecq proceeding, filed by opposer on September 14, 2006, pending disposition of a civil action in the United States Court of Appeals for the Second Circuit.

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<sup>1</sup> Spirits International N.V. (SPI) filed a response to the petition on December 6, 2006. SPI is not a party to this opposition, but has opposed the registration of petitioner's same mark, RUSSIAN VODKA, App. No. 76604592, in a different opposition proceeding (the SPI proceeding). The SPI proceeding was also suspended by the Board pending the outcome of a civil action.

In an order dated October 12, 2006, the Board granted the motion, determining that suspension of a Board case is appropriate, even if the civil case may not be dispositive of the Board case so long as the ruling might have a bearing on the rights of the parties in the Board case. (suspension order at p. 2). This petition followed.

## ANALYSIS

Petitioner argues that suspension of the Allied Domecq proceeding is unwarranted because the issues of law and fact in *Federal Treasury Enterprise Sojuzplodoimport v. Spirits Int'l N.V.*, No. 06-3532, currently pending before the Second Circuit Court of Appeals ("the Second Circuit Appeal"), are unrelated. Therefore, petitioner argues, disposition of the Second Circuit Appeal will have no effect on the Allied Domecq opposition. Petitioner requests the Director to correct the suspension of the proceeding because of the widespread and potentially irreparable injury the resulting delay might cause. Specifically, petitioner asserts that registration of its RUSSIAN VODKA certification mark might be delayed for at least the year it would take to resolve the Second Circuit Appeal, thereby unnecessarily subjecting American consumers to years of misleading practices and producers of genuine Russian vodka to potentially irreparable damage to the reputation of their products. (petition at pp. 2-3).<sup>2</sup>

Pursuant to 35 U.S.C. §2 and 37 C.F.R. §2.146(a)(3), the Director may invoke supervisory authority in appropriate circumstances. However, the Director will vacate an interlocutory order issued by the Board in an inter partes proceeding only upon a showing of clear error or abuse of discretion. *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093 (Comm'r Pats. 1990); *Riko Enterprises, Inc. v. Lindsley*, 198 USPQ 480 (Comm'r Pats. 1977).

37 C.F.R. §2.117(a) provides: "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 a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding." The parties to the Second Circuit Appeal include the parties to this Board proceeding.

Accordingly, since the Board has the authority and discretion to suspend proceedings before it, the only issue on petition is whether the Board has abused its discretion in suspending the Allied Domecq proceeding. For the reasons set forth below, the circumstances presented in this case do not show an abuse of discretion on the part of the Board.

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<sup>2</sup> SPI opposes the petition, alleging that it is an improper attempt by petitioner to lift the suspension in the SPI proceeding, Opposition No. 91167196. SPI indicates that it was never served a copy of the subject petition and indicates that the deadline for filing a petition in the SPI proceeding has passed. (response to petition at p. 2). The Director is not considering this petition as a request to lift the suspension in the SPI proceeding, and agrees that such a request would be untimely.

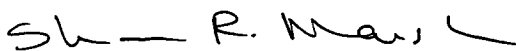
In its suspension order, the Board noted that the parties in the Allied Domecq proceeding included the parties in the civil proceeding. The Board also noted that the Second Circuit Appeal might determine opposer's rights in its STOLICHNAYA RUSSIAN VODKA & Design mark, which opposer relied on in its notice of opposition against petitioner's RUSSIAN VODKA certification mark. As the Board has indicated, any determination of opposer's rights in its asserted mark would have bearing on the opposition proceeding, which is predicated on opposer's rights in the STOLICHNAYA RUSSIAN VODKA & Design mark. Furthermore, as the Board's order noted, the decision of the federal district court and the Second Circuit would be binding on the Board (see 15 U.S.C. §1119), while a decision of the Board would not be binding on the court.

Petitioner asserts that a determination in the Second Circuit Appeal could not impact the Allied Domecq proceeding because opposer had disclaimed the phrase RUSSIAN VODKA in its registration and, therefore, could not claim likelihood of confusion with its certification mark RUSSIAN VODKA based on that phrase. (petition at p. 2).

However, it is well established that a disclaimer does not remove the disclaimed matter from the mark. The mark must still be regarded as a whole, including the disclaimed matter, in evaluating similarity to other marks. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 672, 223 USPQ 1281, 1282 (Fed. Cir. 1984); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570, 218 USPQ 390, 395 (Fed. Cir. 1983); *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 144 USPQ 433 (C.C.P.A. 1965); *In re MCI Communications Corp.*, 21 USPQ2d 1534, 1538-39 (Comm'r Pats. 1991). Accordingly, any determination by a civil court of opposer's rights in its mark STOLICHNAYA RUSSIAN VODKA & Design, which incorporates the phrase RUSSIAN VODKA, would have bearing on the Allied Domecq proceeding, as it involves the same marks. In the interest of judicial economy and to avoid the possibility of reaching inconsistent conclusions, the Board exercised its discretion, as authorized by Rule 2.117(a), and suspended the Allied Domecq proceeding. The Board did not abuse this discretion.

## DECISION

The petition is denied. The opposition file will be returned to the Board.



Sharon R. Marsh  
Deputy Commissioner  
for Trademark Examination Policy

SRM:JCL:MGP

Date: MAY 11 2007

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