

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

MBA

Mailed: December 11, 2007

Opposition No. 91178639

Opposition No. 91178640

Opposition No. 91179911

Opposition No. 91180049

Sporting Goods Intelligence,  
Inc.

v.

Formula4Media, LLC

**Michael B. Adlin, Interlocutory Attorney:**

This case now comes up for consideration of opposer Sporting Goods Intelligence, Inc.'s ("opposer") motion to suspend Opposition Nos. 91178639, 91178640, 91179911 and 91180049, filed September 6, 2007 in Opposition Nos. 91178639 and 91178640, and October 22, 2007 in Opposition Nos. 91179911 and 91180049. Applicant Formula4Media, LLC ("applicant") opposes the motion.

Consolidation

As a preliminary matter, a review of opposer's motion, applicant's response thereto the record herein reveals that consolidation of Opposition Nos. 91178639, 91178640, 91179911 and 91180049 is appropriate. Each involves

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identical parties, similar or related marks and related or identical issues. When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. See Fed. R. Civ. P. 42(a); see also, *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991). In view thereof, Opposition Nos. 91178639, 91178640, 91179911 and 91180049 are hereby consolidated.

The consolidated cases may be presented on the same record and briefs. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989) and *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993). The Board file will be maintained in Opposition No. 91178639 as the "parent" case. As a general rule, from this point on only a single copy of any paper or motion should be filed herein; but that copy should bear both proceeding numbers in its caption.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

Suspension

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Opposer argues that this consolidated proceeding should be suspended, because the parties are currently litigating their dispute over ownership of the marks at issue in this proceeding in another forum.<sup>1</sup> Specifically, the parties in this proceeding are also parties to a pending American Arbitration Association ("AAA") trademark proceeding, captioned John Horan and Sporting Goods Intelligence, Inc. v. Formula 4 Media, Inc., LLC, Mark Sullivan, Jeff Nott, Troy Leonard, Jeff Gruenhut, AAA File No. 18 133 01172 06. Furthermore, applicant filed a civil action against opposer in New York state court, Formula 4 Media LLC, Mark Sullivan, Jeff Nott, Troy Leonard and Jeff Gruenhut v. John Horan and Sporting Goods Intelligence, Inc., Supreme Court of the State of New York, County of Nassau, Index No. 3825/07, "which seeks to address the identical issues in the Arbitration, including ownership of the trademarks at issue here."

According to opposer, applicant filed a motion to dismiss the arbitration proceeding, alleging that opposer's filing of its notices of opposition in these cases was a breach of the parties' trademark license agreement. The

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<sup>1</sup> The marks at issue include applicant's application Serial Nos. 76666672 and 76666674, and opposer's application Serial Nos. 78958601 and 77026496.

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arbitrator denied applicant's motion, specifically ruling as follows:

Since the parties agree that the sole remedy for resolving issues concerning the License Agreement at issue is by arbitration, and that the issues in the pending and anticipated future oppositions before the TTAB all concern central issues concerning the License Agreement, the arbitration concerning the License Agreement between these parties shall proceed to conclusion in the manner established by the Orders previously entered in this matter. The Application to Dismiss the Arbitration is hereby denied.

Arbitrator Ruling Re Motion to Dismiss Arbitration at 2, issued August 29, 2007.

Opposer further argues that "[s]hould [opposer] prevail before the arbitrator or in New York state court, [applicant's] trademark registration applications would be rendered moot; if [opposer] does not prevail, [applicant] can petition the TTAB to resume the proceedings."

In opposition to the motion to suspend, applicant argues that opposer "should not be allowed to further delay [applicant's] applications, by asking the TTAB to suspend the oppositions that [opposer] themselves brought." Applicant further argues that by bringing its motion to suspend, opposer "has waived its right to arbitration and this Board has the authority to review the registerability of the marks."

In its reply brief, opposer argues that even if the arbitration and state court rulings are not binding on the Board, "the Arbitration decision would still determine ownership rights of the parties." This would be "critical to any decision of the Board." It appears that the New York state court proceeding was dismissed on October 29, 2007 in favor of the parties' pending arbitration proceeding.

Under Trademark Rule 2.117(a), whenever it comes to the attention of the Board that the parties to a case pending before it are involved in a civil action which may be dispositive of the Board case, proceedings before the Board may be suspended until final determination of the civil action. *See also General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1936-37 (TTAB 1992). Here, the arbitration proceeding, while not a civil action, may nevertheless be dispositive of at least some issues in this proceeding. That proceeding will at the very least result in rulings going directly to the core issues presented here.

Furthermore, not only did the parties specifically agree to arbitrate issues relating to their trademark license agreement, including ownership of the marks at issue in these proceedings, but the arbitrator has already

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ruled that the issues in these opposition proceedings "concern central issues concerning the License Agreement." Proceeding here at the same time that the arbitration considers the parties' license agreement would be inefficient and contrary to the parties' agreement to arbitrate.

Accordingly, opposer's motion to suspend is hereby **GRANTED**. See Trademark Rule 2.117(a); TBMP § 510.02(a) (2d ed. rev. 2004). Proceedings herein are suspended pending final disposition of the arbitration proceeding.

Within **twenty days** after the final determination of the arbitration, the interested party shall so notify the Board so that the Board may take appropriate action in these consolidated proceedings.

During the suspension period the Board shall be notified of any address changes for the parties or their attorneys.

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