

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Trademark Trial and Appeal Board**  
**P.O. Box 1451**  
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Mailed: December 3, 2008

Opposition Nos. 91180491  
91180749  
91181536  
91184063  
91185427  
91186454

The Board of Trustees of the  
Leland Stanford Junior  
University

v.

Stanford Financial Group  
Company

(as consolidated)

Angela Lykos, Interlocutory Attorney

This case now comes before the Board for consideration of opposer's motion (filed in each opposition proceeding referenced above) to suspend proceedings pending the outcome of civil litigation between the parties. Counsel for opposer contacted the Board requesting a telephone conference to resolve the present dispute amongst the parties. The Board granted opposer's request. After contacting counsel for applicant, the Board permitted additional written briefing of the motion by applicant, but

determined that the filing of a reply brief would be unnecessary.

The telephone conference was held on December 2, 2008 at 2:00 PM EST among Mit Winter and Bill Abrams, counsel for opposer, Michael R. Graif, counsel for applicant, and the undersigned, as the Board attorney responsible for resolving interlocutory disputes in these proceedings.

#### **I. Consolidation**

As a preliminary matter, the Board hereby orders consolidation of the above referenced proceedings.

When cases involving common questions of law or facts are pending before the Board, the Board may order, upon its own initiative or upon motion, the consolidation of the cases. See Fed. R. Civ. P. 42(a) and TBMP § 511 (2d ed. rev. 2008) and authorities cited therein.

A review of the pleadings in the above identified proceedings indicates that the parties are the same, and the proceedings involved substantially identical questions of fact and law. As such, these cases may be presented on the same record without appreciable inconvenience or confusion.

Moreover, the consolidation would be equally advantageous to those parties in the avoidance of duplication of effort, loss of time, and the extra expense involved in conducting the proceedings individually. By consolidating the cases, the parties may use any discovery

served and responded to from the earlier filed cases in the later filed proceedings.

Under Board practice, 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*, 26 USPQ2d 1423 (TTAB 1993). The Board file will be maintained in Opposition No. 91180491 as the "parent" case. Only a single copy of any paper or motion should be filed herein in the parent case; but that copy should bear all six proceeding numbers in its caption as noted above.

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 filed.

The parties are further advised that they are to inform the Board in any subsequent oppositions or cancellations are instituted which involve the same parties in the same issues.

During the telephone conference, the Board noted with the exception of the parent opposition proceeding, all subsequent oppositions consolidated herein were instituted pursuant to the Board's amended trademark rules for cases commenced on or after of November 1, 2007. See

Miscellaneous Changes to Trademark Trial and Appeal Board Rules (Final Rule), 72 Fed. Reg. 42242, 42245 (August 1, 2007). Under Board practice, cases instituted prior to November 1, 2007, when consolidated with cases instituted under the amended trademark rules are suspended until after the parties exchange initial disclosures in the amended trademark rules case. The rationale is to bring both cases in symmetry for discovery and trial purposes. In this particular instance, the Board noted that only in the latest filed proceeding under the amended rules, Opposition No. 91186454, initial disclosures have yet to be made.

## II. **Motion to Suspend**

Opposer has moved to suspend proceedings pending the final disposition of a civil action involving the parties in the United States District Court of the Northern District of California (*The Board of Trustees of the Leland Stanford Junior University v. Stanford Financial Group Company and Stanford Group Company*, Civil Action No. C08-04950 CRB). In support of its motion to suspend, opposer has submitted a copy of the civil action complaint, in which opposer, in the position of plaintiff in the civil action, has asserted various claims against applicant, including federal and state trademark infringement and dilution with regard to applicant's STANFORD marks.

Applicant opposes suspension on the grounds that in the civil action, on November 26, 2008, applicant filed a motion to dismiss portions of opposer's complaint for lack of personal jurisdiction and to suspend the federal district court case in favor of the opposition proceedings currently pending before the Board. Applicant therefore requests that the Board defer making a determination on opposer's motion to suspend until the district court has issued a ruling on the outstanding motion in the civil suit.

With regard to suspension of a Board proceeding pending other litigation, Trademark Rule 2.117(a) provides as follows:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that parties to a pending case are engaged in a civil action which may be dispositive of the case, proceedings before the Board may be suspended until determination of the civil action.

Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board. *See Martin Beverage Co., Inc. v. Colita Beverage Corp.*, 169 USPQ 568 (TTAB 1971). However, if as sometimes happens, the court before which a civil action is pending elects to suspend the civil action to await determination of the Board proceeding and the Board is so advised, the Board will go forward with its proceeding. TBMP Section 510.02(a) (2d ed. rev. 2004).

Opposer is correct that the Board generally suspends its proceedings pending the outcome of federal litigation involving the parties where as here, it appears that the federal court's final determination will have a bearing on the claims asserted in the opposition proceedings. However, in this particular instance, we have pending in the federal district court a motion to suspend the civil suit pending the Board's determination in the oppositions. According to the record, a hearing for the motion is scheduled for January 9, 2009. Under these circumstances, it is appropriate for the Board to defer to the federal district court's determination on applicant's motion to suspend the civil suit pending the Board's determination in the oppositions. The Board is therefore exercising its discretion to suspend the consolidated proceedings herein until the federal district court issues a ruling on that portion of the pending motion.

Proceedings herein are suspended pending disposition of the motion in the federal district court to suspend the civil suit pending the Board's determination in the oppositions. Within twenty days after the federal court's ruling, the parties should notify the Board so that this

case may be called up for appropriate action.<sup>1</sup>

In view of the Board's order, consideration of applicant's pending motions to amend its answers to add a counterclaim is deferred.<sup>2</sup>

**NEWS FROM THE TTAB:**

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>

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<sup>1</sup> During the suspension period the Board should be notified of any address changes for the parties or their attorneys.

<sup>2</sup> The parties' stipulations to extend the time to file a responsive brief to applicant's motions are granted.