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

Proceeding	91183857
Party	Defendant Paige Hamilton
Correspondence Address	SCOTT W. KELLEY KELLY LOWRY & KELLEY, LLP 6320 CANOGA AVE , STE 1650 WOODLAND HILLS, CA 91367-7704 UNITED STATES mike@klkpatentlaw.com
Submission	Opposition/Response to Motion
Filer's Name	Michael A. DiNardo
Filer's e-mail	Mike@KLKPatentLaw.com
Signature	/Michael A. DiNardo/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of
Trademark Application Serial Nos. 77/159,559
and 77/977,668

For the mark: PAIGE HAMILTON DESIGN
Published in Official Gazette on April 1, 2008

PREMIUM DENIM, LLC, Opposer

v.

PAIGE HAMILTON, Applicant

Opposition No. 91183857

APPLICANT’S OPPOSITION TO MOTION TO SUSPEND PROCEEDINGS

Applicant Paige Hamilton (“Applicant”), provides the following Opposition to the Motion to Suspend Proceedings under 37 CFR §2.117(a) and TMBP §510 filed by Opposer PREMIUM DENIM, LLC (“Opposer”).

I. INTRODUCTION.

Applicant believes that this is not an appropriate matter for suspension in favor of the recently filed District Court action. Applicant’s belief is based, in part, on the long period of time that this Opposition has been pending, as well as, the point at which the proceedings currently stand. Further, Applicant believes that the timing of the filing of the District Court action is merely an effort by Opposer to avoid its obligation to present testimony and evidence in this case.

II. BRIEF STATEMENT OF THE FACTS.

This Opposition proceeding has been pending for over two (2) years. During that time the parties have engaged in and completed the discovery period. Further, the parties have substantially discussed and litigated the issues including a Motion to Divide and Amend the opposed application as well as Motions challenging the sufficiency of a fraud claim. All such issues have been resolved and Opposer’s testimony period was set to open only days from the

filing of Opposer's Motion to Suspend and fifteen (15) days after the filing of the District Court Complaint.

The Notice of Opposition in this case was filed by Opposer in May, 2008. The parties exchanged written discovery in May of 2009. About the same time, Applicant filed a Motion to Divide and Amend the subject application to divide out the goods on which Applicant had not yet used but intended to use the subject mark and amended the basis of the divided application to intent-to-use. This Motion was granted on July 16th, following submission of a statement of bona fide intent to use by Applicant.

In response to the divided and amended applications, Opposer filed an Amended Notice of Opposition in October, 2009. This Amended Notice of Opposition reasserted an allegation of fraud by Applicant, which Applicant challenged the sufficiency of by way of Motion to Dismiss granted in February, 2010. At Opposer's request, the discovery period was reopened to allow Opposer to conduct discovery on Applicant's bona fide intent to use the mark on the stated goods in the divided application, which Opposer did in May, 2010.

Following the limited discovery period, Opposer served its Pre-Trial Disclosures on July 2nd. On the same day that Opposer served its Pre-Trial Disclosures, Opposer also filed the District Court action upon which its Motion to Suspend is based. Prior to the filing of the Motion to Suspend, Opposer's testimony period was set to open on July 17, 2010.¹

III. DISCUSSION.

Applicant believes that this Opposition proceeding has gone too far and has been pending for too long to now suspend it in favor of a District Court lawsuit filed only days before Opposer's testimony period was to open. As explained above, the parties have completed both the initial discovery period and a subsequent discovery period granted to Opposer to investigate Applicant's bona fide intent to use the subject mark. The parties also engaged in substantial motion practice to resolve the issues for Trial. Specifically, Applicant's Motion to Divide and

¹Unrelated to this Motion to Suspend, the parties stipulated to continue the testimony periods to facilitate an exchange of documents between the parties.

Amend the application, as well as Applicant's Motion to Dismiss the fraud claim (both of which were granted) have clarified the issues for the testimony periods and subsequent briefing.

Now that this proceeding is nearing the end, Opposer seeks to delay an ultimate resolution in favor of a newly-filed District Court action which will itself likely take more than a year to resolve. In contrast, this Opposition proceeding can be completed in a fraction of the time. Further, a resolution on the issues in this case can possibly help the District Court with some of the sub-issues involved in the claims asserted therein, i.e., priority of use, likelihood of confusion, etc.

As Opposer points out in its Motion to Suspend, Trademark Rule §2.117(a) provides that when the Board learns that a party or parties to a pending case are engaged in another action which may have bearing on the case, "proceedings before the Board **may be suspended until termination**" of the other action (emphasis added). Applicant acknowledges that typically the Board will suspend a pending proceeding when it learns that there is a co-pending civil action. However, there are certain exceptions which Applicant believes are applicable in this case.

Factors that are relevant to a determination not to suspend a Board proceeding in favor of a co-pending civil action include: (1) the duration of time that the Board proceeding has been pending; (2) the current status of the Board proceeding; and (3) the likelihood that a determination of the issues in the Board proceeding would assist in resolving issues in the civil action. See, Boyd's Collection Ltd. v. Herrington & Co., 65 USPQ2d 2017 (TTAB 2003); E. I. duPont de Nemours & Co. v. G. C. Murphy Co., 199 USPQ 807, 808 n.3 (TTAB 1978); Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp., 178 USPQ 429 (TTAB 1973);² See also, TIPS FROM THE TTAB: IMPACT OF TTAB DECISIONS IN CIVIL LITIGATION: THE ALPHONSE-GASTON ACT, 74 TRADEMARK REP 180, 186-189 (1984). Applicant submits that in the present instance each of these factors weigh in favor of not suspending proceedings.

²Although each of these cases dealt with situations after testimony, Applicant submits that the reasoning applied therein is informative on this case.

As detailed above, this Opposition proceeding has been pending for over two (2) years. Further, the parties have expended significant time, effort and money in preparing to try this case. As explained above, the parties have completed discovery and litigated multiple motions to limit and/or resolve specific issues. The efforts by the parties have put this proceeding into a position where it is now ready to be tried.

Indeed, Opposer's testimony period was set to open on July 17, 2010. In connection with this testimony period, Opposer's Pre-Trial Disclosures were served on July 2, 2010. On the same day, Opposer filed the District Court action upon which it now bases its Motion to Suspend. Thus, Opposer was fully aware of the status of the pending Opposition at the time it filed the civil court action.

The timing of these actions is not coincidental. Applicant believes that Opposer wants to avoid its obligation to present testimony and evidence in this Opposition proceeding.

IV. CONCLUSION.

Applicant respectfully submits that the instant Motion to Suspend should be denied.

Dated: July 28, 2010

/Michael A. DiNardo/

Michael A. DiNardo
KELLY LOWRY & KELLEY, LLP
Attorneys for Applicant, Paige Hamilton

CERTIFICATE OF SERVICE

I hereby certify that on July 28, 2010, I caused a copy of the attached **APPLICANT'S OPPOSITION TO MOTION TO SUSPEND PROCEEDINGS** to be served on counsel for Applicant, via U.S. first class mail, postage prepaid, as follows:

Rod S. Berman, Esq.
Jessica Bromal, Esq.
Jeffer Mangels Butler & Marmaro LLP
1900 Avenue of the Stars, 7th Floor
Los Angeles, CA 90067

Dated: July 28, 2010

/Nancy Hoover/

Nancy Hoover
For Kelly Lowry & Kelley, LLP