

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

CME

Mailed: September 9, 2013

Opposition No. 91195670
Opposition No. 91195671
Cancellation No. 92052674

Clover Farms Dairy Company

v.

Clover-Stornetta Farms, Inc.

Christen M. English, Interlocutory Attorney:

On August 9, 2013, a third party, Cloverland Dairy Limited Partnership ("Cloverland"), filed a motion to suspend these consolidated proceedings pending the disposition of a civil action between it and opposer/petitioner, (*Cloverland Dairy Limited Partnership v. Clover Farms Dairy Company, et al.*, Case No. 1:13-cv-01007-JKB, pending in the U.S. District Court for the District of Maryland (the "Federal Case")). Cloverland is not a party to this case, and Board rules provide no mechanism for a third party to file motions in a Board proceeding. *Cf* Trademark Rule 2.119(e) ("Every paper filed in an *inter partes* proceeding ... must be signed by the *party* filing it, or by the *party's* attorney or other authorized representative.") (emphasis added); see also TBMP § 106.02

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(3d ed. rev.2 2013). Accordingly, Cloverland's motion is hereby **DENIED** as improper.

However, when it comes to the Board's attention that a party to a case pending before it is involved in a civil action which may have bearing on the Board case, the Board may suspend proceedings before it until final determination of the civil action. TBMP § 510.01. When the Board learns about a potentially relevant civil action, it typically requests that the parties file copies of the pleadings in the civil action. Here, however, the complaint and answer in the Federal Case are already of record, and it would serve no purpose other than delay to require that the parties resubmit copies of the pleadings. Moreover, applicant/respondent has had an opportunity to be heard on the issue of suspension because it filed a response to Cloverland's motion.

By way of background, opposer/petitioner in these consolidated proceedings has alleged prior common law rights in and a use-based application for the mark CLOVER FARMS for "milk, chocolate milk, buttermilk, butter, cottage cheese, egg nog, half and half, heavy cream, light cream, non-dairy creamer, sour cream, and whipping cream."¹ In its notices of opposition and petition for cancellation,

¹ Application Serial No. 77763209, filed on June 18, 2009, alleging a date of first use of 1940 and a date of first use in commerce of 1970; "farms" disclaimed.

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opposer/petitioner alleges that applicant/respondent's marks CLOVER ORGANIC FARMS, CLOVER FARMSTEAD and CLOVER STORNETTA, all in standard characters, for milk, eggs, and other dairy products, namely, cheese, and ice cream,² are likely to cause confusion with opposer/petitioner's prior-used CLOVER FARMS mark. In its answers, applicant/respondent denies the salient allegations.

In the Federal Case, Cloverland has alleged that opposer/petitioner's use of the marks CLOVER FARMS and a cloverleaf design in certain jurisdictions (defined as the "Market") infringes its prior rights in the mark CLOVERLAND FARMS DAIRY. Cloverland seeks an injunction enjoining and restraining opposer/petitioner from "using the CLOVER FARMS mark, including any variations thereof, the cloverleaf or any other mark, logo or design" similar to Cloverland's mark, in "the Market and in[] any zone of natural expansion into which Cloverland Farms is likely to expand." Federal Complaint, Prayer for Relief, ¶ A. Cloverland has also requested that the Federal court "order that registration of the CLOVER FARMS mark [subject to the pleaded application

² Application Serial No. 76680931, filed on August 20, 2007 alleging first use dates of February 18, 2005, "organic farms disclaimed"; Application Serial No. 76680932, filed on August 20, 2007, alleging an intent to use the mark, "farmstead disclaimed"; and Registration No. 3503416, issued on September 23, 2008, alleging a date of first use of January 1, 1980.

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here] not be allowed to proceed, or that it be cancelled if
it is registered." *Id.* at ¶ G.

The Board's well-settled policy is to suspend
proceedings when one or both parties are involved in a civil
action which *may* be dispositive of or *have a bearing* on the
Board case. Trademark Rule 2.117(a) (emphasis added); TMEP
§ 510.02(a); *General Motors Corp. v. Cadillac Club Fashions,
Inc.*, 22 USPQ2d 1933, 1937 (TTAB 1992). Opposer/petitioner
is the defendant in the Federal Case, which involves
opposer/petitioner's pleaded mark and its common law rights
therein.³ Indeed, Cloverland seeks to enjoin
opposer/petitioner from using its pleaded mark in the Market
and in "any zone of natural expansion into which Cloverland
Farms is likely to expand" and has requested that the
pleaded application be denied registration. Because
opposer/petitioner relies on its common law rights to
support its claims of priority and likelihood of confusion
in these consolidated proceedings, the Federal Case is
relevant and "*may have a bearing*" on these proceedings and
any settlement between the parties "to establish concurrent
registrations in different geographic regions of the United
States." July 30, 2013 Motion (acknowledging that the
Federal Case "*may have a bearing* on the proposed settlement

³ Contrary to applicant/respondent's assertion, the Federal
Case involves the word mark CLOVER FARMS separate and apart from
opposer/petitioner's cloverleaf design mark.

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in this proceeding.") Accordingly, proceedings herein are suspended pending final disposition of the Federal Case, including any appeals thereof.⁴ Within **TWENTY DAYS** after the final determination of the Federal Case, the parties shall so notify the Board and call this case up for any appropriate action.

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

⁴ Opposer/petitioner's consented motion to suspend for settlement, filed on July 30, 2013, is moot and will be given no further consideration.