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

Proceeding	91204576
Party	Defendant Borghese Trademarks, Inc.
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Submission	Motion to Suspend for Civil Action
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Date	04/09/2012
Attachments	Applicant's motion to suspend and consoliante.pdf ( 8 pages )(44419 bytes )

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

-----X  
Multi Media Exposure, Inc.,  
Opposer,  
v. Opposition No.: 91204572  
Serial No.: 85363847  
Mark: BORGHESE PET PALAZZO  
Class: 31  
Borghese Trademarks, Inc.  
Applicant.

-----X  
Multi Media Exposure, Inc.,  
Opposer,  
v. Opposition No.: 91204573  
Serial No.: 85363825  
Mark: BORGHESE PET PALAZZO  
Class: 3  
Borghese Trademarks, Inc.  
Applicant.

-----X  
Multi Media Exposure, Inc.,  
Opposer,  
v. Opposition No.: 91204574  
Serial No.: 85363828  
Mark: BORGHESE PET PALAZZO  
Class: 18  
Borghese Trademarks, Inc.  
Applicant.

-----X  
Multi Media Exposure, Inc.,  
Opposer,  
v. Opposition No.: 91204575  
Serial No.: 85363836  
Mark: BORGHESE PET PALAZZO  
Class: 20  
Borghese Trademarks, Inc.  
Applicant.

-----X  
Multi Media Exposure, Inc.,  
Opposer,  
v. Opposition No.: 91204576  
Serial No.: 85363842  
Mark: BORGHESE PET PALAZZO  
Class: 21  
Borghese Trademarks, Inc.  
Applicant.  
-----X

**MOTION TO SUSPEND AND TO CONSOLIDATE OPPOSITION PROCEEDINGS  
PENDING DISPOSITION OF RELATED CIVIL ACTION  
IN LIEU OF FILING AN ANSWER**

Pursuant to Rule 42(a) of the F.R.Civ.P, Applicant herein hereby moves to consolidate the captioned proceedings for purposes of trial. The alleged grounds for all five (5) proceedings are identical. The same questions of law and fact are involved in all proceedings. Rule 42(a) of the F.R.Civ.P. provides that when actions involve a common question of law or fact and are pending before a court, the court may order that the actions be consolidated. In view of the identical alleged grounds and the common questions of law and fact, Applicant respectfully requests that the proceedings be consolidated. Consolidation will benefit the Board as well as the parties in terms of judicial resources and costs to both parties.

Pursuant to 37 CFR § 2.117(a) and TBMP § 510.02(a), Applicant, Borghese Trademarks, Inc. ("Applicant") also hereby requests that the Trademark Trial and Appeal Board suspend this opposition proceeding pending a final determinations of *Borghese Trademarks Inc. v. Borghese*, Civil Action No. 10 CIV 5552 ("Civil Action"), ongoing between the parties and involving Opposer's mark PRINCE LORENZO BORGHESE'S LA DOLCE VITA ("Opposer's Mark"), because this action will have a direct bearing on the instant proceeding.

**FACTUAL BACKGROUND**

On March 28, 2009, Opposer herein filed Application Serial No. 77/435,171 for the mark PRINCE LORENZO BORGHESE'S LA DOLCE VITA. On April 8, 2009, Applicant herein initiated Opposition Proceeding Number 91189629, alleging, *inter alia*, a likelihood of confusion between Opposer's Mark and Applicant's various registered marks.

On July 21, 2010, Applicant, herein, filed a Complaint with the United States District Court for the Southern District of New York ("S.D.N.Y."), a matter that remains pending to date, alleging, *inter alia*, that Opposer's use of the LA DOLCE VITA BY PRINCE LORENZO BORGHESE mark constitutes federal and common-law trademark infringement. (See Complaint

attached hereto as Exhibit 1.) In the Complaint, Applicant herein is seeking, among other relief, an order that Opposer's Application for registration of its Mark, the subject of Opposition Proceeding Number 91189629, be withdrawn, and enjoining Opposer from using or registering Opposer's Mark.

On July 23, 2010, Opposer herein filed a motion to suspend Opposition Proceeding Number 91189629, pending disposition of the civil complaint. The Board granted this motion, and Opposition Proceeding Number 91189629 remains suspended to date.

On July 6, 2011, Applicant herein filed Application Serial Number 85363847 for the mark BORGHESE PET PALAZZO ("Applicant's Mark") in International Class 31, along with four (4) other applications for the same mark in other classes, namely Application Serial Numbers 85363825, 85363828, 85363836, and 85363842.

On March 4, 2012, Opposer filed the instant opposition, Opposition Number 91204572, against Application Serial Number 85363847, and likewise filed four other oppositions against Applicant's four other pending applications for Applicant's Mark, namely Opposition numbers 91204573, 91204574, 91204575 and 91204576 citing its common law mark LORENZO BORGHESE as grounds for the oppositions, a mark with the identical term LORENZO BORGHESE as in the application for the mark, LA DOLCE VITA BY PRINCE LORENZO BORGHESE, the mark at issue in the civil matter.

## ARGUMENT

### ***The Determinations in *Borghese Trademarks Inc. v. Borghese* Will Have A Direct Bearing On The Issues Before The Board***

The Board has broad power to suspend a matter brought before pending final disposition of a related case brought in a Federal Court civil action that may have a bearing on the Board matter. 37 CFR § 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.”

Here, The District Court proceedings and the TTAB proceedings herein involve the same parties as in the civil matter and the other TTAB proceedings, involve common issues and the same underlying facts. If the court enjoins Opposer’s use of its LA DOLCE VITA BY PRINCE LORENZO BORGHESE trademark in the civil matter and orders its application withdrawn for its LA DOLCE VITA BY PRINCE LORENZO BORGHESE mark, Opposer herein will be unable to maintain its application which Opposer references in its claims in the Opposition proceeding herein. That fact will weigh heavily against Opposer in the instant Oppositions with respect to its cited LORENZO BORGHESE mark.

“A decision by the United States District Court would be binding on the Patent Office whereas a determination by the Patent Office as to respondent's right to retain its registration would not be binding or res judicata in respect to the proceeding before the federal district court." *Whopper- Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (T.T.A.B. 1971). A court's decision regarding the right to registration would be binding on the Board. *The Seven-Up Co. v. Bubble Up Co.*, 136 U.S.P.Q. 210,214 (C.C.P.A. 1963); *see also In re Alfred Dunhill Ltd.*, 224 U.S.P.Q. 501,503 (T.T.A.B. 1984); J. Thomas McCarthy, 6 *McCarthy on Trademarks and Unfair Competition* § 32:94 (4th ed. 2009) (hereinafter "McCarthy").

The Board’s well-settled policy is to suspend proceedings when the 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); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1937 (TTAB 1992). Here, the civil action between these parties will have a bearing on these oppositions because the marks in all the cases include the term BORGHESE and are between identical parties.

Applicant and Opposer herein are both parties to the Civil Action, which is currently pending before the S.D.N.Y. and involves Applicant's PRINCE LORENZO BORGHESE'S LA DOLCE VITA mark and similar legal issues related to trademark-infringement and unfair-competition, a mark highly similar to its LORENZO BORHGESE common law mark cited against the applications at issue here. In that case, the District Court will determine the respective rights of Applicant and Opposer with respect to Applicant's PRINCE LORENZO BORGHESE'S LA DOLCE VITA Mark, a determination which will affect its rights as to its LORENZO BORGHESE mark used as grounds for its current oppositions. It is clear that this type of determination will directly affect the resolution of the issues of Applicant's BORGHESE PET PALAZZO marks and applications before the Board. *See The Other Tel. Co. v. Conn. Nat'l Tel. Co., Inc.*, 181 U.S.P.Q. 125, 126-7 (T.T.A.B. 1974).

While the other TTAB case and civil matter involving these parties involves other marks, the Federal Case may nevertheless have a bearing on this one. Indeed, Applicant's Marks herein encompass the word marks involved in the other proceeding. And if the Court issues an injunction therein, Opposer's case herein may be thereby affected. In fact, the decision in the Federal Case may be "binding upon the Board, while the decision of the Board is not binding upon the court," and it would therefore be inappropriate to proceed here and risk inconsistent judgments. TBMP § 510.02(a) (3d ed. 2011); see also, *The Other Telephone Co. v. Connecticut National Telephone Co., Inc.*, 181 USPQ 779 (Comr. 1974); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971).

In fact, Applicant contends that Opposer only brought the instant proceedings as a result of the other ongoing litigation, and brought them in bad faith. It is notable that Opposer herein did not base its oppositions on its pending application for its mark PRINCE LORENZO BORGHESE'S LA DOLCE VITA, but rather only relied on its common law mark LORENZO

BORGHESE. Nevertheless, the outcome of the civil litigation will have a strong bearing on the outcome of the instant oppositions.

Based on the foregoing, Applicant respectfully requests that the Board stay these proceedings pending the final determination of the Civil Action.

Moreover, with regard to the motion for consolidation, Applicant's marks at issue, namely BORGHESE PET PALAZZO, are identical among the applications being opposed, and are for related pet goods and services in related classes. Moreover, the Opposer herein cites its LORENZO BORGHESE against all applications at issue.

Primarily, the proceedings may be presented on the same record, thus avoiding the need to take multiple testimony depositions of the same witnesses, avoiding the need to submit multiple and identical documents as evidence, and avoiding the need to file identical Notices of Reliance and trial briefs in each case. It is in the interest of justice, time and resources that the proceedings be consolidated. There can be no prejudice to the Opposer if the proceedings are consolidated as Applicant has not yet filed its Answers. The above request is not filed merely for purposes of delay.

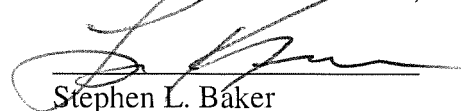
Applicant also requests that the Board reset all dates, including Applicant's time to file its Answers, based on its dispositions of this motion to consolidate and to suspend. This motion is sought in good faith and not for any improper purpose of delay.

For the foregoing reasons, Applicant requests that its motion to consolidate and to suspend the Oppositions be granted in all respects.

Dated: April 9, 2012

Respectfully submitted,

BAKER AND RANNELLS, PA



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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Applicant's Motion to Suspend re Multi Media Exposure, Inc. v Borghese Trademarks Inc.,. Opposition No. 91204572 was forwarded by email and first class, postage pre-paid mail by depositing the same with the U.S. Postal Service on this 9<sup>th</sup> day of April, 2012 to the attorneys for the Opposer at the following address:

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/s/Linda Kurth  
Linda Kurth