

ESTTA Tracking number: **ESTTA679826**

Filing date: **06/24/2015**

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

Proceeding	91216909
Party	Defendant BOL ENTERPRISE (PVT.) LIMITED
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Attachments	BOL - Applicant's Opposition to Motion to Suspend.pdf(22180 bytes )

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

In re Application Serial Nos. 85/966,100 and 86/003,454  
Filed: June 21, 2013 and July 6, 2013  
For Marks: BOL and Design and BOL (Urdu) and Design  
Published in the Official Gazette: February 18, 2014

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INDEPENDENT MEDIA CORPORATION :  
(PVT.) LTD., :  
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Opposer, : Opposition Nos.: 91216909 (parent)  
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v. : 91216942  
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BOL ENTERPRISE (PVT.) LIMITED, :  
:  
Applicant. :  
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**APPLICANT'S OPPOSITION TO MOTION TO SUSPEND**

Applicant BOL Enterprise (Pvt.) Limited ("BOL") ("Applicant"), by and through its undersigned attorneys, hereby respectfully submits this opposition to the motion to suspend filed on June 15, 2015 by Opposer Independent Media Corporation (Pvt.) Ltd. ("Opposer") [Dkt. 13].

Opposer's motion seeks to suspend the instant consolidated opposition proceedings (the "Consolidated Opposition") pending a decision by the Board on a motion to consolidate the instant proceedings with a later-filed proceeding, Opp. No. 91219384 (the "Opposition").

The Board should deny the motion because Opposer has not met its burden to shown good cause for the requested suspension. Such suspension would unnecessarily delay the resolution of the instant Consolidated Opposition, in which extensive discovery has already taken place, discovery has closed and testimony periods are about to commence, in contrast to the later-filed Opposition which has not moved beyond the pleading stage. Such extensive delay

would result in significant prejudice to Applicant, who has already invested substantial resources in defending the instant Consolidated Opposition and has filed a motion for summary judgment seeking to dismiss the instant proceedings in their entirety based upon a straightforward legal issue addressed to whether Opposer's theory of priority fails as a matter of law [Dkt. 14]. Thus, the requested suspension would not serve the interests of judicial economy since a resolution of the instant Consolidated Opposition could also effectively dispose of the later-filed Opposition as it involves the same priority dispute between the same parties over the mark BOL.

Indeed, to the extent there should be any suspension, it is the later-filed Opposition that should be suspended pending the outcome of the instant Consolidated Opposition since the Board's ruling in the instant proceedings, including on Applicant's pending motion for summary judgment, will have a direct bearing on the later-filed Opposition. *See* 37 C.F.R. § 2.117(a).<sup>1</sup>

The motion to consolidate the later-filed Opposition – the sole basis for the requested suspension – was filed over 6 months ago, and yet Opposer did not even raise the subject of suspension until after the close of discovery in the instant Consolidated Opposition. Thus, the suspension motion should be viewed as a stalling tactic whose purpose is to delay prompt adjudication of the priority dispute at the heart of the instant Consolidated Opposition. Accordingly, the Board should exercise its discretion under these circumstances by denying Opposer's motion to suspend and permitting disposition of the instant Consolidated Opposition.

### **STATEMENT OF FACTS**

At its crux, the instant Consolidated Opposition involves a priority dispute among two Pakistani companies concerning ownership of the mark "BOL" in the United States.

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<sup>1</sup> For this reason, on June 18, 2015, Applicant filed a motion in the later-filed Opposition seeking to suspend that proceeding pending the outcome of the instant Consolidated Opposition. Opp. No. 91219384, Dkt. 7. That motion remains pending before the Board.

On June 18, 2014, Opposer filed two oppositions: one against Applicant's application to register the mark BOL and Design for services in International Class 41 (Opposition No. 91216909), and one against Applicant's application to register the mark BOL (Urdu) and Design for services in International Classes 38 and 41 (Opp. No. 91216942). On October 15, 2014, the Board consolidated the oppositions and designated Opposition No. 91216909 as the parent opposition. Dkt. 8. The Notices of Opposition in the instant proceeding principally assert a claim for likelihood of confusion based upon Opposer's alleged prior rights in the mark BOL.

On November 18, 2014, over a month after the instant proceedings were consolidated, Opposer filed a third opposition against Applicant's more recent application to register the standard character word mark BOL for services in International Classes 38 and 41 (Opposition No. 91219384). On December 10, 2014, Applicant filed its Answer and a motion on consent to consolidate that proceeding with the instant Consolidated Opposition. Dkts. 5-6.

The motion to consolidate in Opposition No. 91219384 was not acted upon by the Board. Meanwhile, the parties moved forward with discovery in the instant Consolidated Opposition, serving and responding to document requests, interrogatories, and requests for admission. Discovery in the instant Consolidated Opposition closed on May 24, 2015. Dkts. 11-12. On June 24, 2015, upon the close of discovery, Applicant filed a motion for summary judgment seeking to dismiss Opposer's claims based upon a straightforward, potentially dispositive legal issue, namely, whether the "single creative work" doctrine bars Opposer from establishing priority as a matter of law. [Dkt. 14].

Because the later-filed Opposition involves the same priority dispute between the parties concerning the mark BOL, if the Board grants Applicant's motion for summary judgment in the

instant Consolidated Opposition, such ruling by the Board will have a direct bearing on the later-filed Opposition.

### **ARGUMENT**

As the Board has recognized, the permissive language of Trademark Rule 2.117(a) indicating that proceedings *may* be suspended as well as the express provisions of Trademark Rule 2.117(b) make clear that suspension is not the appropriate result in all cases. *See Boyds Collection Ltd. v. Herrington & Co.*, 65 U.S.P.Q.2d 2017, 2018 (T.T.A.B. 2003) (finding suspension “neither necessary nor appropriate”). “All motions to suspend, regardless of circumstances . . . are subject to the ‘good cause’ standard.” *Nat’l Football League v. DNH Mgmt. LLC*, 85 U.S.P.Q.2d 1852, 1855, n.8 (T.T.A.B. 2008). As set forth below, Opposer has not met its burden to show “good cause” for the requested suspension.

First, the only effect of the requested suspension would be to delay resolution of the instant Consolidated Opposition unnecessarily. While Applicant initially supported the request to consolidate the later-filed Opposition with the instant proceedings, over six months have passed since the filing of that request and in the interim the parties have completed substantial written discovery in the instant Consolidated Opposition, discovery is now closed and testimony periods are about to commence. Meanwhile, the later-filed Opposition has not moved beyond the pleading stage. The obvious disparity with respect to the proceedings’ stages of discovery belies Opposer’s claim that a suspension would result in judicial economy. *Accord Lever Brothers Co. v. Shaklee Corp.*, 214 U.S.P.Q. 654, 655 (T.T.A.B. 1982) (denying consolidation where one case was just in pleading stage, and testimony periods had expired in other); *Long v. Dickson*, 2006 U.S. Dist. LEXIS 47377, at \*1 (D. Kan. Jan. 1, 2006) (“Because the two actions are at such widely separate stages of preparation, consolidation of these cases would cause

further delay and could prejudice the parties”); *Henderson v. National R. Passenger Corp.*, 118 F.R.D. 440, 441 (N.D. Ill. 1987) (“Consolidation with a recently filed case in which discovery is just beginning will obviously entail further delay”).

Furthermore, the requested suspension would severely prejudice Applicant, who, at great effort and expense, has prepared and filed a motion for summary judgment seeking to dismiss the instant Consolidated Opposition based upon a straightforward, potentially dispositive legal issue—*i.e.*, whether Opposer’s theory of priority of use of the mark BOL is barred as a matter of law under the “single creative work” doctrine. Such a discrete legal issue is ripe for the Board’s consideration and, if such motion is granted, it would warrant the dismissal of Opposer’s claims. There is simply no compelling reason why the Board should forestall its determination of Applicant’s summary judgment motion directed to a purely legal issue that could result in a prompt termination of these proceedings. In circumstances such as these, the Board’s rules express a clear preference to decide the potentially dispositive motion irrespective of whether a motion to suspend has been filed. *See* Trademark Rule 2.117(b) (“Whenever there is pending before the Board both a motion to suspend and a motion which is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered regardless of the order in which the motions were filed”).

Additionally, the fact that Opposer did not even raise the prospect of a suspension until after discovery had already closed in the Consolidated Opposition suggests that the instant motion is nothing more than a stalling tactic. In similar circumstances, where the impetus of the suspension motion was to avoid dispositive findings and delay the proceeding, the Board has denied the request to suspend. *See Boyds Collection, Ltd.*, 65 U.S.P.Q.2d at 2018 (denying suspension where motion was filed to avoid dispositive motion and delay the outcome of the

proceeding). The Board should similarly refuse to countenance what is a tactical maneuver designed to unnecessarily delay its resolution of the instant Consolidated Opposition.

The more appropriate and efficient procedure in this situation is to suspend the later-filed Opposition pending disposition of the instant Consolidated Opposition in accordance with Trademark Rule 2.117(a). *See, e.g., Honda Giken Kogyo Kabushiki Kaisha v. H-D Michigan Inc.*, 43 U.S.P.Q. 2d 1526 (T.T.A.B. 1997) (denying motion to consolidate and instead staying proceedings except those where dispositive motions were pending); *Lever Brothers*, 214 U.S.P.Q. at 655 (noting that later-filed cancellation proceeding was suspended pending outcome of opposition proceeding involve same parties and marks). If Applicant prevails on summary judgment and the Board decides that Opposer is unable as a matter of law to establish proprietary rights in the claimed mark prior to Applicant's priority date of June 21, 2013, that finding would effectively dispose of the later-filed Opposition as well insofar as it involves the same priority dispute between the same parties. Moreover, whatever the outcome in the instant Consolidated Opposition, the decision will likely have a significant impact on the later-filed Opposition and quite possibly render it unnecessary as a practical matter.

### **CONCLUSION**

For all of the foregoing reasons, Applicant respectfully requests that Opposer's motion to suspend be denied in all respects.



**CERTIFICATE OF SERVICE**

I hereby certify that I caused a copy of the foregoing APPLICANT'S OPPOSITION TO MOTION TO SUSPEND to be served on Opposer's attorneys of record via electronic mail to the email addresses specified below:

Harold Novick ([hnovick@nkllaw.com](mailto:hnovick@nkllaw.com))

Angela Dai ([adai@nkllaw.com](mailto:adai@nkllaw.com))

Dated: New York, New York  
June 24, 2015

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/s/ Scott P. Ceresia  
Scott P. Ceresia