

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: December 17, 2016

Opposition No. 91226297

The Kitchen Cafe, LLC

v.

Wolfgang Puck Licensing LLC

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of Opposer's November 30, 2016 motion to suspend proceedings in view of pending civil action. The motion is fully briefed.¹

Analysis

It is the policy of the Board to suspend proceedings when a party or the parties are involved in a civil action, which may be dispositive of or may have a bearing on

¹ The Board, in its discretion, and to avoid delay to this proceeding, considers the merits of the motion prior to the time for filing a reply brief thereon. TBMP § 502.02(b) (2016); *Cf.* TBMP § 502.06(a) (2016); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1720 n.3 (TTAB 1989).

Opposer's June 7, 2016 consent motion for leave to file first amended answer to counterclaims, is granted. Opposer's first amended answer to counterclaims is its operative pleading with respect to Applicant's counterclaims.

The August 30, 2016 notice of appearance on behalf of Applicant is noted and is of record.

the Board proceeding. The applicable authority, Trademark Rule 2.117(a), provides as follows:

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.

TBMP § 510.02(a) (2016); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1937 (TTAB 1992). Suspension of a Board proceeding pending the final determination of a civil action or another proceeding is solely within the discretion of the Board. TBMP § 510.02(a) (2016).

The Board presumes the parties' familiarity with the record, including arguments presented on both motions. The Board addresses the record to the extent necessary to set forth its analysis and findings, and does not repeat or address all of the parties' arguments and exhibits. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

Opposer moves for suspension of this proceeding pending disposition of a civil action between the same parties, namely, *The Kitchen Café LLC v. Wolfgang Puck Licensing LLC*, Civil Action No. 1:16-cv-02814, which is pending in the United States District Court for the District of Colorado ("civil action"). Opposer appropriately submitted with its motion a copy of the complaint filed in the civil action. TBMP § 510.02(a) (2016).

This opposition proceeding involves Opposer's pleaded registered and common law marks, which consist of or incorporate the wording THE KITCHEN, and involves

Opposer's claim of priority and likelihood of confusion, pursuant to Trademark Act Section 2(d), against Applicant's involved marks THE KITCHEN BY WOLFGANG PUCK and THE KITCHEN COUNTER BY WOLFGANG PUCK (standard characters). Also involved are Applicant's counterclaims to cancel, or for disclaimer of KITCHEN, against two of Opposer's pleaded registrations, for the marks THE KITCHEN UPSTAIRS and THE KITCHEN NEXT DOOR (standard characters).

In the civil action, Opposer brings, *inter alia*, claims of trademark infringement and unfair competition against Applicant's mark THE KITCHEN BY WOLFGANG PUCK, and seeks relief in the form of, *inter alia*, enjoining Applicant from making any use of the marks THE KITCHEN, THE KITCHEN BY WOLFGANG PUCK and "any mark confusingly similar to THE KITCHEN."² *See, e.g., Other Tel. Co. v. Conn. Nat'l Tel. Co.*, 181 USPQ 125, 126-27 (TTAB 1974) (decision in civil action for infringement and unfair competition would have bearing on outcome of Trademark Act § 2(d) claim before Board), *pet. denied*, 181 USPQ 779 (Comm'r 1974).

As set forth in the complaint, the relief that Opposer seeks in the civil action could encompass Applicant's use of either of its involved marks. The record does not reflect that the relief sought would not encompass Applicant's mark THE KITCHEN COUNTER BY WOLFGANG PUCK. Moreover, the likelihood of confusion analyses in the Board proceeding and civil action would involve some of the same issues of fact inasmuch as each of the parties' marks are or begin with the identical wording THE KITCHEN; the additional wording in certain of the parties' marks may bear on the

² 11 TTABVUE 19-20; civil action complaint p. 14-15.

ultimate *findings* going to likelihood of confusion, but does not, as Applicant argues, militate that a different *analysis* would be applied in the two proceedings.

The Board notes Applicant's argument that the Board should allow its counterclaims for cancellation of two of Opposer's pleaded marks to go forward. In the civil action, Opposer alleges use of "THE KITCHEN mark and a family of KITCHEN-formative marks" including THE KITCHEN UPSTAIRS and THE KITCHEN NEXT DOOR,³ and also alleges ownership of Registration Nos. 4679061, 4165447 and 5411498, submitting copies of the registration certificates for these properties.⁴ Accordingly, the record does not at this time support Applicant's conclusion that Opposer's federal registrations are not at issue in the civil action.

Having thoroughly considered the record, the Board finds that the determination of the civil action may have a bearing on the determination of the claims, defenses and counterclaims in this proceeding. In view of these findings, Opposer's motion to suspend pending final determination of the civil action is granted. Accordingly, proceedings in this opposition are suspended pending final disposition of the civil action. Trademark Rule 2.117(a).

Within twenty days after the final determination of the civil action, the parties shall so notify the Board so that this proceeding may be called up for appropriate

³ 11 TTABVUE 9.

⁴ 11 TTABVUE 13.

action.⁵ Such notification to the Board should include a copy of any final order(s) or judgment(s) which issue in the civil action.⁶

During the suspension period, the parties must notify the Board of any address or email address changes for the parties or their attorneys.

In addition, the parties are to promptly inform the Board of any other related cases, even if they become aware of such cases during the suspension period. Upon resumption, if appropriate, the Board may consolidate related Board cases.

**NOTICE: CHANGES TO THE TRADEMARK TRIAL AND APPEAL BOARD
("BOARD") RULES OF PRACTICE WILL BE
EFFECTIVE JANUARY 14, 2017**

The USPTO published a Notice of Final Rulemaking in the Federal Register on October 7 2016, at 81 F.R. 69950. It sets forth several amendments to the rules that govern *inter partes* (oppositions, cancellations, concurrent use) and *ex parte* appeal proceedings.

For complete information, the parties are referred to:

- The Board's home page on the uspto.gov website:
<http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab>
- The final rule:
<http://www.uspto.gov/sites/default/files/documents/81%20FR%2069950.pdf>
- A chart summarizing the affected rules and changes:
http://www.uspto.gov/sites/default/files/documents/RulesChart_01_14_17.pdf

For all proceedings, including those **already in progress on January 14, 2017**, some of the changes are:

- All pleadings and submissions must be filed through ESTTA. Trademark Rules 2.101, 2.102, 2.106, 2.111, 2.114, 2.121, 2.123, 2.126, 2.190 and 2.191.
- Service of all papers must be by email, unless otherwise stipulated. Trademark Rule 2.119.
- Response periods are no longer extended by five days for service by mail. Trademark Rule 2.119.

⁵ A proceeding is considered to have been finally determined when an order or ruling that ends litigation has been rendered, and no appeal has been filed, or all appeals filed have been decided and the time for any further review has expired. *See* TBMP § 510.02(b) (2016).

⁶ The copies submitted to the Board need not be certified, but must be clear and legible.

- Deadlines for submissions to the Board that are initiated by a date of service are 20 days. Trademark Rule 2.119. Responses to motions for summary judgment remain 30 days. Similarly, deadlines for responses to discovery requests remain 30 days.
- All discovery requests must be served early enough to allow for responses prior to the close of discovery. Trademark Rule 2.120. Duty to supplement discovery responses will continue after the close of discovery.
- Motions to compel initial disclosures must be filed within 30 days after the deadline for serving initial disclosures. Trademark Rule 2.120.
- Motions to compel discovery, motions to test the sufficiency of responses or objections, and motions for summary judgment must be filed prior to the first pretrial disclosure deadline. Trademark Rules 2.120 and 2.127.
- Requests for production and requests for admission, as well as interrogatories, are each limited to 75. Trademark Rule 2.120.
- Testimony may be submitted in the form of an affidavit or declaration. Trademark Rules 2.121, 2.123 and 2.125
- New requirements for the submission of trial evidence and deposition transcripts. Trademark Rules 2.122, 2.123, and 2.125.

- For proceedings **filed on or after January 14, 2017**, in addition to the changes set forth above, the Board's notice of institution constitutes service of complaints. Trademark Rules 2.101 and 2.111.