

ESTTA Tracking number: **ESTTA822197**

Filing date: **05/19/2017**

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

Proceeding	91232430
Party	Plaintiff Emeril's Food of Love Productions, LLC
Correspondence Address	DEBORAH K SQUIERS COWAN LIEBOWITZ & LATMAN PC 114 WEST 47TH ST 21ST FL NEW YORK, NY 10036 UNITED STATES trademark@cll.com, dks@cll.com, lsf@cll.com, fxm@cll.com
Submission	Other Motions/Papers
Filer's Name	Timothy J. Buckley
Filer's e-mail	tjb@cll.com, dks@cll.com, lsf@cll.com, fxm@cll.com, trademark@cll.com
Signature	/Timothy J. Buckley/
Date	05/19/2017
Attachments	Emerils Opposition to Motion to Suspend Ocinomled Opposition.pdf(152950 bytes )

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

In the Matter of Application Serial Nos. 76577252 and 76577253  
For Mark: DELMONICO’S  
Published in the Official Gazette: December 27, 2016 and January 3, 2017

-----X

EMERIL’S FOOD OF LOVE PRODUCTIONS,	:	
LLC,	:	Opposition No. 91232430
	:	
Opposer,	:	
	:	
v.	:	
	:	
OCINOMLED, LTD.	:	
	:	
	:	
Applicant.	:	

-----X

**OPPOSER’S OPPOSITION TO  
APPLICANT’S MOTION TO SUSPEND**

Opposer Emeril’s Food of Love Productions, LLC (“Emeril’s”) hereby submits this opposition to Applicant’s motion to suspend, which was brought pursuant to 37 C.F.R. § 2.117(a). Suspension would not be in the interests of judicial economy in view of (1) the pending dispositive motion filed by Emeril’s with respect to Ocinomled’s Class 43 application; (2) the attenuated nature of any relationship between the issues in the federal court litigation on which Ocinomled’s suspension motion is based and the issues in this opposition proceeding; and (3) the long history of related litigation between the parties to this opposition proceeding in a prior concurrent use proceeding that has already been litigated to conclusion before the Board and affirmed by the Federal Circuit. Accordingly, the Board should exercise its discretion to consider Emeril’s’ pending summary judgment motion and deny Ocinomled’s motion to suspend.

While Trademark Rule 2.117(a) gives the Board authority to suspend a proceeding when a party to such proceeding is engaged in a civil action that may have a bearing on the proceeding, Rule 2.117(b) also provides that “[w]henver 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.” 37 C.F.R. § 2.117(b) . As the Board explained in Boyds Collection, Ltd. v. Herrington & Co., 65 U.S.P.Q.2d 2017 (T.T.A.B. 2003), “both the permissive language of Trademark Rule 2.117(a) ... and the explicit provisions of Trademark Rule 2.117(b) make clear that “suspension is not the necessary result in all cases.” Id. at 2018 (finding that suspension is neither necessary nor appropriate” in case before it).

In the unique circumstances of the present case, it is clear that suspension is not the most efficient manner to proceed here and the interests of judicial economy weigh strongly in favor of consideration of Emeril’s’ pending summary judgment motion. It is important to note that Ocinomled has offered no meaningful explanation of how the outcome in the federal court litigation among the owners of Ocinomled is likely to impact on the present opposition. Indeed, Ocinomled emphasizes that “it wishes to make one point very clearly – it is the owner of the DELMONICO’S Mark.” Ocinomled Motion at 6. Nor has Emeril’s’ raised any claim in this opposition proceeding that Ocinomled is not the proper owner of such mark. Rather, the sole issues raised by Emeril’s’ opposition is which party has prior rights and is there a likelihood of confusion between the parties’ marks. As the likelihood of confusion issue has already been conceded by Ocinomled, see Ocinomled Answer (6 TTABVUE) ¶ 7, and the federal court litigation is irrelevant to the priority issue, there is no compelling reason to delay these proceedings further based on the outcome of the federal court litigation.

Ocinomled offers no logical argument as to how any issues involved in the federal court litigation can realistically be expected to impact on the present proceeding. It references potential findings in the federal court litigation concerning the “scope of protection” and the “strength of the mark,” but such likelihood of confusion factors are completely irrelevant given the admitted existence of likelihood of confusion in the present case from use of virtually identical marks on the same restaurant services. Nor are Ocinomled’s vague references to unspecified potential “claims and defenses” (Ocinomled Motion at 6) sufficient to justify suspending the proceeding. While Emeril’s could theoretically have additional grounds for opposition in the future if it is determined in the referenced federal court case that Ocinomled is not the owner of the mark for which it applied, there is no such claim presently pending in the opposition. Given that Emeril’s’ opposition to Ocinomled’s restaurant application can already be disposed of based on the same undisputed evidence already analyzed by the Board in a concurrent use proceeding, Southwestern Management, Inc. v. Ocinomled, Ltd. and Emeril’s Food of Love Productions, LLC , Concurrent Use Proceeding No. 94002242 (the “Concurrent Use Proceeding”), it makes little sense to wait for the federal court to resolve issues that may impact on potential future claims that have yet to be asserted.

As set forth at length in Emeril’s summary judgment motion, the parties here have already spent the better part of a decade litigating the same issues raised in this opposition proceeding to a conclusion in the Concurrent Use Proceeding before the Board, and through an appeal to the Federal Circuit. See Southwestern Management, Inc. v. Ocinomled Ltd., 652 F. App’x. 971 (Fed. Cir. 2016). Moreover, Emeril’s has already filed a summary judgment motion, based on the same evidence reviewed and analyzed by the Board in the Concurrent Use

Proceeding, that is potentially dispositive of one of the two applications at issue in this opposition proceeding.

As set forth in detail in Emeril's' summary judgment motion, the current opposition proceeding turns on the narrow question of which party, Emeril's or Ocinomled, has priority. As all of the evidence on that issue has already been fully developed in the Concurrent Use Proceeding, and has already been considered and analyzed by the Board in its precedential ruling in that case, the interests of judicial economy strongly favor allowing the dispositive issue of priority to be resolved by the Board without waiting indefinitely for some unspecified ruling on undefined issues in an internal fight among the various owners of Ocinomled concerning ownership of the DELMONICO'S mark.

Finally, the fact that Southwestern has sought suspension of its own opposition proceeding against Ocinomled is beside the point. If Emeril's' summary judgment motion is granted, then Southwestern's opposition to the restaurant application is rendered moot anyway, so there is little point in holding Emeril's' case in abeyance because of Southwestern's opposition. The reality is that both Ocinomled and Southwestern seem determined simply to delay further proceedings rather than confront the inevitable reality flowing from what the Board has already determined in the Concurrent Use Proceeding. Given the extensive amount of time, money and effort that these parties have already devoted to litigation, the interests of judicial economy do not favor further delay based on speculative arguments about the potential impact of tangential litigation among the owners of Ocinomled concerning issues unrelated to the core issues presented by Emeril's' summary judgment motion. If ever there were a situation in which the Board should exercise its discretion in the interests of efficiency by first considering the pending dispositive motion, this is such a case.

**CONCLUSION**

For the foregoing reasons, Ocinomled's motion to suspend should be denied, and the Board should exercise its discretion to first consider Emeril's' pending motion for summary judgment.

Dated: New York, New York  
May 19, 2017

Respectfully submitted,

COWAN LIEBOWITZ & LATMAN, P.C.  
Attorneys for Opposer

By: Deborah K. Squiers/  
Deborah K. Squiers  
Richard S. Mandel  
Lynn S. Fruchter  
114 West 47<sup>th</sup> Street  
New York, New York 10036  
(212) 790-9200 / [trademark@cll.com](mailto:trademark@cll.com) and  
[dks@cll.com](mailto:dks@cll.com)

**CERTIFICATE OF SERVICE**

I hereby certify that I caused a true and correct copy of the foregoing to be served on May 19, 2017 upon Applicant by electronic mail to Applicant's Counsel of Record Dickerson Downing at the following the email addresses identified:

ddowning@downingip.com; dickersondowning@gmail.com

Dated: New York, New York  
May 19, 2017

/s/ Timothy J. Buckley  
Timothy J. Buckley