


ESTTA Tracking number: **ESTTA841841**

Filing date: **08/25/2017**


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

Proceeding	91235434
Party	Plaintiff Multi Access Limited
Correspondence Address	SUSAN OKIN GOLDSMITH MCCARTER & ENGLISH LLP TWO TOWER CENTER BLVD 24TH FLOOR EAST BRUNSWICK, NJ 08816 UNITED STATES Email: sgoldsmith@mccarter.com, bostontrademarks@mccarter.com
Submission	Other Motions/Papers
Filer's Name	Susan Okin Goldsmith
Filer's email	sgoldsmith@mccarter.com, lshyavitz@mccarter.com, epagan@mccarter.com, bostontrademarks@mccarter.com
Signature	/Susan Goldsmith/
Date	08/25/2017
Attachments	Multi Access Limited v GBP - Opp to Motion to Suspend Proceedings.pdf(321754 bytes)

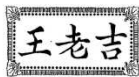
and 91234843 (filed May 31, 2017) against Multi Access' Application Nos. 87100791,


87101038, 87100961, and 87100809 (respectively) for the Chinese character mark . As grounds for each opposition, GBPH cited priority and likelihood of confusion pursuant to Trademark Act Section 2(d) and referenced two of its marks as bases, namely US. Registration

No. 2153322 and Application No. 86691579 for . A consented motion to consolidate

these four opposition proceedings concerning Multi Access' Chinese character mark  was filed on July 24, 2017, and the motion was granted on August 14, 2017.

Multi Access filed this proceeding on June 23, 2017 to oppose the trademark application for the English language mark WONGLO, owned by a different party, namely GPH. Multi Access cited "priority and likelihood of confusion" as well as "false suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute," under Trademark Act Sections 2(d) and 2(a), respectively. Multi Access cited three of its marks as bases for opposition, namely Registration No. 2005908 for



and Application Nos. 87101038 and 87100961 for .

II. ARGUMENT

A. The Referenced Proceedings Involve Different Parties, Different Marks, and Different Claims

Whether a proceeding should be suspended is left to the discretion of the Trademark Trial and Appeal Board ("Board"). *See* TBMP § 510.02(a) ("the Board may also, in its discretion,

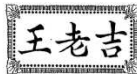

suspend a proceeding pending the final determination of another Board proceeding in which the parties are involved.”). However, “the Board seldom grants a motion to suspend a particular proceeding pending disposition of other opposition or cancellation proceedings brought by unrelated plaintiffs against the same application or registration, and asserting unrelated claims.”

Id.


Accordingly, when the proceedings involve different parties, different claims, or different marks, the Board may find that the proceedings referenced as grounds for suspension lack sufficient bearing on the instant proceeding to warrant suspension. *See New Orleans Louisiana Saints LLC & NFL Properties LLC v. Who Dat? Inc.*, Opp. No. 91198708, 99 U.S.P.Q.2d 1550, 1551 (TTAB July 22, 2011) (denying motion to suspend because referenced oppositions to same application were brought by third parties and involved different grounds of opposition); *In re Wieland Dental + Technik GmbH & Co. KG*, Serial No. 79018103, 2010 WL 302018, at *2 (Jan. 15, 2010) (suspension denied because parties in referenced proceeding were considered different even though third party was related to registrant, and grounds for suspension too tenuous); *Missiontrek Ltd. Co. v. Onfolio Inc.*, Opp. No. 91165315 and Can. No. 92044538, 80 U.S.P.Q.2d 1381, 1382 (TTAB Nov. 29, 2005) (suspension denied where primary commonality between proceedings was the party opposing the suspension). “That a decision in the other proceeding ‘may’ affect registrability...is too tenuous a basis upon which to grant a suspension.” *In re Wieland Dental + Technik GmbH & Co. KG*, 2010 WL 302018, at *2.

Here, Proceeding Nos. 91234845 and 91234831 referenced by Applicant do not have sufficient bearing on the instant opposition proceeding to warrant suspension because they involve different parties and different claims. *See* TBMP § 510.02(a). Proceeding Nos. 91234845 and 91234831, like the other two proceedings consolidated with them, involve only GBPH and

Multi Access, and claims of priority and likelihood of confusion directed to the two parties' Chinese character marks. In contrast, the instant proceeding involves a dispute between Multi Access and a different party, GPH, regarding likelihood of confusion between WONGLO - the alleged English language mark of one party - and two Chinese language marks of another party,

namely  and . Thus, the Board will be considering very different issues from those involving only Chinese language marks.

Further, if Multi Access is successful in defending the oppositions brought by GBPH

with respect to the mark , the final decision will have little impact on Multi Access' claims here of false suggestion of a connection arising from a different party's English language mark WONGLO. *See New Orleans Louisiana Saints LLC & NFL Properties LLC*, 99 U.S.P.Q.2d at 1551.

Indeed, Multi Access is the only party and has the only mark common to all proceedings. GPH has provided no evidence of relatedness between itself and GBPH, and has not explained how such relatedness would cause the referenced proceedings to have a bearing on the instant proceeding sufficient to suspend the case. *See In re Wieland Dental + Technik GmbH & Co. KG*, 2010 WL 302018, at *2 *Missiontrek Ltd. Co.*, 80 U.S.P.Q.2d a 1382.

B. Applicant's Cited Decisions Are Inapposite

Applicant has offered only a handful of decisions to support its motion for suspension, and those decisions are readily distinguishable from the facts before the Board in this motion. In the precedential cases cited by Applicant the proceedings were all suspended due to the pendency of an on-going civil action, which is not the case here, and furthermore, all but one

case involved both the same parties and identical or nearly identical English language marks. While one non-precedential decision included both a civil action and an ongoing Board proceeding as basis for a suspension, in that case there were similar claims that were related to the identical English language mark.¹

C. Alternatively, The Board Should Consolidate All Five Cases

Alternatively, if the Board believes that the cited proceedings may have sufficient bearing to suspend this proceeding, Multi Access respectfully requests instead that the Board consolidate this proceeding with Opposition Nos. 91233411 (Parent), 91234831, 91234845, and 91234843 (each a Child case), rather than suspend this case. *See* TBMP § 510.02(a) (“If multiple proceedings are at the same stage of litigation and plead the same claims, the Board may order consolidation.”). These five proceedings were all filed within several months of each other and are “in the same stage of litigation.” *See id.* The “Child” oppositions were filed within a month prior to this action being brought and were consolidated with the Parent case within a week after this motion was filed. All are in the same very early stages of litigation.

Further, if the Board believes that the issues, claims, parties, and marks are sufficiently similar or related that any of the other proceedings may have a bearing on this case, then the most efficient way to resolve the matter is to consider them together in a consolidated proceeding. Consolidation would allow for all parties to meet their obligations in all proceedings, thus moving the proceedings toward resolution, while conserving the parties’ and the Board’s time and resources. *See Datanational Corp. v. Bellsouth Corp.*, 18 U.S.P.Q.2d 1862 (T.T.A.B.

¹ *See Arcadia Group Brands Ltd. v. Studio Moderna SA*, 99 U.S.P.Q. 2d 1134 (T.T.A.B. 2011); *Gen. Motors Corp. v. Cadillac Club Fashions, Inc.*, 22 U.S.P.Q. 2d 1933, 1937 (T.T.A.B. 1992); *The Other Tel. Co. v. Connecticut Nat’l Tel. Co.*, 181 U.S.P.Q. 125 (T.T.A.B. 1974); *Sturgis Motorcycle Rally, Inc. v. Farrokhi*, 2013 WL 11247190, at *6 (T.T.A.B. 2013).

Mar. 4, 1991) (case consolidated as to 24 opposers in 12 oppositions, but proceeding involving different legal and factual issues not consolidated).

CONCLUSION

Because the referenced proceedings are unlikely to have sufficient bearing on the instant proceeding, Multi Access respectfully requests that the Board deny Applicant's Motion For Suspension. If the Board nonetheless believes that the proceedings may have bearing on each other, Multi Access requests in the alternative that the Board consolidate this proceeding with Opposition Nos. 91233411 (Parent), 91234831, 91234845, and 91234843.

Dated: August 25, 2017

Respectfully submitted,

MCCARTER & ENGLISH LLP

By: / Susan Okin Goldsmith /
Susan Okin Goldsmith

Susan Okin Goldsmith
Lori J. Shyavitz
Attorneys for Opposer
Two Tower Center Blvd, 24th Fl.
East Brunswick, NJ 08816
e-mail: sgoldsmith@mccarter.com
phone: 732-867-9670

CERTIFICATE OF ELECTRONIC FILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FILED ELECTRONICALLY WITH THE UNITED STATES PATENT AND TRADEMARK OFFICE TRADEMARK TRIAL AND APPEAL BOARD, VIA ESTTA, ON THE DATE INDICATED BELOW.

By: /Susan Okin Goldsmith/

Date: August 25, 2017

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing OPPOSITION TO APPLICANT'S MOTION TO SUSPEND PROCEEDINGS has been served via e-mail on this 25th day of August 2017, upon the following:

CARLYNN DAVIS
IpHorgan Ltd.
195 Arlington Heights Rd., Suite 125
Buffalo Grove, IL 60089
mail@iphorgan.net

Courtesy copy to:
Christopher B. Lay, Esq.
IpHorgan Ltd.
195 Arlington Heights Rd., Suite 125
Buffalo Grove, IL 60089
E-mail: clay@iphorgan.net
mail@iphorgan.net

/Susan Goldsmith/
Susan Okin Goldsmith