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

Proceeding	91238546
Party	Plaintiff Westlake Longview Corporation
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**In the matter of Trademark
Application Serial No.: 79/194,431**

For the mark: HIFORMER

Published in the Official Gazette on: Nov. 21, 2017

WESTLAKE LONGVIEW CORPORATION

Opposer,

v.

OPPOSITION NO. 91238546

CLARIANT AG

Applicant.

RESPONSE TO MOTION TO SUSPEND AND BRIEF IN SUPPORT

Opposer, Westlake Longview Corporation, files this its response to Applicant's motion to suspend and would respectfully show the Board the following.

I. BACKGROUND

On September 27, 2016, Applicant filed Trademark Serial No. 79/194,431 requesting an extension of protection, under 15 U.S.C. § 66(a), based on a trademark registration in Switzerland ("Application"). The request extended to goods in classes 1 and 2 and services in class 42.

On December 14, 2017, Opposer timely filed its Notice of Opposition. The Notice is based on a likelihood of confusion with commonly owned Trademark Registration Nos. 3,661,578; 3,661,577; and 3,670,225.

On October 9, 2018, Applicant filed its Motion to Amend Application and Brief in Support [No. 21] (“Motion to Amend”).

On October 22, 2018, Applicant filed its Motion to Suspend and Brief in Support [No. 22] (“Motion to Suspend”).

On October 29, 2018, Opposer filed its Response to Applicant’s Motion to Amend Application [No. 23] (“Response to Motion to Amend”).

For the following reasons, the Board should deny Applicant’s Motion to Suspend.

II. ARGUMENT AND AUTHORITIES

Proceedings may be suspended by the Board, but only for good cause.¹ Situations where good cause has been found to exist generally fall into one of two categories:

1. Where causes of action may be resolved or eliminated;² or
2. Where the circumstances require additional time to adequately complete discovery or trial testimony.³

In this case, Applicant has failed to show good cause.

A. There is No Good Cause to Suspend.

1. Applicant’s Motion to Amend does not eliminate any cause of action from the Notice.

The Notice sets out a single cause of action of likelihood of confusion. That same cause of action will remain whether or not Applicant’s Motion to Amend is granted. Since the

¹ 37 C.F.R. § 2.117(c).

² *See, e.g.*, 37 C.F.R. § 2.117(a) (The same parties are involved in a civil action or another Board proceeding which may have a bearing on the case), 37 C.F.R. § 2.127(d) (Potentially dispositive motion, such as motion to dismiss, motion for judgment on the pleadings, or motion for summary judgment), TBMP § 510.03(a) (Settlement negotiations, consideration of a matter by an examining attorney which includes the disposition of a party’s application, and bankruptcy of defendant.)

³ *See, e.g.*, 37 C.F.R. § 2.120(f)(2) (Motions to compel initial disclosures, expert testimony disclosure, or discovery), 37 C.F.R. § 2.124(d)(2) and TBMP § 510.03(a) (Testimonial and discovery depositions to be taken upon written questions), and TBMP § 510.03(a) (Discovery of expert witness and withdrawal of counsel).

proposed amendment fails to eliminate or resolve any cause of action, there is no reason to suspend.

2. There are no facts which indicate that additional time is needed.

The proposed amendment would also not require additional time to complete discovery or trial testimony. The scheduling order sets out a deadline of March 11, 2019 to complete discovery, which leaves approximately five (5) months in which to complete the discovery required. Five (5) months should be adequate time whether or not Applicant's proposed amendment to the description of goods is allowed (which it should not be). Hence, there is no good cause to suspend.

B. *Wisconsin Cheese* does not support the requested suspension.

The suspension ordered in *Wisconsin Cheese Group LLC v. Comercializadora de Lácteos y Derivados, SA de C.V.*, Opposition No. 91224131 (TTAB Jan. 11, 2016) was consistent with the traditional basis of good cause. However, *Wisconsin Cheese* does not support Applicant's request that a suspension be granted in this case. In *Wisconsin Cheese*, the Notice of Opposition asserted three (3) causes of action - likelihood of confusion, deceptiveness, and deceptive misdescription.⁴ The proposed amendment eliminated the deceptiveness and deceptive misdescription causes of action. Therefore, good cause existed to suspend *Wisconsin Cheese* because resolution of the motion resolved two causes of action. In contrast, Applicant's Motion to Amend will not resolve any causes of action. So, no good cause exists here.

C. Suspension would not conserve resources of the Parties or the Board.

As discussed more fully in Opposer's Response to Motion to Amend, the proposed amendment will not change the discovery conducted by the Parties significantly,⁵ nor will it

⁴ *Wisconsin Cheese*, Opp. No. 91224131, *2 – 3 (TTAB Mar. 30, 2016).

⁵ See, Response to Motion to Amend, pp. 6 – 7.

change the evidence required.⁶ Since the discovery and the evidence should not change, the burden on the parties and the Board should remain largely the same. So, there is no good reason to suspend.

D. Opposer will be negatively impacted if a suspension is granted.

The Notice of Opposition was filed December 14, 2017, almost a year ago. Opposer agreed to several extensions of time for Applicant to answer in order to facilitate potential settlement. However, the efforts at early settlement were unsuccessful. A suspension would negatively impact Opposer by causing further unnecessary delay in achieving a resolution in this case.

III. CONCLUSION

Applicant has the burden to show the Board good cause as to why the proceeding should be suspended until a ruling on its Motion to Amend. Applicant has failed to meet this burden. The proposed amendment does not have the potential to resolve any cause of action in the case nor is additional time for discovery or trial necessary. The proposed amendment would also not substantially change the burden of discovery on the Parties. For these reasons, the Board should deny Applicant's Motion and refuse to suspend the case.

⁶ *Id.*, p. 7.

Dated: November 9, 2018.

Respectfully submitted,



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CERTIFICATE OF SERVICE

A true and correct copy of the foregoing Response to Motion to Suspend and Brief in Support was served upon the persons listed below in the manner indicated on November 9, 2018.

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*Via Email moran@mbhb.com and
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