

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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February 14, 2019

Opposition No. 91244819

The Vineyard House LLC

v.

Constellation Brands U.S. Operations Inc.

**Katie W. McKnight,
Interlocutory Attorney:**

This proceeding now comes before the Board for consideration of Applicant's motion (filed January 8, 2019) to suspend pending disposition of a motion to dismiss pending in Proceeding No. 91244082. The motion is fully briefed.

In support of its motion, Applicant argues that inasmuch as Proceeding No. 91244082 involves the same parties, the same goods, and the salient allegations in both proceedings are "identical,"¹ Proceeding No. 91244082 will "necessarily impact" this proceeding.² In response, Opposer argues that the oppositions should be considered separately, inasmuch as the involved marks – THE MIRACLE OF TO KALON (the involved mark in this proceeding) and THE BOSS (the involved mark

¹ 6 TTABVUE 3; *see also* 8 TTABVUE 4.

² 6 TTABVUE 5.

in Proceeding No. 91244082) – are “completely different”.³ Opposer further contends that the facts underlying the claims common to both proceedings – the involved marks are primarily geographically descriptive under Section 2(e)(2) of the Trademark Act and primarily geographically deceptively misdescriptive under Section 2(e)(3) of the Trademark Act – are “completely different.”⁴

Ordinarily, it is the policy of the Board to suspend a proceeding when the parties are involved in another Board proceeding which may have a bearing on the Board case. *See* Trademark Rule 2.117(a). Such a suspension, however, is solely within the discretion of the Board. Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 510.02 (2018). Here, the pending motion to dismiss in Proceeding No. 91244082 may have a bearing on this proceeding inasmuch as the proceedings involve common legal and factual issues.⁵ *See Other Telephone Co. v. Conn. Nat’l Telephone Co., Inc.*, 181 USPQ 125, 126-27 (TTAB 1974); *cf. Tamarkin Co. v. Seaway Food Town, Inc.*, 34 USPQ2d 1587, 1591 (TTAB 1995). For instance, in this proceeding, Opposer alleges that “[t]he primary significance of TO KALON to the relevant public is the name as set forth by the first owner, H.W. Crabb, and which specifically describes a geographical area of a vineyard in Napa Valley,”⁶ and in Proceeding No. 91244082,

³ 7 TTABVUE 2.

⁴ *Id.* at 3.

⁵ Moreover, when cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. *See* Fed. R. Civ. P. 42(a); *see also, Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). Accordingly, upon resumption of this proceeding, the Board may consider whether to consolidate proceedings.

⁶ Proceeding No. 91244819, amended notice of opposition at ¶10.

Opposer alleges that “[t]he primary significance of THE BOSS to the relevant public is as an alternative name for the To Kalon vineyards as set forth by the first owner, H.W. Crabb.”⁷

Accordingly, Applicant’s motion to suspend is **granted**. This proceeding is **suspended** pending disposition of the motion to dismiss pending in Proceeding No. 91244082. Within **twenty days** of the mail date of the Board’s order addressing Applicant’s motion to dismiss in Proceeding No. 91244082, the parties shall so notify the Board in writing. During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys. *See* Trademark Rule 2.18(b)(1). In addition, the parties shall promptly inform the Board of any other related cases, even if they become aware of such cases during the suspension period.

⁷ Proceeding No. 91244082, notice of opposition at ¶9.