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

Proceeding	91244927
Party	Defendant Indie Lee & Co.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Cocoon Apothecary

Opposer,

v.

Indie Lee & Co.

Applicant.

Opp. No. 91244927

Serial No. 88000549

**APPLICANT’S MOTION TO SUSPEND
PROCEEDING**

Mark: I WAKEN

**APPLICANT’S MOTION TO SUSPEND PROCEEDING IN VIEW OF PENDING CIVIL
ACTION PURSUANT TO TRADEMARK RULE 2.117(a)**

Applicant Indie Lee & Co. (“Indie Lee” or “Applicant”), by its undersigned attorneys, hereby moves for suspension of these proceedings pursuant to Trademark Rule 2.117(a).

BACKGROUND AND FACTS

On December 11, 2019, Applicant Indie Lee & Co. (“Indie Lee” or “Applicant”), initiated a lawsuit against Opposer Cocoon Apothecary (“Cocoon” or “Opposer”) in the United States District Court, Southern District of New York, Case No. 19-CV-11210 (the “District Court Litigation”). The central issues in the District Court Litigation relate to the same issues present in the current Opposition—namely, whether Indie Lee’s registration and use of the I WAKEN mark is likely to cause confusion with Cocoon’s EYEWAKEN mark. A copy of Indie Lee’s Complaint seeking a declaration that its mark does not infringe on Cocoon’s rights in the EYEWAKEN mark is attached hereto as Exhibit A.

In the District Court Litigation, Indie Lee seeks a determination that “it has not infringed upon any trademark rights of Cocoon” by virtue of its sale of products under the I WAKEN mark and a judgment “declaring that Cocoon’s trademark rights are invalid, void, unenforceable and/or not infringed by [Indie Lee].” (Ex. A at pp. 1, 9)

Cocoon’s present Opposition seeks to prevent the registration of Indie Lee’s I WAKEN mark on the basis of Cocoon’s allegations that “Indie Lee’s marks are “confusingly similar, in appearance, sound, meaning and commercial impression to [Cocoon’s] EYEWAKEN trademark,” and that “[t]he registration and use of [Indie Lee’s marks] is likely to cause confusion as to the source or origin of [Indie Lee’s] Goods and Services, and is likely to mislead consumers, all causing damage to [Cocoon].” Cocoon further alleges in the present Opposition that Indie Lee’s marks, “when used in association with [Indie Lee’s] Goods and Services, [are] likely to cause confusion in the minds of the public and is likely to deceive the purchasers of such goods and services,” leading those purchasers to “believe that such goods and services originate with, are approved, sponsored or endorsed by, or have some connection or affiliation with [Cocoon].”

Due to the similar issues at play in this proceeding and the District Court Litigation, Indie Lee respectfully requests that this Opposition be suspended pending the outcome of the District Court Litigation.

ARGUMENT

“It is standard procedure for the Trademark Board to stay administrative proceedings pending the outcome of court litigation between the same parties involving related issues.” *New Orleans Louisiana Saints LLC & NFL Props. LLC v. Who Dat?, Inc.*, 2011 TTAB LEXIS 208, *7 (Trademark Trial & App. Bd. July 22, 2011) citing McCarthy on Trademarks and Unfair Competition § 32:47 (4th ed. updated June 2011). The standard for suspension is whether the civil action “may have a bearing on the case” in front of the TTAB. *Arcadia Group Brands Ltd. v. Studio Moderna SA*, 2011 TTAB LEXIS 413, *7 (Trademark Trial & App. Bd. Jan. 6, 2011). Thus, it is not necessary for the party requesting the suspension to show that the civil action will be dispositive of the TTAB proceeding. *Id.*

To determine whether the issues in a civil action may have a bearing on a Trademark Board proceeding, “the Board will scrutinize the pleadings in the civil action.” *Id.* at 6; *Birlinn Ltd. v. Stewart*, 2014 TTAB LEXIS 346, *13 (Trademark Trial & App. Bd. Sept. 3, 2014) (“Opposer must...file and serve a notice which sets forth the status of the referenced litigation, including a copy of the pleadings, so that the Board may ascertain whether the final determination in the [underlying] proceeding may have a bearing on the issues before the Board.”)

Here, this action should be suspended in accordance with the Trademark Board’s standard procedure because both the District Court Litigation and this proceeding involve issues relating to whether consumers are likely to mistakenly associate with Cocoon goods sold and services performed under Indie Lee’s I WAKEN mark. The District Court Litigation seeks a determination of exactly the same issue present in this Opposition: whether Indie Lee’s I

WAKEN mark likely to cause confusion with any marks owned by Cocoon, namely, the EYEWAKEN mark. Thus, the District Court Litigation has a clear bearing on this proceeding. Moreover, any decision impacting the registrability of the I WAKEN mark would have a direct bearing on the non-infringement allegations in the District Court Litigation.

In view of the foregoing, Indie Lee respectfully requests suspension of this proceeding pending determination of the District Court Litigation pursuant to Trademark Rule 2.117(a).

Dated: December 11, 2019

Mark D. Kremer
Zachary Page, members of
CONKLE, KREMER & ENGEL
Professional Law Corporation

By: */s/ Zachary Page*
Zachary Page
Attorneys for INDIE LEE & CO.

EXHIBIT A

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

INDIE LEE & CO., INC.

Plaintiff,
v.

COCOON APOTHECARY, INC.,

Defendant.

Civil Action No. 19-11210

COMPLAINT FOR
DECLARATORY JUDGMENT

ECF CASE

Plaintiff, Indie Lee & Co., Inc. (“Plaintiff” or “Indie Lee”), by and through its undersigned attorneys, STERN & SCHURIN LLP, for its Complaint against Defendant, Cocoon Apothecary, Inc. (“Defendant” or “Cocoon”), alleges as follows:

NATURE OF ACTION

1. This is an action for declaratory judgment which arises under the Lanham Act, 15 U.S.C. § 1051, *et seq.* By this action, Indie Lee seeks a declaration that it has not infringed upon any trademark rights of Cocoon as set forth herein.

JURISDICTION AND VENUE

2. This Court has jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338 with respect to the claims arising out of the Lanham Act, 15 U.S.C. § 1051, *et seq.* and pursuant to the Declaratory Judgment Act, 28 U.S.C. §2201, *et seq.*

3. Venue is proper in this jurisdiction pursuant to 28 U.S.C. §1391(b)(2) and §1391(c)(3) because a substantial part of the events giving rise to the claim in this Complaint occurred in this District, and Cocoon is a Canadian corporation.

THE PARTIES

4. Indie Lee is a corporation organized and existing under the laws of the State of Delaware with a headquarters located in this judicial district at 425 Smith Ridge Road, South Salem, New York 10590.

5. Indie Lee is registered to do business in the State of New York.

6. Indie Lee develops, advertises, markets and sells unique skincare and cosmetic products. Indie Lee regularly transacts business throughout this judicial district.

7. Upon information and belief, Cocoon is a corporation organized and existing under the laws of Canada, with a principal place of business located at 72 St. Leger Street, Unit 2B, Kitchener, Ontario Canada N2H 6R4.

8. Upon information and belief Cocoon advertises, markets and sells skincare and cosmetic products in this judicial district.

FACTS

INDIE LEE'S BUSINESS AND TRADEMARKS

9. Plaintiff Indie Lee & Co. was founded by Ms. Indie Lee in 2009 and incorporated in 2013. Plaintiff's predecessor entity, Lidareme, Inc., was incorporated in New York in 2010.

10. In November of 2008, Indie Lee was diagnosed with a rare brain tumor that according to her many doctors may have been "environmentally derived." Ms. Lee's doctors advised Ms. Lee that what she puts on her body is just as important as what she put inside her body.

11. Following successful brain surgery, Ms. Lee awoke with a new calling, which was to develop skincare and cosmetic products that were eco-friendly, effective, and free of any

chemicals that were potentially toxic. Ms. Lee then created a line of non-toxic, and eco-friendly skin care and cosmetic products.

12. Indie Lee's products were introduced in 2010.

13. Indie Lee's products are primarily sold under its registered "house mark" INDIE LEE. Indie Lee also owns other trademarks, which function as "product marks" and which are typically used in association with INDIE LEE. Plaintiff's product mark at issue herein is I WAKEN.

14. Indie Lee is the owner of the following relevant U.S. Trademarks which appear on its advertisements and packaging:

- Plaintiff's INDIE LEE house mark for goods in International Class 041 was registered on the Principal Register of the United States Patent and Trademark Office on July 26, 2011 as U.S. Registration No. 4,000,989 and was recognized by the Patent and Trademark Office as incontestable, under 15 U.S.C. § 1065, on August 30, 2017;
- Plaintiff's INDIE LEE house mark for goods in International Class 003 was registered on the Principal Register of the United States Patent and Trademark Office on June 23, 2015 as U.S. Registration No. 4,758,619;
- Plaintiff's I WAKEN product mark for goods in International Classes 003 and 041, an application for registration for which was filed on May 31, 2018 receiving Serial No. 87943996. This application for I WAKEN was examined and approved by the Trademark Office Examiner and then published for opposition on October 23, 2018;

- Plaintiff's I WAKEN product mark for additional goods in International Classes 003 and 041, an application for registration for which was filed on June 14, 2018 receiving Serial No. 88000549. This application for I WAKEN was examined and approved by the Trademark Office Examiner and then published for opposition on October 23, 2018.
- Plaintiff's INDIE LEE I WAKEN mark for goods and services in International Classes 003 and 041, an application for registration for which was filed on June 14, 2018, receiving Serial No. 88000544. The application for INDIE LEE I WAKEN was examined and approved by the Trademark Office Examiner and then published for opposition on December 11, 2018.¹

15. A photo of Plaintiff's use of its marks on product advertised and offered for sale is shown below:



¹ The Applications for I WAKEN and INDIE LEE I WAKEN are referred to collectively herein as the "I WAKEN Applications."

COCOON'S BUSINESS AND TRADEMARK

16. Upon information and belief, Cocoon is a Canadian company selling skincare and other products into the United States since 2003.

17. Defendant advertises and sells products under its “house mark” COCOON APOTHECARY. Defendant frequently uses its house mark in association with product marks, one of which is the single word mark EYEWAKEN.

18. Defendant applied to register EYEWAKEN, after Plaintiff, on October 15, 2018, receiving Serial No. 88155190. However, its application was suspended by the U.S. Patent and Trademark Office in favor of Plaintiff’s prior pending applications.

19. A photo of Defendant’s use of its COCOON APOTHECARY house mark on an actual product advertised and offered for sale by Defendant is shown below:



COCOON’S CLAIMS OF INFRINGEMENT

20. In a cease and desist letter dated August 7, 2018, counsel for Cocoon asserted its purported trademark rights in the product mark EYEWAKEN against Indie Lee (hereinafter “Cease and Desist Letter”).

21. Defendant’s claims are based on Indie Lee’s advertising, offering for sale and sale of allegedly infringing products under its I WAKEN product mark.

22. In particular, the Cease and Desist Letter asserts that Cocoon is the owner of the “well known and valuable” EYEWAKEN trademark.

23. The Cease and Desist Letter further states that “[i]t has recently come to our attention that [Indie Lee is] selling an eye serum product in both Canada and the United States with a confusingly similar trademark, I-WAKEN.”

24. The Cease and Desist Letter demands, in part, that Indie Lee “immediately cease and desist from all further use of I-WAKEN or any other trademark confusingly similar to EYEWAKEN in all respects.”

25. Notwithstanding the allegations of infringement set forth in the Cease and Desist Letter, Indie Lee’s products do not infringe any possible rights that Cocoon may have, especially considering that both marks are product marks and appear in close association with the parties’ INDIE LEE and COCOON APOTHECARY house marks, respectively, which easily distinguish the source of the Indie Lee’s and Cocoon’s products.

26. Accordingly, Indie Lee rejected Cocoon’s demands and through its counsel has tried to resolve this dispute for the past year without success.

27. By virtue of the foregoing, Indie Lee is compelled to seek a declaration from this Court that it does not infringe Cocoon’s trademark rights.

COCOON’S OPPOSITIONS TO INDIE LEE’S TRADEMARK APPLICATIONS

28. Cocoon has opposed each of Indie Lee’s I WAKEN Applications in the Trademark Trial and Appeal Board.

29. On November 21, 2018, Cocoon filed Opposition No. 91244905 against Indie Lee’s Application Serial No. 87943996 for the I WAKEN mark.

30. On November 22, 2018, Cocoon filed Opposition No. 91244927 against Indie Lee’s Application Serial No. 88000549 for the I WAKEN mark.

31. On January 8, 2019, Cocoon filed Opposition No. 91245681 against Indie Lee’s Application Serial No. 88000544 for the INDIE LEE I WAKEN mark.

32. Like Cocoon’s letter alleging infringement, each of Cocoon’s Oppositions filed at the Trademark Trial and Appeal Board alleges that Cocoon’s rights in the EYEWAKEN mark are infringed by Indie Lee’s I WAKEN and INDIE LEE I WAKEN marks.

33. For example, Cocoon alleges in each of the Oppositions that Indie Lee’s marks are “confusingly similar, in appearance, sound, meaning and commercial impression to [Cocoon’s] EYEWAKEN trademark,” and that “[t]he registration **and use** of [Indie Lee’s marks] is likely to cause confusion as to the source or origin of [Indie Lee’s] Goods and Services, and is likely to mislead consumers, all causing damage to [Cocoon]” (emphasis added).

34. Cocoon further alleges in the Oppositions that Indie Lee’s marks, “when used in association with [Indie Lee’s] Goods and Services, [are] likely to cause confusion in the minds of the public and is likely to deceive the purchasers of such goods and services,” leading those purchasers to “believe that such goods and services originate with, are approved, sponsored or endorsed by, or have some connection or affiliation with [Cocoon].”

COUNT I
DECLARATION OF NON-INFRINGEMENT UNDER THE LANHAM ACT

35. Plaintiff repeats and realleges the allegations set forth in each of the preceding paragraphs as if fully set forth herein

36. An actual controversy has arisen and now exists between Indie Lee and Cocoon concerning whether Indie Lee has infringed Cocoon's trademark rights.

37. Indie Lee has advertised, marketed offered for sale, and sold cosmetic products alleged by Cocoon to have infringed its trademark rights.

38. Upon information and belief, Cocoon believes and maintains that Indie Lee's activities with respect to its advertising, marketing, offering for sale and selling of products infringes on Cocoon's trademark rights.

39. Upon information and belief, Cocoon objects to Indie Lee's activities with respect to its advertising, marketing, offering for sale and selling of products under the INDIE LEE I WAKEN and I WAKEN marks.

40. In contrast, Indie Lee believes and alleges that its products and advertisements do not infringe upon any valid trademark rights of Cocoon under the Lanham Act. Importantly, Indie Lee's use of its INDIE LEE I WAKEN and I WAKEN marks is not likely to cause consumers to mistakenly believe that Indie Lee's products come from, are associated with or are endorsed by Cocoon.

41. By virtue of the foregoing, Indie Lee desires a judicial determination of the parties' rights and duties with respect to the trademark rights asserted by Cocoon.

42. A judicial determination is necessary and appropriate at this time so that the parties may proceed in accordance with their respective rights as determined by the Court.

WHEREFORE, Indie Lee prays for judgment against Cocoon as follows:

- A. For judgment declaring that Defendant's trademark rights are invalid, void, unenforceable and/or not infringed by Plaintiff;
- B. Awarding Plaintiff costs, expenses and reasonable attorneys' fees as permitted by law; and,
- C. Awarding Plaintiff such other and further relief as the Court may deem just and proper.

JURY DEMAND

Indie Lee requests a trial by jury on all issues so triable.

Respectfully submitted,
STERN & SCHURIN LLP

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Dated: December 11, 2019
Garden City, New York

CERTIFICATE OF SERVICE

This is to certify that on December 11, 2019, I served true copies of **APPLICANT'S MOTION TO SUSPEND PROCEEDING** on the interested parties in this action via email as follows:

Michael Bean

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Deborah J. Peckham and Eilene Duberow

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I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct and that I am employed in the office of a member of the bar of this Court at whose direction the service was made.

Executed on December 11, 2019, at Santa Monica, California.

/s/ Zachary Page

Zachary Page