

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Opposition Nos. 91243801 (parent)
91245132
91245133

Cancellation Nos. 92070427
92070429
92070457
92070458

Intercontinental Exchange, Inc.

v.

Chicago Mercantile Exchange, Inc.

Wendy Boldt Cohen, Interlocutory Attorney:

Intercontinental Exchange, Inc. (“ICE”) filed motions to resume each of the noted proceedings asserting that the portion of the Civil Action¹ involving the Lanham Act was resolved by motion to dismiss. *See* 12 TTABVUE. The motions are fully briefed.²

¹ Civil Action No. 1:18-cv-01376 filed in the United States District Court for the Northern District of Illinois Eastern Division, styled *Chicago Mercantile Exchange Inc. v. ICE Clear US, Inc; ICE Clear Europe Limited; and Intercontinental Exchange, Inc.*

² The Board has considered the parties’ submissions and presumes the parties’ familiarity with the factual bases for the motion and does not recount them here except as necessary to explain the Board’s decision. Each of the motions to resume and briefings related thereto are similar and nearly identical; accordingly, the Board’s citations to the record are to one proceeding, Cancellation No. 92070457.

The parties’ respective changes of correspondence are noted. *See* 14 TTABVUE; 16 TTABVUE; 17 TTABVUE.

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Consolidation

It has come to the attention of the Board that Opposition Nos. 91243801, 91245132, and 91245133 and Cancellation Nos. 92070427, 92070429, 92070457 and 92070458, involve the same parties and common questions of law and fact. It is therefore appropriate to consolidate these proceedings pursuant to Fed. R. Civ. P. 42 (a). Accordingly, these proceedings are hereby consolidated and may be presented on the same record and briefs. *See, e.g., Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

The Board file will be maintained in Opposition No. **91243801** as the “parent case.” From this point on, only a single copy of all motions and submissions should be filed, and each submission should be filed in the parent case only, but captioned with all consolidated proceeding numbers, listing and identifying the “parent case” first.³ Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

Civil Action

In each of the motions to resume, ICE asserts that although the Civil Action is still pending, the Court granted a motion to dismiss ICE as a party to the Civil Action. 12 TTABVUE 3. In response, Chicago Mercantile Exchange, Inc. (“CHE”) asserts that

³ The parties should promptly inform the Board of any other Board proceedings or related cases within the meaning of Fed. R. Civ. P. 42, so that the Board can consider whether further consolidation is appropriate.

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the Civil Action has not been finally determined; that the dismissal could be appealed; and that the Court's findings are relevant to the Board proceeding. 15 TTABVUE 473-74.

Upon review of the parties' submissions, the Board notes that the Court indicated in its order related to the motion to dismiss that "there is an ongoing controversy between [CHE] and the other defendants ... including trademark infringement claims"; and that the issue related to "attorney's fees under the Lanham Act ... is a matter to be determined following entry of judgment." 15 TTABVUE 28-29. The Court further noted that the "validity of the marks asserted against the other defendants will no longer be an issue for the upcoming trial," however, other issues related to the asserted marks such as trademark infringement, unfair competition and deceptive trade practices remain. *Id.* at 28-29; 278-81. Indeed, part of the relief sought by CHE is an injunction prohibiting the defendants and "their officers, directors, agents ... employees, affiliates, successors, shareholders, assigns and attorneys, as well as those in active concert or participation with them ... from" using the SPAN Marks or any name, mark or domain name that incorporates the SPAN Marks or is confusingly similar. 15 TTABVUE 283. The Civil Action includes assertions in the Civil Action regarding subsidiaries of ICE. 15 TTABVUE 43-44.

Review of this language indicates there are still issues remaining for the Court that involve the pleaded marks in this Board proceeding. Further, although ICE may have been dismissed as a party in the Civil Action, the Civil Action contains assertions regarding ICE's purported subsidiaries and because the relief sought

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involves persons/parties associated with or in “active concert or participation with” the other defendants, those persons/parties could be related to ICE or its subsidiaries. Additionally, the dismissal is one that could be appealed and the time for that appeal has not expired.⁴

In short, the Civil Action may involve matters outside Board jurisdiction and may consider broader issues beyond the right to registration and, therefore, the Board finds that judicial economy is served by suspension. *See, e.g., B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 U.S. 1293, 135 S. Ct. 1293, 113 USPQ2d 2045, 2048, 2053, 2056 (2015); *Goya Foods Inc. v. Tropicana Prod. Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988).

In view of the foregoing, in the Board’s discretion, proceedings remain suspended pending final determination of the Civil Action and all appeals filed have been decided and the time for any further review has expired. *See* Trademark Rule 2.117(a). In view thereof, the motion to resume this proceeding is **denied**.

Within **twenty days** after such final determination⁵ (e.g., if no appeal is filed and/or the time to appeal has expired), the parties shall notify the Board so that this proceeding may be called up for appropriate action. Such notification to the Board should include a copy of any final order or final judgment which issued in the Civil Action.

⁴ ICE does not dispute this issue. 18 TTABVUE 5.

The Court has also indicated that the case before it “nearing its end.” 15 TTABVUE 30.

⁵ A proceeding is considered to have been finally determined when an order or ruling that ends the litigation has been rendered, and no appeal has been filed, or all appeals filed have been decided and the time for any further review has expired. *See* TBMP § 510.02(b).

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During the suspension period, the parties shall notify the Board of any address or email address changes for the parties or their attorneys.

In view of the continued suspension for Civil Action, all other pending motions at the time of this suspension are denied without prejudice.

After final disposition of the Civil Action or upon resumption of this proceeding, if a party believes its motion denied by this order was not resolved or made moot, the party may renew the motion by written request to the Board, citing the motion's title, date of filing, proceeding number and docket entry in the Board's electronic proceeding file. Any motion renewed must be accompanied by a signed statement that the motion has been reviewed in its entirety and concerns matters still disputed between the parties.

If the Board accepts any renewed motion, it may reset briefing, as necessary.