

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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June 19, 2019

Opposition No. 91245272

Amer Group Inc.

v.

Alibaba Group Holding Limited

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

This proceeding now comes before the Board for consideration of Applicant Alibaba Group Holding Limited's ("Alibaba") motion (filed February 20, 2019) to suspend this proceeding pending disposition of Opposition No. 91233862.¹ The motion is fully briefed.

In support of its motion, Alibaba argues that inasmuch as Proceeding No. 91233862 involves the same parties, substantially similar marks, and the same issue of likelihood of confusion, final determination of Opposition No. 91233862 "will more than likely have a bearing on the issues before the Board in this proceeding."² In response, Opposer Amer Group Inc. ("Amer") argues that Alibaba's motion is

¹ Alibaba included a copy of the notice of opposition in Opposition No. 91233862, filed April 4, 2017, with its motion to suspend.

² 6 TTABVUE 4.

premature because Alibaba has not yet filed its answer in this proceeding.³ Amer further contends that the outcome of Opposition No. 91233862 will not have a bearing on this proceeding because the goods and services involved in this proceeding differ in scope, the issue of strength of the mark will differ in each proceeding, and Opposition No. 91233862 will have no bearing on its claim of no bona fide intent to use in this proceeding.⁴ Finally, Amer argues that judicial economy will not be served by suspending this proceeding, inasmuch as Opposition No. 91233862 is not a civil action and the Board does not adjudicate broader issues than the right to registration.⁵

In reply, Alibaba argues that any decision made by the Board in Opposition No. 91233862 regarding likelihood of confusion will have a preclusive effect on the same issue in this proceeding.⁶ Nevertheless, Alibaba argues, the standard to be applied on a motion to suspend is not whether a prior proceeding will be dispositive of the instant proceeding, but whether the prior proceeding may have a bearing on this proceeding.⁷ Alibaba also notes that to the extent Amer refers to Opposition No. 91233862 in its notice of opposition in this proceeding, and refers to Opposition No. 91233862 as a “related” proceeding in its response to Alibaba’s motion to suspend, Amer has

³ 7 TTABVUE 4.

⁴ *Id.* at 3-4.

⁵ *Id.* at 4.

⁶ 8 TTABVUE 4-5.

⁷ *Id.* at 5.

effectively admitted that Opposition No. 91233862 may have a bearing on this proceeding.⁸

Ordinarily, it is the policy of the Board to suspend a proceeding when the parties are involved in another proceeding which may have a bearing on the Board case. *See* Trademark Rule 2.117(a); *see also New Orleans Louisiana Saints LLC v. Who Dat?, Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (the proceeding does not have to be dispositive of the Board proceeding to warrant suspension; “it need only have a bearing on the issues before the Board”). Such a suspension, however, is solely within the discretion of the Board. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 510.02 (2018). Pursuant to Trademark Rule 2.117(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. *See* TBMP § 510.02(a). The Board does not usually require that an issue be joined in one or both proceedings before the Board will consider suspending a Board proceeding pending the outcome of another proceeding. *See id.*

Here, Opposition No. 91233862 may have a bearing on this proceeding inasmuch as the proceedings involve the same parties and common legal and factual issues. *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, final disposition of Opposition No. 91233862 may have a bearing on the issue of Amer’s standing to pursue this proceeding, as well as the issue of

⁸ *Id.* at 2-3.

priority. Specifically, in the notice of opposition filed in this proceeding, Amer claims ownership of application Serial No. 86821204,⁹ and in support of its likelihood of confusion claim, asserts that the filing date of its application Serial No. 86821204 predates the filing date of Alibaba's subject application Serial No. 87628472.¹⁰ However, in prior pending Opposition No. 91233862, Alibaba requests that Amer's application Serial No. 86821204 be refused registration in view of a likelihood of confusion with Alibaba's pleaded registrations.¹¹ If the Board refuses registration of Amer's application Serial No. 86821204 in Opposition No. 91233862, such a decision may have a bearing on Amer's standing and pleaded claim of likelihood of confusion in this proceeding.¹²

In view of the foregoing, Alibaba's motion to suspend is **granted**. This proceeding is **suspended** pending final determination of Opposition No. 91233862.¹³ Within **thirty days** after final determination of Opposition No. 91233862, the parties shall so notify the Board in writing, including a copy of the Board's final order. 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

⁹ Opposition No. 91245272, Notice of opposition at ¶1, 1 TTABVUE 11.

¹⁰ *Id.* at ¶8, 1 TTABVUE 36.

¹¹ Opposition No. 91233862, Notice of opposition at ¶10, 1 TTABVUE 26-27.

¹² The fact that the Board has found that the final determination of Opposition No. 91233862 may have a bearing on certain issues in this case should not be construed as a finding that these are the only issues regarding this proceeding that may be resolved or affected by a final determination of the prior-pending opposition.

¹³ "A proceeding is considered to have been finally determined when an order or ruling that ends 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." TBMP § 510.02(b).

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shall promptly inform the Board of any other related cases, even if they become aware of such cases during the suspension period.