

ESTTA Tracking number: **ESTTA974756**

Filing date: **05/17/2019**

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

Proceeding	91245800
Party	Defendant The Vineyard House LLC
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Attachments	Applicants Opposition to Opposers Motion to Suspend HENRY WALKER marks.pdf(33878 bytes)

dispositive of any issue in the present opposition or affect any right of Applicant, which would bear any issue in the present opposition.

II. ARGUMENTS

The language of TBMP 510.02(a) is unambiguous stating that “Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board....” Most commonly, the request to suspend pending the outcome of another proceeding occurs where there is a civil action pending between the parties in a federal district court and the final determination of the other proceeding may have a bearing on the issues before the Board. *See, e.g., New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (civil action need not be dispositive of Board proceeding, but only needs to have a bearing on issues before the Board); *General Motors Corp v. Cadillac Club Fashions, Inc.*, 22 USPQ2d 1933, 1936-37 (TTAB 1992) (relief sought in federal district court included an order directing Office to cancel registration involved in cancellation proceeding); *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125, 126-27 (TTAB 1974) (decision in civil action for infringement and unfair competition would have bearing on outcome of Trademark Act § 2(d) claim before Board), *pet. denied*, 181 USPQ 779 (Comm’r 1974). *See also Tokaido v. Honda Associates Inc.*, 179 USPQ 861, 862 (TTAB 1973); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805, 806-07 (TTAB 1971); *Martin Beverage Co. v. Colita Beverage Corp.*, 169 USPQ 568, 570 (TTAB 1971).

In this instance, Opposer has filed a Motion to Suspend the proceedings and has provided a copy of the complaint filed by Applicant against Opposer in Federal District Court, claiming that the filing of such complaint is a reasonable basis for suspension of the instant application. Applicant notes that the complaint filed in District Court is for a **completely** different trademark,

TO KALON. TO KALON is a geographically descriptive term that was hijacked by Opposer and fraudulently registered by Opposer to the detriment of others who own a part of the original TO KALON estate. Applicant's complaint clearly shows that Opposer fraudulently registered the TO KALON trademark and is looking for a declaratory judgment to allow Applicant to make fair use of the term.

A decision in the federal action will have no bearing on the issues before the Board in the instant case. The instant opposition is for the marks HENRY WALKER CRABB, HENRY WALKER (H.W.) CRABB, HENRY WALKER, H.W. CRABB and HENRY W. CRABB. None of the marks includes the term TO KALON. Opposer claims that the Board should suspend action on this application "in the interest of judicial economy and consistent with [its] inherent authority to regulate its own proceedings to avoid duplicating the effort of the court and possibility of reaching an inconsistent conclusion" and cited *Soc'y of Mex. Am. Eng'rs & Scientists, Inc. v. GVR Pub. Relations Agency, Inc.*, Opp. No. 91121723, 2002 WL 31488947, at *4 (TTAB Nov. 6, 2002). What Opposer fails to tell the Board is that the decision in *Soc'y's of Mex. Am. Eng'rs & Scientists, Inc.*, to suspend was based on the fact that the federal action **did** in fact address the asserted trademark. In this instance, the opposition is for the trademarks CRABB and HENRY WALKER, not TO KALON, which is the subject of the federal action. Therefore, there is no reason to suspend the instant opposition.

The federal court is not reviewing the trademarks CRABB or HENRY WALKER, nor will it render a decision or conclusion with regard to the same, as it is not being asked to do so. Then how can it be possible for the Board to rely on the decision of the federal court in order to make a determination in the instant case? It is not possible – plain and simple. The federal action will not affect whether the Board finds a likelihood of confusion in the current opposition

and will not determine whether Opposer even has standing to bring this action, given that it has no rights in the CRABB or HENRY WALKER marks. The Board must review the instant case on its own merits in order to make a determination with regard to Applicant's rights. The Federal Court is not being asked to review the CRABB or HENRY WALKER trademarks, nor will it make any determinations with regard to the mark such that its decision will have no conclusory effect on the decision of the Board in this matter.

In addition, Opposer also cites TBMP 510.02, regarding the pending dispositive motion. TBMP 510.02 states that if there is a pending motion at the time when suspension of proceedings is raised before the Board, a motion that is potentially dispositive of the case may be decided before the question of suspension is considered. *See* 37 C.F.R §2.117(b); *See also* *Boyd's Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2018-19 (TTAB 2003) (motion to strike petitioner's notice of reliance, its only evidence in the case, decided before motion to suspend, and granted). As stated by Opposer, "[t]he purpose of this rule is to prevent a party served with a potentially dispositive motion from escaping the motion by filing a civil action and then moving to suspend before the Board has decided the potentially dispositive motion."

In this case, Defendant's Motion to Dismiss has yet to be decided by the Board. Opposer had previously requested Applicant's consent to suspend these proceedings pending the civil action. As the Board may be aware via Applicant's prior filing providing the email correspondence between the parties, Applicant denied such request, stating that the issues in this opposition are wholly different from those in the civil action. By filing the Motion to Suspend, Opposer is trying to avoid having the dispositive motion reviewed to delay a negative judgment against it, contrary to the purpose of TBMP §512.02 cited by Opposer.

As clearly stated in Applicant's Motion to Dismiss, Opposer does not have any rights to the CRABB or HENRY WALKER trademarks and thus has no standing to bring this frivolous claim. Opposer does not claim any prior use of the marks, and in fact, clearly denied any affiliation or connection between CRABB, HENRY WALKER and TO KALON when filing its trademark applications with the USPTO. For Opposer to conveniently now claim an affiliation because it suits its own purposes is in bad faith and clearly without any basis. Opposer has no legal authority that would grant it any rights to the CRABB or HENRY WALKER name. Opposer's claims to CRABB and HENRY WALKER are clearly overreaching as Opposer cannot claim anything and everything that it alleges is somewhat related to TO KALON. This is an unfair extension of Opposer's rights which would provide it with an entire universe of claims and rights based on a trademark, TO KALON, that is geographically descriptive and was fraudulently obtained and registered by Opposer.

Opposer's Motion to Suspend should not prevent the Board from considering the Applicant's dispositive Motion to Dismiss first. The Trademark Rules specifically provide for a decision on Applicant's dispositive Motion to Dismiss before a decision is made on Opposer's Motion to Suspend. See 37 C.F.R. §2.117(b).

The civil case between the parties is not dispositive with regard to any trademark which includes the terms CRABB or HENRY WALKER. The federal case focuses specifically on the geographically descriptive wording TO KALON and issues related only to that particular trademark. The complaint does not address the terms or trademarks CRABB or HENRY WALKER and any decision by the federal court will not render any decision or conclusion with regard to the CRABB or HENRY WALKER marks. Moreover, the cases present completely

different facts and legal arguments such that there is no basis to suspend this case in favor of the civil action which will have no bearing on any decision with regard to this matter.

III. CONCLUSION

As stated above, suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board. Applicant respectfully requests that the Board use its discretion in this proceeding to deny Opposer's Motion to Suspend this case and act on Applicant's Motion to Dismiss and otherwise allow this opposition to proceed.

Dated: May 17, 2019

Respectfully Submitted.

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO SUSPEND PENDING DISPOSITION OF CIVIL ACTION** was served by email on this 17th day of May 2019, upon Opposer at the following addresses of record:

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