

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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JMM

March 24, 2021

Opposition No. 91252817 (parent)

House of Kuipers, LLC and Zox LLC

v.

John Zox

Opposition No. 91265309

Opposition No. 91265525

John Zox

v.

Zox LLC

Cancellation No. 92074323

Zox LLC

v.

John Zox, Daniel Zox, and Andrew Zox

By the Trademark Trial and Appeal Board:

I. MOTION TO EXTEND IN OPPOSITION NO. 91252817

In its order dated December 31, 2020, the Board allowed the parties time to file amended pleadings and stated that proceedings remain suspended. (26 TTABVue 9–10). On January 30, 2021, House of Kuipers, LLC and Zox LLC, filed a combined

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amended notice of opposition and notice of request for consolidation. (27 TTABVUE).

On February 26, 2021, John Zox filed a consented motion to extend the end of plaintiff's trial period by 30 days, (28 TTABVUE), which was automatically granted by the Board's electronic filing system. (29 TTABVUE).

Inasmuch as proceedings were suspended, John Zox's consent motion to extend trial dates is moot. Accordingly, the Board's February 26, 2021 order granting the extension, (29 TTABVUE), is **VACATED**.

Nevertheless, in the textbox provided on the Consent Motion to Extend form, John Zox stated that House of Kuipers, LLC and Zox LLC "consented to the request for a 30-day extension of time to answer or otherwise respond to the amended notice of opposition." (28 TTABVUE). As a result, the Board construes John Zox's consented motion to extend as the parties' consent to a 30-day extension of time for John Zox to file an answer to the amended notice of opposition. Such a construed motion is **GRANTED**; however, all pending dates are suspended pursuant to this order.

II. COUNTERCLAIMS IN OPPOSITION NOS. 91265309 AND 91265525

On May 26, 2020, Zox LLC filed a petition to cancel Registration No. 5268843, which was instituted as Cancellation No. 92074323.¹ On November 23, 2020, Zox, LLC filed nearly identical counterclaims to cancel Registration No. 5268843 in Opposition Nos. 91265309 and 91265525.

¹ Following disposition of a motion to dismiss, Zox LLC filed an amended petition to cancel on February 19, 2021. (17 TTABVUE).

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It was unnecessary for Zox LLC to re-plead the counterclaims in the opposition proceedings. Accordingly, the Board's orders instituting the counterclaims in Opposition Nos. 91265309 and 91265525 (7 TTABVUE in each proceeding) are **VACATED**, and Zox LLC's duplicative counterclaims to cancel Registration No. 5268843 in Opposition Nos. 91265309 and 91265525 are **DISMISSED**.²

Additionally, in view of the foregoing, John Zox's motions to dismiss the counterclaims in Opposition Nos. 91265309 and 91265525, (8 TTABVUE in each proceeding), are **DENIED AS MOOT**.³

III. PROCEEDINGS CONSOLIDATED

On January 24, 2021, Zox LLC filed in Opposition No. 91265525, inter alia, a motion to consolidate Opposition Nos. 91252817, 91265309, and 91265525, and Cancellation No. 92074323. (10 TTABVUE).⁴

On February 16, 2021, John Zox filed in Opposition No. 91265525, inter alia, an opposition to the motion to consolidate.⁵ (11 TTABVUE). John Zox argues that the

² The filing fees associated with the counterclaims will be refunded to Zox LLC in due course.

³ Zox LLC's oppositions to the motion to dismiss counterclaims in Opposition Nos. 91265309 and 91265525 (10 TTABVUE in each proceeding) will be given no further consideration.

⁴ Zox LLC also filed an embedded "request" for consolidation in Cancellation No. 92074323 (17 TTABVUE), and Opposition No. 91265309 (10 TTABVUE). In addition, on January 30, 2021, House of Kuipers, LLC and Zox LLC filed, along with their amended pleading in Opposition No. 91252817, a motion to consolidate the proceedings. (27 TTABVUE).

⁵ In Cancellation No. 92074323, John Zox, Daniel Zox, and Andrew Zox filed a response to the "request" for consolidation, stating that they "object to the consolidation of the instant proceeding with any of the allegedly related proceedings referenced in Petitioner's Notice, for the reasons set forth in Registrant John Zox's Opposition to Applicant's Request to Consolidate, filed in Opposition No. 91265525 on February 16, 2021." (16 TTABVUE 2).

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Board should deny the motion to consolidate because of the lack of identity between the parties, the “widely divergent legal issues,” and the potential prejudice to Andrew Zox and Daniel Zox given that they are not party to the three opposition proceedings. (*Id.* at 8). However, John Zox also states that “[t]o the extent that the Board determines that some degree of consolidation is essential, then John Zox does not object to consolidation of the ’817, ’525, and ’309 Proceedings, to which only he and Zox LLC are parties.” (*Id.* at 11, n.5).

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); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 511 (2019); *see also* *Wis. Cheese Grp., LLC v. Comercializadora de Lacteos y Derivados, S.A. de C.V.*, 118 USPQ2d 1262, 1264 (TTAB 2016); *Venture Out Props. LLC v. Wynn Resorts Holding LLC*, 81 USPQ2d 1887, 1889 (TTAB 2007). Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, upon stipulation of the parties approved by the Board, or upon the Board’s own initiative. *See, e.g., Wis. Cheese Grp., LLC*, 118 USPQ2d at 1264. In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby. *See id.*; *World Hockey Ass’n v. Tudor Metal Prods. Corp.*, 185 USPQ 246, 248 (TTAB 1975); TBMP § 511.

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The Board finds that consolidation is appropriate here. The parties to these proceedings are overlapping, and the issues are similar or related. For example, although the parties are not identical, Registration No. 5268843, the subject of Cancellation No. 92074323, has been pleaded by plaintiff John Zox in Opposition Nos. 91265309 and 91265525. Similarly, application Serial No. 88228839, the subject of Opposition No. 91252817, has been pleaded by plaintiff John Zox in Opposition Nos. 91265309 and 91265525. In addition, application Serial Nos. 88582432 and 88829957, the subjects of Opposition Nos. 91265309 and 91265525, respectively, have been pleaded by plaintiff Zox LLC in Cancellation No. 92074323. As a result, John Zox's argument that the proceedings are unrelated and involve "widely divergent legal issues and facts" is unpersuasive, and judicial economy is best served by consolidating proceedings and moving forward to a single trial rather than in a piecemeal manner. *See* TBMP § 511.

Accordingly, House of Kuipers, LLC's and Zox LLC's motions to consolidate are **GRANTED**. Opposition No. 91252817, Opposition No. 91265309, Opposition No. 91265525, and Cancellation No. 92074323 are hereby consolidated and may be presented on the same record and briefs. *See, e.g., Wis. Cheese Grp., LLC*, 118 USPQ2d at 1264 (citing *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1619 n.1 (TTAB 1989)).

The Board file will be maintained in Opposition No. 91252817 as the "parent case." From this point on, with the exception of an answer in Cancellation No. 92074323,

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only a single copy of all motions and submissions should be filed, and each submission should be filed in the parent case only, but caption all consolidated proceeding numbers, listing and identifying the “parent case” first. However, because the pleadings must be complete in each individual proceeding, upon resumption of proceedings as appropriate, John Zox, Daniel Zox, and Andrew Zox will be required to file their answer to the amended petition to cancel in Cancellation No. 92074323 in the child case.

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.

IV. CONSOLIDATED PROCEEDINGS SUSPENDED FOR CIVIL ACTION

On March 12, 2021, the parties in Cancellation No. 92074323 filed a consent motion to suspend proceedings pending a civil action between the parties, *Zox LLC v. John Zox et al.*, Civil Action No. 2:21-cv-01609, pending in the United States District Court for the Central District of California. (18 TTABVUE). The parties provided a copy of the complaint in the civil action along with the consent motion. (*Id.*).

On March 17, 2021, House of Kuipers LLC and Zox LLC filed in Opposition No. 91252817 a motion to suspend proceedings pending the outcome of the same civil action. (30 TTABVUE). Zox LLC filed the nearly identical motion to suspend in Opposition Nos. 91265309 and 91265525. (9, 12, TTABVUE, respectively).

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On March 22, 2021, John Zox filed a notice in Opposition No. 91265309 stating, inter alia, that he “consents to Zox LLC’s March 17, 2021 Motion to Suspend Proceedings Pending Outcome of Civil Litigation on the grounds that the parties are engaged in a civil action that may have a bearing on this proceeding.” (11 TTABVUE). John Zox filed a nearly identical notice in Opposition No. 91265525. (13 TTABVUE).

Trademark Rule 2.117(a), provides that,

[w]henever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

37 C.F.R. § 2.117(a). It is the policy of the Board, absent unusual circumstances, to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case. *See, e.g., Monster Energy Co. v. William J. Martin*, 125 USPQ2d 1774, 1778 (TTAB 2018); *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); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805, 806–07 (TTAB 1971). The Board typically will review the pleadings in the civil action to determine if the issues before the court may have a bearing on the Board proceeding. *See New Orleans La. Saints LLC*, 99 USPQ2d at 1552.

In the civil action here, Zox LLC seeks, inter alia, an ordering cancelling Registration No. 5268843, the subject of Cancellation No. 92074323 and the

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registration pleaded by John Zox in Opposition Nos. 91265309 and 91265525. In addition, Zox LLC seeks an order requiring abandonment of application Serial No. 88228839, the subject of Opposition No. 91252817 and the application pleaded by John Zox in Opposition Nos. 91265309 and 91265525. As a result, the civil action raises issues of fact and law that may have a bearing on this proceeding, and judicial economy will be served by suspension.

In view of the foregoing, the above-referenced motions to suspend for civil action are **GRANTED**. Trademark Rule 2.117(a).

Proceedings are suspended pending final disposition of the civil action.⁶ Within TWENTY (20) DAYS after the final determination of the civil action, the parties shall so notify the Board, in writing, so that these consolidated proceedings may be called up for appropriate action.⁷ Such notification to the Board should include a copy of any final order or final judgment which issued in the civil action.

During the suspension period, the parties must notify the Board of (i) any address or email address changes for the parties or their attorneys, and (ii) any other related cases, even if they become aware of such cases during the suspension period.⁸

⁶ 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. *See* TBMP § 510.02(b).

⁷ To the extent that a final determination in the civil action is dispositive as to some, but not all, of the cases in this consolidated proceeding, upon resumption as appropriate, the remaining cases may no longer be considered consolidated with the cases for which a final disposition is entered.

⁸ The Board recognizes that respondents in Cancellation No. 92074323, John Zox, Daniel Zox, and Andrew Zox, are represented by different counsel than John Zox in the opposition

proceedings. Upon resumption as appropriate, to the extent proceedings remain consolidated, John Zox, Daniel Zox, and Andrew Zox will be required to designate one lead counsel to whom the Board may send postal correspondence intended for John Zox, Daniel Zox, and Andrew Zox. *Cf.* TBMP § 117.02. Lead counsel is not substituted for the separate counsel of each party, but rather is responsible for coordinating the conduct of the parties' cases. However, by designating more than one email address (separated by commas, up to a limit of 800 characters) for receipt of notice of Board actions, all representatives may receive electronic correspondence from the Board.