

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

June 13, 2022

Opposition No. 91270271 (**Parent**)

Alfwear Inc.

v.

IBKUL UBHOT Ltd.

Opposition No. 91274967

IBKUL UBHOT Ltd.

v.

Alfwear, Inc.

Mary Beth Myles, Interlocutory Attorney:

This proceeding now comes before the Board for consideration of Alfwear Inc.’s (“Alfwear”) motion (filed December 7, 2021) to suspend proceedings pending disposition of a civil action.¹ The motion is fully briefed.²

For purposes of this order, the Board presumes the parties’ familiarity with the pleadings, the history of the proceeding, and the arguments and evidence submitted with respect to the motion and does not repeat the parties’ arguments herein except

¹ IBKUL UBHOT Ltd.’s (“IBKUL”) consented motion (filed December 27, 2021) to extend its time to file a response to Alfwear’s motion to suspend is retroactively granted.

² Alfwear’s notices of appearance of co-counsel (filed July 27, 2021) and IBKUL’s change of correspondence address (filed August 12, 2021) are noted.

as necessary to explain the Board's order. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

I. Sua Sponte Consolidation

It has come to the Board's attention that the above-captioned proceedings involve the same parties and common questions of law or fact.

Accordingly, the Board orders consolidation of the above-captioned proceedings. See Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). The consolidated cases may be presented on the same record and briefs. See *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989); *Hilson Res. Inc. v. Soc. For Human Resource Mgmt.*, 26 USPQ2d 1423 (TTAB 1993).

The file record will be maintained in Opposition No. 91270271 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 caption both 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.

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.

II. Alfwear's Motion to Suspend for Civil Action

Alfwear moves to suspend Opposition No. 91270271 pending determination of a civil action filed in the United States District Court for District of Utah, *Alfwear, Inc. v. IBKUL Ubhot Ltd.*, 2:21-cv-00698-DAO (the "Civil Action"). Alfwear filed a copy of its complaint in the Civil Action concurrently with its motion to suspend.

In support of its motion, Alfwear argues that the parties are the same, the marks are the same or similar, and that the Civil Action specifically references IBKUL's involved applications in Opposition No. 91270271.

In response, IBKUL argues that although the complaint in the Civil Action identifies its involved applications, Alfwear did not assert any claims against those two applications in the Civil Action, but instead asserted infringement claims against the mark **IBKÜL** (Application Serial No. 87188136), which is subject to Opposition No. 91233985. 12 TTABVUE 4. IBKUL also argues that it has filed a motion to strike the references to its involved applications in the complaint in the Civil Action and that the Civil Action will have no bearing on Opposition No. 91270271. *Id.* at 5. Additionally, IBKUL argues that proceedings should not be suspended, because the district court does not have "jurisdiction to issue an order refusing registration of IBKUL's two intent to use application marks...". *Id.* at 6.

It is the policy of the Board to suspend proceedings when the parties are involved in a civil action that may be dispositive of or have a bearing on the Board case. *See* Trademark Rule 2.117(a); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 510.02(a) (2021).

Following a careful review of the record, the Board finds that a decision by the district court in the Civil Action could have a bearing on the issues in these consolidated proceedings. Specifically, in Opposition No. 91270271, Alfwear has opposed registration of IBKUL's involved marks on the grounds of likelihood of confusion and dilution, based on its pleaded prior registrations and prior rights in the mark KUHL for various apparel and related goods and services. In the Civil Action, Alfwear has pleaded, inter alia, claims of trademark infringement and dilution based on IBKUL's use of the mark IBKÜL for clothing. 10 TTABVUE 16-17. Both of IBKUL's involved marks in this proceeding are stylized versions of the mark IBKUL or IBKÜL for various apparel. Additionally, Alfwear relies on the same prior registrations in support of its claims, including Registration No. 3916866, which IBKUL has counterclaimed to cancel. Similarly, in Opposition No. 91274967, IBKUL has opposed Alfwear's registration of the mark KÜHL, which was pleaded by Alfwear in its complaint in the Civil Action as an identical "replacement" for its pleaded Registration No. 3916866, which had been inadvertently cancelled. 10 TTABVUE 15.

The Board therefore finds that the Civil Action may have a bearing on these proceedings and that suspension of these proceedings pending disposition of the Civil Action will serve the interests of judicial economy. A civil action need not be dispositive of a Board proceeding, but only needs to have a bearing on the issues before the Board. *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011)

The Board also notes that, to the extent that a civil action in a federal district court involves issues in common with those in a Board proceeding, the district court decision would be binding on the Board. *See Wella Corp. v. Cal. Concept. Corp.*, 194 USPQ 419, 423 (CCPA 1977); *Midland Cooperatives, Inc. v. Midland Int'l Corp.*, 164 USPQ 579, 583 (CCPA 1970).

Furthermore, Board decisions are appealable to the district court. *See* Section 21(b) of the Trademark Act, 15 U.S.C. § 1071(b). Finally, suspending this matter pending the final determination of the Civil Action will serve the interests of judicial economy.

In view of the foregoing, Alfwear's motion to suspend proceedings pending the Civil Action is **granted**.

Additionally, the Board notes that the parties in these consolidated proceedings are also party to Opposition No. 91233985, which was remanded to the Board on October 13, 2021 after appeal to the Federal Circuit. Opposition No. 91233985 involves the same parties and the same or similar marks as these consolidated proceedings and the Civil Action. The Board therefore finds that Opposition No. 91233985 may similarly have a bearing on these consolidated proceedings.

Accordingly, these consolidated proceedings are **suspended** pending final determination of both the Civil Action and Opposition No. 91233985, including all appeals or remands.⁴

⁴ 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).

Within **twenty days** after the final determination of the Civil Action and Opposition No. 91233985, the parties must so notify the Board so that these consolidated proceedings may be called up for appropriate action. Such notification to the Board should include a copy of any final order or final judgment that issued in the Civil Action and Opposition No. 91233985.

During the suspension period, the parties must notify the Board of any address changes for the parties or their attorneys. In addition, the parties are to promptly inform the Board of any other related cases, even if they become aware of such cases during the suspension period.⁵

⁵ On April 28, 2022, the parties filed a joint motion to reset deadlines upon determination of Alfwear's motion to suspend. The motion is granted to the extent that the Board considers proceedings retroactively suspended as of the filing date of the motion. In the event proceedings are resumed, dates will be reset appropriately in these consolidated proceedings.