

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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LH/AJL/MW

July 27, 2022

Opposition No. 91271199

Cult Beauty Limited

v.

Jasmin Larian, LLC

Michael Webster, Managing Interlocutory Attorney:

Cult Beauty Limited (“Opposer”) opposes registration of the standard character mark CULT GAIA BEAUTY for goods in International Class 3¹ on grounds of likelihood of confusion based on prior common law use and ownership of three registrations for the standard character mark CULT BEAUTY for a variety of goods and services.² Each of Opposer’s pleaded registrations is based on a request for extension of protection under Trademark Act Section 66(a), 15 U.S.C. § 1141f(a); *see also* 37 C.F.R. § 2.34(a)(5).

On December 1, 2021, Jasmin Larian, LLC (“Applicant”) filed a motion to suspend this proceeding pending final determination of proceedings filed by DKH Retail Ltd.

¹ Application Serial No. 88827429 was filed on March 9, 2020, based on Applicant’s allegation of a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

² Opposer pleads ownership of Registration No. 4378248 (issued August 6, 2013), No. 4709986 (issued March 31, 2015), and No. 6160665 (issued September 29, 2020).

in the EUIPO³ and the UKIPO⁴ challenging the validity of the foreign registrations on which Opposer's International registrations are based. Opposer did not oppose the motion.

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a civil action, another Board proceeding, or an expungement or reexamination proceeding may have a bearing on a pending case, proceedings before the Board may be suspended until termination of the civil action, the other Board proceeding, or the expungement or reexamination proceeding. Trademark Rule 2.117(a). A civil action 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. *New Orleans Louisiana Saints LLC and NFL Prop. LLC v. Who Dat?, Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011). Foreign actions which may affect the validity of a U.S. registration may also form the basis for a suspension. *See Marie Claire Album S.A. v. Kruger GmbH & Co. KG*, 29 USPQ2d 1792, 1793 (TTAB. 1993) (suspension for foreign action affecting validity of underlying foreign registration in U.S. application under Trademark Act § 44).

³ In EUIPO Revocation No. 000044586 C, filed on June 19, 2020, DKH Retail Limited seeks to cancel EUTM Reg. No. 010304715 for CULT BEAUTY for all goods and services in all classes on the basis of nonuse. EUTM Reg. No. 010304715 formed the basis for International Registration No. 1138512, registered November 24, 2011, from which Opposer's Registration Nos. 4378248 (CULT BEAUTY in Classes 18 and 35 following Trademark Act § 71 affidavit) and 6160665 (CULT BEAUTY in Classes 4, 8, 18, 21, and 35) stem as the result of an extension of protection under Trademark Act § 66, 15 U.S.C. § 1141.

⁴ In UKIPO Cancellation No. CA000503365, DKH Retail Limited seeks to cancel UK Reg. No. UK00003032733 for CULT BEAUTY. Applicant's motion did not include the pleadings for this action. UK Reg. No. UK00003032733 formed the basis for International Registration No. 1195792, registered February 13, 2014, from which Opposer's Registration No. 4709986 (CULT BEAUTY in Class 3) stems as the result of an extension of protection under Trademark Act § 66, 15 U.S.C. § 1141.

Extensions of protection to the United States, filed pursuant to Trademark Act § 66, 15 U.S.C. § 1141f, are always dependent upon the underlying international registration. Trademark Act § 70(a), 15 U.S.C. § 1141j; *SaddleSprings, Inc. v. Mad Croc Brands, Inc.*, 104 USPQ2d 1948, 1951 (TTAB 2012). International registrations are dependent upon their underlying basic applications or registrations for five years from the international registration date. See Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, 828 U.N.T.S 1185, Article 6(3) (protection of international registration may no longer be invoked in event of, inter alia, full or partial cancellation of basic application/registration resulting from proceeding that had begun before the expiry of five years from the date of the international registration); *Accord* Trademark Act § 63, 15 U.S.C. § 1141c.

On the face of the document provided, the EUIPO proceeding was filed on June 19, 2020,⁵ more than five years after the November 24, 2011 registration date of International Registration No. 1138512 for which the EU trademark Registration No. 010304715 forms a basis. Consequently, the proceeding will not affect the International Registration and will not have a bearing on Opposer's pleaded registrations that are based on the International Registration.⁶ See Madrid Protocol, Article 6(2) (independence of international registration after five years). In turn, those proceedings will not have a bearing on the instant Board proceeding. In view thereof, Applicant's motion to suspend for the EUIPO proceeding is **denied**.

⁵ 7 TTABVUE 39 (Exhibit D).

⁶ Registration Nos. 4378248 and 6460665.

Turning to the UKIPO proceeding, Applicant did not provide a copy of the pleadings for the proceeding or information regarding the date the proceeding commenced. *See Birlinn Ltd. v. Stewart*, 111 USPQ2d 1905, 1909 (TTAB 2014); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 510.02(a). Thus, the Board is unable to determine whether the UKIPO proceeding will have a bearing on Opposer's pleaded Registration No. 4709986.

In view thereof, proceedings are suspended and Applicant is allowed **twenty days** from the date of this order to submit documentation regarding the status of the referenced proceeding, including the date it was filed, failing which the Board will resume proceedings and reset the schedule beginning with the discovery conference deadline and the opening of discovery.⁷ However, as discussed herein, if the UKIPO proceeding was not filed within five years of the registration date of International Registration No. 1195792, the proceeding will not affect the registration.

⁷ The motion to suspend was filed prior to the discovery conference deadline. The Board apologizes for the delay in determining the motion.