

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500
General Email: TTABInfo@uspto.gov

LTS

July 12, 2022

Opposition No. 91272420

The University of Mississippi

v.


Suzi Altman

Lawrence T. Stanley, Jr., Interlocutory Attorney:

This case comes up for consideration on Opposer's motion, filed June 14, 2022, to suspend this proceeding pending final determination of a civil action between the parties. 13 TTABVUE. The motion to suspend is contested.¹

The Board has carefully considered all of the parties' arguments, presumes the parties' familiarity with the bases for their filings, and does not recount the arguments here except as necessary to explain this decision. *See Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

I. Background

Applicant seeks registration of the mark  for "hats; shirts; shirts and short-sleeved shirts; baseball caps and hats; golf shirts; hoodies;

¹ The Board exercises its discretion to rule on the motion before Opposer's reply brief is due because it finds a reply brief unnecessary to resolution of the motion.

jackets; jerseys; polo shirts; sports caps and hats; tee shirts” in International Class 25.²

In its notice of opposition, Opposer alleges prior use and registration of the mark **OLE MISS** for “sports and athletic clothing, namely t-shirts, sweat shirts and pants, workout suits and jackets, sweaters, dresses, sport coats, hats, socks, ties and underwear” in International Class 25 and “providing university-level graduate and undergraduate courses of instruction; adult education programs; preparing and publishing classroom text and course material, conducting schools, seminars, and training courses on a variety of subjects; presenting education related entertainment services, namely, lectures, concerts, theater productions, intra and intercollegiate sporting events and sports training programs” in International Class 41.³ Opposer also alleges prior common law use of the mark OLE MISS for “the sale and licensing of apparel and accessories, and education, sports, entertainment, and philanthropic services.” 1 TTABVue 5-6, ¶¶ 3-6.

As grounds for opposition, Opposer purports to plead claims of likelihood of confusion under Section 2(d) of the Trademark Act, false suggestion of a connection under Section 2(a) of the Trademark Act, and dilution under Section 43(c) of the Trademark Act. *Id.* at 8-10, ¶¶ 16-26.

² Application Serial No. 90050159; filed July 13, 2020 under Section 1(a) of the Trademark Act, based on Applicant’s claim of first use of the mark in commerce on October 1, 2018.

³ Registration No. 1405895; issued August 19, 1986; renewed.

On November 29, 2021, Applicant filed her answer denying the salient allegations of the notice of opposition and purporting to plead several “affirmative defenses.” 4 TTABVUE.

On June 14, 2022, Opposer filed its motion to suspend this proceeding pending disposition of a civil action between the parties. 13 TTABVUE.

II. Determination

Opposer moves to suspend this proceeding pending final disposition of a civil action between the parties pending in the Circuit Court for Lafayette County, Mississippi, captioned *The University of Mississippi v. Suzi Altman*, Civil Action No. L22-261 (the “Civil Action”). 13 TTABVUE; 14 TTABVUE 10-15.⁴ Opposer argues, inter alia, that: (1) Opposer filed the Civil Action against Applicant on June 3, 2022, which asserts causes of action for common law trademark infringement and violation of Mississippi’s anti-dilution statute (13 TTABVUE 3); (2) the complaint seeks, among other remedies, to enjoin Applicant in the entire state of Mississippi from use of Applicant’s involved mark (*id.*); (3) the Civil Action “will certainly have a bearing on this proceeding” in that it “includes causes of action for common law trademark infringement and dilution of the famous Ole Miss mark” (*id.* at 4); and (4) “the suspension of this proceeding will assist in avoiding premature and unnecessary discovery regarding currently unresolved issues about the Subject Mark that may be resolved in the [Civil] Action” (*id.*).

⁴ Although Opposer stated that a copy of the operative complaint from the Civil Action was attached to its motion to suspend (13 TTABVUE 3), the attachment was not included. Applicant, however, attached the operative complaint to her response to Opposer’s motion to suspend (14 TTABVUE 10-15).

In response, Applicant argues that suspension for the Civil Action is not appropriate because, inter alia: (1) “[s]uspension of this opposition proceeding would unnecessarily delay proper determination of the issues before ... the Board ... and force the parties to litigate tangential issues while the Applicant’s mark awaits registration” (14 TTABVUE 2); (2) “the issues in the [Civil Action] are not nearly as overlapping with the issues in this opposition as Opposer’s motion suggests” (*id.*); (3) “not only will the [Civil Action] not have bearing on the issues before the Board, but the decision of the Board may have bearing on the issues before the [Civil Action]” (*id.* at 3); (4) “the issues posed by the [Civil Action] are not identical to the issues to be determined by the Board, nor is any issue in the [Civil Action] dispositive or preclusive of any issue in the opposition” (*id.* at 4); (4) “[a]lthough the Mississippi common law trademark infringement analysis involves the consideration of the likelihood of confusion, likelihood of confusion is only one factor in determining state common law infringement” (*id.* at 5); and (6) “[t]he[] differences that distinguish the state claim [of dilution] from the federal claim of dilution ensure that the [Civil Action] decision on the claim of dilution should not bear on the issues before the Board” (*id.* at 6).

“Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a civil action ... may have a bearing on a pending case, proceedings before the Board may be suspended until termination of the civil action[.]” Trademark Rule 2.117(a). “[T]he 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 v. Who Dat?, Inc., 99 USPQ2d 1550, 1552 (TTAB 2011). Suspension of a Board proceeding pending the outcome of another proceeding is solely within the discretion of the Board. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 510.02(a) (2021).

In the Civil Action, Opposer pleads, inter alia, prior use and ownership of the same pleaded registration as in this proceeding (i.e., Registration No. 1405895) and the same prior common law rights in its OLE MISS mark, and that Applicant's use of the mark NEW MISS, inter alia, infringes and dilutes Opposer's rights in its pleaded marks under Mississippi state law. 14 TTABVUE 11-14, ¶¶ 6-24. Opposer's prayer for relief in the Civil Action includes a request that Applicant be enjoined from "using the New Miss mark in any manner in the State of Mississippi." *Id.* at 14.

The Civil Action involves the same parties and marks as are at issue in this proceeding, as well as overlapping issues, including whether Opposer owns rights in its OLE MISS marks and whether Applicant's use of the NEW MISS mark is likely to cause confusion with, or dilute, Opposer's pleaded marks. For these reasons, the Civil Action may have a bearing on the cancellation proceeding such that proceeding here prior to resolution of the Civil Action would be inefficient and pose a risk of inconsistent judgments. For these reasons, Opposer's motion to suspend is **granted**, and proceedings are **suspended** pending final disposition of the Civil Action.

To the extent that Applicant argues that the Board proceeding will have a bearing on the Civil Action, not the other way around (14 TTABVUE 3-7), it is unclear on the current record whether Applicant has sought to stay the Civil Action in favor of the

Board proceeding. To the extent that Applicant has filed a motion to stay the Civil Action, or intends to file such a motion, the Board notes that, if the State Court grants a motion to stay the Civil Action in favor of this proceeding, the Board will resume this proceeding. TBMP § 510.02(a) (“[I]f, as sometimes happens, the court before which a civil action is pending elects to suspend the civil action to await determination of the Board proceeding and the Board is so advised, the Board will go forward with its proceeding.”). Otherwise, within **twenty days** after the **final** determination of the Civil Action,⁵ the parties shall notify the Board and call this case up for any appropriate action.⁶ Such notification to the Board should include a copy of any final order or final judgment which issued in the civil action.⁷

⁵ 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).

⁶ The Board notes Opposer’s notice of expert disclosure, filed July 8, 2022. 15 TTABVUE. If and when proceedings resume following the final determination of the Civil Action, the Board will address the schedule for expert discovery.

⁷ During the suspension period, the parties must notify the Board of any address or email address changes for the parties or their attorneys.