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

Proceeding no.	91273333
Party	Defendant Williams-Sonoma, Inc.
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Date	04/04/2023
Attachments	THE ONE - WSI - Motion to Suspend for TTAB Cancellation Proceeding.pdf (112134 bytes)

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

ENTREPRENEURIAL VENTURES
CAPITAL CO., LLC,

Opposer,

v.

WILLIAMS-SONOMA, INC.,

Applicant.

Opposition No. 91273333

Serial No. 90/592,171

Mark: THE ONE

**APPLICANT’S MOTION TO SUSPEND OPPOSITION PROCEEDING PENDING
DISPOSITION OF A CANCELLATION COUNTERCLAIM FILED AGAINST THE
SUBJECT REGISTRATION**

Pursuant to 37 C.F.R. § 2.117(a) and T.B.M.P. § 510.02(a), Applicant Williams-Sonoma, Inc. (“Applicant”) hereby requests that the above-captioned opposition proceeding be suspended pending disposition of a cancellation counterclaim currently before the Trademark Trial and Appeal Board in TTAB proceeding No. 91270721 (the “Cancellation Counterclaim”). In that Cancellation Counterclaim, a third party is seeking to cancel Opposer Entrepreneurial Ventures Capital Co., LLC’s (“Opposer”) registration for THE ONE (Reg. No. 3865993) (“Opposer’s Registration”). A copy of that third party Cancellation Counterclaim and related documents including the Board’s decision refusing Opposer’s motion to dismiss, are attached to this Motion.

The Cancellation Counterclaim claims, among other things, that Opposer does not use and never has used its alleged ONE mark in commerce in connection with the goods in Opposer’s Registration. That same alleged mark and corresponding registration are the basis of the Opposer’s

claims raised in this opposition proceeding. The Opposer sought to dismiss the Cancellation Counterclaim, but failed. The Board in that proceeding denied Opposer's motion to dismiss the third party's cancellation claims, and instead resumed proceedings, setting pretrial disclosures and various trials dates, a large number of which are set to occur this year.

The Board has the power to suspend proceedings in favor of a parallel Board proceeding pursuant to Trademark Rule 2.117(a), which provides:

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.

37 C.F.R. § 2.117(a) (emphasis added). Similarly, the Trademark Trial and Appeal Board Manual of Procedure provides that, “[o]rdinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding may have a bearing on the issues before the Board.” T.B.M.P. § 510.02(a); *see also* 1 Jeffery A. Handelman, *Guide to TTAB Practice* § 14.15(A) (2011) (“Generally, it is the Board’s practice to suspend a Board proceeding when there is a pending civil action or another Board proceeding which may be dispositive of, or have a bearing on, the proceeding proposed to be suspended.”).

The issue raised in this Board proceeding—Applicant’s right to registration of the mark depicted in Application Serial No. 90/592,171 for the goods identified therein—is fully subsumed by the pending Cancellation Counterclaim. The Board’s conclusion in the Cancellation Counterclaim with respect to the validity of Opposer’s Registration is crucial to the disposition of Opposer’s opposition proceeding against Applicant. *See, e.g., In re LKK Health Products Group Limited*, 88160995 (T.T.A.B. Oct. 9, 2020) (suspending *ex parte* appeals pending the disposition

of a cancellation action against the registration blocking the refused applications, which was filed by an unrelated third party).

Because the outcome of the Cancellation Counterclaim will, at a minimum, bear on an important issue before the Board in this proceeding, and may resolve that issue before the Board entirely, the instant proceeding should be suspended pending disposition of the Cancellation Counterclaim.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that this opposition proceeding be suspended pending final disposition of the Cancellation Counterclaim.

Respectfully submitted,

Dated: April 4, 2023

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing was served on Opposer's counsel on
April 4, 2023, via e-mail to:

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/s/ _____
Beth Craig

CERTIFICATE OF TRANSMITTAL

I hereby certify that a true copy of the foregoing is being filed electronically with the
PTO via ESTTA on this day, April 4, 2023.

/Beth Craig/ _____
Beth Craig