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

| | |
|------------------------|---|
| Proceeding no. | 91284307 |
| Party | Defendant Emirates Leisure Retail (Holding) LLC |
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**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Dufry International AG

Opposer,

v.

Opposition No. 91284307

Emirates Leisure Retail (Holding) LLC

Applicant,

_____)

APPLICANT’S MOTION TO DECONSOLIDATE/SEPARATE PROCEEDINGS

Applicant, Emirates Leisure Retail (Holding) LLC. (“Applicant”), submits its Motion to Deconsolidate/Separate Proceeding No. 91284307 brought by Opposer, Dufry International AG (“Opposer”), and in support states as follows.

I. INTRODUCTION

On May 4th, 2023, Opposer filed a consolidated Notice of Opposition (1 TTABVUE) against Applicant’s mark applications identified as Serial Nos. 90817419, 90817256, and 90817306 (these are in class 035), and Serial Nos. 90817322, 90817290, and 90817277 (these are in class 043), (“Applicant’s Applications”). Three of these applications fall in class 035 and remaining three fall in class 043. On facts it is clear that while the Opposer is relying on registration in class 035 only, but by way of consolidated Opposition the Opposer is also attempting to oppose Applicant’s applications in classes 043 in addition to class 035 applications. Since nature of services in class 035 pertain to “Retail” and the nature of services in class 043 pertain to “Cafes / Restaurants” so it is important on factual basis to ascertain the likelihood of confusion separately for oppositions falling in Class 035 and separately for class 043. Going by the strict construction of TBMP § 305.01, the question of law and facts, that are not common are: (1) Opposer’s lack of any registration in class 43; (2) Opposer’s lack of any use

of its marks in relation of cafes / restaurants services, (i.e. Opposer never used the “Hudson” mark in relation to cafes / restaurants services, or in other words Opposer’s use in retail of goods cannot be equated with cafes / restaurants services); (3) lack of any cross-connection or lack of overlap between the description of services (i.e. the United States Patent and Trademark Office, according to its own examination manual, never does any cross-class searches between class 35 and 43 and it never thinks that description of services for these classes have any overlap); (4) Opposer’s had never packed any coffee goods under “Hudson” mark, rather any off the shelf coffee products that the Opposer ever offered have always been under third parties marks; and (5) that Applicant’s similar mark was previously filed and published under Application No. 87440282 in class 43 in respect of which a Notice of Allowance was issued by the United States Patent and Trademark Office, so the Opposer never Opposed Applicants previous application in class 043. Therefore, Opposer’s current consolidated Opposition (at least in class 43 matters) is inconsistent and contradictory of its previous acquiesce conduct.

Therefore, due to the dissimilarity between the opposed mark applications, and Opposer’s lack of registration in class 043 and lack of use in relation to cafes / restaurants services, and potential prejudice to Applicant, Applicant requests that the Board order the separation of the instant proceeding in at the least for the applications Nos. 90817419, 90817256, and 90817306, falling in class 035, from the applications Nos. 90817322, 90817290, and 90817277, falling in class 043.





II. ARGUMENT




TBMP § 305.01 provides, “A consolidated notice of opposition, or consolidated petition to cancel, is appropriate if the plaintiff’s claims against each of the defendant’s subject applications, and/or registrations, involve common (i.e., similar) questions of law or fact.” On

determining whether consolidation is appropriate, the Board must weigh the savings in time and expense against any prejudice or inconvenience to the parties. TBMP § 511.

Opposer opposes Applicant’s Applications on two grounds: (1) likelihood of confusion under Trademark Act Section 2(d); and (2) lack of intent to use the marks at the time of filing. Although other *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002).

Applicant’s Applications consist of the following displayed marks for the identified services (collectively “Applicant’s Marks”):

| APPLICANT’S MARKS | APPLICANT SERIAL NO. | APPLICANT’S SERVICES | Lacking Common Questions of Law / Facts | OPPOSER’S MARKS | OPPOSER SERIAL NO. | OPPOSER’S SERVICES |
|---|----------------------|--|---|-------------------------|--------------------|---|
|  hudsons | 90817256 | Retail store services featuring coffee products, coffee beverages, coffee beans, coffee flavorings, coffee mixtures, and coffee substitutes – IC 035 | - | Hudsons News | 1765128 | Retail store services featuring newspapers, magazines, books, snack food, clothing, film, and other sundries – IC 035 |
|  hudsons | 90817277 | Coffee shops; Preparation of beverages - IC 043 | YES | - | - | - |
|  hudsons coffee | 90817306 | Retail store services featuring coffee products, coffee beverages, coffee beans, coffee flavorings, coffee mixtures, and coffee substitutes - IC 035 | - | HUDSON NEWS | 1767766 | Retail store services featuring newspapers, magazines, books, snack food, clothing, film, and other sundries – IC 035 |
|  hudsons coffee | 90817322 | Coffee shops; Preparation of beverages - IC 043 | YES | - | - | - |


| | | | | | | |
|---|----------|--|-----|--|---------|---|
|  | 90817419 | Retail store services featuring coffee products, coffee beverages, coffee beans, coffee flavorings, coffee mixtures, and coffee substitutes - IC 035 | - |  | 4583696 | Retail store services featuring newspapers, magazines, books, snack food, clothing, film, and other sundries – IC 035 |
|  | 90817290 | Coffee shops; Preparation of beverages - IC 043 | YES | - | | - |


As seen in the table above, Applicant’s Marks are not identical and actually have different design and literary elements. Two of Applicant’s Marks consist of a heart design to the immediate left of the word “hudsons” in lowercase stylized font but are for different services (retail store services v. coffee shop and preparation of beverages). Two of Applicant’s Marks consist of a heart design to the immediate left of the word “hudsons” in lowercase bolded stylized font followed by the word “coffee” in lowercase unbolded stylized font, but again are for different services (retail store services v. coffee shop and preparation of beverages). And the remaining two of Applicant’s Marks consist of a centered heart design above the word “hudsons” in lowercase bolded stylized font and “coffee” underneath in lowercase unbolded stylized font and underneath that the phrase “a little love in every drop” but again are for different services (retail store services v. coffee shop and preparation of beverages). While the marks share some elements, they each create distinct commercial impression on consumers.

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014). When comparing marks, “[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that [consumers] who encounter the marks

would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018)

Here, each of Applicant’s Marks will need to be compared to each of Opposer’s marks.

The analysis of whether  hudsons for retail store services featuring coffee products is likely to cause confusion with Opposer’s Marks is different from the analysis of whether the

 mark for coffee shops is likely to cause confusion with Opposer’s Marks.

However, by consolidating all marks into one proceeding, there is greater likelihood of prejudice to Applicant in comparing the marks due to not giving enough consideration to the distinctions between each of Applicant’s Marks, particularly as compared to Opposer’s marks. *See Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 726 (TTAB 1981) (consolidation denied as possibly prejudicial to defendant where defendant’s involved marks were not all the same). As the Board acknowledged in *Envirotech*, consolidation involving different marks requiring different legal theories similarities may put the applicant “at a disadvantage.” *Id.* Consolidation would oversimplify the issues and create confusion in the analysis of the factors of likelihood of confusion especially the factors of similarity of the marks and relatedness of the services.

III. CONCLUSION

The opposed applications are for sufficiently dissimilar marks and services, and Opposer’s lack of registration in class 043 and lack of use in relation to cafes / restaurants services, and potential prejudice to Applicant. Accordingly, the Board should deconsolidate and separate the instant proceedings in at the least for the applications Nos. 90817419, 90817256, and 90817306, falling in class 035, from the applications Nos. 90817322, 90817290, and 90817277, falling in class 043.

Dated: May 15, 2023

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing was emailed on this 15 day of May 2023 to counsel identified below:

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