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

Proceeding no.	91285094
Party	Defendant EXP Corp.
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Date	08/01/2023
Attachments	Opp to Motion to Suspend .pdf(145129 bytes)

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

In the matter of Application Serial No. 90462963
Mark: BROOKLYN LAB

JUDA OHANA

Opposer,

Opposition No. 91285094

v.

EXP Corp,

Applicant.

**APPLICANT’S OPPOSITION TO OPPOSER’S MOTION TO SUSPEND PROCEEDING
PENDING CIVIL ACTION**

Applicant, EXP Corp. (“EXP Corp.” or “Applicant”), by its undersigned counsel respectfully submits this opposition to Opposer Juda Ohana’s (“Ohana” or “Opposer”) Motion to Suspend the opposition proceeding pending a civil action in the United States District Court for the Eastern District of New York.

On May 18, 2023, Ohana initiated the subject opposition proceedings against the registration of EXP Corp.’s “Brooklyn Lab” mark for coffee and coffee-related products. Tellingly, Ohana’s Notice of Opposition fails to state the section or sections of the Trademark Act which Opposer is relying on. Moreover, Ohana asserts misguided boilerplate “catch-all” allegations unsupported by law or fact of as putative grounds for opposition.

As analyzed in Exp Corp.’s Motion to Dismiss pursuant to Rule 12(b), filed on July 20, 2023, Ohana lacks standing to bring the instant Notice of Opposition, while his putative grounds are all dismissible as a matter of law.

Ohana's second application to register an infringing "Brooklyn Lab" mark was ostensibly submitted under Trademark Act Section 1(b), as an intent-to-use application. It is well-settled that an intent-to-use application only demonstrates an applicant's intention to use the infringing mark in the future and *fails to establish any rights* in a mark *prior to* the submission of a registration with the United States Patent and Trademark Office. *WarnerVision Entm't Inc. v. Empire of Carolina, Inc.*, 101 F.3d 259, 262 (2d Cir.1996) (finding that because an intent-to-use applicant has the right to engage in use so as to complete registration, a court may enjoin a use from a rival who began use *after* the intent-to-use filing date).

Now, Ohana seeks to suspend the opposition proceedings that *he* initiated by erroneously urging that the civil action *initiated by EXP Corp.* will purportedly dispose of the issues raised in its unfounded Notice of Opposition. Opposer is wrong. There is a distinction between the two actions. EXP Corp's civil action is related to the infringement of the "Brooklyn Lab" mark by Ohana, while the instant proceeding concerns the registration of EXP Corp's "Brooklyn Lab" mark.

It is respectfully submitted that the Trademark Trial and Appeal Board (the "Board") *should not suspend* the instant proceedings before deciding Applicant's Motion to Dismiss. Ohana's misguided Notice of Opposition is rooted in flawed assertions and mere generalities that should not survive EXP Corp's Motion to Dismiss. Accordingly, the Board can and should dispose of this matter by way of deciding Exp. Corp.'s Rule 12(b) motion.

Moreover, Ohana's Answer to the Exp Corp's Federal Complaint is due on September 25, 2023, while EXP Corp has already filed its Motion to Dismiss with the Board. Ohana's instant application to suspend serves nothing more than to unnecessarily protract resolution of his Notice of Opposition, leading to needless delay. Likewise, suspension would likely lead to collateral

consequences including complication and frustration of the proceedings in the Federal Court by Ohana's anticipated perpetuation of his dismissible, baseless and ill-defined grounds of cancellation. The granting of the instant Motion to Suspend will result in wasting significant resources and an unjust increase of litigation costs to EXP Corp., including as relates to preparation of its Motion to Dismiss and the defense of Ohana's Notice of Opposition.

It is respectfully submitted that Ohana's instant Motion is procedurally improper. By way of an Order dated July 26, 2023, the Board decided the suspension of the instant proceedings with respect to all matters not germane to EXP Corp's Motion to Dismiss pending disposition of the motion (Doc #9). Ohana's application is irrelevant to Applicant's Motion to Dismiss, and, thus, it should be denied for procedural reasons as it directly contravenes the Board's prior decision.

CONCLUSION

Based on the foregoing, EXP Corp. respectfully requests that the Board deny Ohana's Motion to Suspend, and grant EXP Corp such other and further relief, favorable to the Applicant, as the Board deems just and proper.

Dated: New York, New York
August 1, 2023

Respectfully submitted,
PARDALIS & NOHAVICKA, LLP
By: /s/ Eleni Melekou
Eleni Melekou, Esq.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Opposition to Motion to Suspend have been served on Opposer's counsel, ROBERTO LEDESMA by forwarding said copy on August 1, 2023, via email to: roberto@ilawco.com.

Signature_/s/ Eleni Melekou____ Date: August 1, 2023