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

Proceeding	92054408
Party	Plaintiff Hublot of America, Inc.
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Date	06/08/2016
Attachments	HBLA-0004 Stipulated Motion.pdf(61108 bytes )

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

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HUBLOT OF AMERICA, INC.,	:
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Petitioner,	:
	:
- against -	:
	:
SOLID 21 INCORPORATED,	:
	:
Registrant.	:
	:
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Cancellation No. 92054408

**STIPULATED MOTION TO SUSPEND PROCEEDINGS  
PENDING RESOLUTION OF THE CIVIL ACTION**

Pursuant to Trademark Rule of Practice 2.117(a), 37 C.F.R. § 2.117(a), Petitioner Hublot of America, Inc. (“**Petitioner**”) and Registrant Solid 21 Incorporated (“**Registrant**”) hereby jointly move for the Trademark Trial and Appeal Board (the “**Board**”) to suspend these proceedings pending termination of a civil action involving the mark at issue herein, RED GOLD.

**BACKGROUND**

The Petition for Cancellation herein seeks cancellation of Registrant’s Registration No. 2793987 for the mark RED GOLD on the basis that the phrase “red gold” is generic and cannot function to indicate source. That same issue—whether Registrant’s RED GOLD mark is generic and therefore invalid—is pending before the United States Court of Appeals for the Ninth Circuit. *Solid 21 Inc. v. Hublot of America, et al.*, No. 15-56036.

Registrant instituted a suit against Petitioner in the United States District Court for the Central District of California on January 14, 2011, alleging, among other things, trademark

infringement of Registrant's purported RED GOLD trademark. *See Solid 21, Inc. v. Hublot of America, et al.*, Case No. 2:11-cv-0468-DMG-JC (C.D. Cal.) (hereinafter, the "**Civil Action**"). In the Civil Action, Petitioner denied the salient allegations of the complaint, asserted affirmative defenses including that the Registrant's purported RED GOLD mark is generic, and filing counterclaims seeking declaratory judgment as to the invalidity of Registrant's RED GOLD trademark and cancellation of Registrant's trademark registration.

On August 11, 2011, the Civil Action was taken off the Court's active calendar after a parallel case held that Solid 21's RED GOLD registration was invalid because the mark is generic. *Solid 21, Inc. v. Breitling USA, Inc.*, No. 11-0457, 2011 WL 2938209 (C.D. Cal. July 19, 2011). On March 19, 2013, the Ninth Circuit reversed the decision, holding that defendant's challenge could not be resolved on a motion to dismiss. *Solid 21, Inc. v. Breitling USA, Inc.*, 512 F. App'x 685, 687 (9th Cir. 2013). The Civil Action thereafter resumed, and on January 6, 2014, Registrant filed an amended complaint, which Petitioner answered on January 8, 2014, again denying the salient allegations of the amended complaint, asserting affirmative defenses including that the Registrant's purported RED GOLD mark is generic, and filing counterclaims seeking declaratory judgment as to the invalidity of Registrant's RED GOLD trademark and cancellation of Registrant's trademark registration.

On January 3, 2014, Petitioner filed a motion in the Civil Action (the "**Summary Judgment Motion**") seeking summary judgment on all of Registrant's claims and Petitioner's counterclaims. On September 29, 2014, the district court denied Petitioner's Summary Judgment Motion (the "**September 29<sup>th</sup> Order**"). On October 29, 2014, Petitioner filed a motion to certify the denial for interlocutory appeal (the "**Motion for Interlocutory Appeal**"), and on November

10, 2014, pursuant to Court Order, filed a Supplemental Memorandum regarding the Motion for Interlocutory Appeal.

On June 12, 2015, the district court granted Petitioner's motion for reconsideration, denied the motion to certify its September 29, 2014 Order for interlocutory appeal as moot, vacated its September 29, 2014 Order, and issued an Amended Order granting Petitioner's Motion for Summary Judgment finding that Registrant's RED GOLD trademark is invalid as generic and therefore not entitled to trademark protection.

Registrant timely filed a notice of appeal on July 2, 2015, and that appeal is now pending in the Ninth Circuit Court of Appeals. *See Solid 21 Inc. vs. Hublot of America, et al.*, No. 15-56036 (9<sup>th</sup> Cir.). Registrant-Appellant filed its opening brief on April 18, 2016. Pursuant to the Ninth Circuit's May 21, 2016 Order, Petitioner-Appellee's answering brief is due on July 18, 2016. Registrant-Appellant's optional reply brief is due fourteen days from the service of the answering brief. Therefore, the appeal remains pending.

### **ARGUMENT**

Pursuant to 37 C.F.R. § 2.117, "[w]henver it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action . . . which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action . . . ." *See also* T.B.M.P. § 510.02(a). The resolution of the pending Civil Action will bear directly on, and may be dispositive of, this Cancellation proceeding. Indeed, the Board routinely grants motions to suspend opposition and cancellation proceedings pending the outcome of a pending civil action on the grounds that such actions may be dispositive of the inter partes proceedings. T.B.M.P. § 510.02(a); *see also The*

*Other Tel. Co. v. Conn. Nat'l Tel. Co. Inc.*, 181 U.S.P.Q. 125, 126 (T.T.A.B. 1974) (suspending opposition proceeding during pendency of district court action where Opposer was seeking to enjoin Applicant from using the mark at issue in the opposition proceeding).


Here, both the Civil Action and the Cancellation relate directly to whether the RED GOLD mark is generic and therefore incapable as functioning as a mark. A decision by the Ninth Circuit Court of Appeals, or by the Central District of California on remand, that the RED GOLD mark is generic will be determinative of the issues raised in the Cancellation. Accordingly, a suspension is appropriate pending a final determination in the Civil Action.

### CONCLUSION

For the reasons set forth above, the parties jointly move the Board to suspend these proceedings until final resolution of the pending Civil Action between the parties.

Dated: Chicago, Illinois  
June 8, 2016

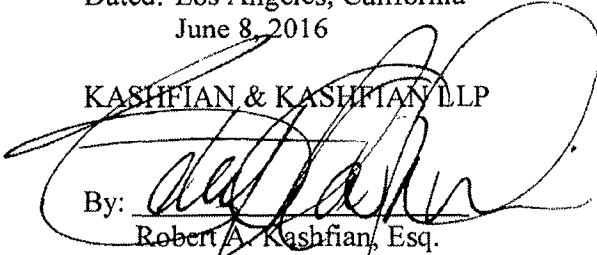
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Dated: Los Angeles, California  
June 8, 2016

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**CERTIFICATE OF SERVICE**

I hereby certify that on this 8th day of June 2016, I caused a true and correct copy of the foregoing **STIPULATED MOTION TO SUSPEND PROCEEDINGS PENDING RESOLUTION OF THE CIVIL ACTION** to be served upon counsel for Registrant at the following address:

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Scott J. Slavick