

ESTTA Tracking number: **ESTTA448991**

Filing date: **12/30/2011**

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

Proceeding	92054675
Party	Defendant Pure Detroit, Inc.
Correspondence Address	JOHN VANOPHEM DOBRUSIN & THENNISCH PC 29 W LAWRENCE STREET, SUITE 210 PONTIAC, MI 48342 UNITED STATES jvanophem@patentco.com, jeff@patentco.com
Submission	Motion to Suspend for Civil Action
Filer's Name	John VanOphem
Filer's e-mail	bwilson@patentco.com
Signature	/John VanOphem/
Date	12/30/2011
Attachments	MOTION.pdf (10 pages)(30846 bytes)

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

Chrysler Group, LLC,)	
a Delaware limited liability company,)	Cancellation No. 92054675
)	
Petitioner)	Reg. No. 3,164,890
)	
v.)	Mark: PURE DETROIT
)	
Pure Detroit, Inc., a Michigan corporation;)	
Moda Group, LLC, a Michigan limited)	
liability company, d/b/a PURE DETROIT)	
real party in interest)	
)	
<u>Registrant</u>)	

**REGISTRANT’S COMBINED MOTION AND BRIEF TO SUSPEND AND
CONSOLIDATE CANCELLATION PROCEEDING**

I. INTRODUCTION

Moda Group, LLC (“Moda Group” or “Registrant”), a Michigan limited liability company, is the real party in interest since it is the assignee of the entire right title and interest from Pure Detroit, Inc., of the US Trademark Registration No. 3,164,890 that is the subject of this Petition to Cancel No. 92054675 (hereinafter “Cancellation” or “Petition”). Accordingly, Moda Group, as the real party in interest, respectfully hereby moves, by and through its undersigned counsel, the Trademark Trial and Appeal Board (“Board”) for an Order suspending this Petition to Cancel in view of a pending, earlier-filed Civil Action in the United States Federal District Court for the Eastern District of Michigan that will necessarily dispose and/or significantly affect the issues raised in this Cancellation proceeding, namely Registrant's entitlement to maintain Registration No. 3,164,890 (“890 Registration”).

II. BACKGROUND

a. GENESIS OF ACTIONS

The Petitioner's filing of the present Cancellation against Applicant's registered PURE DETROIT mark is another overt and aggressive action by Petitioner Chrysler to complicate and broaden the legal proceedings and actions among these Parties. The extension of these actions by Petitioner to the present Cancellation proceeding is unfortunate. Ultimately, all of these actions stem from Petitioner Chrysler's adoption and use of the public domain, geographically descriptive IMPORTED FROM DETROIT phrase in Chrysler's advertising for its Chrysler-brand products (including the Chrysler 200, 300, and Town and Country vehicles, all of which are actually assembled in places other than Detroit).

b. PETITIONER'S US DISTRICT COURT ACTION AGAINST REGISTRANT

On March 15, 2011, Petitioner Chrysler filed Case No. 11-11074, in the United States District Court for the Eastern District of Michigan ("Civil Action"), asserting Petitioner Chrysler allegedly owned certain enforceable Lanham Act rights in the IMPORTED FROM DETROIT phrase and accusing Registrant, Moda Group, LLC, d/b/a PURE DETROIT, *inter alia*, of infringing such Lanham Act rights because of Pure Detroit's use of the IMPORTED FROM DETROIT phrase on its t-shirts and tote bags. For reasons not currently relevant to deciding this Motion, on September 15, 2011, pursuant to the Court's Order, Petitioner filed a Second Amended Complaint in the Civil Action. Consistent with its original Complaint, Petitioner Chrysler's Second Amended Complaint in the Civil Action asserted claims and Lanham Act causes of action relating to the IMPORTED FROM DETROIT phrase virtually identical to the original Complaint (see Exhibit A attached).

In particular, its Second Amended Complaint in the Civil Action, Petitioner Chrysler (as Plaintiff/Counter-Defendant in the Civil Action) brought a total of five (5) Counts against Registrant Pure Detroit relating to the IMPORTED FROM DETROIT phrase **and** Petitioner Chrysler added a Count regarding Registrant Moda Group's use of its PURE DETROIT® mark that is the subject of this Cancellation. Specifically, in Count V of the Second Amended Complaint in the Civil Action, Petitioner Chrysler attempts to invoke certain rights and alleges certain violations of the Lanham Act by Respondent Moda Group and relating to Respondent's uses of its PURE DETROIT® mark that is the subject of the '890 Registration in this Cancellation. In its entirety, Petitioner Chrysler's Count V in the Civil Action states:

COUNT V
Violation of 15 U.S.C. § 1125(a)(1)(B)

53. Chrysler repeats and incorporates by reference the allegations of paragraphs 1-36.

54. Defendants' contention that Chrysler's mark is misdescriptive is without merit, but if it were deemed to have merit, then the contention would apply to Defendants' use of the IMPORTED FROM DETROIT™ and PURE DETROIT® trademarks as to their own goods, some of which are made in places such as China, Thailand, and India.

55. If Defendants' misdescriptiveness contention were deemed to have merit, then Defendants' use of the IMPORTED FROM DETROIT™ and PURE DETROIT® trademarks in connection with goods made in places such as China, Thailand, and India would constitute a misrepresentation of the nature, characteristics, qualities, or geographic origin of such goods in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125 (a)(1)(B), and would be likely to cause substantial injury to the public and to Chrysler, entitling Chrysler to injunctive relief and to recover its damages, costs, and reasonable attorneys' fees.

See Exhibit A attached, Second Amended Complaint at page 17.

To the extent that Claim V of Petitioner Chrysler's Count V of its Second Amended Complaint in the Civil Action can be properly understood, they have a very substantial overlap

and rely upon claims that are a nearly identical attack upon the Registrant's use of its Registered PURE DETROIT[®] mark that Petitioner Chrysler pleads as the subject of this Cancellation proceeding. See Counts I through III of the Petitioner's Petition to Cancel filed in this Cancellation Proceeding.

c. **OTHER TTAB PROCEEDINGS INVOLVING THE SAME PARTIES**

In addition to the Civil Action and this Cancellation Proceeding, there are already three (3) separate *inter partes* Opposition proceedings between these same parties for substantially similar and overlapping subject matter regarding the registerability of the geographically descriptive phrase IMPORTED FROM DETROIT in various international classes and in conjunction with various goods and services. In particular, US Trademark Opposition Nos. 91200995, 91201015, and 91201052 (the Petitions of which are attached here as Exhibits C, D and E, respectively) (hereinafter "Oppositions"). The Oppositions seek to prevent registration by Petitioner of US Trademark Registrations for the use of the primarily geographically descriptive phrase IMPORTED FROM DETROIT. In particular, the Oppositions assert, in part, that because the phrase IMPORTED FROM DETROIT is a merely geographically descriptive term, because of its use of the City of DETROIT name for the listed goods and services, registration of such phrase is not permissible under the statute. In particular, in filing such Oppositions, Moda Group relied upon the Opinion and Order of the Court in the Civil Action, a copy of which is attached hereto at Exhibit F.

III. ARGUMENT FOR SUSPENSION

The Trademark Trial and Appeal Board ("Board") has the power to suspend proceedings in favor of a pending civil action 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 party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

37 C.F.R. § 2.117(a). Suspension is appropriate where, as here, the "other proceeding" in which the parties are engaged is a Civil Action. See [*New Orleans Louisiana Saints LLC and NFL Properties LLC v. Who Dat?, Inc.*](#), 99 USPQ2d 1550 (TTAB 2011) [precedential] (citing *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805, 805 (TTAB 1971)). Similarly, the TBMP 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." See TBMP § 510.02(a) (3d ed. 2011). The Board routinely exercises this power "in the interest of judicial economy and consistent with [its] inherent authority to regulate its own proceedings to avoid duplicating the effort of the court and the possibility of reaching an inconsistent conclusion." *Soc'y of Mex. Am. Eng'rs & Scientists, Inc. v. GVR Pub. Relations Agency, Inc.*, opp. No. 91121723, 2002 WL 31488947, at *4 (T.T.A.B. Nov. 6, 2002).

Registrant Moda Group d/b/a PURE DETROIT submits that this Cancellation proceeding (whether consolidated or not) should also be suspended pending the final determination of the Civil Action pending before the U.S. District Court for the Eastern District of Michigan. As set forth herein (and as shown at Exhibit B, attached hereto), Count V of Petitioner's Second Amended Complaint of the Civil Action clearly involves factual and legal issues nearly identical to the Counts set forth in the Petitioner's Petition to Cancel before the Board. It is the Board's stated policy and precedent that any pending action before the Board be suspended when there is a Civil Action that may have a bearing upon the pending Board cases. See Trademark Rule

2.117(a) and TBMP 510. A decision by the District Court may be binding on the Board whereas a determination by the Board as to a defendant's right to obtain or retain a registration would not be binding or *res judicata* in respect to the proceeding pending before the District Court. *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805, 807 (TTAB 1971). Thus, it is well established in the Board's precedent that the 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. Trademark Rule 2.117(a). As noted above, the Parties to this Cancellation proceeding (as well as the Opposition proceedings), are the same, albeit generally in reversed positions, as in the Civil Action. Petitioner's Second Amended Complaint in the Civil Action alleges, among other claims, that Registrant Moda Group has misused its PURE DETROIT® mark and that it is geographically descriptive in violation of the Lanham Act's requirements and that Registrant has apparently committed other Lanham Act violations for which it should be enjoined. Petitioner's claims in the Civil Action are strongly related, factually and legally, to its claims in this Cancellation proceeding.

Most notably, any decision of the Eastern District of Michigan Court will likely subsume the issues in this Cancellation and be binding upon the Board, while the decision of the Board will not be binding upon the Eastern District of Michigan Court. See *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir. 1988). Since the decision by the District Court in the Civil Action, whether to enjoin Registrant's use of the PURE DETROIT mark, would have a direct bearing on this Cancellation proceeding, this proceeding should be suspended pending final disposition of the Civil Action between the Parties.

IV. ARGUMENT FOR CONSOLIDATION

Pursuant to Fed. R. Civ. P. 42(a) and TBMP 511, Registrant hereby moves the Board to consider consolidating the subject Cancellation Proceeding with the pending and active Oppositions into a single, *inter partes* Proceeding. Under Fed. R. Civ. P. 42(a) and TBMP 511, the Board may consolidate matters when they involve common questions of law or fact. “In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense, which may be gained from consolidation, against any prejudice or inconvenience that may be caused thereby.” TBMP 511.

There clearly are common questions of fact and law at issue in the Civil Action, the three (3) Oppositions and the present Cancellation. Namely, all of the *inter partes* proceedings involve Section 2(a) and Section 2(e) analysis of the use of the city of DETROIT name as part of a mark (for Petitioner Chrysler as used in the IMPORTED FROM DETROIT mark that is the subject of the applications in the Oppositions and as used by Respondent Moda Group in the PURE DETROIT mark that is the subject of this Cancellation). The parties to all proceedings are identical. All proceedings involve the same or similar business, goods and/or services of the Parties and the underlying factual details and allegations. If the Board were to continue with its reviewing of the Oppositions and the Cancellation proceeding separately, the Board would necessarily be considering the same and/or similar factual and legal arguments as applied to the putative mark(s) (i.e. IMPORTED FROM DETROIT and PURE DETROIT) as those that are clearly and simply set forth in the Counts of the Civil Action pending in a U.S. Federal District Court. As such, there will also necessarily be a significant overlap of many, if not all, discovery issues relating to such claims in all such proceedings. For at least these reasons, consolidation of

the *inter partes* Oppositions and this Cancellation proceeding would clearly and simply conserve the limited resources of the Board as well as the parties.

Registrant further argues that such consolidation will result in no prejudice or inconvenience to the Parties. The Parties are identical, so they would be litigating each matter regardless of whether they are kept separate or they are consolidated. In fact, the Parties have already agreed to stipulate to the use of discovery in the Civil Action in the TTAB Proceedings and vice versa. Thus, if all TTAB Proceedings are consolidated, the Parties would save resources by filing pleadings in only one matter. As stated in TBMP 511, the Board will still consider each matter separately, so the merits of each Opposition and the Cancellation proceeding will be fully heard and decided by the Board. See TBMP 511 (“Consolidated cases do not lose their separate identity because of consolidation.”).

It is well established that the Board will grant a motion for consolidation when separate *inter partes* proceedings involve "identical parties and similar marks and issues." *Dating DNA, LLC v. Imagini Holdings, Ltd.*, 94 USPQ2d 1889 (TTAB 2010) [precedential]. Here, the proceedings involve marks each including a key geographic term (i.e., “Detroit”) as a significant component of the mark and as a key issue of the proceedings for overlapping goods and services and the identical Parties are involved. Consolidation of the Oppositions and this Cancellation proceeding will merely serve to assist in the organizing, scheduling, and filings in the various matters while conserving the limited resources of the Board and the Parties, particularly those of Moda Group who is relatively a very tiny entity with very limited resources as compared to Petitioner Chrysler who is a giant, multinational corporation with relatively vast resources.

It is respectfully submitted that the Petitioner (as Plaintiff/Counter-Defendant) already

picked its chosen forum to assert its putative rights by filing the Civil Action before a U.S. Federal District Court. Further, it is submitted that a consolidated and suspended *inter partes* proceedings would also preserve the Board's resources, avoid duplication of effort, and reduce the expenses to the Parties given the overlap of facts and law at issue in all of the proceedings all while avoiding the potential for inconsistent results from different tribunals.

V. CONCLUSION

Registrant Moda Group d/b/a PURE DETROIT respectfully submits that this Motion embodies a "brief" within the meaning of 37 C.F.R. 2.127(a). For the foregoing reasons, Registrant respectfully submits that this Cancellation be suspended and/ or consolidated with the Oppositions pending disposition of the Civil Action.

Dated: December 30, 2011

BY: DOBRUSIN & THENNISCH PC

s/John VanOphem/

John VanOphem (Mich. Bar P48804)

jvanophem@patentco.com

Jeffrey P. Thennisch (Mich. Bar P51499)

jeff@patentco.com

29 W. Lawrence Street, Suite 210

Pontiac, Michigan 48342

(248) 292-2920

*Attorneys for Moda Group, LLC d/b/a PURE
DETROIT, Registrant*

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

Chrysler Group, LLC,)	
a Delaware limited liability company,)	Cancellation No. 92054675
)	
Petitioner)	Reg. No. 3,164,890
)	
v.)	Mark: PURE DETROIT
)	
Pure Detroit, Inc., a Michigan corporation;)	
Moda Group, LLC, a Michigan limited)	
liability company, d/b/a PURE DETROIT)	
real party in interest)	
)	
<u>Registrant</u>)	

CERTIFICATE OF SERVICE

I, hereby certify that a true copy of the foregoing REGISTRANT’S COMBINED
MOTION AND BRIEF TO CONSOLIDATE AND SUSPEND CANCELLATION
PROCEEDING was served on counsel for Petitioners on December 30, 2011, via First Class US
Mail to:

JUDITH A POWELL
KILPATRICK TOWNSEND & STOCKTON LLP
1100 PEACHTREE STREET NE , SUITE 2800
ATLANTA, GA 30309

s/John VanOphem/
John VanOphem
Attorney for Moda Group, LLC, Registrant