

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
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Mailed: March 26, 2014

Cancellation Nos. 92057460
(Parent)
Cancellation No. 92057479
Cancellation No. 92057493
Cancellation No. 92057541

Hawaiian Airlines, Inc.

v.

Yucaipa Corporate Initiatives
Fund I, L.P.¹

Elizabeth A. Dunn, Attorney (571-272-4267):

This case comes up on respondent's motion to suspend this consolidated cancellation pending final disposition of the civil action between the parties. The motion has been fully briefed.

¹ Upon review, the Board improperly instituted parent Cancellation No. 92057460 against the former, and not the current, owner of Registration Nos. 2303334. As recorded with the USPTO Assignment Branch at Reel 4469, Frame 0453, on February 7, 2011, the Chapter 7 trustee for Aloha Airlines Inc. assigned the registration to Yucaipa Corporate Initiatives Fund I, L.P. The other consolidated cancellations were instituted listing the current owner of the subject registrations. The Board hereby corrects its error in the case caption.

In this consolidated proceeding petitioner seeks cancellation of respondent's ALOHA AIRLINES marks on the grounds that the marks have been abandoned.

On December 9, 2013, respondent Yucaipa Corporate Initiatives Fund I, L.P. filed a complaint against Hawaiian Airlines, Inc. in the United States District Court for the Central District of California (CV13-09060 MRW) alleging, among other things, that it acquired the ALOHA AIRLINES marks in bankruptcy and seeking, among other things, a declaratory judgment that the marks have not been abandoned and the registrations remain valid. On December 11, 2013, respondent moved to suspend the consolidated cancellation on the ground that the civil action will be dispositive of this proceeding.

Petitioner opposes suspension on the grounds that the civil action omits an owner of the mark and should be dismissed, and because the Board is better suited to decide the issue of registrability. As to the latter point, 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 court. *New Orleans Louisiana Saints LLC and NFL Properties LLC v. Who Dat?, Inc.*, 99 USPQ2d 1550,

1552 (TTAB 2011). While a court may decide that it wishes the benefit of the Board's decision, that is for the court, and not the Board to decide. If petitioner is successful in obtaining a district court stay for the purpose of this proceeding going forward, the Board will resume proceedings. Absent such a court order, the Board will stay its own proceeding in deference to the court.

With respect to the ownership issue, petitioner argues that the asset purchase agreement approved by the bankruptcy court and the assignment filed with the Board show that the ALOHA AIRLINES registrations were conveyed to both respondent Yucaipa Corporate Initiatives Fund I, L.P. and the separate legal entity Yucaipa Corporate Initiatives Fund I, L.L.C. As a result, petitioner argues, the district court action is not brought against the proper party, and thus the district court action will not bear on the rights of one of the parties to this proceeding. Because it is for the court, and not the Board, to decide who is a proper party to the court proceeding, petitioner has presented no argument for denying the motion to suspend. Accordingly, respondent's motion to suspend proceedings pending the final disposition of the civil action between the parties is GRANTED.

Moreover, petitioner errs in its contention that there are two owners of each of the subject registrations. It is incumbent upon the new owner of a registration to update ownership information at USPTO. See U.S. Patent and Trademark Office (USPTO) Rule 3.71(d) ("the assignee of a trademark application or registration may prosecute a trademark application, submit documents to maintain a trademark registration, or file papers against a third party in reliance on the assignee's trademark application or registration, to the exclusion of the original applicant or previous assignee. The assignee must establish ownership in compliance with § 3.73(b).").² All documents submitted for recording must be accompanied by a cover sheet that meets the requirements of USPTO Rule §3.31. Trademark Manual of Examining Procedure 503.03(a) (8th ed., rev. 2013) ("TMEP").

The USPTO Assignment Branch enters only the data specified on the assignment cover sheet in the Assignment database. TMEP 503.05. Respondent listed itself as the sole owner on the assignment cover sheet, and thus is the owner of record, and sole respondent in this proceeding. See Trademark Rule 2.113(c) ("The respondent shall be the party

² The Board's decision is binding upon the assignee, whether or not they are party to the proceeding involving the registration. *Burr Publishing Co. v. E. W. Communications, Inc.*, 216 USPQ 802, 802 n. 1 (TTAB 1982).

shown by the records of the Office to be the current owner of the registration(s) sought to be cancelled, except that the Board, in its discretion, may join or substitute as respondent a party who makes a showing of a current ownership interest in such registration(s)."). If respondent erred in its recordal, respondent must file a corrective assignment.³ TMEP 505.02.

Within twenty days after the final determination of the civil action, the parties shall so notify the Board and call this case up for any appropriate action. During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.

³ The Board notes that respondent's August 7, 2013 stipulation to consolidate this proceeding states that the registrations are owned by both respondent Yucaipa Corporate Initiatives Fund I, L.P. and Yucaipa Corporate Initiatives Fund I, L.L.C.