

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500  
General Email: [TTABInfo@uspto.gov](mailto:TTABInfo@uspto.gov)

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February 8, 2019

**Opposition No. 91241668 (Parent Case)**

Opposition No. 91241670

Opposition No. 91241680

Opposition No. 91241810

Opposition No. 91241924

Opposition No. 91242450

Opposition No. 91242451

Opposition No. 91242452

*Omaha Steaks International, Inc.*

*v.*

*Greater Omaha Packing Co., Inc.*

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Cancellation No. 92069413

Cancellation No. 92069427

Cancellation No. 92069434

*Greater Omaha Packing Co., Inc.*

*v.*

*Omaha Steaks International, Inc.*

**By the Board:**

**Motions to Dismiss Cancellation Nos. 92069413, 92069427 and 92069434**

Three of the captioned proceedings - Cancellation Nos. 92069413, 92069427 and 92069434 - are before the Board for consideration of the motions to dismiss filed by

Respondent therein, Omaha Steaks International, Inc. (Omaha Steaks) on October 7, 2018. The motions are fully briefed.<sup>1</sup>

### **Background and Summary of Cancellation Proceedings**

On August 23, 2018, Petitioner Greater Omaha Packing Company (Greater Omaha) filed three petitions to cancel various registrations that are owned by Respondent Omaha Steaks and are pleaded in various opposition proceedings, as follows:

- 1) Cancellation No. 92069413, seeking to cancel Registration Nos. 3857500, 4172329, 4172330, 4325113, 5045810 and 5055023 (which Omaha Steaks pleads in Opposition Nos. 91242450, 91242451, 91242452, 91241668, 91241670, 91241680, 91241810);
- 2) Cancellation No. 92069427, seeking to cancel Registration Nos. 3768689, 3768690, 3768691, 3768693, 3774260 and 3799411 (which Omaha Steaks pleads in Opposition Nos. 91242450, 91242451, 91242452, 91241924, 91241668, 91241670, 91241680, 91241810), and to cancel Registration No. 3857498 (which Omaha Steaks pleads in Opposition Nos. 91242450, 91242451, 91242452, 91241668, 91241670, 91241680 and 91241810); and
- 3) Cancellation No. 92069434, seeking to cancel Registration Nos. 1458802, 1515602, 1555215, 1674686, 2002499, 2414603, 2840193, 2893159 and 3758608 (which Omaha Steaks pleads in Opposition Nos. 91242450, 91242451, 91242452, 91241924, 91241668, 91241670, 91241680 and 91241810).

Greater Omaha seeks to restrict or rectify the registrations by amending the goods and services specified in Omaha Steaks' involved registrations. It alleges that Omaha Steaks is not using the registered mark for the goods and services sought to be excluded by the proposed limitation and that the limitation will avoid a likelihood of

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<sup>1</sup> The Board has considered the parties' briefs on the contested motions, but does not repeat or discuss all of the arguments, and does not address irrelevant arguments. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

confusion, and alleges that Omaha Steaks has abandoned use of its registered marks for the goods and services sought to be excluded by the proposed limitation. In completing the ESTTA filing cover sheet for each of the three petitions to cancel, Greater Omaha listed the 8 related (now consolidated herein) earlier-filed opposition proceedings under the “Related Proceedings” query field.

On August 24, 2018, Greater Omaha filed an answer in each of the notices of opposition, therein denying the salient allegations. It included in each answer a specific notification that it had earlier filed a petition to cancel the registrations on which Omaha Steaks relies in the respective opposition.

In each cancellation proceeding, in lieu of filing an answer to the petition to cancel, Omaha Steaks filed a nearly identical motion to dismiss the petition on the basis that 1) Omaha Steaks asserted each of the involved registrations against Greater Omaha in the oppositions, thereby making the petitions compulsory counterclaims that pursuant to Trademark Rule 2.106(b)(3)(i) must be filed in those oppositions, and 2) the claims are time-barred pursuant to Trademark Act Section 14(1).

Regarding the first basis for seeking dismissal,<sup>2</sup> Trademark Rules 2.106(b)(3)(i) and (ii) state *in their entirety* (emphasis added):

- (i) A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory

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<sup>2</sup> Omaha Steaks cites *Southern Construction No., Inc., et al. v. Pickard*, 371 U.S. 57 (1962), in support of the purported need to prevent a multiplicity of actions and resolve in a single suit all disputes arising out of common matters (e.g., 92069427: 4 TTABVUE 4). However, with respect to Board proceedings such concerns are not as great as they were in earlier decades when Board files were maintained, accessed and organized only manually, thereby creating difficulty in identifying and consolidating related proceedings and claims.

counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. *A counterclaim need not be filed if the claim is the subject of another proceeding between the same parties or anyone in privity therewith; but the applicant must promptly inform the Board, in the context of the opposition proceeding, of the filing of the other proceeding.*

(ii) An attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim *or separate petition* is filed to seek the cancellation of such registration.

TBMP §§ 311.02 and 313.01 (June 2018). In filing the three separate petitions to cancel, Greater Omaha did not violate the rules or the spirit and intent of the rules. Although the Board has provided guidance that the better practice is to raise an attack on the validity of a plaintiff's pleaded registration as a counterclaim, under the circumstances here the failure to do so was not contrary to the rules and is not a basis for dismissal of the separate petitions to cancel. TBMP § 313.01. The petitions are not untimely inasmuch as Greater Omaha did not delay in asserting its allegations. More to the point, inasmuch as Greater Omaha had not yet filed its answers to the notices of opposition, setting forth its claims as counterclaims in the oppositions was not the sole option available to it.

Regarding the second basis for seeking dismissal, Omaha Steaks is mistaken that the claims for cancellation are time-barred under Trademark Act Section 14(1). A claim or counterclaim to partially cancel a registration by deleting some of the goods or services therein, or by restricting the manner of use of the goods or services therein, or to restrict or rectify the register as to the registration in order to avoid a likelihood

of confusion, is in the nature of an equitable remedy and does not constitute an attack on the validity of a registration or have to be tied to a properly pleaded ground for opposition or cancellation. TBMP §§ 309.03(d) and 313.01. Under Trademark Act Section 18, a petitioner may seek to partially cancel a registration over 5 years old by restricting the goods or services therein in order to avoid a likelihood of confusion. TBMP §§ 307.02(a) and 309.03(d). Moreover, a counterclaim to delete goods or services from a registration on the ground that the registrant does not use the mark on those goods or services and has no intent to resume use, without regard to likelihood of confusion, is a straightforward abandonment claim. TBMP § 313.01, and cases cited therein. Abandonment claims are allowed, that is, they are not time-barred, by operation of Trademark Act Section 14(3), and may be filed at any time after registration. TBMP § 307.01. Accordingly, the petitions to cancel were properly filed and the Board will entertain them.

In view of these findings, Omaha Steak's motions to dismiss are **denied**. In this order below, the Board resets Omaha Steaks' time to file an answer to the petitions to cancel.

### **Consolidation**

On September 7, 2018, the Board consolidated Opposition Nos. 91241668, 91241670, 91241680, 91241810 and 91241924. Opposition Nos. 91242450, 91242451 and 91242452 also involve the same parties, and involve common questions of law and fact. Cancellation Nos. 92069413, 92069427 and 92069434, wherein the parties

are in reversed positions, also involve the same parties, and involve common questions of law and fact.

The Board has determined that consolidation of all eleven proceedings is appropriate. Accordingly, the captioned proceedings are hereby consolidated and may be presented on the same record and briefs. *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1424 n.1 (TTAB 1993); and *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1619 n.1 (TTAB 1989).

The Board file will continue to be maintained in **Opposition No. 91241668 as the “Parent Case.”** Only a single copy of all motions and submissions pertaining to any of these consolidated proceedings should be filed, and each submission should be filed in the parent case only, and caption all of the consolidated proceeding numbers, listing and identifying the “Parent Case” first as in the caption above. The exception to this practice is the forthcoming submission of an answer to the petitions to cancel in Cancellation Nos. 92069413, 92069427 and 92069434. Omaha Steaks is directed to file said answers in the respective cancellation proceedings to which each pertains.

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

When referring to the record, the parties should reference parent case Opposition No. 91241668 (e.g., 91241668: 10 TTABVUE 5) where practicable, and should identify any reference to one or more of the other consolidated proceedings by that proceeding

number, as appropriate (e.g., 91241670: 10 TTABVUE 5). Thus, all references to the record, including exhibits and evidence, should be by citation to the Board's TTABVUE docket electronic database, by the entry and page number, e.g., 5 TTABVUE 20, to allow the reader to easily locate the cited material. *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). *Cf.* TBMP §§ 801.01-03.

To maintain an orderly and clear record, the parties should refer to each involved application and registration by its assigned serial number or registration number, refer to each *inter partes* proceedings by its assigned opposition or cancellation number, and refer to the respective parties as adopted in this order, namely, Greater Omaha and Omaha Steaks.

Finally, although attachments to ESTTA filings may be in PDF, TIFF or TXT format, for TTABVUE system and reading purposes PDF is preferred and should be used, where practicable. TBMP § 110.02(b).

**Motions to Amend Applications Involved in Opposition Nos. 91242450, 91242451 and 91242452**

In Opposition No. 91242450, the Board issued an order on January 7, 2019, deferring consideration of Greater Omaha's November 28, 2018 unconsented motion to amend involved Application Serial No. 87794233 until final decision or summary judgment. 91242450: 6 TTABVUE 2. That order stands.

Similarly, on November 28, 2018 in Opposition Nos. 91242451 and 91242452, Greater Omaha filed an unconsented motion to amend involved application Serial Nos. 87794274 and 87794383, respectively. As explained in Opposition No. 91242450, the Board generally will defer determination of a timely filed, pretrial unconsented

Opposition No. 91241668 (Parent Case)

motion to amend an application in substance until final decision or until the case is decided upon summary judgment. TBMP § 514.03. *Enbridge Inc. v. Excelerate Energy L.P.*, 92 USPQ2d 1537, 1539 n.3 (TTAB 2009); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552, 1554 (TTAB 1987). In Opposition Nos. 91242451 and 91242452, Omaha Steaks has not consented to the proposed amendment and Greater Omaha has not consented to judgment with respect to the broader identification of goods. *Wisconsin Cheese Group, LLC v. Comercializadora de Lacteos y Derivados S.A. de C.V.*, 118 USPQ2d 1262, 1266-67 (TTAB 2016) (contested motion to amend granted where applicant consented to judgment on the grounds for opposition with respect to the broader identifications of goods); *Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077, 1080 (TTAB 2013) (same); *Drive Trademark Holdings LLC v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB2007) (same).

Accordingly, in Opposition Nos. 91242451 and 91242452, determination of the motions to amend the identifications is **deferred** until final decision or until the proceedings are decided on summary judgment.

#### **Consented Motions to Extend Opposition Nos. 91242451 and 91242452**

In view of the resetting of dates for the consolidated proceedings, the consented motions to extend filed by Greater Omaha on January 9, 2019 in Opposition Nos. 91242451 and 91242452, are **moot**.

#### **Schedule**

Proceedings are resumed in the cancellation proceedings. Omaha Steaks is allowed until **thirty days from the date of this order** to file its answers in



Opposition No. 91241668 (Parent Case)

Cancellation Nos. 92069413, 92069427 and 92069434. TBMP § 313.01.

Notwithstanding consolidation, Omaha Steaks is directed to separately file each answer in the respective proceeding. After this, both parties are to adhere to the directive to file only a single submission in the parent opposition, as set forth above.

The parties are allowed until **sixty days from the date of this order** to hold their discovery conference, and to serve initial disclosures, in Cancellation Nos. 92069413, 92069427 and 92069434.<sup>3</sup>

Discovery and trial are reset as indicated below. In the schedule, “original claim” encompasses the oppositions, and “counterclaim” encompasses the cancellations.

Expert Disclosures Due	8/10/2019
Discovery Closes	9/9/2019
Pretrial Disclosures Due for Party in Position of Plaintiff in Original Claim	10/24/2019
30-day Trial Period Ends for Party in Position of Plaintiff in Original Claim	12/8/2019
Pretrial Disclosures Due for Party in Position of Defendant in Original Claim and in Position of Plaintiff in Counterclaim	12/23/2019
30-day Trial Period Ends for Party in Position of Defendant in Original Claim, and in Position of Plaintiff in Counterclaim	2/6/2020
Pretrial Disclosures Due for Rebuttal of Party in Position of Plaintiff in Original Claim and in Position of Defendant in Counterclaim	2/21/2020
30-day Trial Period Ends for Rebuttal of Party in Position of Plaintiff in Original Claim, and in Position of Defendant in Counterclaim	4/6/2020
Pretrial Disclosures Due for Rebuttal of Party in Position of Plaintiff in Counterclaim	4/21/2020

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<sup>3</sup> The schedule set forth herein accounts for the fact that several of the opposition proceedings are already underway, and the deadlines are set forth so as to avoid delay in all consolidated proceedings. In the event that the parties desire an extension of discovery or trial, they may file a motion requesting this.

15-day Trial Period Ends for Rebuttal of Party in Position of Plaintiff in Counterclaim	5/21/2020
Opening Brief for Party in Position of Plaintiff in Original Claim Due	7/20/2020
Combined Brief for Party in Position of Defendant in Original Claim and Opening Brief as Plaintiff in Counterclaim Due	8/19/2020
Combined Rebuttal Brief for Party in Position of Plaintiff in Original Claim and Brief as Defendant in Counterclaim Due	9/18/2020
Rebuttal Brief for Party in Position of Plaintiff in Counterclaim Due	10/3/2020
Request for Oral Hearing (optional) Due	10/13/2020

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).