

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

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November 8, 2021

Opposition No. 91256015 (parent)

Cancellation Nos. 92070074
92071897
92071907
92071953
92075170

Mast-Jaegermeister US, Inc.

v.

Alfwear Inc.

Wendy Boldt Cohen, Interlocutory Attorney:

This matter comes before the Board to consider Petitioner's motion to suspend proceedings, filed in Cancellation No. 92075170,¹ pending final determination of Civil

¹ Citations to the TTABVUE record will be from Cancellation No. 92075170 unless otherwise specified.

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Action No. 7:20-CV-00591-VB filed in the U.S. District Court for the Southern District of New York (“New York action”).² 13 TTABVUE. The motion is fully briefed.³

Consolidation

As an initial matter, when proceedings involving common questions of law or fact are pending before the Board, the Board may order consolidation upon its own initiative. Fed. R. Civ. P. 42(a); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 511 (2021). Consolidation is discretionary with the Board. *See, e.g., Wis. Cheese Group, LLC v. Comercializadora de Lácteos y Derivados, S.A. de C.V.*, 118 USPQ2d 1262, 1264 (TTAB 2016). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense that may be gained from consolidation against any prejudice or inconvenience that may be caused thereby. *See id.; World Hockey Ass’n v. Tudor Metal Prods. Corp.*, 185 USPQ 246, 248 (TTAB 1975); TBMP § 511.

Cancellation Nos. 92071897, 92071907 and 92071953 were previously consolidated in an order in Cancellation No. 92070074 at 16 TTABVUE. It has come to the Board’s attention that the parties are also involved in Opposition No. 91256015 and Cancellation No. 92075170. A review of Opposition No. 91256015 and

² It is noted that the New York action is currently stayed pending an appeal before the U.S. Court of Appeals for the Tenth Circuit of a civil action filed in the U.S. District Court for the District of Utah (“Utah action”) that granted Petitioner’s motion for summary judgment based upon a finding that Respondent did not “produce[] sufficient evidence for a reasonable juror to find the required elements of federal trademark infringement, dilution, or federal or common law unfair competition.” 13 TTABVUE 3; 14 TTABVUE 3, 28.

³ The Board has considered the parties’ submissions and presumes the parties’ familiarity with the factual bases for the motion, and does not recount the facts or arguments here, except as necessary to explain the Board’s order. *See Guess? IP Holder L.P. v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

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Cancellation Nos. 92070074, 92071897, 92071907, 92071953, and 92075170 reveals that consolidation is appropriate here. Specifically, the parties to these proceedings are identical as is the nature of the claims in part. The involved application and registrations also concern the same or similar marks. Accordingly, Opposition No. 91256015 and Cancellation Nos. 92070074, 92071897, 92071907, 92071953, and 92075170 are hereby consolidated and may be presented on the same record and briefs. *See, e.g., Wis. Cheese Grp.*, 118 USPQ2d at 1264 (citing *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1619 n.1 (TTAB 1989)).

The Board file will now be maintained in Opposition No. 91266264 re-designated as the “parent.”⁴ From this point on, the parties are directed to file only a single copy of all motions and submissions in the parent case only, and caption all consolidated proceeding numbers, listing and identifying the “parent” first (as in the caption to this order).

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.

⁴ The prior parent was Cancellation No. 92070074. In view of the consolidation with the pending opposition, the Board now re-designates the parent proceeding.

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Motion to Suspend

Turning to Petitioner's motion to suspend, the Board's policy is to suspend proceedings when the parties are involved in a civil action that may bear on Board proceedings. *New Orleans La. Saints LLC v. Who Dat?, Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) ("Thus, 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."); TBMP § 510.02(a).

Trademark Rule 2.117(a) 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.

Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board. TBMP § 510.02(a).

A civil action may involve other matters outside the Board's jurisdiction and may consider issues beyond the right to registration, and, therefore, judicial economy is usually served by suspension. *See Goya Foods, Inc. v. Tropicana Prods., Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988) (doctrine of primary jurisdiction might be applicable if a district court action involved only the issue of registrability, but would not be applicable where court action concerns infringement where the interest in prompt adjudication far outweighs the value of having the views of the USPTO).

Petitioner requests that the Board suspend proceedings pending disposition of the New York action, wherein Petitioner seeks, among other things, declaratory

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judgment declaring Respondent's Registration Nos. 4441177, 4576371, 4576447, 4580723, 1990375, 3916866, 5931177, 5931048, 5466394, and 4818036 invalid. 13 TTABVUE 16, ¶ 50. Petitioner argues that the New York action may be dispositive of these consolidated proceedings. *Id.* at 3. Respondent, however, maintains that in the New York action Petitioner "does not challenge" Registration No. 3011867 nor do any of the challenged registrations in the New York action identify "wine," the goods identified in Registration No. 3011867. 14 TTABVUE 3, 6. Petitioner replies that "once the New York proceeding is removed from suspension, [it] will likely amend its complaint to include a request for cancellation of the Registration that is the subject of this proceeding." 16 TTABVUE 2.

Here, although there is not complete overlap between the application and registrations at issue in these consolidated proceedings and those in the New York action, such as the identified goods, the civil action and these consolidated proceedings nonetheless involve the same parties and KÜHL marks. The New York action and these consolidated proceedings also involve similar issues, such as abandonment and deceptiveness. 13 TTABVUE 6, ¶ 2 ("Fifth, under Trademark Act Section 14(3), Defendants have abandoned their "KÜHL" marks. Sixth, under Trademark Act Section 14(3) and 2(a), the "KÜHL" marks are deceptive). The Board further notes, as asserted by Petitioner, that the New York action is currently suspended pending the Utah action; and that the Utah action is the basis for suspending Opposition No. 91256015. 13 TTABVUE 3; *see* Opposition No. 91256015, 9 TTABVUE; Cancellation No. 92070074, 22 TTABVUE.

Based on the foregoing, the Board is persuaded that the New York action may have a bearing on these consolidated proceeding such that resuming proceedings prior to resolution of the action would be inefficient and pose a risk of inconsistent judgments.

Decision

In view thereof and the Board's policy to suspend proceedings if the final determination of another proceeding may have a bearing on the issues before the Board, Petitioner's motion to suspend is **granted**, Likewise, Respondent's alternate request, that proceedings by suspended pending the Utah action is also **granted**.⁵ See 14 TTABVUE 7. Proceedings are **suspended** pending final disposition of the New York and Utah actions.⁶

Within **twenty (20) days after the final determination**, the parties shall so notify the Board such that this proceeding may be called up for appropriate action. Such notification to the Board should include a copy of any final order or judgment that issued in the civil action. A certified copy is not necessary; a clear and legible photocopy will suffice. TBMP § 106.03.

A proceeding is considered to have been finally determined when an order or ruling that ends litigation has been rendered, and no appeal has been filed, or all

⁵ Petitioner also seeks, in the alternative, that proceedings be suspended pending the appeal in the Utah court action. 16 TTABVUE 3.

⁶ As such, Petitioner's request "that the time within which [] discovery requests [] be served should be extended until at least thirty (30) days after" this order and "that all other dates be extended accordingly" is **moot**. 13 TTABVUE 2. Dates may be reset if and when proceedings resume.

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appeals filed have been decided and the time for any further review has expired.

TBMP § 510.02(b).

The parties are to promptly inform the Board of any other related cases, even if they become aware of such cases during the suspension period. Upon resumption, if appropriate, the Board may consolidate related Board cases.

It is the responsibility of a party to a proceeding before the Board to ensure that the Board has the party's current correspondence address, including an email address. TBMP § 117.07. The Board must be promptly notified of any address or email address changes for the parties or their attorneys during the suspension period.