

UNITED STATES PATENT AND TRADEMARK OFFICE  
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LTS

October 21, 2020

Opposition No. 91264565 (Parent)

*Entrepreneur Media, Inc.*

*v.*

*Rubinstein & Associates, PLLC*

Cancellation No. 92075025

*Rubinstein & Associates, PLLC*

*v.*

*Entrepreneur Media, Inc.*

**Lawrence T. Stanley, Jr., Interlocutory Attorney:**

This case comes up on: (1) Applicant/Petitioner Rubinstein & Associates, PLLC (“Rubinstein”) motion, filed September 2, 2020 in Cancellation No. 92075025, to consolidate Opposition No. 91254500 and Cancellation No. 92075025; (2) Rubinstein’s motion, filed September 4, 2020 in Opposition No. 91264565, to consolidate Opposition No. 91254500, Opposition No. 91264565, and Cancellation No. 92075025; (3) Opposer/Respondent Entrepreneur Media, Inc.’s (“Entrepreneur Media”) motion, filed September 22, 2020, to suspend Cancellation No. 92075025 pending final determination of a civil action between the parties; and

(4) Entrepreneur Media’s motion, filed September 29, 2020, to extend its time to respond to the petition to cancel in Cancellation No. 92075025. Entrepreneur Media did not respond to Rubinstein’s motion to consolidate in Cancellation No. 92075025, and Rubinstein did not respond to Entrepreneur Media’s motion to suspend in Cancellation No. 92075025, although Entrepreneur Media did file a response the motion to consolidate filed in Opposition No. 91264565.

## **I. Background**

### **A. Opposition No. 91254500 (“the ’500 Opposition”)**

On March 6, 2020, Entrepreneur Media filed a notice of opposition in the ’500 Opposition against Kelly Roach’s application Serial No. 88390522 for the mark THE UNSTOPPABLE ENTREPRENEUR, in standard characters, for “business consultancy; business marketing consulting services” in International Class 35.<sup>1</sup> ’500 Opposition, 1 TTABVue. In its notice of opposition, Entrepreneur Media alleges prior use and registration of the following marks:

- ENTREPRENEUR, in typeset form,<sup>2</sup> for “paper goods and printed matter; namely magazines, books and published reports pertaining to business opportunities” in International Class 16;<sup>3</sup>
- ENTREPRENEUR, in typeset form, for “advertising and business services, namely, arranging for the promotion of the goods and services of others by means of a global computer network and other computer online services providers; providing business information for the use of customers in the field of starting and operating small businesses and permitting customers to obtain information via a global computer network and other computer

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<sup>1</sup> Filed April 17, 2019, under Section 1(a) of the Trademark Act.

<sup>2</sup> Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed or typeset mark is the legal equivalent of a standard character mark. *See In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012).

<sup>3</sup> Registration No. 1453968; issued August 25, 1987; renewed.

online service providers and; web advertising services, namely, providing active links to the websites of others” in International Class 35;<sup>4</sup> and

- ENTREPRENEUR, in in typeset form, for “arranging and conducting trade show exhibitions in the field of entrepreneurial activities, namely the start-up and operation of small business enterprises” in International Class 35 and “educational services, namely, conducting seminars on the development and operation of businesses, and conducting work shops on computer technology, telecommunications, marketing, financing options, real estate management, tax planning and insurance” in International Class 41.<sup>5</sup>

As grounds for opposition, Entrepreneur Media alleges that use of the parties’ respective marks is likely to cause confusion. ’500 Opposition, 1 TTABVUE 9-10, ¶¶ 8-9.

On April 14, 2020, Kelly Roach filed an answer and counterclaim, denying the salient allegations of the notice of opposition, pleading several purported affirmative defenses, and asserting that Entrepreneur Media’s Registration Nos. 1453968, 2263883, and 2502032 should be cancelled because Entrepreneur Media’s pleaded marks are generic. ’500 Opposition, 4 TTABVUE.

On May 29, 2020, Entrepreneur Media filed its answer to Kelly Roach’s counterclaim, denying the salient allegations of the counterclaim and pleading several purported affirmative defenses. ’500 Opposition, 6 TTABVUE.

**B. Cancellation No. 92075025 (“the ’025 Cancellation”)**

On August 18, 2020, Rubinstein filed a petition to cancel Entrepreneur Media’s Registration No. 2263883 (i.e., one of the pleaded registrations in the ’500

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<sup>4</sup> Registration No. 2263883; issued July 27, 1999; renewed.

<sup>5</sup> Registration No. 2502032; issued October 30, 2001; renewed.

Opposition), alleging that: (1) Rubinstein is the owner of application Serial No. 88816134 for the mark ENTREPRAWYER, in standard characters, for “marketing consulting; marketing services; advertising and marketing pleading a single claim of genericness” in International Class 35;<sup>6</sup> (2) Entrepreneur Media filed a request for an extension of time to oppose application Serial No. 88816134; (3) Entrepreneur Media has alleged that the parties’ marks are confusingly similar and demanded a modification to Rubinstein’s ENTREPRAWYER mark; and (4) the mark subject to Registration No. 2263883 is generic. ’025 Cancellation, 1 TTABVUE.

On September 29, 2020, Entrepreneur Media filed a consented motion to extend its time to respond to Rubinstein’s petition to cancel. ’025 Cancellation, 6 TTABVUE.

**C. Opposition No. 91264565 (“the ’565 Opposition”)**

On September 2, 2020, Entrepreneur Media filed a notice of opposition in the ’565 Opposition against Rubinstein’s application Serial No. 88816134 for the mark ENTREPRAWYER. ’565 Opposition, 1 TTABVUE. In its notice of opposition, Entrepreneur Media alleges prior use and registration of the same marks as pleaded in the ’500 Opposition. As grounds for opposition, Entrepreneur Media alleges that use of the parties’ respective marks is likely to cause confusion. ’565 Opposition, 1 TTABVUE 9-10, ¶¶ 8-9.

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<sup>6</sup> Filed February 29, 2020, based upon Rubinstein’s allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act.

On September 4, 2020, Rubinstein filed an answer, denying the salient allegations of the notice of opposition and pleading several purported affirmative defenses. '565 Opposition, 4 TTABVUE.

## **II. Rubinstein's Motion to Consolidate the '565 Opposition and '025 Cancellation**

### **A. Preliminary Matter**

Entrepreneur Media's response to the motion to consolidate filed in the '565 Opposition appears to be untimely. If Rubinstein served its motion on September 4, 2020 (the date it was filed), then Entrepreneur Media's response was due by September 24, 2020. *See* Trademark Rule 2.127(a). Entrepreneur Media filed its response on September 28, 2020. Nevertheless, the Board exercises its discretion to consider Entrepreneur Media's response to the motion. The parties are advised, however, that compliance with the Board's rules and deadlines is expected of them going forward.

### **B. Analysis**

When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. *See* Fed. R. Civ. P. 42(a) and TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 511 (2020). *See Wis. Cheese Grp., LLC v. Comercializadora de Lacteos y Derivados, S.A. de C.V.*, 118 USPQ2d 1262, 1264 (TTAB 2016); *Venture Out Props. LLC v. Wynn Resorts Holding LLC*, 81 USPQ2d 1887, 1889 (TTAB 2007). 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

which may be caused thereby. *See World Hockey Ass'n v. Tudor Metal Prods. Corp.*, 185 USPQ 246, 248 (TTAB 1975); TBMP § 511.

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See, e.g., Wis. Cheese Grp., LLC*, 118 USPQ2d at 1264.

The parties to the '565 Opposition and '025 Cancellation are the same, and the involved marks, allegations, and claims are similar or identical. For these reasons, the Board finds that consolidation is appropriate. Accordingly, the '565 Opposition and '025 Cancellation are consolidated and may be presented on the same record and briefs. *See Hilson Research Inc. v. Soc'y for Human Res. Mgmt.*, 27 USPQ2d 1423, 1424 n.1 (TTAB 1993); *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1619 n.1 (TTAB 1989).

The Board file will be maintained in the '565 Opposition as the "parent case." After the pleadings are closed, the parties shall commence the practice of filing only a single copy of all motions and submissions, filing in the parent case only, and captioning both consolidated proceedings, listing and identifying the parent case first (see the caption above).<sup>7</sup>

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall

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<sup>7</sup> The parties should promptly inform the Board of any other Board proceedings or related cases within the meaning of Fed. R. Civ. P. 42, so that the Board can consider whether further consolidation is appropriate.

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. *See Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010).

### **III. Entrepreneur Media’s Motion to Suspend**

Entrepreneur Media moves to suspend Cancellation No. 92075025 pending final disposition of a civil action between Entrepreneur Media and Rubinstein pending in the United States District Court for the Eastern District of New York, captioned *Rubinstein & Associates, PLLC v. Entrepreneur Media, Inc.*, Case No. 2:20-cv-04173 (E.D.N.Y.) (the “New York Civil Action”). ’025 Cancellation, 5 TTABVUE.

“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.” Trademark Rule 2.117(a). “[T]he 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.” *New Orleans Louisiana Saints LLC v. Who Dat?, Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011). Suspension of a Board proceeding pending the outcome of another proceeding is solely within the discretion of the Board. *See* TBMP § 510.02.

In the New York Civil Action, Rubinstein seeks, among other things: (1) a declaration of non-infringement, namely that Rubinstein’s use of the mark **ENTREPRENAWYER** in connection with its services does not infringe the rights of Entrepreneur Media in its **ENTREPRENEUR** marks; and (2) a declaration of

invalidity and cancellation of Entrepreneur Media's ENTREPRENEUR marks, including Registration Nos. 1453968, 2263883, and 2502032. '025 Cancellation, 5 TTABVUE 4-18.

The New York Civil Action involves the same parties and marks at issue in the '565 Opposition and '025 Cancellation, and overlapping issues, including whether there is a likelihood of confusion between Entrepreneur Media's ENTREPRENEUR marks and Rubinstein's ENTREPRENAWYER mark. Accordingly, proceeding in the '565 Opposition or '025 Cancellation prior to termination of the New York Civil Action would be inefficient and pose a risk of inconsistent judgments.

In view of the foregoing, Entrepreneur Media's motion to suspend is **granted**. Although Entrepreneur Media did not request suspension of the '025 Cancellation, the Board has consolidated the '565 Opposition and '025 Cancellation and finds that suspension of both proceedings is appropriate. Accordingly, the '565 Opposition and '025 Cancellation are **suspended** pending final disposition of the New York Civil Action. Within **twenty days** after the final determination of the New York Civil Action,<sup>8</sup> the parties shall notify the Board so that these consolidated proceedings may be called up for appropriate action.<sup>9</sup>

In view of this order, Entrepreneur Media's motion to extend its time to respond to the petition to cancel in the '025 Cancellation is moot. Entrepreneur Media's

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<sup>8</sup> 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 appeals filed have been decided and the time for any further review has expired. *See* TBMP § 510.02(b).

<sup>9</sup> During the suspension period, the parties must notify the Board of any address or email address changes for the parties or their attorneys.



deadline to respond to the petition to cancel will be reset, if and when these consolidated proceedings resume.

**IV. Rubinstein's Motion to Consolidate the '565 Opposition and '025 Cancellation with the '500 Opposition**

In view of suspension, to the extent Rubinstein also moves to consolidate the '565 Opposition and '025 Cancellation with the '500 Opposition, which involves a different applicant and involved application, that motion is **denied without prejudice**. Upon the resumption of proceedings, if Rubinstein believes the '500 Opposition should still be consolidated with the '565 Opposition and '025 Cancellation, Rubinstein may renew its motion to consolidate by written request to the Board citing the title, date of filing, and docket entry of the motion in the Board's electronic docket. Any renewed motion must be accompanied by a signed statement that the motion has been reviewed in its entirety and concerns matters still disputed between the parties.