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

Proceeding	92075530
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re: Registration of: Gerber Childrenswear LLC
Registration Number: 2,549,557
Mark: ONESIES
Registration Date: March 19, 2002

MADELYNE DAWSON,)
)
Petitioner,)
) **Cancellation Proceeding**
) **No. 92075530**
v.)
)
)
GERBER CHILDRENSWEAR)
LLC,)
)
Registrant.)

**MOTION TO DISMISS FOR LACK OF STANDING OR, IN THE ALTERNATIVE,
FOR FAILURE TO JOIN A REQUIRED PARTY, AND MOTION TO
SUSPEND PROCEEDINGS PENDING RULING ON DISPOSITIVE MOTION**

INTRODUCTION

Registrant, Gerber Childrenswear LLC (“Registrant” and/or “Gerber”), by and through its undersigned counsel, hereby respectfully moves, pursuant to 37 C.F.R. Sections 2.116(a), 2.117, and 2.127(d), Rules 12 (b)(7) and 19, Fed. R. Civ. P., Section 510.01 TBMP, and other applicable rules and statutes, to dismiss this Cancellation Proceeding on the ground that Petitioner lacks standing or, in the alternative, that Petitioner has failed to join a required party. Registrant, additionally, moves for a suspension of proceedings herein pending the ruling by the

Trademark Trial and Appeal Board (“TTAB”) of the United States Patent and Trademark Office (“USPTO”) on this potentially dispositive dismissal motion.

FACTUAL BACKGROUND AND PROCEDURAL POSTURE

Factual Background

Gerber is the owner of U.S. Trademark Registration No. 2,549,557 for the trademark ONESIES, in Class 25, for infant’s and children’s clothing, namely, infant wear, underwear, bodysuits, underclothes, and undergarments, issued ON March 19, 2002. The first use date is August 15, 1982, almost 4 decades ago.

Gerber timely filed Section 8 and 15 Declarations which the USPTO accepted in 2012. ONESIES, the mark here at issue, consequently, has incontestable status.

It is alleged in the Petition for Cancellation (“Petition”) that the “Plaintiff” (sic) began selling her baby clothing and accessories in October of 2019, which is almost 40 years after Gerber commenced its use of the ONESIES mark. Petitioner further alleges that she sells her baby clothing goods under the mark “BUNDLED & COMPANY.”¹ Ms. Dawson has admitted selling her baby clothing wares on Etsy, Instagram, and Facebook. (*See* Petition, at pp. 1-2.) (*See also* Exhibit A to Petition.)

In or around the Fall of 2020, it came to Gerber’s attention that a Florida business (not a brand) named “BundledandCompany” was selling baby clothing goods on an internet website using Registrant’s ONESIES mark without approval, authorization, consent, or permission. Gerber complained about this trademark

¹ There is no indication, allegation, or evidence that Ms. Dawson has invested any effort, time, or money in registering her purported mark, “BundledandCompany.”

infringement to Etsy, an e-commerce platform and Etsy, in turn, sent an appropriate Notice...not to the named Petitioner, but BundledandCompany. Etsy also took appropriate action to deactivate certain offending baby clothing items' listings...that were being peddled by BundeledandCompany. (*See* Petition at p. 2; *see also* Exhibit B to Petition.)

There is nothing contained in Exhibit A (or, for that matter, Exhibit B) to the Petition, to demonstrate, or even suggest, that Petitioner's mark is "BUNDLED & COMPANY." Rather, it is quite clear, from Petitioner's own exhibits, which form part and parcel of her complaining pleading, that the foregoing is a company name. (*See* Exhibit A to the Petition.)

To illustrate, if one peruses the Etsy pages attached by Petitioner to her pleading, under the name "BundledandCompany" there is a button link for the customers' "favorite shop." Similarly, under the words "Shop Owner," it reads "BundledandCompany."

It also bears emphasis that many different baby clothing items are shown in Exhibit A, in the Etsy-related pages, all under the "BundledandCompany" store banner if you will. Continuing along, on the third page, there is an icon (with an illegible image or photo) under the heading "Shop members" which reads "BundledandCompany Owner."

Likewise, the snapshot copies of the Instagram pages shown by Petitioner, in Exhibit A, unmistakably reflect the name of "bundledandcompany" used as the store name, not a brand. The "Follow" hyperlink, and the Instagram address used

(i.e., www.instagram.com/bundledandcompany) make this all too apparent. Again, many baby apparel items are sold there by virtue of this e-commerce store.

On the Facebook pages displayed in Exhibit A by Petitioner, once again, the name “bundledandcompany” clearly shines through as a business name as opposed to a brand name. Moreover, “bundledandcompany” is listed there as a so-called “Product/Service,” and it also is the contact name given and the name used in e-communications with customers, as reflected in that same Exhibit.

In similar fashion, the last page of Exhibit A to the Petition, a Pinterest screenshot, prominently displays the company’s “Bundled & Co. Onesies.” (Emphasis added.) Notably, the Pinterest address (i.e., www.pinterest.com/bundledandcompany/bundled-co-onesies/14.102020) likewise shows that Pinterest considers “bundledandcompany” the business name and, even more egregiously, that “onesies” is part of the name of, or otherwise belongs to, “bundled and company.”

In Exhibit B to her own Petition, Ms. Dawson shows us the Notice from Etsy Legal (of Etsy, Inc.). It is, however, obviously not a Notice directed to Ms. Dawson. Rather, it is quite clearly addressed to the company that has been selling the offending baby clothing goods and using the ONESIES mark (unlawfully), namely, to “BundledandCompany.”

Tellingly, nowhere does Ms. Dawson’s name appear on said Notice from Etsy Legal. And nowhere does Ms. Dawson’s name appear in any of the snapshots from

the e-commerce sites that Petitioner has incorporated as her exhibits -- designed to support her own Petition to Cancel.

Indeed, there is nothing in the Petition tying Ms. Dawson to any named company; there is no mention of Ms. Dawson having received any notices with her name on them, take down or otherwise; and, as shown above, there is no mention of Ms. Dawson in any of the pages/images shown in Exhibits A and B to the Petition.

Quite curiously, there is nothing about the company in the Petition at all. There are no allegations of proprietorship or of being a principal in the company. There is no claim to any stake in the business on the part of Ms. Dawson.

Peculiarly, Ms. Dawson's pleading rambles on as if the company did not exist. For some unbeknownst reason, the Petitioner has re-cast "BundledandCompany" as a mark and not a company. She also has, deliberately in Registrant's estimation, shied away from any allegations of her involvement in any such company. Why? We will not here speculate. However, it cannot be gainsaid that the company, that is to say, BundledandCompany, is ignored totally in the allegations of this Petition. The company, thus, has become, as the old adage goes, conspicuous by its absence.

And, so, the Petitioner who has come before the TTAB, and who now attacks Gerber for the take-down efforts vis-à-vis BundledandCompany is, strangely enough, not BundledandCompany, but rather the individual, Ms. Dawson, whose name and involvement do not register anywhere in the Exhibits submitted along with, and incorporated into, the pleading here under scrutiny.

Procedural Posture of the Proceeding

Shortly after the Etsy Legal Notice (issued September 1, 2020), on October 20, 2020, Petitioner, an individual, lodged the instant Cancellation Proceeding against Gerber and its '557 Registration (D.E. 1). Procedurally, there have been a number of extensions sought and duly granted (D.E. 4, 5, and 6). As matters now stand, however, based upon the January 18, 2021 Consent Motion to Extend, coupled with the Board's granting of same (D.E. 7; *see also* D.E. 10), the Registrant's Answer or responsive papers fall due on February 28, 2021. The instant motion, therefore, is being timely submitted.

ARGUMENT

MOTION TO DISMISS FOR LACK OF STANDING

Petitioner Lacks Standing to Bring this Cancellation Proceeding

As a threshold jurisdictional issue, a petitioner in the context of a TTAB Cancellation Proceeding must demonstrate standing in order to contest a registration. The Lanham Act provides that any person that believes it will be damaged by continued registration of a registered mark may bring a cancellation proceeding against the registration (Title 15, U.S. Code Section 1064).

The Petitioner, Dawson, lacks standing to bring this Cancellation Proceeding. It hardly seems necessary to add that, in situations wherein a party lacks standing to initiate the case, the TTAB lacks the power to hear the case.

In order to obtain cancellation of the registration, the petitioning party must show both standing and valid grounds for cancellation. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). Standing requires that the petitioner have a “real interest” in the cancellation proceeding. *Int’l Order of Job’s Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 1092, 220 USPQ 1017, 1020 (Fed.Cir.1984). In most settings, a direct commercial interest satisfies the “real interest” test. *Cunningham, supra*, at 945. See also *Herbko International, Inc. v. Kappa Books, Inc.*, 305 F.3d 1156, 1161 (Fed. Cir. 2002). (Except when dealing with incontestable marks, any reason that would have precluded registration in the first instance suffices as a valid ground for cancellation. *Cunningham, supra*, at 946.)

Simply stated, the doctrine of standing is that the person seeking relief be the proper party to advance the litigation (or proceeding). This doctrine in the federal court system, generally, consists of two inter-related components: Article III constitutional requirements and non-constitutional prudential concerns. *Franchise Tax Bd. of California, et al. v. Alcan Aluminum Ltd., et al.*, 110 S. Ct. 661 (1990), *reh’g denied*, 111 S. Ct. 1311 (1990).

Notably, however, “[t]he ‘case’ and ‘controversy’ restrictions do not . . . apply to matters before [an] administrative agency[.]” such as the TTAB. *Ritchie v. O.J. Simpson*, 170 F.3d 1092, 1095 (Fed. Cir. 1999)). In marked contradistinction, standing before an administrative agency is conferred by statute. Here, “[a] petition to cancel a registration of a mark” may be filed “by any person who believes that he [or she] is or will be damaged . . . by the registration of a mark[.]” 15 U.S.C. § 1064.

“[C]ancellation is most often premised on the grounds listed in [15 U.S.C. § 1052.]” *Young v. AGB Corp.*, 152 F.3d 1377, 1380 (Fed. Cir. 1998). “The party seeking cancellation must prove two elements: (1) that it has standing; and (2) that there are valid grounds for canceling the registration.” *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945 (Fed. Cir. 2000). To successfully establish standing in an *inter partes* proceeding, the party in the position of plaintiff must plead and prove facts showing that he or she has “a real interest in the proceedings and [has] a reasonable basis for his [or her] belief of damage.” *Ritchie, supra*, 170 F.3d at 1095 (internal quotation marks omitted).

In *Corcamore, LLC v. SFM, LLC*, 978 F. 3d 1298, 2020 WL 6277728, at *3-4 (Fed. Cir. Oct. 27, 2020), the Federal Circuit held that the statutory standing requirements that the Supreme Court set out in *Lexmark Int'l, Inc. v. Static Control Components, Inc.* (a false advertising case) apply to TTAB proceedings (572 U.S. 118, 134 S. Ct. 1377 (2014)). Stated another way, a party in the position of plaintiff must allege and show both:

1. An injury within the zone of interests protected by the Lanham Act. Any commercial interest in preventing or canceling a registration is generally sufficient; and
2. The injury is proximately caused by the defendant's registration. A plaintiff's reasonable belief of damage (the statutory requirement) is generally sufficient.

Corcamore, supra, at *3-4.

In so doing, the Federal Circuit confirmed that this test is substantively the same as the "real interest" test that the Federal Circuit and the TTAB had

traditionally applied to evaluate standing in TTAB proceedings, which requires a party in the position of plaintiff to show:

- (1) A real interest in the proceeding; and
- (2) A reasonable basis for its belief of damage.

Id., at *5.

Standing, then, must be sufficiently alleged in the initial pleading and ultimately proven at trial or on summary judgment. In this matter before the Board, the Petition's allegations, viewed from the perspective of standing, simply do not pass legal muster.

As a general proposition, standing is liberally construed. Thus, albeit a party need not plead or prove actual damage² to establish standing, a person must demonstrate a real interest in the proceeding; that is to say, a direct and personal stake in the outcome. *See, e.g., Ritchie v. O.J. Simpson*, 170 F.3d 1092, at 1095 (Fed. Cir. 1999). To illustrate, a party may seek to cancel a registration that is blocking (or that the party reasonably believes may block) the party's application. *See, e.g., The Hartwell Co. v. Shane*, 17 U.S.P.Q.2d 1569, 1990 WL 354584, at *2 (T.T.A.B. 1990). In still other cases, standing is commonly established through the opposer or petitioner making its pleaded trademark registrations of record. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945 (Fed. Cir. 2000).

“[A] real interest in the proceeding” means the petitioner has “a legitimate personal interest” in the cancellation. *Coach Servs., Inc. v. Triumph Learning*

² For the purposes of 15 U.S.C. § 1064, a petitioner must show that “it has both a real interest in the proceedings ... [and] a reasonable basis for its belief of damage.” *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 1275 (Fed. Cir. 2014) (internal quotation marks and citation omitted).

LLC, 668 F.3d 1356, 1376 (Fed. Cir. 2012) (internal quotation marks and citation omitted). “[A] reasonable basis” for belief of damage means the petitioner's “belief of damage” has “a reasonable basis in fact.” *Id.* (internal quotation marks and citation omitted).

A reasonable belief in damage “can be shown by establishing a direct commercial interest,” *Cunningham, supra*, 222 F.3d at 945 (citing *Int’l Order of Job’s Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 1092 (Fed. Cir. 1984)), such as the “longtime production and sale of merchandise with the [mark]” at issue, with “an equal right [to] that of [registrant-approved retailers] to use the [mark],” *Job’s Daughters*, 727 F.2d at 1092, or “own[er]s[hip]” and use of potentially similar “prior registrations,” *Cunningham*, 222 F.3d at 945. Such requirements are meant to “prevent litigation where there is no real controversy between the parties, where a plaintiff, petitioner[,] or opposer, **is no more than an intermeddler.**” *Jewelers, supra*, 823 F.2d at 492 (quoting *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, at 1029–30 (CCPA 1982)). (Emphasis added.)

Therefore, to plead a “real interest,” plaintiff must allege a “direct and personal stake” in the outcome of the proceeding. TBMP Section 309.03(b). Moreover, the allegations in support of plaintiff’s belief of damage must have a reasonable basis “in fact.” TBMP Section 309.03(b). *Id.*

In the case at bar, Petitioner has alleged no trademark applications of record for the ONESIES mark which she has attacked. In addition, the pleading is bereft of mention of any trademark registrations for the ONESIES mark ever issued to

her. Furthermore, Ms. Dawson has neither explained nor shown any indicia of any trade identity of her own and especially as related to the mark here at issue.

What is more, Ms. Dawson has not claimed or pleaded any proprietary rights in the mark, ONESIES. She has not claimed or pleaded any proprietary rights in any company (BundledandCompany or otherwise). A petitioner has to show that he(she) has a “real commercial interest in the disputed mark, and a reasonable basis for the belief that he would be damaged by the registration of the mark.” *Chem. New York Corp. v. Conmar Form Sys. Inc.*, 1 U.S.P.Q. 2d 1139, 1142 (TTAB 1986), quoted in *Soro v. Citigroup*, 287 Fed. Appx. 57 (11th Cir. 2008). In her pleading, Petitioner does not assert or claim any commercial interest (direct or otherwise) in Bundled and Company, or in any company for that matter. She has chosen, for unspecified motive(s), not to mention any company with which she is or may be in league.

Petitioner has not pleaded she has a *bona fide* intent to use the same mark for related goods. She unequivocally stated in her Petition that she is using the mark “BundledandCompany.” She also admitted that she also uses the words “bodysuits” or “jumpsuits” to describe goods. (*See* Para. 3, at p. 2 of Petition.)

Besides, the pleading is bare of allegations of any long-time sales or production of merchandise under the ONESIES mark... by the Petitioner. To the contrary, it shows nothing of the sort under her name, only an oblique reference to the “mark” BUNDLED & COMPANY.” (*See* Petition, D.E. 1, Para. 1, at p. 1.)

Incredibly, Petitioner, in the context of her pleading, does not even allege use (let alone application for, or registration of) the mark ONESIES, the mark that is supposedly here at issue and under the legal microscope.

Staying within, and examining closely, the four corners of the pleading, the “marketing, offering, and selling” of baby clothes is claimed to be conduct or activity by the Petitioner, but that allegation is undeniably contradicted by her own exhibits to the pleading (which show only a company, BUNDLED & COMPANY) selling such baby clothing items. Dawson cavalierly characterizes “BUNDLED & COMPANY,” as a “mark” (which raises other problems, as discussed herein), but it does serve to make it crystal clear that the clothing is not sold by her or under her name.

Petitioner further opines that she describes the “BUNDLED & COMPANY” clothing goods as “onesies” (and sometimes as “bodysuits or jumpsuits”; *see* Petition, Para. 3, at p. 2.) Again, whatever the goods may be called, and whoever is selling them, this Petition, other than the self-serving allegations set forth in Paras. 1-2, does not even make a facial showing that Ms. Dawson is doing the selling or marketing of such baby clothing goods. In fact, the pleading, when taken as a whole, and incorporating, as we must, its exhibits (including the critical Exhibit A which is referred to by Petitioner in Para. 2, at pp. 1-2 of the Petition), clearly contradicts the notion that Ms. Dawson is the seller.

As the pleader, it was, and is, up to Ms. Dawson to connect the dots -- if any there are to be so connected -- between her and the sale and marketing of the goods.

Neither the Registrant, nor the Board can be left to guess, conjecture, or speculate as to: whether Ms. Dawson has, or does not have, a proprietary interest in the activities alleged as related to such clothing; whether or not she has a direct commercial interest in the company; or whether she has an ownership or other legitimate connection to the company which, from all appearances, is selling them. As a litigant, Gerber should not be required to take a leap of faith and just accept Ms. Dawson's unilateral characterizations, particularly as it incontrovertibly clashes with her own Petition's exhibits. To be sure, the Board cannot reasonably be expected to flesh out a case, if any there be, for Ms. Dawson.

In this case, then, Petitioner is not asserting her own legal rights, but rather the purported claims of a third party, *i.e.*, the heretofore unacknowledged entity. We now can divine the entity, thanks to Petitioner's documentary exhibits annexed to and incorporated in her Petition.

What then, is the nature or source of the claim here? There exists no properly alleged or demonstrated causal connection between the Petitioner, Dawson, and any injury alleged. It cannot be gainsaid that the infringement accusation and take-down notice were not directed at Petitioner. They were directed to a company, Bundled and Company. (*See Exhibit B to Petition.*)

It is axiomatic that access to federal courts or tribunals should be limited to those litigants best suited to assert a particular claim. *Gladstone, Realtors, et al. v. Village of Bellwood, et al.*, 411 U.S. 91, 99-100, 99 S. Ct. 1601 (1979). In the present case, Ms. Dawson fails to qualify in that critical regard.

MOTION TO DISMISS FOR FAILURE TO JOIN A REQUIRED PARTY

Alternatively, Dismissal Should be Ordered Under Rule 12(b)(7), Fed. R. Civ. P.

In the alternative, Registrant respectfully submits that this Petition ought to be dismissed for failure to join a required party. In short, Bundled & Company, the missing entity,³ is a required party that should be joined under Rule 19.

Such a motion can be raised at any time, even by a reviewing court on its own motion. *Quaburg Rubber Co. v. Fabiano Shoe, Inc.*, 567 F.2d 154, 195 U.S.P.Q. 689 (1st Cir., 1977). It clearly is timely as submitted under the broader umbrella of the instant Motion to Dismiss.

As has become evident, just a few months before Gerber had discovered the infringing conduct in Etsy, as well as in other e-commerce platforms, a limited liability company was in the process of coming into being; that company was named “BUNDLED AND COMPANY, LLC.” and was formed, in Florida, on June 22, 2020. (Annexed hereto and made a part hereof as Exhibit 1 is a true and correct copy of a status copy of an entity search, derived from the public records of the Florida Secretary of State, Division of Corporations, and retrieved February 25, 2021.) Ms. Dawson, the Petitioner, is listed as a Manager and as Registered Agent of the aforesaid entity. Can there be even a scintilla of doubt that this company is one and the same with the company shown in Petitioner’s own Exhibits as the company conducting the baby clothing business which Petitioner, instead, claims to

³ “Bundled and Company, LLC.” is, upon information and belief, and according to public records of the Florida Secretary of State, Division of Corporations, is Florida limited liability company, recently formed in mid-2020.

be running? Can there be any lack of suspicion that Petitioner misspoke, or misstated, her claim when she characterized “BundledandCompany” as her mark when it is here for all the world to see it is a company? Can there be any question that Petitioner is not here to usurp and litigate a third-party’s claim (rightful or otherwise)? The curtain must fall on her charade as the proper party here.

Rule 12(b), Fed. R. Civ. P., provides, in relevant part:

(b) HOW TO PRESENT DEFENSES. Every defense to a claim for relief in any pleading must be asserted in the responsive pleading if one is required. But a party may assert the following defenses by motion:

* * *

(7) failure to join a party under Rule 19.

A motion asserting any of these defenses must be made before pleading if a responsive pleading is allowed. If a pleading sets out a claim for relief that does not require a responsive pleading, an opposing party may assert at trial any defense to that claim. No defense or objection is waived by joining it with one or more other defenses or objections in a responsive pleading or in a motion.

As a general rule, the movant has the burden to show that the other party has failed to join a required party. *See Rotec Indus., Inc. v. Aecon Grp., Inc.*, 436 F.Supp.2d 931, 933 (N.D. Ill., E. Div. 2006). Rule 19(a)(1) provides that a person must be joined as a party if (A) in that person's absence, the court cannot accord complete relief among existing parties; or (B) that person claims an interest relating to the subject of the action and is so situated that disposing of the action in the person's absence may:

- (i) as a practical matter impair or impede the person's ability to protect the interest; or

- (ii) leave an existing party subject to a substantial risk of incurring double, multiple, or otherwise inconsistent obligations because of the interest.

Fed. R. Civ. P. 19(a)(1).

However, unlike a motion to dismiss pursuant to Rule 12(b)(6), a court may consider extrinsic evidence outside the four corners of the complaint when deciding a motion to dismiss pursuant to Rule 12(b)(7). *See Microsoft*, 2008 WL 3162535, at *5. (*See Exhibit 1 annexed hereto.*)

As explained in *Slep-Tone Entertainment Corporation v. Elwood Enterprises, Inc.*, 2014 WL 1612891 (N.D. Ill., E. Div. 2014), which was a case involving a Rule 12(b)(7) motion to dismiss for failure to join a required party under Rule 19, the court conducts a two-step analysis. First, the court determines whether the party is “required” under Rule 19(a). *See Askew v. Sheriff of Cook Cnty., Ill.*, 568 F.3d 632, 635 (7th Cir. 2009). A party is required if joinder is feasible and (1) the court cannot accord complete relief to existing parties in the party's absence; (2) the absent party's ability to protect an interest relating to the subject of the action will be impaired; or (3) an existing party would be subject to a substantial risk of multiple or inconsistent obligations if the absent party is not joined. Fed. R. Civ. P. 19(a)(1).

Second, if the court determines the party is required but joinder is not feasible, it must consider whether, under Rule 19(b), “equity and good conscience” require that the litigation should proceed without the absent party. *Davis Cos. v. Emerald Casino, Inc., et al.*, 268 F.3d 477, 480 (7th Cir. 2001). The court considers

the prejudice to the existing parties, the adequacy of a judgment that would be rendered without the absent party, and whether the plaintiff would have an adequate remedy if the action were dismissed. Fed. R. Civ. P. 19(b). “If there is no way to structure a judgment in the absence of the party that will protect both the party's own rights and the rights of the existing litigants, the unavailable party is regarded as ‘indispensable’ and the action is subject to dismissal ... under [Rule] 12(b)(7).” *Davis, supra*, 268 F.3d at 481 (internal quotation marks and citation omitted).

One jurist, in the case of *Nanko Shipping, USA et al. v. Alcoa, Inc. et ano.*, 850 F. 3d 461 (D.C. Cir. 2017), succinctly explained the Rule 19 analysis in the following manner:

“We have summed up the Rule 19 inquiry as posing three questions: Should the absentee be joined, *i.e.*, is it necessary to the litigation? If so, can the absentee be joined? And finally, if the absentee should but cannot be joined, may the lawsuit nonetheless proceed “in equity and good conscience”? *W. Md. Ry. Co. v. Harbor Ins. Co.*, 910 F.2d 960, 961 (D.C. Cir. 1990); *see Kickapoo Tribe of Indians of Kickapoo Reservation in Kan. v. Babbitt*, 43 F.3d 1491, 1494 (D.C. Cir. 1995). Rule 19 promotes fair treatment of nonparties in certain circumstances where their interests, and particularly their due process rights, are at risk from litigation between others. It also seeks to avoid multiple and wasteful litigation, such as where the absence of a party would prevent the court from granting the relief sought or expose an existing party (typically the defendant) to a substantial risk of incurring double, multiple, or otherwise inconsistent obligations. Rule 19 does not apply merely because dispute resolution would be more efficient with the nonparty's participation, nor because the pending case could yield precedent adverse to the absentee's interests. A decision under Rule 19 “not to decide” a case otherwise properly before the court is a power to be exercised only “[i]n rare instances.” *Nat'l Ass'n of Chain Drug Stores v. New England Carpenters Health Benefits Fund*, 582 F.3d 30, 42 (1st Cir. 2009); *see also Fort Yates Pub. Sch. Dist. No. 4 v. Murphy ex rel. C.M.B.*, 786 F.3d 662, 671 (8th Cir. 2015).

In the matter at hand, for reasons known only to her and her counsel, Petitioner completely has bypassed the entity involved and substituted herself as the allegedly aggrieved, interested, and legitimate party. We will not here speculate on the machinations that prompted such maneuver of circumvention.

Nevertheless, even if we accept Ms. Dawson's allegations as true and draw all reasonable inferences in her favor, this cannot change the fact that her allegations, as sparse as they are, conflict with her own Petition's exhibits. There can, thus, be no credible concern regarding the existence of the company. There is likewise no justifiable debate that the company can be joined in this proceeding.

Allowing Ms. Dawson to continue this façade potentially would work a great prejudice on Gerber. It would subject Gerber to the possibility of duplicative proceedings which, in turn, involve more cost and inconvenience, along with the attendant aggravation, time, and effort commonly required by litigating federal cases. As matters now stand, the entity would not be precluded from future proceedings since it is not a party to, or in proven privity with, Ms. Dawson. The potential prejudice described above can neither be mitigated nor eliminated, by Ms. Dawson and her continued role in this case.

The lack of fairness and equity is manifest. The absent party (the entity) appears, from Petitioner's own evidence, to be the party involved in the transactions and, thus, it was (and is) the entity's interests that are involved. Any just resolution of this matter will, thus, require a determination of the entities' rights and obligations vis-à-vis Gerber.

Consequently, the entity, Bundled and Company, should be viewed not just as a potential party, but rather a required one under Rule 19. In that light, we should also focus on the Registrant- Gerber's right to protect its intellectual property interests, which ought not be impaired or impeded. Nor should Gerber be subject to endless proceedings over this Registration; if, for example, at the conclusion of this proceeding, Ms. Dawson, Petitioner herein, is unsuccessful, are we to allow Bundled & Company to suddenly emerge from its safe perch on the legal tournament's sidelines and take up the legal sword to challenge Gerber, once again, on the same Registration, on the identical or substantially similar facts?

At the current pleading stage, based upon the Petitioner's own allegations, when held up and considered and compared (and contrasted) to her own paperwork (*see* Exhibit A), Bundled & Company, LLC. should be viewed as a required party in this pending Cancellation Proceeding before the Board.

MOTION TO SUSPEND PROCEEDINGS

The Proceedings Should be Suspended Pending the TTAB's Disposition of the Instant Motion to Dismiss

Section 2.117 of Title 37 C.F.R. provides, in pertinent portion, as follows:

37 C.F.R. § 2.117 *Suspension of proceedings.*

* * *

(b) Whenever there is pending before the Board both a motion to suspend and a motion which is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered regardless of the order in which the motions were filed.

(c) Proceedings may also be suspended sua sponte by the Board, or, for good cause, upon motion or a stipulation of the parties approved by the Board...

In addition to the foregoing, Section 2.127(d) of Title 37 C.F.R. recites, in *haec verba*:

“When any party timely files a potentially dispositive motion, including, but not limited to, a **motion to dismiss**, a motion for judgment on the pleadings, or a motion for summary judgment, **the case is suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion except as otherwise may be specified in Board’s suspension order.** If the case is not disposed of as a result of the motion, proceedings will be resumed pursuant to an order of the Board when the motion is decided.” (Emphasis added.)

As well-summarized in TBMP Section 510.01, “[f]ollowing from the Board’s inherent power to schedule disposition of the cases on its docket is the power to stay proceedings, which may be exercised by the Board upon its own initiative, upon motion, or upon stipulation of the parties approved by the Board.” See, e.g., *Opticians Association of America v. Independent Opticians of America Inc.*, 734 F. Supp. 1171, 14 USPQ2d 2021, 2029 (D.N.J. 1990) (“The power to stay a cancellation proceeding resides only in the Board itself.”) (citing *The Other Tel. Co. v. Conn. National Tel. Co.*, 181 USPQ 779, 782 (Comm’r 1974)), *rev’d on other grounds*, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990).

Where, as here, a party to an *inter partes* Cancellation Proceeding has seasonably interposed a motion that, potentially, is dispositive of the case, such as a motion to dismiss, the case is considered automatically suspended by operation of Title 37 C.F.R. § 2.127(d) with respect to all matters not germane to the motion. As explained in Note 9 to Section 510.01, TBMP:

MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69962, 69967 (Oct. 7, 2016) (“[A]n amendment to § 2.127(d) specifies that a case ‘is suspended’

when a party timely files a potentially dispositive motion."; "The Office is amending § 2.127(d) to clarify that a case is suspended when a party timely files any potentially dispositive motion."). (Citations omitted.)

Therefore, under the facts and circumstances here extant, the Board should treat the proceeding as if it had been suspended as of the filing date of the potentially dispositive motion. In addition, the time to Registrant's Answer should be tolled. It hardly seems necessary to add that neither party should file any paper that is not germane to the motion, except as otherwise may be specified by the Board in an issued order.

CONCLUSION

WHEREFORE, Registrant respectfully requests that the Board grant the Motion to Suspend Proceedings in the instant Cancellation Proceeding, said suspension to endure during the pendency of the Motion to Dismiss, which is a potentially dispositive motion and, upon the Board's consideration of the Motion to Dismiss, to grant the Registrant's said Motion to Dismiss, together with such other, further, and different relief as to the Board may seem just and proper.

Dated: Miami, FL
February 26, 2021

Respectfully submitted,

/Ira Cohen/
IRA COHEN, ESQ.

Counsel of Record for Registrant

CERTIFICATE OF SERVICE

On February 26, 2021, a copy of the foregoing Motion to Dismiss and Motion to Suspend Proceedings was sent by email to the following counsel of record for Petitioner.

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EXHIBIT 1



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Detail by Entity Name

Florida Limited Liability Company
BUNDLED AND COMPANY, LLC.

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