

ESTTA Tracking number: **ESTTA463981**

Filing date: **03/27/2012**

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

Proceeding	91203866
Party	Defendant 1-800-Flowers.com, Inc.
Correspondence Address	THOMAS M GALGANO GALGANO & ASSOCIATES PLLC 20 W PARK AVE STE 204 LONG BEACH, NY 11561-2019 UNITED STATES
Submission	Other Motions/Papers
Filer's Name	James W. Faris
Filer's e-mail	jfaris@ktslaw.com,jpowell@ktslaw.com,tmadmin@ktslaw.com,lcrumbley@ktslaw.com
Signature	/James W. Faris/
Date	03/27/2012
Attachments	Part 1.pdf (50 pages)(939065 bytes) Part 2.pdf (51 pages)(2641847 bytes) Part 3.pdf (55 pages)(273658 bytes)

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

EDIBLE ARRANGEMENTS, LLC)	Opposition No. 91203846
)	Mark: FRUIT BOUQUETS & Design
)	
)	Opposition No. 91203866
)	Mark: FRUIT BOUQUETS BY
Opposer,)	1800FLOWERS.COM & Design
)	
)	Opposition No. 91203868
)	Mark: FRUIT BOUQUETS & Design
)	
v.)	Opposition No. 91203873
)	Mark: FRUIT BOUQUETS.COM
)	& Design
)	
)	Opposition No. 91203891
1-800-FLOWERS.COM, INC.)	Mark: FRUIT BOUQUETS.COM
)	& Design
)	
)	Opposition No. 91203907
)	Mark: FRUIT BOUQUETS BY
Applicant.)	1800FLOWERS.COM & Design

**APPLICANT’S MOTION TO CONSOLIDATE OPPOSITION PROCEEDINGS AND
TO SUSPEND THE CONSOLIDATED OPPOSITION PROCEEDING**

Pursuant to Rule 42(a) of the Federal Rules of Civil Procedure, 37 C.F.R. § 2.104(b), and T.B.M.P § 511, Applicant 1-800-Flowers.com, Inc. (“Applicant”) hereby moves the Board to consolidate Opposition Nos. 91203846 (FRUIT BOUQUETS & Design), 91203866 (FRUIT BOUQUETS BY 1800FLOWERS.COM & Design), 91203868 (FRUIT BOUQUETS & Design), 91203873 (FRUIT BOUQUETS.COM & Design), 91203891 (FRUIT BOUQUETS.COM & Design), and 91203907 (FRUIT BOUQUETS BY 1800FLOWERS.COM & Design) (collectively, the “FRUIT BOUQUETS Oppositions”). Further, pursuant to 37 C.F.R. § 2.117(a) and T.B.M.P. § 510.02(a), Applicant moves the Board to suspend the consolidated opposition proceeding on the ground that Applicant and Opposer Edible Arrangements, LLC

(“Opposer”) are currently parties to a civil action initiated by Applicant in the United States District Court for the Eastern District of New York that will dispose of the issues raised in the FRUIT BOUQUETS Oppositions.

I. Applicant’s Motion to Consolidate the FRUIT BOUQUETS Oppositions

The Board has the discretion to consolidate opposition proceedings when the proceedings involve common questions of law or fact and when consolidation will result in savings of time, effort, and expense. Fed. R. Civ. P. 42(a); *see also* T.B.M.P. § 511 and authorities cited therein. In this case, consolidation is appropriate because the FRUIT BOUQUETS Oppositions involve identical parties and identical questions of law and fact, namely, whether Applicant’s marks—consisting of the phrase “FRUIT BOUQUETS” together with a distinctive stylized strawberry and vine design (collectively, Applicant’s “FRUIT BOUQUETS Marks”)—are likely to cause confusion with Opposer’s Registration Nos. 3429717 (BERRY BOUQUET), 3429718 (BERRY TREE BOUQUET), and 3869223 (DIPPEDFRUIT.COM & Design) (collectively, Opposer’s “BERRY Marks”). Indeed, the six notices of opposition filed by Opposer in connection with the FRUIT BOUQUETS Oppositions are identical, containing the same sixteen paragraphs. Consolidation is also appropriate because Applicant already has filed answers to each of the FRUIT BOUQUETS Oppositions. *See* T.B.M.P. § 511 (“Generally, the Board will not consider a motion to consolidate until an answer has been filed . . . in each case sought to be consolidated.”).

Accordingly, Opposer respectfully requests the Board to consolidate the FRUIT BOUQUETS Oppositions for purposes of both discovery and trial, and to reset a common schedule for discovery, testimony, and trial dates for the consolidated proceedings.

II. Applicant's Motion to Suspend the Consolidated Opposition Proceeding

In its FRUIT BOUQUETS Oppositions, Opposer alleges that Applicant's use and registration of Applicant's FRUIT BOUQUETS Marks are likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Applicant and Applicant's goods and services with Opposer and Opposer's goods and services offered under Opposer's BERRY Marks. Earlier today, on March 27, 2012, Applicant filed a civil action against Opposer in the United States District Court for the Eastern District of New York seeking declaratory judgment that its FRUIT BOUQUETS Marks do not infringe, deceive, or unfairly compete with Opposer's BERRY Marks under federal or state law. A copy of the Complaint filed in the case, captioned *1-800-Flowers.com, Inc. v. Edible Arrangements, LLC* (Civil Action No. 1:12-cv-1483) (the "Civil Action"), is attached as **Exhibit A**. Because the issues raised in the FRUIT BOUQUETS Oppositions are fully subsumed by the pending Civil Action, the FRUIT BOUQUETS Oppositions should be suspended in favor of the Civil Action.

The Board has the power to suspend proceedings in favor of a pending civil action pursuant to Trademark Rule 2.117(a), which 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.

37 C.F.R. § 2.117(a). Similarly, the Trademark Trial and Appeal Board Manual of Procedure provides that, "[o]rdinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding may have a bearing on the issues before the Board."

T.B.M.P. § 510.02(a) (3d ed. 2011).

The Board routinely exercises this power “in the interest of judicial economy and consistent with [its] inherent authority to regulate its own proceedings to avoid duplicating the effort of the court and the possibility of reaching an inconsistent conclusion.” *Soc’y of Mex. Am. Eng’rs & Scientists, Inc. v. GVR Pub. Relations Agency, Inc.*, Opp. No. 91121723, 2002 WL 31488947, at *4 (T.T.A.B. Nov. 6, 2001).¹ And suspension is appropriate where, as here, the Board proceeding commenced before the civil action. *See, e.g., Tokaido v. Honda Assocs., Inc.*, 179 U.S.P.Q. 861, 862 (T.T.A.B. 1973) (“[N]otwithstanding the fact that the Patent Office proceeding was the first to be filed, it is deemed to be the better policy to suspend proceedings herein until the civil suit has been finally concluded.”); *see also* McCarthy, *supra*, at § 32:47 (“An inter partes administrative proceeding may even be stayed when the court action was commenced after the commencement of the administrative proceeding.”).

The outcome of the Civil Action will conclusively and permanently resolve the issues presently before the Board in the FRUIT BOUQUETS Oppositions. The Civil Action is therefore the appropriate venue in which to resolve these issues, particularly because a final

¹ *See also* *Vais v. Vais Arms, Inc.*, Opp. No. 91154485, 2004 WL 390936, at *1 (T.T.A.B. Feb. 26, 2004) (“It is the policy of the Board to suspend proceedings pursuant to Trademark Rule 2.117(a) when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case.”); *Kearns-Tribune, LLC v. Salt Lake Tribune Publ’g Co., LLC*, Opp. No. 91151843, 2003 WL 22134916, at *3 (T.T.A.B. Sept. 11, 2003); *Gen. Motors Corp. v. Cadillac Club Fashions Inc.*, 22 U.S.P.Q.2d 1933, 1937 (T.T.A.B. 1992) (suspending cancellation proceeding where pending civil action requested cancellation of respondent’s trademark registrations); *Argo & Co. v. Carpetsheen Mfg., Inc.*, 187 U.S.P.Q. 366, 367 (T.T.A.B. 1975) (suspending opposition proceeding pending state court action between applicant and third party to determine ownership of applicant’s mark); *Townley Clothes, Inc. v. Goldring, Inc.*, 100 U.S.P.Q. 57, 58 (Comm’r Pat. & Trademarks 1953) (“[I]t would not seem to be in the interests of ‘judicial economy’ for the parties to proceed in two forums”); 6 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 32:47 (4th ed. 2010) (“It is standard procedure for the Trademark Board to stay administrative proceedings pending the outcome of court litigation between the same parties involving related issues.”); 1 Jeffery A. Handelman, *Guide to TTAB Practice* § 14.15(A) (2011) (“Generally, it is the Board’s practice to suspend a Board proceeding when there is a pending civil action or another Board proceeding which may be dispositive of, or have a bearing on, the proceeding proposed to be suspended.”).

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.