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

Mailed: November 3, 2017

Cancellation No. 92060579

adidas America, Inc.

v.

Robert M. Lyden

Geoffrey M. McNutt, Interlocutory Attorney:

This case is before the Board for consideration of the parties' respective submissions in response to the Board's July 17, 2017, order requiring them to inform the Board of the status of the civil action which occasioned the suspension of this proceeding. Respondent filed its initial response on August 15, 2017, and Petitioner filed its initial response on August 16, 2017. On August 16, 2017, Respondent filed two supplemental status reports, and on August 21, 2017, Petitioner filed a supplemental status report and a motion for entry of judgment based on the outcome of the civil action. In short, Respondent states that the civil action has not been finally determined, and thus further suspension of this Board proceeding is warranted. Petitioner, on the other hand, contends that the adjudication of the trademark claims in the civil action is final, and therefore this proceeding should be resumed for purposes of cancelling Respondent's involved registrations in accordance with the determination of the Court in the civil action.

1. Background

Respondent owns supplemental register Registration Nos. 3629011 and 3633365 for the marks shown below for "footwear" in International Class 25.

Supplemental Registration No. 3,629,011

Supplemental Registration No. 3,633,365

On December 22, 2014, Petitioner petitioned to cancel the involved registrations on the grounds of nonuse, fraud, and abandonment. Respondent, in its answer, denied the salient allegations in the petition for cancellation.

On May 7, 2015, the Board suspended this cancellation proceeding pending the final determination of the federal court action between the parties in the United States District Court for the District of Oregon, styled *Robert Lyden v. adidas America, Inc. et al.,* Case No. 3:14-cv-01586-MO. *See* 6 TTABVUE. The Board subsequently continued the suspension by order dated July 16, 2016. *See* 10 TTABVUE.

2. The Civil Action

The parties are in reverse positons in the civil action. As plaintiff in the civil action, Respondent, in its amended complaint for trademark and patent infringement, asserted claims of federal trademark infringement, federal unfair competition, unfair and deceptive trade practices and common law trademark infringement and unfair competition, based on the marks in Registration Nos.

3629011 and 3633365 *See* 5 TTABVUE 55–56 and 173–183. In addition to the trademark infringement and related unfair competition claims, Respondent also asserted four claims of patent infringement (claims 7–10). *Id*. at 64–78. Petitioner answered by denying the salient allegations in the amended complaint and asserting two counterclaims relating to Respondent's trademark and unfair competition claims, including a counterclaim for cancellation of Respondent's pleaded Registration Nos. 3629011 and 3633365 on grounds including that the marks in the supplemental registrations are functional. *Id*. at 129.

Petitioner subsequently moved for summary judgment on Respondent's trademark and related unfair competition claims and for partial summary judgment on Respondent's patent claims. *See* 12 TTABVUE 15.

On April 18, 2016, the District Court for the District of Oregon granted summary judgment to Petitioner on its counterclaim that Respondent's marks are functional as a matter of law. *See* 12 TTABVUE 19. The Court further granted Petitioner's motion for partial summary judgment on Respondent's claims of patent infringement of Respondent's U.S. Patent Nos. 6449878; 8959797; and D507094 (claims 7 and 9–10). *See* 12 TTABVUE 20 and 26. The Court thus dismissed with prejudice all four of Respondent's trademark and unfair competition claims (claims 1–4) and three of the four patent claims (claims 7 and 9–10). *Id*. at 26. However, the Court's summary judgment order did not address Respondent's eighth claim in the amended complaint, namely, Respondent's allegations of infringement of Patent No. 8209883. *See* Amended Complaint ¶¶ 208–221 (5 TTABVUE 68–70).

In a May 4, 2016, "Order Clarifying the Record," the Court further ordered and adjudged that:

> 1. The Court's Summary Judgment Order ... found [Respondent's] purported "Springblade" trademarks, as reflected in Supplemental Trademark Registration Nos. 3,629,011 and 3,633,365, to be functional as a matter of law.
>
> 2. Therefore, pursuant to 15 U.S.C. § 1119, ***Supplemental Trademark Registration Nos. 3,629,011 and 3,633,365 are hereby cancelled***.
>
> 3. For the reasons set forth in the SJ Order, summary judgment is granted in favor of [Petitioner] on their Second Counterclaim, and [Petitioner's] First Counterclaim is dismissed as moot.

12 TTABVUE 28 (emphasis added).

In an order dated June 30, 2016, the Court denied Respondent's motion for reconsideration of the Court's previous orders. *See* 14 TTABVUE 23.

Based on the forgoing Court orders, Petitioner asks the Board to resume proceedings and give effect to the Court's orders by cancelling involved Registration Nos. 3629011 and 3633365.

3. Analysis and Determination

Upon review of the Court's order, the Board cannot, without more information, cancel the involved registrations at this time.

As noted above, the Court's summary judgment order did not address Respondent's eighth claim, namely, Respondent's allegations of infringement of Patent No. 8209883.

With respect to judgment in an action involving multiple claims, Fed. R. Civ. P.

54(b) provides:

> When an action presents more than one claim for relief … the court may direct entry of a final judgment as to one or more, but fewer than all, claims or parties only if the court expressly determines that there is no just reason for delay. Otherwise, any order or other decision, however designated, that adjudicates fewer than all the claims or the rights and liabilities of fewer than all the parties does not end the action as to any of the claims or parties and may be revised at any time before the entry of a judgment adjudicating all the claims and all the parties' rights and liabilities.

Absent Rule 54(b) certification or special circumstances, orders granting partial summary judgment are not appealable final orders because they do not dispose of all claims and do not end the litigation on the merits.[1] *Service Employees Int'l Union, Local 102 v. County of San Diego*, 60 F.3d 1346, 1349 (9th Cir.1994) ("Partial summary judgment is not an inherently final order."); *Cheng v. Comm'r Internal Revenue Service*, 878 F.2d 306, 309 (9th Cir.1989) ("It is axiomatic that orders granting partial summary judgment, because they do not dispose of all claims, are not final appealable orders under [28 U.S.C. 1291]."). Here, the Court's summary judgment constitutes such an order. *See, e.g.*, *Chacon v. Babcock*, 640 F.2d 221, 222 (9th Cir. 1981) ("Without a Rule 54(b) certification, orders granting partial summary judgment are non-final."); *United States v. Desert Gold Min. Co.*, 433 F.2d 713, 715 (9th Cir. 1970); *Wynn v. Reconstr. Fin. Corp.*, 212 F.2d 953, 956 (9th Cir. 1954).

[1] Indeed, it is well-settled that a final judgment supersedes any prior orders that may be inconsistent with it. *See, e.g.*, *Southern California Darts Ass'n v. Zaffina*, 762 F.3d 921, 925 n.2 (9th Cir. 2014); *Glens Falls Ins. Co. v. Satree*, 320 F.2d 92, 95 (9th Cir. 1963).

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