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

Proceeding	92064898
Party	Defendant Converse Inc.
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Attachments	006952.00169 Converse Opposition to Walmart_s Motion to Suspend.pdf(213076 bytes) 006952.00169 Exhibit A - Motion in Limine.pdf(1750241 bytes) 006952.00169 Exhibit B - Initial Determination (public).pdf(2198099 bytes) 006952.00169 Exhibit C - Superstar Consent Judgment.pdf(270460 bytes) 006952.00169 Exhibit D - Autonomie Consent Judgment.pdf(92266 bytes)

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

In the Matter of Trademark Registrant
Converse Inc.

Mark:



Registration No.: 4,062,112

Registered: November 29, 2011

WAL-MART STORES, INC.,
Petitioner,

vs.

CONVERSE INC.
Registrant.

Cancellation No. 92064898

**REGISTRANT CONVERSE INC.'S RESPONSE IN OPPOSITION TO PETITIONER
WAL-MART STORES, INC.'S MOTION TO SUSPEND**

Registrant Converse Inc. (“Converse”) respectfully submits this Response in Opposition to Petitioner Wal-Mart Stores, Inc.’s (“Walmart’s”) Motion to Suspend the Proceeding.

I. INTRODUCTION

This proceeding relates to U.S. Trademark Registration No. 4,062,112 (“the ‘112 Registration”). Walmart requests suspension of this proceeding in view of a different proceeding that Converse filed against Walmart in the International Trade Commission (“ITC”), now on

appeal to the U.S. Court of Appeals for the Federal Circuit, involving a different trademark, U.S. Trademark Registration No. 4,398,753 (“the ‘753 Registration”). Converse did not and has not asserted the ‘112 Registration against Walmart.

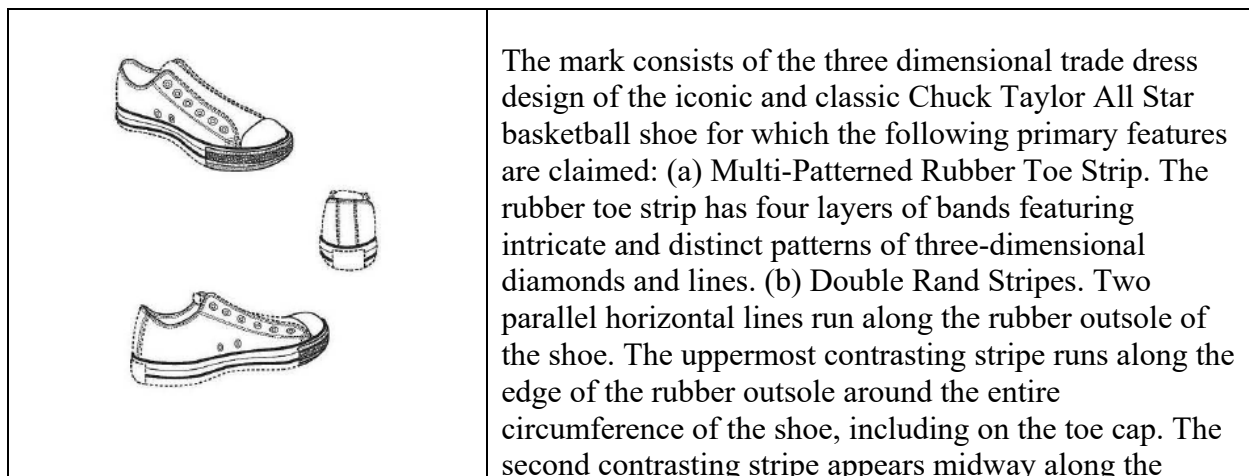
Converse requests that the Board deny Walmart’s Motion to Suspend because (1) the ‘112 Registration is not at issue in the ITC proceeding and Walmart itself argued to the ITC that evidence relating to the ‘112 Registration does not bear on the validity of the ‘753 Registration; (2) the Board is best situated to decide the relevant issues given its expertise in trademark law; and (3) a suspension will substantially prejudice Converse and potentially harm consumers because Converse has relied on the ‘112 Registration to protect consumers and prevent infringements, and continuing with this proceeding will not prejudice Walmart.

Accordingly, because Walmart has failed to show good cause for suspending the proceeding that it initiated, Converse respectfully requests that the Board exercise its discretion and deny the Motion to Suspend.

II. BACKGROUND

The Trademark Office issued the ‘112 Registration to Converse on November 29, 2011, for the mark shown and described below:

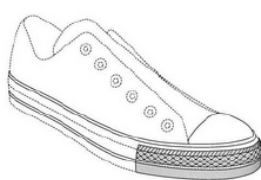
Figure 1: The ‘112 Registration



	<p>rubber outsole and runs from the front edge of the license plate heel tab to the back edge of the rubber toe bumper. (c) Brushed Metal Grommets in Medial Side Arch. Two round brushed steel grommets are placed in a horizontal line above the inside medial arch of the shoe. (d) Brushed Metal Eystay Grommets. A series of equally-spaced wide, round brushed metal eystay grommets are part of the lacing system instead of hooks, loops, D-rings, or other holding and lacing mechanisms. (e) Convex Rubber Toe Cap. A raised, protruding rubber toe cap. (f) Double Stitching and Box-Like Stitch Along the Upper. The matter shown in broken lines, namely, the license plate heel tab as well as the outline of the shoe along the upper, the tongue, the back edge, the rear panel, and the sole are not part of the mark. The broken lines serve only to show the position or placement of the primary features of the trade dress. The dashed lines indicating the Double Stitching and Box-Like Stitch Along the Upper are part of the mark.</p>
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The Trademark Office issued the ‘753 Registration to Converse on September 10, 2013, for the mark shown and described below:

Figure 2: The ‘753 Registration

	<p>The mark consists of the design of the two stripes on the midsole of the shoe, the design of the toe cap, the design of the multi-layered toe bumper featuring diamonds and line patterns, and the relative position of these elements to each other. The broken lines show the position of the mark and are not claimed as part of the mark.</p>
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Thus, although the ‘112 and ‘753 Registrations relate to the product configuration of Converse’s Chuck Taylor All Star shoes (“All Star” shoes), they are for different trademarks. Converse did not and has not asserted the ‘112 Registration against Walmart. Nevertheless, Walmart filed a Petition to Cancel the ‘112 Registration, alleging it is or will be damaged by the ‘112 Registration because Converse asserted the ‘753 Registration against Walmart in the ITC,

In re Certain Footwear Products, Inv. No. 337-TA-936, now on appeal to the Federal Circuit, No. 2016-2497. (Pet. ¶ 5.)

III. ARGUMENT

Suspension of a cancellation proceeding pending termination of a civil action is not mandatory; rather, it “is solely within the discretion of the Board.” TBMP § 510.02(a); *see also Jodi Kristopher Inc. v. Int’l Seaway Trading Corp.*, 91 U.S.P.Q.2d 1957, 2009 WL 3154232, at *2 (T.T.A.B. Jan. 30, 2009) (denying the petitioner’s motion to suspend). To that end, “[a]ll motions to suspend, regardless of circumstances . . . are subject to the ‘good cause’ standard. ‘[B]oth the permissive language of Trademark Rule 2.117(a) . . . and the explicit provisions of Trademark Rule 2.117(b) make clear that suspension is not the necessary result in all cases.’” *Jodi*, 2009 WL 3154232, at *2 (citations omitted). Among the issues the Board considers in deciding whether to suspend a proceeding is whether a pending civil action involves issues in common with the proceeding before the Board because the decision of a federal district court may be binding on the Board. TBMP § 510.02(a).

Walmart has not established “good cause” for suspending this proceeding. First, while it now argues that the Federal Circuit’s decision as to the ‘753 Registration has a bearing on this proceeding, Walmart took the opposite position in the ITC proceeding. Indeed, Walmart repeatedly argued that evidence relating to marks other than the ‘753 Registration, *e.g.*, the ‘112 Registration, was “irrelevant, inadmissible and/or entitled to zero weight” in assessing validity of the ‘753 Registration (*see* Figure 3 below). (Ex. A at 2, 2 n.2, motion *in limine*.) For example, Walmart and the other Respondents in the ITC proceeding filed a motion *in limine* seeking to exclude survey evidence on the grounds that the evidence did not relate to the specific elements at issue in the ‘753 Registration, but instead related to additional elements of All Star shoes, such

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