

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Lykos

Mailed: February 21, 2007

Opposition No. 91174198

Debbie, LLC, and Bicon, LLC

v.

Implant Innovations, Inc.

Angela Lykos, Interlocutory Attorney

This case now comes up for consideration of applicant's motion (filed January 5, 2005) to suspend proceedings. The motion is fully briefed.¹

By way of background, applicant seeks to register the mark NANOTITE for "dental implants, dental implant abutments and parts and fittings therefore" in International Class 10.² Opposers have opposed registration on the grounds that applicant's applied-for mark so resemble opposers' previously used NANOTITE mark for the identical goods that it is likely to cause confusion, mistake, or deceive prospective consumers under Section 2(d) of the Lanham Act. In the notice of opposition, opposers pleaded ownership of

¹ Applicant has submitted a reply brief which the Board has considered because it clarifies the issues herein. Consideration of a reply brief is discretionary on the part of the Board. See Trademark Rule 2.127(a).

pending Application Serial No. 76665445 for the mark NANOTITE for "dental implants, abutments for dental implants" in International Class 10.³ The notice of opposition also alleges in relevant part that "on September 26, 2006, applicant filed suit against opposers and opposers' related companies in the United States District Court for the Southern District of Florida for trademark infringement and related claims alleging Opposers' use of NANOTITE trademark infringes applicant's rights."⁴

Applicant, in lieu of filing an answer, filed a motion to suspend proceedings arguing that the civil litigation will have a bearing on the instant opposition insofar as the central issue in both cases is which party has priority. In support of its motion to suspend, applicant has submitted a copy of the civil action complaint and answer. In the complaint applicant, acting as plaintiff in the civil action, alleges that it owns and has used a family of TITE marks for use in connection with dental implants and products; that as a further extension of its family of marks, it filed an application to register the NANOTITE mark with the USPTO; and that opposers' did not use the mark

² Application Serial No. 78876594, filed May 4, 2006, alleging a bona fide intent to use the mark in commerce.

³ Filed August 31, 2006, alleging May 1, 2006 as the date of first used anywhere and May 2, 2006 as the date of first use in commerce.

⁴ Civil Action No. 06-80913.

NANOTITE in print advertising or on their website prior to the filing date of applicant's application before the USPTO. The complaint asserts claims of trademark infringement, false designation of origin and unfair competition, and various violations under state law, arising from opposers' purported misappropriation of the NANOTITE mark. Applicant has requested various forms of relief, including that opposers be permanently enjoined from using the mark NANOTITE.

Opposers have submitted with their responsive brief an amended complaint in the civil litigation. In the amended pleading, in addition to the other relief previously requested, applicant requests that the present opposition proceeding be dismissed and that applicant's pending application be permitted to move forward to registration. Opposers argue that the district court lacks the requisite jurisdiction to determine applicant's right to obtain a registration because Section 37 of the Lanham Act restricts a district court's power to determine questions of registrability to those actions involving a registered mark.

In reply, applicant argues that opposers, in their answer to applicant's amended pleading, seek a permanent injunction prohibiting applicant from using the NANOTITE mark. Applicant also contends that contrary to opposers' assertions, federal courts have the jurisdiction to decide

issues of priority and the registrability of pending applications.

With regard to suspension of a Board proceeding pending other litigation, Trademark Rule 2.117(a) provides as follows:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that parties to a pending case are engaged in a civil action which may be dispositive of the case, proceedings before the Board may be suspended until determination of the civil action.

Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board. *See Martin Beverage Co., Inc. v. Colita Beverage Corp.*, 169 USPQ 568 (TTAB 1971). To the extent that a civil action in a federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the Board, while the decision of the Board is not binding upon the court. *See, for example, Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir.1988); and TBMP § 510.02(a).

After carefully considering the parties' arguments, as well as reviewing the pleadings in the civil action submitted by respondent, the Board finds that the civil action may have a bearing on the cancellation proceeding herein. Indeed, the relief requested by opposers and

applicant in the civil suit, that the adverse party be permanently enjoined from using the NANOTITE mark, clearly may have a bearing on our determination. In addition, whether opposers are correct that a federal court lacks jurisdiction under Section 37 to order dismissal of the instant opposition proceeding does not affect our decision to suspend proceedings.⁵ In this matter, the crux of both the civil litigation and the instant opposition is the determination of which party has prior rights in the NANOTITE mark. While there are instances in which a federal court's findings concerning priority are not binding upon the Board for purposes of an opposition proceeding (*see e.g. Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840 (TTAB 1995)), in this particular case, we cannot make that determination until the federal court has rendered a decision. Hence, the civil action may indeed have a bearing on this proceeding.

Accordingly, proceedings herein are suspended pending disposition of the civil action between the parties.

⁵ In *In re Fortex Industries, Inc.*, 18 USPQ2d 1224 (TTAB 1991), the Commissioner stated that a federal court's authority to determine the right to register a mark, while not expressly provided for in Section 37, may be implied.

Within twenty days after the final determination of the civil action, the interested party should notify the Board so that this case may be called up for appropriate action.⁶

⁶ During the suspension period the Board should be notified of any address changes for the parties or their attorneys.

A "final determination" refers to the expiration of an appeal period with no appeal being taken, or the exhaustion of the appeal process available. See TBMP § 510.02(b).