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

Proceeding	91194358
Party	Defendant Jeffrey Pancer
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Submission	Motion to Suspend for Civil Action
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In Re Application: 76/621097
Filed: November 17, 2004
Published: December 1, 2009
For: COMEDY HALL OF FAME

COMEDY HALL OF FAME, INC.)	
)	
Opposer,)	Opposition No. 91194358
v.)	
)	
JEFFREY PANCER)	
)	
Applicant.)	
)	

MOTION TO SUSPEND THE PROCEEDING

Pursuant to 37 C.F.R. § 2.117(a) and TBMP § 510.02(a), Applicant, Jeffrey Pancer, through his undersigned counsel, hereby requests that the Trademark Trial and Appeal Board (“TTAB” or “Board”) suspend this Opposition pending the final determination of *CHF PRODUCTIONS LLC D/B/A COMEDY HALL OF FAME, COMEDY HALL OF FAME FOUNDATION, and JEFFREY PANCER v. NATIONAL COMEDY HALL OF FAME, INC.* Case No. 12 CIV 2986 (“Civil Action”), which is pending between the parties before the United States District Court for the Southern District of New York, and involves the same trademark applications and registrations at issue in the instant proceeding because the Civil Action will have a direct bearing on this proceeding.

FACTUAL BACKGROUND

Applicant has applied for the mark COMEDY HALL OF FAME based on its intent to use of the mark in commerce in connection with “Television programming; live music concerts, live performances by a musical band and live, televised appearances by a

professional entertainer.” See US Ser. No. 76/621097 (“the Opposed Application”). In addition, Applicant has other pending trademark applications with the US Patent and Trademark Office for the same and similar marks covering additional goods and services, such as “production services, namely movie and television film production”; and “apparel, namely shirts and jackets”. Opposer has opposed the Opposed Application based on its claimed prior use of a confusingly similar mark. Further, Applicant expects that Opposer will oppose or otherwise interfere with Applicant’s use of the mark COMEDY HALL OF FAME in connection with the additional goods and services as detailed in Applicant’s additional US trademark applications. To prevent the on-going interference with Applicant’s claims of trademark rights, including the right to use those marks in interstate commerce which Congress can regulate and Applicant’s rights to register its marks on the Principal Registry of the U.S. Patent and Trademark Office, Applicant has now initiated a Civil Action against Opposer seeking (a) declaratory judgment of non-infringement of its trademarks with respect to any trademark claim Opposer may have against Applicant, as well as (b) damages and injunctive relief for false and deceptive advertising. See Attachment 1 hereto. The United States District Court for the Southern District of New York (the “District Court” or “Court”) will necessarily need to resolve all of the issues before the Board in this Opposition in the disposition of the Civil Action.

ARGUMENT

Where a party to a case pending before the Board is also involved in a civil action that may have a bearing on the TTAB matter, the Board may suspend the proceeding until the final determination of the civil action. 37 C.F.R. § 2.117(a); TBMP §510.02(a). This is because a decision by the United States District Court would be binding on the Patent and

Trademark Office whereas a determination by the Patent and Trademark Office as to a party's right to registration would not be binding or *res judicata* in respect to the proceeding before the federal district court. See, e.g., J. Thomas McCarthy, 6 *McCarthy on Trademarks and Unfair Competition* § 32:94 (4th Ed. 2009).

Applicant and Opposer are both parties to the Civil Action, which is current pending before the District Court, and Applicant asserts legal claims against Opposer which relate directly to the claims raised in the instant proceeding. The District Court's determinations in the Civil Action will directly affect the resolution of the issues currently before the Board. For example, the District Court will have to determine (a) whether Opposer has any material rights in the mark COMEDY HALL OF FAME that would prevent Applicant's registration and use of the term as part of its mark; and (b) if so, whether Applicant or Opposer has priority to the mark to determine infringement and/or non-infringement. Further, the District Court will also have to determine whether the marks of Opposer on which the Opposition is based are confusingly similar to Applicant's mark that is the subject of the Opposition. These are the same determinations that the Board will need to make here.

Based on the foregoing, Applicant respectfully requests that the Board suspend this proceeding pending the final determination of the Civil Action.

Respectfully submitted,

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COUNSEL TO JEFFREY PANCER.

DATED: MAY 11, 2012

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of Jeffrey Pancer's MOTION TO SUSPEND THE PROCEEDING was served by electronic mail and First Class Mail, postage prepaid, on this 11th day of May 2012 on the following:

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