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

Proceeding	91196503
Party	Plaintiff Resident Artist Studio, LLC
Correspondence Address	A. Sidney Johnston Cesari and McKenna, LLP 88 Black Falcon Avenue Suite 271 Boston, MA 02210 UNITED STATES ASJ@c-m.com, KTG@c-m.com, kristin@c-m.com
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**

_____)	
Resident Artist Studio, LLC,)	In re App. Ser. No. 77947865
Opposer,)	Mark: EYE-PAL
v.)	Filing Date: March 1, 2010
ABiSee, Inc.,)	Publ'n Date: July 20, 2010
Applicant.)	Opposition No.: 91196503
_____)	

OPPOSER'S MOTION TO SUSPEND

Opposer, Resident Artist Studio, LLC ("RAS"), by its undersigned counsel, hereby moves pursuant to Trademark Rule 2.117(a) (37 C.F.R. §2.117(a)) and Trademark Board Manual of Procedure ("TBMP") § 510.02(a) that the Board suspend proceedings in the above-captioned opposition pending the disposition of a civil action between the same parties which may have a bearing on the case, and may raise substantially the same issues of fact and law. As grounds for this motion, RAS states as follows.

FACTS

On February 17, 2010, RAS filed a civil action in the United States District Court for the District of Massachusetts, which is captioned *Resident Artist Studio, LLC v. ABiSee, Inc.*, 10-cv-10268DPW asserting that ABiSee, Inc. ("ABiSee") has infringed RAS's EYE PAL mark (the "Massachusetts Civil Action"). A copy of the Complaint in the Massachusetts Civil Action is attached hereto as Exhibit A. A review of RAS's Complaint shows that the Massachusetts Civil Action involves identical issues currently before the Board in the instant proceeding.

On March 1, 2010 ABiSee filed an application for Registration of its alleged mark EYE-PAL in International Class 009 [IC 009]. RAS filed the above captioned Opposition to ABiSee's application for Registration of its alleged mark EYE-PAL on September 17, 2010. In its Opposition, RAS alleges that ABiSee has no right to registration of its alleged mark EYE-PAL because it is substantially similar to RAS's Registered Mark EYE PAL, and that:

“The likelihood of confusion among customers is high in this case because both goods are directed to the same group of the public, those needing vision enhancement, and both goods are sold through similar trade channels such as the internet. Further, actual confusion between the goods of Opposer and of Applicant have occurred. Customers of Opposer have already been actually confused by Applicant's use of its proposed mark EYE-PAL, and have complained to Opposer that they were unable to find Opposer on the internet because of a clutter of web pages arising from Applicant's presence on the internet using the proposed mark EYE- PAL. Also, at least one customer of Applicant contacted Opposer for help with his product purchased from Applicant. Accordingly, Applicant's Proposed Trademark is thus unregistrable under §2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d), as amended.”

See Notice of Opposition, p. 4.

In a related proceeding, on June 1, 2010 ABiSee filed an Opposition to RAS's Application for its mark EYE PAL in IC 009, Serial No. 77/829,909. See Opposition No. 91195183. On August 17, 2010, RAS filed a motion to suspend the opposition proceeding pending the final disposition of the Massachusetts Civil Action. A hearing in Opposition 91195183 was held on September 23, 2010 where the Board granted RAS's motion to suspend. A copy of the Order granting RAS's Motion to Suspend is attached hereto as Exhibit B.

ARGUMENT

Where a party to a case before the Board is also involved in a civil action that may have a bearing on the T.T.A.B. matter, the Board may suspend the proceeding until the final determination of the civil action. 37 CFR § 2.117(a); TBMP § 510.02(a). It is the policy of the Board to suspend administrative proceedings such as this, pending the outcome of a civil action between the same parties involving related issues. *See Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685 (C.C.P.A. 1961); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805, 1971 WL 16554 (TTAB 1971)). “The only question for determination [by the Board], therefore, is whether the outcome of the civil action will have a bearing on the issues involved in the opposition proceeding.” *The Other Tel. Co. v. Conn. Nat’l Tel. Co.*, 181 U.S.P.Q 125, 126-27 (T.T.A.B. 1974). Furthermore, the TBMP states that: “[o]rdinarily, the Board will suspend proceedings in the case before it if a final determination of the other proceedings will have a bearing on the issues before the Board.” *See* TBMP §510.02(a); *see also Toro Co. v. Hardigg Indus., Inc.*, 187 U.S.P.Q. 689 (TTAB 1975).

The rationale for suspension is that a court’s determination is binding on the Board, whereas the Board’s decision is not binding on the court. *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir.1988); *American Bakeries Co. v. Pan- O-Gold Baking Co.*, 650 F Supp 563, 2 USPQ2d 1208 (D. Minn. 1986); *see also* Trademark Trial & App. Board Prac. & Proc. §325.

Suspension of this proceeding pending outcome of the Massachusetts Civil Action is proper because the District Court’s decision in that action “will have a bearing on the

issues before the Board.” *See* 37 CFR 2.117(a) and TBMP §510.02(a). In fact, both proceedings involve identical parties, involve the same disputed issues, namely the validity of ABiSee’s Application Ser. No. 77/947,865.

The District Court’s decision in the Massachusetts Civil Action will therefore be dispositive. Where the decision by the court will be dispositive of the issues before the Board, a “motion to suspend is well taken.” *See General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992); *see also Society of Mexican Am. Engineers and Scientists, Inc. v. GVR Public Relations Agency, Inc.*, 2002 WL 31488947, at *4 (TTAB Nov. 6, 2002)(suspending proceedings “where in the interest of judicial economy and consistent with the Board’s inherent authority to regulate its own proceedings to avoid duplicating the effort of the court and the possibility of reaching an inconsistent conclusion”); *Martin Beverage Co. Inc. v. Colita Beverage Company.*, 169 USPQ 568, 570 (TTAB 1971)(stating that suspension of a Board case is appropriate even if the civil case may not be dispositive of the Board case, so long as the ruling will have a bearing on the rights of the parties in the Board case). Since this opposition seeks to address the same claims that are set forth in the Massachusetts Civil Action, this opposition proceeding should be suspended, pending the outcome of the Civil Action.

Finally, it makes sense to suspend all proceedings herein because the District Court Action has progressed further:

- On February 17, 2010, RAS filed its Complaint;
- On May 12, 2010, RAS filed its First Amended Complaint;
- On June 3, 2010, ABiSee filed its Answer and Counterclaims;

- On June 3, 2010, ABiSee filed a Motion to Dismiss Federal Trademark Dilution Claim;
- On June 8, 2010 ABiSee filed a Motion to Disqualify Counsel for Resident Artist Studio;
- On June 16, 2010, RAS filed its Response to ABiSee's Motion to Dismiss Federal Trademark Dilution Claim;
- On June 23, 2010, RAS filed its Answer to ABiSee's Counterclaim;
- On June 23, 2010, RAS filed its Opposition to ABiSee's Motion to Disqualify;
- Scheduling Conference/Hearing on Motion to Disqualify was held on July 8, 2010;
- On July 15, 2010, the Court issued its Scheduling Order;
- On July 22, 2010 RAS served its Initial Disclosures, First Set of Interrogatories and First Request for the Production of Documents and Things;
- On July 22, 2010 ABiSee served its Initial Disclosures;
- On August 24, 2010, ABiSee served its Responses to RAS's First Set of Interrogatories and First Request for the Production of Documents and Things;
- On September 10, 2010 ABiSee served its First Set of Interrogatories, First Set of Requests for Production of Documents and Things and its First Set of Requests for Admissions.

RELIEF REQUESTED

For all the foregoing reasons, Resident Artist Studio, LLC respectfully prays that this Board suspend all proceedings herein, pending the disposition of the previously filed civil action in the United States District Court for the District of Massachusetts.

Dated: September 27, 2010

RESIDENT ARTIST STUDIO, LLC

By: /A. Sidney Johnston/
A. Sidney Johnston
Thomas C. O'Konski
Kevin Gannon
CESARI and MCKENNA, LLP
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CERTIFICATE OF SERVICE

I hereby certify that the foregoing pleading was served by e-mail to the e-mail address gkrakau@mbbp.com and by first-class mail postage prepaid on September 27, 2010 to:

Gregory M. Krakau
Morse, Barnes-Brown & Pendleton, PC
Reservoir Place
1601 Trapelo Road, Suite 205
Waltham, MA 02451 USA

/A. Sidney Johnston/
A. Sidney Johnston

EXHIBIT A

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

RESIDENT ARTIST STUDIO, LLC,
a Massachusetts limited liability company,

Plaintiff

v.

ABISEE, INC.,
a Massachusetts corporation

Defendant

COMPLAINT FOR TRADEMARK
INFRINGEMENT, TRADEMARK
DILUTION, FALSE
DESIGNATION OF ORIGIN, AND
UNFAIR COMPETITION
WITH JURY DEMAND

Plaintiff, Resident Artist Studio, LLC ("Resident Artist"), as and for its Complaint against Defendant, ABiSee, Inc. ("ABiSee"), alleges as follows:

1. This action arises from the unauthorized adoption and use of the mark or designation EYE PAL by ABiSee in connection with a vision-related product. Resident Artist is the prior user and exclusive owner of the trademark EYE PAL for vision-related products, including gun sights for firearms, optical lenses, optical lenses to improve vision, optical pinhole lenses, optical pinhole devices to improve impaired vision and optical pinhole devices to improve "depth of field".

2. By using the mark or designation EYE PAL in connection with one of its vision-related products, ABiSee has caused, and is likely to cause, confusion, mistake and deception with regard to whether Resident Artist is the source or sponsor of ABiSee's product, or whether there is an association between Resident Artist and ABiSee, when in fact there is none. In addition, ABiSee's acts are causing, and are likely to cause, dilution of Resident Artist's EYE

PAL® trademark. Consequently, Resident Artist seeks injunctive relief and damages under the federal Lanham Act (15 U.S.C. § 1051 et seq.), the Massachusetts Consumer Protection Act (M.G.L.A. c. 93A) and the common law doctrine of unfair competition.

I. JURISDICTION AND VENUE

3. The Court has personal jurisdiction over ABiSee because it conducts business in this judicial district, and resides within this judicial district.

4. This Court has jurisdiction over the subject matter of this action pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1332, 1338 and 1367. The Court has jurisdiction over the state law claims pursuant to 28 U.S.C. §§ 1332, 1338(b) and 1367.

5. Venue lies in this judicial district pursuant to 28 U.S.C. § 1391(b) and (c). ABiSee resides in this judicial district, transacts and has transacted business in this judicial district and may otherwise be found here, and a substantial part of the acts giving rise to Resident Artist's claims herein were performed in this judicial district.

II. THE PARTIES

6. Plaintiff, Resident Artist, is a limited liability company organized and existing under the laws of the Commonwealth of Massachusetts with a principal place of business at 438 Hill Road, Boxborough, Massachusetts 01719.

7. Upon information and belief, Defendant, ABiSee, is a corporation organized and existing under the laws of the Commonwealth of Massachusetts with a principal place of business at 77 Powdermill Road, Acton, Massachusetts 01720.

III. PLAINTIFF'S BUSINESS AND MARKS

8. Since at least November 19, 2005, Plaintiff, Resident Artist, has been in the business of manufacturing and selling a vision-related product under the trademark and

designation EYE PAL. The product is an optical pinhole lens that can be semipermanently attached to a user's eyeglasses to improve the user's ability to view or sight remote objects.

9. Early on, the EYE PAL product was sold, and used by Resident Artist's customers, primarily to improve vision or sighting of a firearm during shooting. As time went on, however, the EYE PAL's product's usefulness in a wide variety of other sighting, reading, vision-enhancing applications became apparent. The EYE PAL is currently promoted and sold by Resident Artist for use in these myriad applications.

10. Resident Artist is the owner of U.S. Trademark Registration No. 3,542,503 for the mark EYE PAL for use in connection with gun sights for firearms. This registration, duly and legally issued by the United States Patent and Trademark Office ("PTO") on December 9, 2008 is valid and subsisting, and pursuant to 15 U.S.C. § 1057(b), is prima facie evidence of Resident Artist's ownership of the mark EYE PAL and exclusive right to use the mark EYE PAL on the goods recited therein and on goods substantially similar thereto.

11. Resident Artist is also the owner of U.S. Trademark Application No. 77/829,909 filed with the PTO on September 18, 2009 and amended on January 26, 2010 for the mark EYE PAL for use in connection with optical lens, optical lens to improve vision, optical pinhole lens, optical pinhole lens to improve impaired vision, optical pinhole lens to improve "depth of field" of vision.

12. Since at least November 19, 2005, Resident Artist has advertised its EYE PAL product in trade publications, at gun shows and over the Internet. Resident Artist is the owner of the Internet domain name www.eyepalUSA.com which can be accessed by the public worldwide and through which Resident Artist's product can be purchased.

13. The mark EYE PAL is a particularly strong mark because of its uniqueness and distinctiveness, and a valuable asset of Resident Artist. On information and belief, the mark EYE PAL has acquired status as a "famous" mark for purposes of 15 U.S.C. § 1125(c)(1) in the firearm sighting industry and in related vision-enhancing industries.

IV. ABISEE'S BUSINESS AND WRONGFUL ACTS

14. ABiSee sells vision-related products that assist blind or visually-challenged individuals in reading documents, texts and other printed or graphic material by converting the printed or graphic material into audio.

15. In 2008, on information and belief, ABiSee introduced a reader product under the trademark or designation EYE PAL. ABiSee's EYE PAL reader product includes a camera having an optical lens and light source for scanning the material to be read, and a processor for converting the scanned material into an audio signal for playback to the user.

16. In 2008, on information and belief, ABiSee introduced a reader product under the trademark or designation EYE PAL. ABiSee's EYE PAL reader product includes a camera having an optical pinhole lens and light source for scanning the material to be read, and a processor for converting the scanned material into an audio signal for playback to the user.

17. ABiSee prominently displayed the EYE PAL mark or designation on its website and in its printed literature with a symbol, to wit, ®, falsely indicating that ABiSee owned a federal trademark registration for the mark.

18. After learning of ABiSee's use of the mark or designation EYE PAL, Resident Artist, through its counsel, contacted ABiSee and requested that ABiSee discontinue its use of the same. Despite this and other attempts by Resident Artist to resolve this dispute amicably,

ABiSee has persisted in using the EYE PAL mark or designation, leaving Resident Artist with no choice but to commence this action.

**FIRST CAUSE OF ACTION TRADEMARK INFRINGEMENT
(15 U.S.C. § 1114)**

19. Resident Artist realleges and incorporates herein by reference the allegations in Paragraphs 1 through 18 of this Complaint.

20. On information and belief, ABiSee was aware of Resident Artist's business and use of its EYE PAL trademark prior to ABiSee's adoption and use of the EYE PAL mark or designation for its vision-related product.

21. On information and belief, ABiSee either had actual notice, or had constructive notice, of Resident Artist's ownership and registration of the EYE PAL trademark pursuant to 15 U.S.C. § 1072 prior to ABiSee's adoption and use of the EYE PAL mark or designation for its vision-related product.

22. ABiSee is using the EYE PAL mark or designation in connection with its vision-related product without Resident Artist's consent and with knowledge of Resident Artist's rights.

23. ABiSee's unauthorized adoption and use of the EYE PAL mark or designation falsely indicates to consumers that ABiSee's product is in some manner connected with, sponsored by, affiliated with or related to Resident Artist or its vision-related product.

24. ABiSee's unauthorized adoption and use of the EYE PAL mark or designation has caused actual confusion, and is also likely to cause confusion, among consumers as to the source, nature and quality of the goods offered by the respective parties. A customer of ABiSee contacted Resident Artist by e-mail seeking help with the ABiSee reader product sold using

Resident Artist's trademark EYE PAL. Numerous customers of Resident Artist have stated that they searched the Internet for its trademark EYE PAL and found only ABiSee's webpage.

25. ABiSee's unauthorized adoption and use of the EYE PAL mark or designation allows, and will continue to allow, ABiSee to receive the benefit of the good will established at great labor and expense by Resident Artist in the unique and distinctive trademark EYE PAL.

26. ABiSee's unauthorized adoption and use of the EYE PAL mark or designation deprives Resident Artist of the ability to control the consumer perception of the quality of its goods, and places Resident Artist's valuable reputation and good will in connection with the trademark EYE PAL in the hands of ABiSee, over which Resident Artist has no control.

27. ABiSee is likely to cause further confusion, or to cause mistake, or to deceive consumers or potential consumers in violation of 15 U.S.C. § 1114.

28. Resident Artist has been, is now, and will be irreparably harmed by ABiSee's trademark infringement, and unless enjoined by the Court, Resident Artist will suffer further harm for which Resident Artist has no adequate remedy at law.

**SECOND CAUSE OF ACTION FEDERAL TRADEMARK DILUTION
(15 U.S.C. § 1125(c))**

29. Resident Artist realleges and incorporates herein by reference the allegations of paragraphs 1-28 of this Complaint.

30. On information and belief, because of its uniqueness and distinctiveness, Resident Artist's EYE PAL trademark is a "famous" mark that is widely recognized by consumers in the firearm sighting industry and other vision-related industries.

31. ABiSee's unauthorized adoption and use of the EYE PAL mark or designation has, and will continue to have, an adverse effect upon the value and distinctive quality of the

EYE PAL trademark. ABiSee's acts blur and erode the distinctiveness and source-identifying quality of the EYE PAL trademark, diluting the trademark in violation of 15 U.S.C. § 1125(c).

32. Resident Artist has been, is now and will be irreparably harmed by ABiSee's aforementioned acts, and unless enjoined by the Court, Resident Artist will suffer further harm for which Resident Artist has no adequate remedy at law.

**THIRD CAUSE OF ACTION FALSE DESIGNATION OF ORIGIN AND
MISREPRESENTATION OF FACT
(15 U.S.C. § 1125(a))**

33. Resident Artist realleges and incorporates herein by reference the allegations in paragraphs 1-32 of this Complaint.

34. ABiSee's unauthorized adoption and use of the EYE PAL mark or designation falsely suggests that its vision-related product is connected with, sponsored by, affiliated with or related to Resident Artist or its vision-related product, and constitutes a false designation of origin in violation of 15 U.S.C. § 1125(a).

35. ABiSee's wrongful use of the symbol ® in association with the mark or designation EYE PAL constitutes a false or misleading description or representation of fact in violation of 15 U.S.C. § 1125(a).

36. Resident Artist has been, is now and will be irreparably harmed by ABiSee's aforementioned acts, and unless enjoined by the Court, Resident Artist will suffer further harm for which Resident Artist has no adequate remedy at law.

**FOURTH CAUSE OF ACTION UNFAIR AND DECEPTIVE ACTS
IN VIOLATION OF MASSACHUSETTS LAW
(M.G.L.A. c. 93(a))**

37. Resident Artist realleges and incorporates herein by reference the allegations in paragraphs 1-36 of this Complaint.

38. At all times relevant hereto and in regard to the acts alleged herein, Resident Artist and ABiSee were engaged in trade or commerce primarily and substantially within the Commonwealth of Massachusetts.

39. ABiSee's unauthorized adoption and use of the EYE PAL mark or designation, and false marking of the mark or designation with the symbol @ , constitute unfair or deceptive acts or practices within the meaning of M.G.L.A. c. 93(a), § 2.

40. ABiSee's acts described herein were performed willfully and knowingly.

41. As a result of the above-described unfair acts and practices, Resident Artist has sustained injury.

FIFTH CAUSE OF ACTION COMMON LAW UNFAIR COMPETITION

42. Resident Artist realleges and incorporates herein by reference the allegations in paragraphs 1-41 of this Complaint.

43. ABiSee's unauthorized adoption and use of the EYE PAL mark or designation, and false marking of the mark or designation with the symbol @, constitute unfair competition in violation of the common law of Massachusetts.

44. ABiSee's wrongful acts have caused and will continue to cause Resident Artist irreparable harm for which it has no adequate remedy at law.

PRAYER FOR RELIEF

WHEREFORE, Resident Artist prays for relief as follows:

1. Entry of an order and judgment requiring that ABiSee and its officers, agents, servants, employees, owners and representatives, and all other persons in active concert or participation with it, be enjoined and restrained from (a) using in any manner the EYE PAL trademark, or any designation, mark or domain name that incorporates the EYE PAL trademark or is confusingly similar to or colorable imitation of the trademark, (b) doing any act or thing calculated or likely to cause confusion or mistake in the minds of members of the public, or prospective customers of Resident Artist's products, as to the source of the products, or likely to deceive members of the public, or prospective customers, into believing that there is some connection between ABiSee and Resident Artist, and (c) committing any acts which will tarnish, blur or dilute or are likely to tarnish, blur or dilute the distinctive quality of the EYE PAL trademark;

2. A judgment ordering ABiSee, pursuant to 15 U.S.C. § 1116(a), to file with this Court and serve upon Resident Artist thirty (30) days after entry of the injunction, a report writing under oath setting forth in detail the manner and form in which ABiSee has complied with the injunction;

3. A judgment ordering ABiSee, pursuant to 15 U.S.C. § 1118, to deliver up for destruction, or to show proof of said destruction or sufficient modification to eliminate any materials bearing the EYE PAL mark or designation or any other mark or designation that is confusingly similar to or a colorable imitation of the same;

4. A judgment in the amount of Resident Artist's actual damages, ABiSee's profits, Resident Artist's reasonable attorneys fees, costs of suit and prejudgment interest pursuant to 15 U.S.C. § 1117;

5. A judgment for enhanced damages under 15 U.S.C. § 1117 and punitive damages under Massachusetts law as appropriate; and

6. A judgment granting Resident Artist such other and further relief as the Court deems just and proper.

JURY DEMAND

Resident Artist hereby demands a jury trial of all issues raised in this Complaint so triable as a matter of law.

Dated: February 17, 2010

Respectfully submitted,

RESIDENT ARTIST STUDIO, LLC

By Its Attorneys,



A. Sidney Johnston
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EXHIBIT B

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

Mailed: September 24, 2010

Opposition No. 91195183

ABiSee, Inc.

v.

Resident Artist Studio, LLC

George C. Pologeorgis, Interlocutory Attorney:

This case now comes before the Board for consideration of (1) opposer's motion (filed August 9, 2010) to strike applicant's affirmative defenses, (2) opposer's motion for summary judgment (filed on August 13, 2010), (3) applicant's motion (filed August 17, 2010) to suspend this proceeding pending the final disposition of a civil action between the parties herein, (4) applicant's motion (filed August 30, 2010) to strike opposer's motion for summary judgment as premature, and (5) applicant's motion (filed September 23, 2010) to strike opposer's supplemental opposition to applicant's motion to suspend and motion to strike filed on September 20, 2010.

The Board, in its discretion, suggested that the issues raised in the aforementioned motions should be resolved by telephonic conference as permitted by TBMP § 502.06 (2nd ed.

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rev. 2004). The Board contacted the parties to discuss the date and time for holding the phone conference.

The parties agreed to hold a telephone conference at 2:00 p.m. Eastern time on Thursday, September 23, 2010. The conference was held as scheduled among Gregory M. Krakau, as opposer's counsel, A. Sidney Johnston, as applicant's counsel, and the above signed, as a Board attorney responsible for resolving interlocutory disputes in this case.

The Board carefully considered the arguments raised by the parties, as well as the supporting correspondence and the record of this case, in coming to a determination regarding the above matters. During the telephone conference, the Board made the following findings and determinations:

**Applicant's Motion to Strike Opposer's Supplemental
Opposition to Applicant's Motion to Suspend and Motion
to Strike**

Applicant's motion (filed September 23, 2010) to strike opposer's supplemental opposition to applicant's motion to suspend for civil action and motion to strike opposer's motion for summary judgment filed on September 20, 2010 is **granted** as well-taken inasmuch as opposer's supplemental opposition constitutes an impermissible sur-reply to applicant's motion to suspend and to strike. See Trademark Rule 2.127(a). Accordingly, opposer's supplemental

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opposition has been given no consideration in the Board's findings and determinations herein.

Opposer's Motion for Summary Judgment and Applicant's Motion to Suspend for Civil Action

As noted above, opposer filed a motion for summary judgment on its asserted claims of fraud and non-use on August 13, 2010. On August 30, 2010, applicant filed a motion to strike opposer's motion for summary judgment as premature on the ground that opposer had not served its initial disclosures upon applicant at time opposer filed its motion for summary judgment.

During the course of the telephone conference and based upon the record herein, it was ascertained that opposer had served its initial disclosures in the federal civil action upon applicant prior to filing its motion for summary judgment in this proceeding and that opposer mistakenly believed that service of initial disclosures in the civil action satisfied opposer's obligation to serve its initial disclosures in this Board case. The Board advised opposer that service of initial disclosures in the civil action did not, in fact, fulfill opposer's obligation to serve initial disclosures in this proceeding. It was further ascertained, however, that opposer, after filing its motion for summary judgment, eventually did serve its initial disclosures in

regard to the Board proceeding upon applicant. Although technically late and in order to avoid the re-filing of duplicative papers, the Board finds that opposer has now satisfied the prerequisite that a party must serve its initial disclosures upon the adverse party prior to filing a motion for summary judgment. See Trademark rule 2.127(e)(1).¹ In view thereof, applicant's motion to strike opposer's motion for summary judgment as premature is deemed moot and will be given no further consideration.

The Board further notes that, subsequent to opposer's filing of its motion for summary judgment, applicant filed a motion to suspend this proceeding pending the final disposition of a civil action between the parties in the United States District Court for the District of Massachusetts. Concurrently with its motion, applicant provided a copy of the civil action complaint, as well as a copy of the civil action answer and counterclaims.²

Trademark Rule 2.117(b) provides that "[w]henver there is pending before the Board both a motion to suspend and a

¹ The Board notes that the prerequisite of serving initial disclosures prior to filing a motion for summary judgment is not required if the motion for summary judgment is based upon issue or claim preclusion or on the ground that the Board lacks jurisdiction to entertain the claims being asserted. Trademark Rule 2.127(e)(1).

² Case 1:10-cv-10268-DPW, styled *Resident Artist Studio, LLC v. Abisee, Inc.*, filed in the United States District Court for the District of Massachusetts on or about February 17, 2010.

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motion which is potentially dispositive of the case, [as is the case here], the potentially dispositive motion may be decided before the question of suspension is considered regardless of the order in which the motions were filed." (emphasis added). However, the Board, in its discretion, may elect to suspend without first deciding the potentially dispositive motion. See TBMP § 510.02(a) (2nd ed. rev. 2004).

Following a careful review of the civil action complaint, the Board finds that the civil action may be dispositive of or have a bearing on this Board case. This especially holds true since opposer has asserted a counterclaim of fraud in the civil action similar, if not identical, to the fraud claim asserted in this proceeding. Inasmuch as the Board has found that the civil action may be dispositive of, or have a bearing on, this proceeding, and in the interest of judicial economy and in an effort to avoid inconsistent findings between the district court and the Board, the Board, pursuant to its inherent authority to manage its own docket, has elected to decide applicant's motion to suspend for civil action first which it hereby grants as well taken.

Accordingly, proceedings herein are suspended pending final disposition of the civil action between the parties. Upon resumption of these proceedings, if necessary and

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appropriate, the Board will reset applicant's time in which to file and serve a response to both opposer's motion for summary judgment and opposer's motion to strike applicant's affirmative defenses.

Within twenty days after the final determination of the civil action, the parties shall so notify the Board and call this case up for any appropriate action. During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.