

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

MBA

Mailed: April 26, 2011

Opposition No. 91198852

Erica Chriswell

v.

Big Score Entertainment, LLC
d/b/a BSE Recordings

Michael B. Adlin, Interlocutory Attorney:

This case now comes up for consideration of applicant's motion, filed March 22, 2011, to: (1) suspend this proceeding pending resolution of a civil action between the parties (Big Score Entertainment, LLC v. Erica M. Chriswell, Case No. 3:10-cv-01993-CFD, pending in the U.S. District Court for the District of Connecticut) (the "Federal Case"); and (2) divide its involved application. The motion to suspend is fully briefed, but opposer does not contest the request to divide.

Background

Applicant seeks registration of ARIKA KANE, in standard characters, for audio recordings, clothing products and entertainment services.¹ In her notice of opposition, opposer alleges prior use of ERYKA KANE and variations

thereof for entertainment-related products and services, and that use of applicant's mark is likely to cause confusion with opposer's mark and falsely suggest a connection with opposer. In lieu of filing an answer to the notice of opposition, applicant filed its motion to suspend.

In the Federal Case, applicant is the plaintiff, and therein alleges prior use of ARIKA KANE for entertainment-related goods and services and that use of opposer's mark is likely to cause confusion. Applicant's Complaint in the Federal Case includes claims for false designation of origin under the Lanham Act and common law unfair competition. Among other things, applicant seeks a judgment that opposer has infringed applicant's mark and an injunction prohibiting opposer from using her mark(s).

Motion to Divide

Applicant's involved application identifies goods in Classes 9 and 25 and services in Class 41, but opposer paid the fee required to oppose only one of the three classes, which, pursuant to Board practice, is Class 9, the lowest-numbered Class. By its motion to divide, applicant seeks to create a new "child" application to include the goods and services identified in unopposed Classes 25 and 41. While opposer does not contest the motion, and it would therefore be eligible to be granted as conceded, Trademark Rule

¹ Application Serial No. 77751586, filed June 3, 2009,

2.127(a), applicant has not paid the fee required to divide the application. Accordingly, a decision on applicant's motion to divide is **DEFERRED**, and applicant is allowed until **THIRTY DAYS** from the mailing date of this order to pay the required fee, failing which the motion to divide will be given no further consideration.

Motion to Suspend

Applicant argues that the Federal Case and this proceeding "involve" similar issues and that therefore suspension of this proceeding is appropriate. Opposer argues in response that applicant failed to submit "the necessary evidence" to establish that the Federal Case is "live," suggesting that applicant has not properly served the Complaint in the Federal Case. However, applicant includes with its reply brief a copy of a motion to dismiss which opposer allegedly filed in the Federal Case. In addition, applicant claims that opposer filed a "similar lawsuit" in another federal court.

The Board's well-settled policy is to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case. Trademark Rule 2.117(a); General Motors Corp. v. Cadillac Club Fashions Inc., 22 USPQ2d 1933, 1937 (TTAB

alleging dates of first use in commerce of January 1, 2008.

1992). Here, the Federal Case "may have a bearing" on this one, and suspension is therefore appropriate.

Indeed, it seems likely, if not inevitable, that the Court will determine which party has priority of use. The Court may very well also decide whether there is a likelihood of confusion between the parties' marks.

While opposer's motion to dismiss the Federal Case suggests that the Federal Case is indeed "live," whether or not applicant has yet served the Complaint in the Federal Case is not particularly relevant. The Federal Case will not remain in limbo forever. Fed. R. Civ. P. 4(m). If applicant does not ultimately serve the Complaint, this case will be promptly resumed upon the Federal Case's dismissal, and the resulting delay in this case will be relatively brief. If applicant timely serves the Complaint, proceeding here prior to termination of the Federal Case would be inappropriate and inefficient, because the Federal Case may be "binding upon the Board, while the decision of the Board is not binding upon the court." TBMP § 510.02(a) (2d ed. rev. 2004); see also, The Other Telephone Co. v. Connecticut National Telephone Co., Inc., 181 USPQ 779 (Comr. 1974); Whopper-Burger, Inc. v. Burger King Corp., 171 USPQ 805 (TTAB 1971). In other words, proceeding here prior to termination of the Federal Case would be inefficient and pose a risk of inconsistent judgments.

For all of these reasons, suspension is appropriate and applicant's motion to suspend is hereby **GRANTED**.

Conclusion

Consideration of applicant's motion to divide is deferred. Applicant's motion to suspend is granted. Proceedings herein are suspended pending final disposition of the Federal Case and/or any other proceedings involving the parties which may have a bearing on this case. Within **twenty days** after the final determination of the Federal Case and/or any other proceeding, the parties shall so notify the Board and call this case up for any appropriate action. During the suspension period the Board shall be notified of any address changes for the parties or their attorneys.
