

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

Baxley

Mailed: August 29, 2011

Opposition No. 91200958

Sweetgreen, Inc.

v.

Sweet Leaf, Inc.

Andrew P. Baxley, Interlocutory Attorney:

On August 3, 2011, opposer filed a motion to suspend this proceeding pending final determination of a civil action between the parties styled *Sweetgreen, Inc. v. Sweet Leaf, Inc.*, Case No. 1:11-cv-00859, filed in the United States District Court for the District of the District of Columbia, alleging therein that the civil action may have a bearing upon this proceeding.

In a brief in response thereto, applicant contends that suspension is premature because (1) no answer has been filed in this case; and (2) a motion to dismiss is pending in the civil action. Applicant further contends that opposer is improperly seeking to preclude the district court from relying upon the Board's expertise and that the claims in this case and the civil action are not exactly the same.

The Board's general practice is to suspend proceedings before it when any party to a pending Board proceeding is

involved in a civil action which may have a bearing on the Board case. See Trademark Rule 2.117(a). Although the USPTO has expertise in determining trademark registrability, such determinations are is not within the USPTO's exclusive jurisdiction. See *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 2 USPQ2d 1208 (D.C. Minn. 1986). To the extent that a civil action in a Federal district court involves issues in common with those in a Board proceeding, the district court's findings are binding on the Board, whereas the Board's findings are merely advisory to the district court. See *id.*; TBMP Section 510.02(a) (3d ed. 2011).

The Board notes initially that an answer need not be of record before the Board will consider suspension pending disposition of a civil action. See *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125 (TTAB 1974); TBMP Section 510.02(a). Further, the fact that a motion to dismiss is pending in the civil action does not warrant denial of a motion to suspend the Board proceeding. Rather, if the motion to dismiss the civil action is granted, or if the district court elects to suspend the civil action to allow the Board proceeding to go forward, the Board will entertain a motion to resume proceedings.

To prevail on its infringement claim in the civil action, opposer must establish that there is a likelihood between the marks at issue. See Trademark Act Section 32,

15 U.S.C. Section 1114. If the district court determines that such a likelihood exists, that determination may have a bearing upon opposer's claim under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), in this proceeding.

Accordingly, the Board finds that suspension of this proceeding pending final determination, including any appeals or remands, of Case No. 1:11-cv-00859 is appropriate, and the motion to suspend is granted.

Proceedings are suspended pending final determination, including any appeals or remands, of Case No. 1:11-cv-00859.

The Board will make annual inquiry as to the status of Case No. 1:11-cv-00859. Within twenty days after the final determination thereof, one of the parties should notify the Board so that this case may be called up for appropriate action. During the suspension period the Board should be notified of any address changes for the parties or their attorneys.