

ESTTA Tracking number: **ESTTA540250**

Filing date: **05/28/2013**

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

Proceeding	91207909
Party	Plaintiff Third Estate LLC
Correspondence Address	EVAN ANDERSON BRAND VENTURES INTELLECTUAL PROPERTY LAW 2434 LINCOLN BLVD, FLOOR 2 LOS ANGELES, CA 90291 UNITED STATES evan@bviplaw.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Evan Anderson
Filer's e-mail	evan@bviplaw.com
Signature	/evananderson/
Date	05/28/2013
Attachments	TTAB - Motion to Suspend - Stamp'd Opposition4.pdf(4302086 bytes )



Where a party to a case pending 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). This is because “a decision by the United States District Court would be binding on the United States Patent and Trademark Office whereas a determination by the Patent Office as to the respondent’s right to retain its registration would not be binding nor would res judicata automatically attach based on a determination by the USPTO with respect to a subsequent or contemporaneous proceeding before the federal district court.” *Whopper-Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (T.T.A.B. 1971). A court’s decision regarding the right to registration is binding on the T.T.A.B. *The Seven-Up Cp. V. Bubble Up Co.*, 136 U.S.P.Q. 210, 214 (C.C.P.A. 1963); *see also In re Alfred Dunhill Ltd.*, 224 U.S.P.Q. 501, 503 (T.T.A.B. 1984); J. Thomas McCarthy, 4 *McCarthy on Trademarks and Unfair Competition* § 32:94 (4<sup>th</sup> ed. 2006) (hereinafter “McCarthy”).

Opposer and Applicant are both parties to the Civil Action with Opposer in the position of Plaintiff and Applicant in the position of Defendant. The Civil Action is a live and ongoing litigation which is at present time is currently pending before the Central District Court of California. The cause of action alleged by the Plaintiff in the Civil Action is identical or nearly identical to basis for the present proceeding, with both disputes centered on allegations of a likelihood of confusion between the same pled trademarks, trademark applications and trademark registrations, specifically, Opposer’s DOPE and DOPE COUTURE trademarks and Applicant’s DOPE STAMPD’ LOS ANGELES trademark.

In the Civil Action, the District Court will determine the rights of the Applicant with respect to both its ability to achieve and maintain a Federal Trademark Registration for that mark

and with respect to its ability to use the mark in commerce and if permitted to continue use, the Court will also make a determination as to what goods and services Applicant can use its trademark in connection with.

It is clear that the nature of the Civil Litigation is directly related to those issues being adjudicated in the present proceeding, and it is also clear that the issues in the Civil Litigation exceed the scope of the issues and prayer for relief currently before the Board. As the District Court's future determination in the Civil Litigation will be binding on the Board with respect to the validity and ownership of the Applicant's trademark, it is clear that the ultimate resolution of the issues in present proceeding will be dependent upon the nature of the resolution of the Civil Litigation.

As the Plaintiff has requested, among other things, relief in the form of injunctive relief, damages, and attorney's fees, it is not possible for the issues now present in the Civil Action to be adjudicated by the Board. Further, it is clear that any continued involvement by the parties in the present Opposition would be redundant and would also be wasteful of the limited resources currently afforded to the USPTO for opposition and cancellation proceedings. As such, and considering the binding effect of any determination made the Court in the Civil Litigation, it is the position of the Opposer that it is in the best interests of the parties and for judicial efficiency to allow for the Civil Litigation to proceed while the present proceeding is suspended pending the outcome of the Civil Litigation. Once there is a final ruling or a final resolution in some other form is reached, the parties will inform the Board of the resulting decision, and the Board can then decide what is the appropriate manner in which to proceed at such a time. *See The Other Tel. Co. v. Conn. Nat'l Tel. Co., Inc.*, 181 U.S.P.Q. 125, 126-7 (T.T.A.B. 1974).

The Civil Litigation cited herein involves the identical parties in a matter involving the identical issues cited in the present matter; however, the issues involved in the Civil Litigation also go beyond and expand upon the claims asserted in the present Opposition and the relief requested by the Plaintiff. As the case has now been expanded to include requests for injunctive relief and monetary damages, any ruling made at this point by the Board would not adequately or sufficiently address the forms of relief deemed necessary and appropriate by the Plaintiff. As the Board's ruling on the issue of a likelihood of confusion is not binding on the court in the Civil Litigation and is an issue now before the court in the Civil Litigation, it the Opposer's belief that it in the best interests of the Board and all involved parties to suspend the present proceeding until a decision can be reached by the District Court in the Civil Litigation.

Based on the foregoing, Opposer respectfully requests that the Board stay this proceeding pending the final determination of the Civil Litigation.

Dated as of: May 28, 2013

By:           /evananderson/          

Evan Anderson  
Patel & Alunit, PC  
16830 Ventura Blvd., Suite 360  
Encino, CA 91436  
(818) 380-1900

Attorney for Opposer,  
Third Estate, LLC

**PROOF OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **OPPOSER'S MOTION TO SUSPEND THE PROCEEDING PENDING CIVIL ACTION** has been served on Jonathan Bird, counsel for Applicant, on May 28, 2013, via First Class U.S. Mail, postage prepaid to:

Jonathan Bird  
8620 HOLLYWOOD BLVD  
LOS ANGELES, CA 90069-1416  
UNITED STATES

A handwritten signature in black ink, appearing to read 'EA', is written over a horizontal line.

Evan Anderson

FILED

1 David Martinez, Bar No. 193183  
DMartinez@rkmc.com  
2 Yakub Hazzard, Bar No. 150242  
YHazzard@rkmc.com  
3 **ROBINS, KAPLAN, MILLER & CIRESI L.L.P.**  
2049 Century Park East, Suite 3400  
4 Los Angeles, CA 90067-3208  
Telephone: (310) 552-0130  
5 Facsimile: (310) 229-5800

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CLERK U.S. DISTRICT COURT  
CENTRAL DIST. OF CALIF.  
LOS ANGELES

BY \_\_\_\_\_

6 Attorneys for Plaintiff  
Third Estate LLC, dba Dope and  
7 Dope Couture

8 **UNITED STATES DISTRICT COURT**  
9 **CENTRAL DISTRICT OF CALIFORNIA**

10  
11 Third Estate LLC, dba Dope and Dope  
Couture,

Case No.

**CV 13-03074** - SKW  
(VBR)

12 Plaintiff,

**CERTIFICATION OF  
INTERESTED PARTIES**

13 v.

14 Cornerman Productions LLC, dba  
15 Dope Stampd' Los Angeles and DOES  
1-10,

16 Defendants.  
17

18  
19 Pursuant to Local Rule 7.1 and Federal Rule of Civil Procedure 7.1, Plaintiff  
20 Third Estate LLC, dba Dope and Dope Couture, through its undersigned counsel,  
21 and to enable the Court to evaluate possible disqualification or recusal, hereby  
22 certifies that the following persons, associations of persons, firms, partnerships and  
23 corporations (including parent corporations clearly identified as such) may have a  
24 pecuniary interest in the outcome of the case:  
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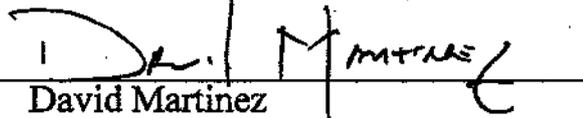
ROBINS, KAPLAN, MILLER & CIRESI L.L.P.  
ATTORNEYS AT LAW  
LOS ANGELES

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Plaintiff Third Estate LLC has no parent corporation and no publicly held corporation owns more than 10% of its stock.

Dated: May 1, 2013

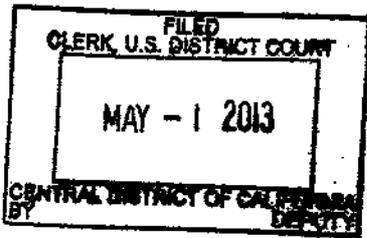
**ROBINS, KAPLAN, MILLER & CIRESI L.L.P.**

By:   
David Martinez

**Attorneys for Plaintiff, Third Estate LLC, dba  
Dope and Dope Couture**

ROBINS, KAPLAN, MILLER & CIRESI L.L.P.  
ATTORNEYS AT LAW  
LOS ANGELES

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2049 Century Park East, Suite 3400  
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5 Facsimile: (310) 229-5800



6 Attorneys for Plaintiff  
Third Estate LLC, dba Dope and  
7 Dope Couture

8 **UNITED STATES DISTRICT COURT**  
9 **CENTRAL DISTRICT OF CALIFORNIA**

10  
11 Third Estate LLC, dba Dope and Dope  
Couture,  
12  
13 Plaintiff,  
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15 v.  
16 Cornerman Productions LLC, dba  
Dope Stampd' Los Angeles and DOES  
1-10,  
17 Defendants.

Case No. **CV13-03074** - SWW  
(VSK)

**COMPLAINT FOR:**  
**(1) FEDERAL TRADEMARK INFRINGEMENT (LANHAM ACT, 15 U.S.C. § 1114);**  
**(2) FALSE DESIGNATION OF ORIGIN (LANHAM ACT, 15 U.S.C. § 1125(a));**  
**(3) FEDERAL TRADEMARK DILUTION (LANHAM ACT, 15 U.S.C. § 1125(c));**  
**(4) COMMON LAW AND STATUTORY TRADE NAME INFRINGEMENT;**  
**(5) UNFAIR COMPETITION (CAL. BUS. & PROF. CODE § 17200);**  
**(6) COMMON LAW UNFAIR COMPETITION; AND**  
**(7) STATE TRADEMARK DILUTION (CAL. BUS. & PROF. CODE § 14247)**  
**DEMAND FOR JURY TRIAL**

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1 Plaintiff Third Estate LLC, dba Dope and Dope Couture (“DOPE”) hereby  
2 alleges and avers based on knowledge as to its acts and based on information and  
3 belief as to the acts of others, as follows:

4 **INTRODUCTION**

5 1. This is an action for trademark and trade name infringement, false  
6 designation of origin, dilution, and unfair competition arising from defendant  
7 Cornerman Productions LLC’s (dba Dope Stampd’ Los Angeles, Dope Stampd LA,  
8 Stampd, Stampd LA and Stamp’ (R) Los Angeles) (“Defendant”) willful and  
9 intentional infringement of DOPE’s trademarks, as well as its continued efforts to  
10 trade on DOPE’s reputation and goodwill. Defendant’s misconduct is likely to  
11 cause, has caused and is causing widespread consumer and vendor confusion. As a  
12 result, DOPE has no choice but to commence this action to protect its valuable  
13 intellectual property and obtain legal redress for Defendant’s willful misconduct.

14 **THE PARTIES**

15 2. DOPE is an Indiana Limited Liability Company, whose headquarters  
16 and principal business are located at 1451 East Fourth Street, Los Angeles,  
17 California. DOPE is a widely recognized designer and retailer of contemporary and  
18 high end street-wear, including clothing, apparel, jewelry and accessories. DOPE  
19 sells its products through both an on-line retail store outlet located at  
20 <http://shop.dopecouture.com> and [www.dope.com](http://www.dope.com) (“DOPE Website”), and a  
21 physical retail store located in 454 N. Fairfax Avenue, Los Angeles, California  
22 (“DOPE Store”).

23 3. DOPE is informed and believes and based thereon alleges that  
24 defendant Cornerman Productions LLC, dba Dope Stampd’ Los Angeles is a  
25 California Limited Liability Company with a principal place of business located at  
26 824 South Los Angeles Street, Suite 200, Los Angeles, California. Defendant  
27 engages in the retail sale of street-wear apparel.

28



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

THIRD ESTATE, LLC,	)	
	)	
Opposer,	)	Opposition No. 91207909
	)	
v.	)	Ser. No. 85/380,544
	)	
CORNERMAN PRODUCTIONS LLC,	)	
	)	
Applicant.	)	

**OPPOSER’S MOTION TO SUSPEND THE  
PROCEEDINGS PENDING CIVIL LITIGATION**

Pursuant to 37 CFR § 2.117(a) and TBMP § 510.02(a), Opposer, Third Estate LLC (“Opposer”), hereby requests that the Trademark Trial and Appeal Board (the “TTAB” or the “Board”) suspend the proceeding until the final determination of *THIRD ESTATE LLC, dba DOPE and DOPE COUTURE v. CORNERMAN PRODUCTIONS LLC, dba DOPE STAMPD’ LOS ANGELES* CV 13-03074, a civil action before the United States District Court in the Central District of California (“Civil Action”), because the Civil Action will have a direct bearing on the instant proceeding

**ARGUMENT**

The Determination in *THIRD ESTATE LLC, dba DOPE and DOPE COUTURE v. CORNERMAN PRODUCTIONS LLC, dba DOPE STAMPD’ LOS ANGELES* CV 13-03074 Will Have A Direct Bearing On The Issues Before The Board

Where a party to a case pending 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). This is because “a decision by the United States District Court would be binding on the United States Patent and Trademark Office whereas a determination by the Patent Office as to the respondent’s right to retain its registration would not be binding nor would res judicata automatically attach based on a determination by the USPTO with respect to a subsequent or contemporaneous proceeding before the federal district court.” *Whopper-Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (T.T.A.B. 1971). A court’s decision regarding the right to registration is binding on the T.T.A.B. *The Seven-Up Cp. V. Bubble Up Co.*, 136 U.S.P.Q. 210, 214 (C.C.P.A. 1963); *see also In re Alfred Dunhill Ltd.*, 224 U.S.P.Q. 501, 503 (T.T.A.B. 1984); J. Thomas McCarthy, 4 *McCarthy on Trademarks and Unfair Competition* § 32:94 (4<sup>th</sup> ed. 2006) (hereinafter “McCarthy”).

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In the Civil Action, the District Court will determine the rights of the Applicant with respect to both its ability to achieve and maintain a Federal Trademark Registration for that mark

and with respect to its ability to use the mark in commerce and if permitted to continue use, the Court will also make a determination as to what goods and services Applicant can use its trademark in connection with.

It is clear that the nature of the Civil Litigation is directly related to those issues being adjudicated in the present proceeding, and it is also clear that the issues in the Civil Litigation exceed the scope of the issues and prayer for relief currently before the Board. As the District Court's future determination in the Civil Litigation will be binding on the Board with respect to the validity and ownership of the Applicant's trademark, it is clear that the ultimate resolution of the issues in present proceeding will be dependent upon the nature of the resolution of the Civil Litigation.

As the Plaintiff has requested, among other things, relief in the form of injunctive relief, damages, and attorney's fees, it is not possible for the issues now present in the Civil Action to be adjudicated by the Board. Further, it is clear that any continued involvement by the parties in the present Opposition would be redundant and would also be wasteful of the limited resources currently afforded to the USPTO for opposition and cancellation proceedings. As such, and considering the binding effect of any determination made the Court in the Civil Litigation, it is the position of the Opposer that it is in the best interests of the parties and for judicial efficiency to allow for the Civil Litigation to proceed while the present proceeding is suspended pending the outcome of the Civil Litigation. Once there is a final ruling or a final resolution in some other form is reached, the parties will inform the Board of the resulting decision, and the Board can then decide what is the appropriate manner in which to proceed at such a time. *See The Other Tel. Co. v. Conn. Nat'l Tel. Co., Inc.*, 181 U.S.P.Q. 125, 126-7 (T.T.A.B. 1974).

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Dated as of: May 28, 2013

By:           /evananderson/          

Evan Anderson  
Patel & Alunit, PC  
16830 Ventura Blvd., Suite 360  
Encino, CA 91436  
(818) 380-1900

Attorney for Opposer,  
Third Estate, LLC

**PROOF OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **OPPOSER'S MOTION TO SUSPEND THE PROCEEDING PENDING CIVIL ACTION** has been served on Jonathan Bird, counsel for Applicant, on May 28, 2013, via First Class U.S. Mail, postage prepaid to:

Jonathan Bird  
8620 HOLLYWOOD BLVD  
LOS ANGELES, CA 90069-1416  
UNITED STATES

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Evan Anderson

FILED

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CLERK U.S. DISTRICT COURT  
CENTRAL DIST. OF CALIF.  
LOS ANGELES

BY \_\_\_\_\_

6 Attorneys for Plaintiff  
Third Estate LLC, dba Dope and  
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8 **UNITED STATES DISTRICT COURT**  
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11 Third Estate LLC, dba Dope and Dope  
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Case No.

**CV13-03074** -SKW  
(VBR)

**CERTIFICATION OF  
INTERESTED PARTIES**

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19 Pursuant to Local Rule 7.1 and Federal Rule of Civil Procedure 7.1, Plaintiff  
20 Third Estate LLC, dba Dope and Dope Couture, through its undersigned counsel,  
21 and to enable the Court to evaluate possible disqualification or recusal, hereby  
22 certifies that the following persons, associations of persons, firms, partnerships and  
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Plaintiff Third Estate LLC has no parent corporation and no publicly held corporation owns more than 10% of its stock.

Dated: May 1, 2013

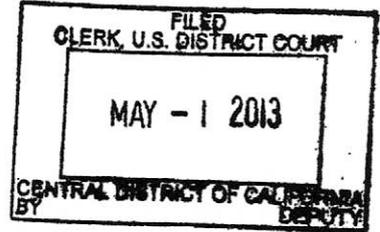
**ROBINS, KAPLAN, MILLER & CIRESI L.L.P.**

By:   
David Martinez

**Attorneys for Plaintiff, Third Estate LLC, dba  
Dope and Dope Couture**

ROBINS, KAPLAN, MILLER & CIRESI L.L.P.  
ATTORNEYS AT LAW  
LOS ANGELES

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2049 Century Park East, Suite 3400  
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6 Attorneys for Plaintiff  
Third Estate LLC, dba Dope and  
7 Dope Couture

8 **UNITED STATES DISTRICT COURT**  
9 **CENTRAL DISTRICT OF CALIFORNIA**

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Case No.

**CV 13-03074** - SWW  
(VBKX)

**COMPLAINT FOR:**

- (1) **FEDERAL TRADEMARK INFRINGEMENT (LANHAM ACT, 15 U.S.C. § 1114);**
- (2) **FALSE DESIGNATION OF ORIGIN (LANHAM ACT, 15 U.S.C. § 1125(a));**
- (3) **FEDERAL TRADEMARK DILUTION (LANHAM ACT, 15 U.S.C. § 1125(c));**
- (4) **COMMON LAW AND STATUTORY TRADE NAME INFRINGEMENT;**
- (5) **UNFAIR COMPETITION (CAL. BUS. & PROF. CODE § 17200);**
- (6) **COMMON LAW UNFAIR COMPETITION; AND**
- (7) **STATE TRADEMARK DILUTION (CAL. BUS. & PROF. CODE § 14247)**

**DEMAND FOR JURY TRIAL**

1 Plaintiff Third Estate LLC, dba Dope and Dope Couture (“DOPE”) hereby  
2 alleges and avers based on knowledge as to its acts and based on information and  
3 belief as to the acts of others, as follows:

4 **INTRODUCTION**

5 1. This is an action for trademark and trade name infringement, false  
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7 Cornerman Productions LLC’s (dba Dope Stampd’ Los Angeles, Dope Stampd LA,  
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10 trade on DOPE’s reputation and goodwill. Defendant’s misconduct is likely to  
11 cause, has caused and is causing widespread consumer and vendor confusion. As a  
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14 **THE PARTIES**

15 2. DOPE is an Indiana Limited Liability Company, whose headquarters  
16 and principal business are located at 1451 East Fourth Street, Los Angeles,  
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