

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

BUO

Mailed: July 10, 2013

Opposition No. 91209647

Jorge J. Carnicero

v.

Middleburg Real Estate, LLC

Benjamin U. Okeke, Interlocutory Attorney:

Now before the Board are applicant's motions to stay proceedings pending the disposition of a civil action pending before the Superior Court of the District of Columbia ("the civil action"),¹ filed June 27, 2013; and for a protective order directing that the subpoena for the deposition of non-party Natalia Pejacsevich be withdrawn and the deposition not be had subject to applicant's "Emergency Motion to Stay Discovery." Opposer contests these motions, alleging that applicant has not shown good cause to issue a protective order or to stay discovery and

¹ The civil action is styled as *Carnicero v. Duchange, Chevy Chase Trust Company, Pejacsevich, Pejacsevich, Inter-Properties, Inc., and Trans-American Aeronautical Corp.*, Case No. 2013-001499B. Applicant attached a copy of the complaint filed in the civil action as an exhibit to its motion.

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that a stay of the proceedings is inappropriate inasmuch as the parties to the two matters are distinct and the issues presented in the civil action are not the same as the issue present in this proceeding. The motions are fully briefed.

The Board, at the request of the parties, conducted a telephone conference to discuss the issues raised in the motions as permitted by TBMP § 502.06(a) (3d ed. rev. 2012). 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 11:30 a.m. EST, on Monday, July 8, 2013. The conference was held as scheduled and participating in the conference were opposer's counsel, Theresa A. Middlebrook and Michelle A. Rosati, applicant's counsel, Michael T. Murphy and Daniel I. Hwang, and Board interlocutory attorney, Benjamin U. Okeke.

Unfortunately, it appears that the parties' communications to this point have been overly contentious and unproductive, if not divisive. To that end, the parties were reminded of their obligation to cooperate with one another in the discovery process and to conduct themselves with decorum and courtesy. Trademark Rule 2.192; see also *Panda Travel Inc., v Resort Option Enters., Inc.*, 94 USPQ2d 1789, 1791 (TTAB 2009); *Sunrider Corp. v.*

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Raats, 83 USPQ2d 1648, 1654 (TTAB 2007) (parties have a duty to cooperate in resolving conflicts in the scheduling and taking of depositions); *MySpace Inc. v. Mitchell*, 91 USPQ2d 1060, 1062 n.4 (TTAB 2009).

The Board carefully considered the arguments raised by the parties during the telephone conference, as well as the supporting correspondence and the record of this case, in coming to a determination regarding the issues presented in the motions.

Following the telephone conference, the Board made the following findings and determinations:

Suspension

It is the policy of the Board to suspend proceedings when the parties are involved in a civil action, which may be dispositive of or may have a bearing on the Board case. See Trademark Rule 2.117(a). The Board may suspend proceedings whenever it comes to the attention of the Board that a party or parties to a case pending before it are involved in a civil action which may have a bearing on the Board case. 37 CFR § 2.117(a). See *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992). Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board. See *Opticians Ass'n of Am. v.*

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Independent Opticians of Am. Inc., 734 F. Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990).²

While a state court does not have appellate review or authority to issue mandates to the USPTO as the federal courts are empowered to do, Board proceedings may nonetheless be suspended pending the disposition of a state court case that may have a bearing on a subsequent Board proceeding. See, e.g. *Jet Inc. v. Sewage Aeration Sys.*, 55 USPQ2d 1854, 1859 (Fed. Cir. 2000); *Mother's Rest., Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 1569, 221 USPQ 394, 397 (Fed. Cir. 1983); see also *Midland Coop., Inc. v. Midland Int'l Corp.*, 421 F.2d 754, 164 USPQ 579 (CCPA 1970). The requirement is not that the civil action be binding on the Board, but that the determination of issues in the civil action may have a bearing on the Board proceeding.

Opposer's argument that the proceedings should not be suspended based upon pending motions to dismiss and to stay

² Therefore, despite the Board's allowance of additional briefing on the matter, applicant's submission of the complaint filed in the civil action was sufficient to bring to the Board's attention the civil action involving the parties, without the additional submission of briefs or memorandum in support or opposition of the motion.

A civil action need only be brought to the Board's attention. The Board will normally require that a copy of the operative pleadings from the civil action be submitted, so that the Board can ascertain whether the final determination of the civil action may have a bearing on the issues before the Board. See *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011).

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the civil action in favor of the Board proceeding is not well-taken. Motions to dismiss are not an uncommon instance in litigation and certainly the belief that claims are meritless is held by every party to have ever filed a motion to dismiss. The superior court will decide if opposer's claims are meritless, and if applicant's motion is granted in the civil action, this proceeding can easily be resumed. Similarly, if the superior court elects to suspend the civil action to await determination of the Board proceeding and the Board is so advised, the Board will go forward with this proceeding.³

Opposer brought the civil action against, among others, applicant's co-owner, Peter Pejacsevich, asserting that he has "improperly and unlawfully [sought] to register the names Atoka, Atoka Farm, and *Atoka Properties*." Civil Action Complaint, ¶ 127(e) (emphasis added). Opposer further alleges that "Peter ... filed applications to register the names, 'Atoka,' 'Atoka Farms,' and, through *his* real estate company, *Middleburg Real Estate, LLC*, the name 'Atoka Properties,' with the United States Patent and Trademark Office." *Id.* at ¶ 102 (emphasis added). Opposer

³ The Board notes, however, that the Superior Court is in better position to determine the ownership issue presented as it relates to the right to seek registration of, and use the name ATOKA PROPERTIES, inasmuch as it requires an interpretation of the parties' settlement agreement.

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seeks to have the superior court "enjoin [Peter, individually and through his real estate company, Middleburg Real Estate, LLC] from registering either 'Atoka,' 'Atoka Farm' or 'Atoka Properties' with the U.S. Patent and Trademark Office." *Id.* at p. 30.

It is important to note at this point that even if we were to accept the idea that Peter Pejacsevich has no relation to applicant, it is not necessary that the parties in the civil action be identical to the parties before the Board. In fact, the Board may suspend pending even another proceeding in which only one of the parties is involved. *See Argo & Co. v. Carpetsheen Mfg., Inc.*, 187 USPQ 366, 367 (TTAB 1975) (state court action between applicant and third party to determine ownership of applicant's mark).

Further, while opposer is correct that the determination of the civil action "will have no bearing on whether Atoka is primarily geographic or whether ATOKA PROPERTIES constitutes a [sic] unregistrable false suggestion of a connection with Atoka Farm," the determination of whether a party should be enjoined from seeking registration of the term ATOKA PROPERTIES, may undoubtedly have a bearing on this proceeding. *See, e.g., id.*

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Opposer will not be heard to argue that the civil action that *it filed* will have no bearing on this proceeding or that suspension is inappropriate because applicant is not a named party to the civil action. Opposer has itself committed the same "mis-definition" it accuses applicant of making, by defining the relationship of Peter Pejacsevich to applicant Middleburg Real Estate, LLC - it is "his real estate company." In its complaint opposer identifies the subject trademark application and applied-for mark - ATOKA PROPERTIES, as components of issues to be resolved.

Moreover, if opposer is granted the relief it seeks in the civil action, it appears that not only will the civil action have a bearing on this case; it may be dispositive of this case, inasmuch as Peter, "through his real estate company, Middleburg Real Estate, LLC," would be enjoined from pursuing registration of the applied-for mark. See, e.g., *Argo*, 187 USPQ at 367. Finally, the Board agrees with applicant that it would be nonsensical for opposer to seek such an injunction against registration of the mark ATOKA PROPERTIES if opposer did not believe it would have any effect on the instant trademark application for registration of that mark.

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Therefore, suspension is appropriate, applicant's motion to suspend is **GRANTED**, and proceedings are suspended pending final disposition of the civil action between the parties.

Protective Order and Emergency Motion to Stay Discovery

In view of the suspension of the proceeding, applicant's pending motions for a protective order and its "Emergency Motion to Stay Discovery" are both **DENIED** without prejudice; the stay of this proceeding includes a stay of all discovery activities.⁴

If, upon resumption, applicant believes its motions denied by this order were not resolved or made moot by the civil action, applicant may, within **FIFTEEN DAYS** from the date of resumption, renew the motions by citing their title, date of filing, and docket entries in the Board's electronic proceeding file. Any motion renewed must be accompanied by a signed statement that the motion has been reviewed in its entirety and concerns matters still disputed between the parties.

If the renewed motion was contested at the time of suspension and opposer believes that its original response requires supplementation in view of events since

⁴ While the Board does not have authority to quash the subpoena issued by the E.D. Va., we would expect opposer to withdraw the subpoena, inasmuch as the deposition will not be held due to suspension.

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suspension, opposer has **FIFTEEN DAYS** from the date of service of the renewal of the motion to file a supplemental response.

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.