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

Proceeding	91210245
Party	Plaintiff Life Forever Changed, LLC, KieAnn Brownell and Lisa Couch
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Attachments	FINAL Reply to Applicant's Response in Opposition to Opposers' Motion to Suspend Proceeding.pdf(365097 bytes ) EXHIBIT 1.pdf(22967 bytes )

IN THE UNITED STATE PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEALS BOARD

In the Matter of Trademark Application Serial Nos. 85/639133, 85/639140, 85/639143  
For the Marks THE ORIGINAL SILHOUTTES & Design, LYNNE WAGGONER-PATTON  
SILHOUTTES & Design and THE SILHOUETTES & Design

Life Forever Changed, LLC,	)	
KieAnn Brownell and Lisa Couch,	)	
	)	
Opposers,	)	Opposition No. 91210245
	)	
v.	)	
	)	
Waggoner-Patton, Lynne	)	
	)	
Applicant.	)	

**OPPOSERS' REPLY AND BRIEF TO APPLICANT'S RESPONSE IN OPPOSITION TO  
OPPOSERS' MOTION TO SUSPEND PROCEEDING**

Pursuant to 37 C.F.R. § 2.127(a) and Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 502.02(b), Opposers Life Forever Changed, LLC, KieAnn Brownell, and Lisa Couch, through its undersigned counsel, hereby reply to Applicant's Response and Brief in Opposition to Opposers' Motion to Suspend Proceeding ("Response") and state as follows:

Trademark Rule 2.117(a) provides that:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

As an initial matter, while it is within the Trademark Trial and Appeal Board's (the "Board") discretion to grant a suspension of the proceedings, the Board is traditionally inclined to suspend its proceedings in deference to civil court proceedings. *See e.g., Gen. Motors Corp. v. Cadillac Club Fashions Inc.*, 22 U.S.P.Q.2d 1933 (TTAB 1992); *Toro Co. v. Hardigg Indus., Inc.*, 187 U.S.P.Q. 689 (TTAB 1975), *rev'd on other grounds*, 549 F.2d 785, 193 U.S.P.Q. 149 (CCPA

1977); *Other Tel. Co. v. Connecticut Nat'l Tel. Co.*, 181 U.S.P.Q. 125 (TTAB 1974), *pet'n denied*, 181 U.S.P.Q. 779 (Comm'r 1974); *Tokaido v. Honda Assocs. Inc.*, 179 U.S.P.Q. 861 (TTAB 1973); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805 (TTAB 1971); *Squirrel Brand Co. v. Barnard Nut Co.*, 101 U.S.P.Q. 340 (Comm'r 1954); *Townley Clothes, Inc. v. Goldring, Inc.*, 100 U.S.P.Q. 57 (Comm'r 1953).

There are several reasons for the Board to suspend proceedings in view of a civil action, a number of which are articulated in the non-precedential case, *Robin Singh Educ. Servs., Inc. v. Test Masters Educ. Servs., Inc.*, Opposition No. 91163136 (Feb. 14, 2005), cited by Applicant in support of the opposite. First, the Board's jurisdiction is strictly limited to questions of registrability, while the district court may consider broader questions of infringement. *Id.* Second, the district court also has a broad range of available remedies not available before the Board, *e.g.*, injunctions, damages, attorney fees, etc. *Id.* Third, a final decision of the Board is subject to *de novo* review in district court. *Id.* Finally, suspension by the Board promotes judicial economy, avoiding duplicative proceedings with possibly inconsistent results. *Id.* Thus, suspending the Board proceedings while there is a pending civil action, which has a bearing on the issues before the Board, is sound public policy. The reasons for suspension apply here and particularly where there a dispute regarding ownership of the mark. In fact, the Board in *Robin Singh* granted the motion to stay, reasoning that the "Federal court may fully determine the parties' claims, while the Board is limited to the question of registration only. Finally, duplication of...litigation at the Board would likely prove a burden upon the Board and a waste of the parties' resources." *Robin Singh*, p. 4.

While a motion for stay of proceedings *in court* may require a showing of hardship or inequity, this is not the case for the suspension of Trademark Trial and Appeal Board

proceedings. Nowhere does it state in Applicant's cited case, *Robin Singh*, that such hardship or inequity is required for the Board to grant a motion to suspend. (Opposers provide the Board a copy at Exhibit 1 of the *Robin Singh* opinion for reference.) This is not a situation where there will not be any proceeding moving forward if the suspension is granted as could be the case in court.

Even if there were a requirement to show hardship or inequity prior to granting a suspension, the hardship in this case is on the party with superior rights to the marks at issue—*i.e.*, the Opposers, not Applicant. Contrary to what Applicant asserts, it is not the “rightful owner of the mark.” In fact, that very issue is the heart of both the civil action and this Opposition. As Applicant states, Applicant continues to use the mark while the civil litigation is pending and thus the status quo has been maintained during the pendency of the civil litigation. Using the discovery from the civil action in the Opposition, as suggested by Applicant, will not avoid duplicative proceedings, but the civil action discovery could be used in the Opposition after the civil action is complete. Applicant's arguments in its Response appear to be that a faster decision will be reached in the Opposition, however, moving the Opposition forward ahead of the civil action could result in inconsistent decisions regarding ownership and registration of the mark. Since the civil action can deal with both registrability and use issues, having the Opposition proceeding wait for the resolution of the civil action is likely to result in disposition of the Opposition while the reverse is not true.

As a final matter regarding Applicant's request for the case to be converted to Accelerated Case Resolution (“ACR”), Opposers submit that only cases with no factual disputes are appropriate for ACR, and that is not the case here. Additionally, “ACR presently can be implemented only by consent of the parties.” TBMP § 702.04(a). Opposer does not consent to

ACR in view of the many factual issues. Thus, Opposers respectfully ask the Board to deny Applicant's request for ACR.

For the foregoing reasons, Opposers respectfully request the Board grant Opposers' Motion to Suspend Proceeding pending a final determination of the Civil Action pursuant to 37 C.F.R. § 2.117(a) and TBMP § 510.

Respectfully submitted,

SHERIDAN ROSS P.C.

Date: July 24, 2013



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**CERTIFICATE OF SERVICE**

I, Amie Martin, do hereby certify that a copy of the foregoing OPPOSERS' REPLY AND BRIEF TO APPLICANT'S RESPONSE IN OPPOSITION TO OPPOSERS' MOTION TO SUSPEND PROCEEDING was served by first class mail, postage prepaid, on the 24<sup>th</sup> day of July, 2013, upon the attorney/domestic representative for the Applicant:



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# **EXHIBIT 1**

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

Mailed: February 14, 2005

Opposition No. 91163136

ROBIN SINGH EDUCATIONAL  
SERVICES, INC.

v.

Test Masters Educational  
Services, Inc.

**David Mermelstein, Attorney:**

On November 29, 2004, the Board instituted this proceeding and set discovery and trial dates. Applicant was allowed forty days, or until January 8, 2004, to answer. On January 18, 2005, (under certificate of mailing dated January 7), applicant filed a motion to dismiss pursuant to Fed. R. Civ. P. 12(b)(6). On January 20, 2005, applicant filed a motion to stay this proceeding in view of the civil matter pending between these parties. Opposer has filed responses to both motions.<sup>1</sup>

We consider first applicant's motion to suspend.

It is clear from the parties' filings that this proceeding is merely the latest skirmish between these and related parties over the rights to register and use the

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<sup>1</sup> Because the file copies of opposer's papers have not yet reached the Board, opposer's counsel has - upon the Board's

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TICKETMASTERS mark. Over the last decade and a half, this dispute has been fought out in courts in the District of Columbia, Texas and California, and has been appealed to the U.S. Court of Appeals for the Fifth Circuit twice; the second appeal is still pending.

Under Trademark Rule 2.117(a),

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

The standard set out in the quoted rule is liberal and vests broad discretion in the Board to determine whether suspension is appropriate in view of related proceedings. The related matter need not be dispositive of all or even part of the Board proceeding; suspension may be justified when the related proceeding "*may have a bearing on the case...*" *Id.* (emphasis added).<sup>2</sup>

The Board is traditionally inclined to suspend its proceedings in deference to civil court proceedings. *E.g.* *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22

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request - sent both motions to the above Board attorney by facsimile.

<sup>2</sup> The quoted language reflects amendments to the rule effective in 1988. The language of the previous version allowed suspension when the related proceeding "may be dispositive of the case." (emphasis added) The rule was amended to clarify and codify Board practice which was considerably more deferential to related proceedings than the previous language of the rule would suggest.

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USPQ2d 1933 (TTAB 1992); *Toro Co. v. Hardigg Industries, Inc.*, 187 USPQ 689 (TTAB 1975), *rev'd on other grounds*, 549 F.2d 785, 193 USPQ 149 (CCPA 1977); *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125 (TTAB 1974), *pet'n denied*, 181 USPQ 779 (Comm'r 1974); *Tokaido v. Honda Associates Inc.*, 179 USPQ 861 (TTAB 1973); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971); *Squirrel Brand Co. v. Barnard Nut Co.*, 101 USPQ 340 (Comm'r 1954); *Townley Clothes, Inc. v. Goldring, Inc.*, 100 USPQ 57 (Comm'r 1953).

The Board will generally suspend in view of a civil action for several reasons. First, the Board's jurisdiction is strictly limited to questions of registrability, while the district court may consider broader questions of infringement, and because the district court has a broad range of available remedies not available before the Board, e.g., injunctions, damages, attorney fees, etc. Second, a final decision of the Board is subject to *de novo* review in district court - possibly in the same district court in which the parties are now litigating. Finally, suspension by the Board promotes judicial economy, avoiding duplicative proceedings with possibly inconsistent results.

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Notice, Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 1214 TMOG 145 (September 29, 1998).

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Applicant argues that the matter now pending before the Fifth Circuit would be dispositive of opposer's rights in this opposition; opposer disagrees. But we need not decide this question at this juncture, because the standard for suspension does not require that the civil action be potentially dispositive of the Board case, only that it "may have a bearing" on the opposition. That standard has clearly been met.

Finally, there appear to be no facts here which would argue against suspension. Neither party would appear to be prejudiced by any delay<sup>3</sup> occasioned by suspension.<sup>4</sup> Moreover, the Federal court may fully determine the parties' claims, while the Board is limited to the question of registration only. Finally, duplication of discovery and litigation at the Board would likely prove a burden upon the Board and a waste of the parties' resources.

As a final matter, opposer argues that "the Fifth Circuit in effect has sanctioned the commencement and continuation of this proceeding." We do not view a circuit court's stay of the district court's injunction against

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<sup>3</sup> Indeed, there is no indication that the Board opposition would be any more expeditious than the federal proceeding already underway. To the extent that the pending federal proceeding finally resolves some or all of the issues now before the Board, it may result in a speedier resolution of the matter.

<sup>4</sup> Although applicant may suffer to some extent in that determination of its rights to registration may be delayed, it is applicant which is requesting suspension in this case. And although opposer may likewise have adjudication of its opposition

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opposer's filing and maintaining this opposition as dispositive of the question of suspension. The Circuit court only stayed the injunction, which could be reinstated after decision on the appeal. Moreover, as pointed out by opposer, the Board has the authority to control its own docket. See *Opticians Ass'n of America v. Indep. Opticians of America, Inc.*, 734 F. Supp. 1711, 14 USPQ2d 2021 (D.N.J. 1990). We do not view the Fifth Circuit's order as a requirement or even an invitation to engage in wasteful and duplicative proceedings.

After careful consideration of the parties' arguments, applicant's motion is GRANTED. Proceedings are accordingly SUSPENDED pending determination of the civil action between the parties. Trademark Rule 2.117(a). Within twenty days of a final disposition of the civil matter, the parties should so advise the Board and call this matter up for any appropriate action.<sup>5</sup>

During the course of the suspension, the Board shall be promptly informed of any change of address for counsel or the parties.

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delayed, it will suffer no harm because the subject application will not issue as a registration during suspension.

<sup>5</sup> In light of this order, we do not consider applicant's motion to dismiss at this time. The Board will take up applicant's motion, if appropriate, upon resumption of proceedings.