

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: May 6, 2014

Opposition No. 91212665

Ryan Lester

v.

Rhapsody International Inc.

**M. Catherine Faint,
Interlocutory Attorney:**

The contested motion (filed February 21, 2014) to suspend this proceeding pending final determination of Civil Action No. CV13-5489 CRB filed in the United States District Court for the Northern District of California is granted. 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 have a bearing on the Board case. *See* Trademark Rule 2.117(a).

Opposer has alleged priority and likelihood of confusion with its common law trademark in this opposition, but argues that the district court action is “unrelated” to the Board proceeding. The Board has scrutinized the pleadings in the civil action to determine if the issues may have a bearing on the Board’s decision in the opposition. *Forest Laboratories Inc. v. G.D. Searle & Co.*, 52 USPQ2d 1058, 1061 (TTAB 1999)(requiring parties to submit copy of complaint in civil action so Board “may determine whether suspension of proceedings herein is warranted.”). A decision by the district court may be binding on the Board

whereas a determination by the Board as to a party's right to obtain or retain a registration would not be binding or res judicata in respect to the proceeding pending before the court. *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805, 807 (TTAB 1971). Thus, the civil action does not have to be dispositive of the Board proceeding to warrant suspension, it need only have a bearing on the issues before the Board. *New Orleans Louisiana Saints LLC v. Who Dat?*, 99 USPQ2d 1550, 1552 (TTAB 2011); Trademark Rule 2.117(a).

Accordingly, proceedings are suspended pending final disposition of the civil action.

Within twenty days after the final determination of the civil action, the parties shall so notify the Board so that this proceeding may be called up for appropriate action.¹ Such notification to the Board should include a copy of any final order or final judgment which issued in the civil action.

During the suspension period, the parties must notify the Board of any address changes for the parties or their attorneys. In addition, the parties are to promptly inform the Board of any other related cases, even if they become aware of such cases during the suspension period. Upon resumption, if appropriate, the Board may consolidate related Board cases.

¹ A proceeding is considered to have been finally determined when a decision on the merits of the case (*i.e.*, a dispositive ruling that ends litigation on the merits) has been rendered, and no appeal has been filed therefrom, or all appeals filed have been decided. *See* TBMP § 510.02(b).