

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

Mailed: December 19, 2013

Opposition No. 91213091

Perine International Inc.

v.

Seena International, Inc.

**Robert H. Coggins,
Interlocutory Attorney:**

Now before the Board is applicant's motion (filed November 19, 2013) to suspend proceedings pending final determination of a civil action between the parties.¹ Opposer filed a brief in opposition thereto. The Board exercises its discretion to determine the motion before the expiration of applicant's time in which to file a reply.

It is the policy of the Board to suspend proceedings when the parties are involved in a civil action that may be dispositive of or have a bearing on the Board case. See Trademark Rule 2.117(a); and TBMP § 510.02(a) (3d ed. rev.2 2013). *Cf. Professional Economics Incorporated v. Professional Economic Services, Inc.*, 205 USPQ 368, 376 (TTAB 1979) (decision of state court, although not binding on the Board,

¹ Applicant's power of attorney (filed November 19, 2013, in corrected form) is noted and entered.

was considered persuasive on the question of likelihood of confusion); and *Argo & Co. v. Carpetsheen Manufacturing, Inc.*, 187 USPQ 336 (TTAB 1975) (state court action to determine ownership of applicant's mark and authority of applicant to file application).² Suspension of a Board case is appropriate even if the civil case may not be dispositive of the Board case, so long as the ruling may have a bearing on the rights of the parties in the Board case. See *Martin Beverage Co. Inc. v. Colita Beverage Company*, 169 USPQ 568, 570 (TTAB 1971).

The parties to the instant opposition proceeding are parties to Civil Action Index No. 650040/2012 in the Supreme Court of the State of New York. Opposer filed that civil action and included applicant as a defendant therein. While the original complaint does not raise trademark issues, the counterclaims do and they are directly related to the mark in the subject application.

In its brief in opposition to the motion to suspend, opposer states that the main issue of the civil action is a contract dispute between the parties; that the validity of the subject mark is only tangential to this main issue; that applicant originally wanted to expedite the subject application and previously claimed that the subject application and the civil action counterclaims were independent of each other, but now applicant wants to "change its tune"; and that applicant

² Opposer attempts to distinguish these cases, see Brief in Opp. p. 7, n.2; however, the cases are useful to support a proposition

has used many tactics to delay the civil action, so resolution of the Board proceeding will likely be quicker than any decision of the state court.

Upon review of the submitted pleadings from the civil action, the Board has determined that the civil action may have a bearing on the Board proceeding. It would therefore be appropriate to suspend Board proceedings pending disposition of the civil action. Indeed, by opposer's own admission, there are trademark issues currently pending before the state court, and common law trademark and unfair competition claims arising under the Lanham Act may be adjudicated before a state court judge. Accordingly, applicant's motion is **granted**, and proceedings in the Board case are **suspended** pending final disposition of the civil action between the parties.

Within twenty days after the final determination³ of the civil action, the parties shall so notify the Board so this case can be called up for any appropriate action (including resetting applicant's time in which to file an answer to the notice of opposition, if appropriate). During the suspension period the Board shall be notified of any address changes for the parties or their attorneys.

(here, suspension) different from the main proposition (i.e., state court issues) but sufficiently analogous to lend support.

³ 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.