

ESTTA Tracking number: **ESTTA658557**

Filing date: **02/27/2015**

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

Proceeding	91214086
Party	Plaintiff Starbuzz Tobacco Inc.
Correspondence Address	NATU J PATEL THE PATEL LAW FIRM PC 22952 MILL CREEK DRIVE LAGUNA HILLS, CA 92653 UNITED STATES NPatel@thePatelLawFirm.com, MUy@thePatelLawFirm.com, JChuan@thePatelLawFirm.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Natu J. Patel
Filer's e-mail	NPatel@thePatelLawFirm.com
Signature	/natupatel/
Date	02/27/2015
Attachments	motion to suspend.pdf(14613 bytes )

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

*In the Matter of Application Serial No. 85/774,314*

**Mark:** *MYST*

**Filed:** *November 8, 2012*

**Published:** *November 19, 2013*

STARBUZZ TOBACCO, INC.,	)	
	)	
Opposer,	)	<b>OPPOSITION NO: 91214086</b>
	)	
v.	)	<b>OPPOSER STARBUZZ TOBACCO, INC.'S MOTION TO SUSPEND PROCEEDINGS</b>
	)	
PHILIP MELNICK,	)	<b>Opposition Filed: December 18, 2013</b>
	)	
Applicant.	)	
	)	
	)	
	)	
	)	
	)	

**INTRODUCTION**

Pursuant to 37 C.F.R. § 2.117(a) and TBMP § 510.02(a), Opposer, Starbuzz Tobacco, Inc. (“Starbuzz”), through its undersigned counsel, hereby requests the Trademark Trial and Appeal Board (“Board”) to suspend this Opposition No. 91207921 (the “Opposition”) pending the final determination of *Starbuzz Tobacco, Inc. v. Philip Melnick*, Case No. 8:15-cv-00224 (the “Civil Action”). The Civil Action is currently pending between the parties before the United States District Court for the Central District of California (the “District Court”). The Civil Action involves the same trademark application at issue in the instant proceeding and will have a direct bearing on this Opposition.

## **FACTUAL BACKGROUND**

Starbuzz initially filed this Opposition against Applicant Philip Melnick's ("Applicant") trademark application for the mark MYST (Serial No. 85/774,314) based upon its ownership of the BLUE MIST, CITRUS MIST, PEACH MIST and TROPICAL MIST trademarks (collectively, the "Starbuzz Marks").

On February 9, 2015, Starbuzz initiated the Civil Action against Applicant in the District Court. *See* **Exhibit I**. In the Civil Action, Starbuzz alleges that Applicant has infringed upon its rights because Starbuzz has priority to the Starbuzz Marks over Applicant's MYST mark, and the marks are likely to be confused with each other. Starbuzz further requests for an order from the District Court directing the USPTO to deny the application to register the MYST mark. Therefore, in reaching a judgment in the Civil Action, the Court will necessarily need to resolve all of the issues that are currently before the Board with respect to the Opposition proceeding.

## **ARGUMENT**

Where a party to a case pending before the Board is also involved in a civil action that may have a bearing on a matter before the Board, it may suspend the proceeding until the final determination of the civil action. 37 C.F.R. § 2.117(a); TBMP § 510.02(a). This is because a decision by the United States District Court would be binding on the Board, whereas a determination by the Board as to a party's right to registration would not be binding or *res judicata* with respect to the proceeding before the United States District Court. *See, e.g., J. Thomas McCarthy, 6 McCarthy on Trademarks and Unfair Competition* § 32:94 (4th Ed. 2009).

In the Civil Action, Starbuzz asserts legal claims against Applicant, which relate directly to the claims and defenses raised in the instant Opposition proceeding. As binding precedent, the District Court's determinations in the Civil Action will directly affect the resolution of the issues currently before the Board.

For example, Starbuzz alleges in the Opposition that it has priority to the Starbuzz Marks over Applicant's MYST mark, and the marks are likely to be confused with each other. Likewise in the Civil Action, Starbuzz claims that Applicant is infringing upon the Starbuzz Marks for the same reasons. Therefore, the District Court will have to determine whether Starbuzz has priority to the Starbuzz Marks, and whether the parties' marks are likely to be confused with each other. Thus, the District Court's determination on such matters will constitute binding precedent.

### **CONCLUSION**

Based upon the foregoing, Starbuzz respectfully requests the Honorable Board to suspend the Opposition proceeding pending the final determination of the Civil Action.

Respectfully submitted,  
**THE PATEL LAW FIRM, P.C.**

---

Natu J. Patel  
Attorneys for Opposer,  
Starbuzz Tobacco, Inc.

The Patel Law Firm, P.C.  
22952 Mill Creek Drive  
Laguna Hills, CA 92653  
Telephone: (949) 955-1077  
Facsimile: (949) 955-1877  
NPatel@thePatelLawFirm.com

**CERTIFICATE OF SERVICE**

I certify that a copy of OPPOSER STARBUZZ TOBACCO, INC.'S MOTION TO SUSPEND PROCEEDINGS is being served via United States mail, postage prepaid, on this the 27th day of February 2015, to the following:

**Applicant's Attorney/Representative:**

PHILIP MELNICK  
PO BOX 131822  
STATEN ISLAND, NY 10313  
UNITED STATES  
philipmelnick@aol.com

---

Mark Uy