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

Proceeding	91214530
Party	Plaintiff American Latex Corp.
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Submission	Motion to Suspend for Civil Action
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Date	12/10/2014
Attachments	Motion to Suspend Proceedings.pdf(747647 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK TRIAL AND APPEAL BOARD

_____x

American Latex Corp. ,

Opposer

Opposition No. 91214530

v.

Thinkbug LLC,

Applicant

_____x

OPPOSER’S MOTION TO SUSPEND PROCEEDING IN VIEW OF PENDING CIVIL ACTION PURSUANT TO TRADEMARK RULE 2.117(A)

Opposer American Latex Corp. (“Opposer”) hereby moves for suspension of the proceedings in Opposition No. 91214530 pursuant to Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a), and T.B.M.P § 510.02(a). In support of this motion, Opposer submits herewith, attached as **Exhibit A**, a copy of its Complaint filed on December 9, 2014 by Opposer American Latex Corp. against Applicant ThinkBug, LLC (“Applicant”) in the United States District Court for the Central District of California, pending under Civil Action No. 2:14-cv-09456 (the “Complaint”).

The Complaint filed in federal court is based on:

- i. Opposer’s prior ownership and use of the mark “LOVES,” which was registered on or about July 19, 2005 and assigned Registration No. 2,972,332 (the “332 Registration”) in connection with adult sexual aids; and
- ii. Applicant ThinkBug, LLC’s subsequent use of the confusingly similar “SECRET LOVE” in connection with certain “[a]dult sexual stimulation aids,” which Applicant sought to register with the PTO via an application filed on or about November 14, 2013 and assigned Serial No. 86/118,907 (the “907 Application”).

The federal lawsuit initiated by Opposer in the Complaint alleges the following counts: (1) Trademark Infringement under 15 U.S.C. § 1114(1), (2) False Designation of Origin under 15 U.S.C. § 1125(a), and (3) Common Law Trademark Infringement. In its Complaint, Opposer asserts, among other things, that Applicant's use of the "SECRET LOVE" mark in connection with adult sexual aids is likely to cause, and upon information and belief, has caused "confusion, mistake and deception among members of the relevant public." Similarly, Opposer's Notice of Opposition alleges that "registration of the SECRET LOVE mark for use in connection with Applicant's goods is likely to cause confusion, mistake or deception."

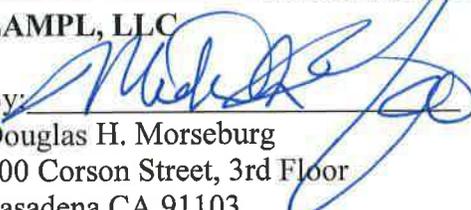
In addition, the Complaint seeks some of the same relief requested in this cancellation proceeding – namely, "a judicial declaration that Defendants are not entitled to a U.S. trademark registration for the term SECRET LOVE for use in connection with the goods that are the subject of the '907 Application."

Therefore, because the pending civil action initiated by the Complaint involves the same parties, requests the same relief and requires determination of the same legal issues which are involved in the present cancellation proceeding before the Board, the determination of these issues in federal court will necessarily be dispositive of this proceeding. T.B.M.P § 510.02(a); 37 C.F.R. § 2.117(a); *see, e.g., General Motors Corp. v. Cadillac Club Fashions, Inc.*, 22 U.S.P.Q.2d 1933, 1936-1937 (T.T.A.B. 1992); *Toro Co. v. Hardigg Industries, Inc.*, 187 U.S.P.Q. 689, 692 (T.T.A.B. 1975), *rev'd on other grounds*, 549 F. 2d 785 (C.C.P.A. 1977); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805, 806-07 (T.T.A.B. 1971).

Accordingly, Opposer therefore requests the suspension of these proceedings pending determination of the civil action, pursuant to Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a) and T.B.M.P § 510.02(a).

DATED: December 10, 2014

**LEECH TISHMAN FUSCALDO &
LAMPL, LLC**

By: 

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EXHIBIT A

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8 Attorneys for Plaintiff American Latex Corp.

9
10 UNITED STATES DISTRICT COURT
11 CENTRAL DISTRICT OF CALIFORNIA
12 WESTERN DIVISION

13 AMERICAN LATEX CORP., a)
14 California corporation,)
15 Plaintiff,)
16 v.)
17 THINKBUG, LLC, a Georgia limited)
18 liability company, and DOES 1-10,)
19 inclusive,)
20 Defendants.)

21 Case No.
22 **COMPLAINT FOR:**
23 1) **TRADEMARK**
24 **INFRINGEMENT;**
25 2) **FALSE DESIGNATION OF**
26 **ORIGIN; AND**
27 3) **COMMON LAW TRADEMARK**
28 **INFRINGEMENT;**
REQUEST FOR JURY TRIAL

COMPLAINT

1 Plaintiff American Latex Corp. (“Plaintiff”), through its attorneys, Leech
2 Tishman Fuscaldo & Lampl, alleges as follows:

3
4 **JURISDICTION AND VENUE**

5 1. The court has original jurisdiction of this action under 15 U.S.C. § 1121 and
6 28 U.S.C. §§ 1331 and 1338(a) in that this case arises under the Trademark Laws of
7 the United States, 15 U.S.C. § 1051, et seq. This court has supplemental jurisdiction
8 over Plaintiff’s non-federal claim under 28 U.S.C. § 1367 in that that claim is so
9 related to Plaintiff’s federal claims that it forms part of the same case or controversy.

10 2. Venue in this district is proper under 28 U.S.C. § 1391(b) on the grounds
11 that, on information and belief, a substantial part of the events giving rise to the
12 within claims occurred in this judicial district.

13
14 **THE PARTIES**

15 3. Plaintiff is a California corporation having a principal place of business in
16 Chatsworth, California and it is the owner of the LOVES mark described herein.

17 4. Defendant ThinkBug, LLC (“ThinkBug”) is, on information and belief, a
18 Georgia limited liability company.

19 5. The true names and capacities of the Defendants named herein as DOES 1
20 through 10, whether individual, corporate, associate, or otherwise, are unknown to
21 Plaintiff, who therefore sues said Defendants by said fictitious names. Plaintiff is
22 informed and it believes, and based thereon it alleges, that each of the Defendants
23 designated herein as DOES 1-10 is legally responsible for the infringement of
24 Plaintiff’s trademark rights hereinafter alleged and has legally caused injury and
25 damages proximately thereby to Plaintiff as alleged herein. Plaintiff will seek leave
26 to amend the Complaint when the true names and capacities of said DOE Defendants
27 have been ascertained. Hereafter, ThinkBug and DOES 1 through 10, are
28 collectively referred to as “Defendants.”

1 vibrators” in IC 010. The application was assigned Serial No. 86/118,907 (the “’907
2 Application”) and it claimed a date of first use in commerce of August 5, 2012.

3 16. Plaintiff is informed and it believes that its constructive and actual dates
4 of first use of LOVES in commerce are prior to the Defendants’ claimed and actual
5 dates of first use of SECRET LOVE. In addition, the goods with which Defendants
6 are using SECRET LOVE and which are identified in the ‘907 Application overlap
7 and are closely related to the goods that are the subject of Plaintiff’s ‘332
8 Registration. Finally, the SECRET LOVE mark that the Defendants are using and
9 that is the subject of the ‘907 Application incorporates a term that is virtually
10 identical to the mark that is the subject of Plaintiff’s ‘332 Registration, namely, the
11 term LOVE.

12
13 **FIRST CLAIM FOR RELIEF**

14 **(Against All Defendants for Trademark Infringement, 15 U.S.C. § 1114(1))**

15 17. Plaintiff incorporates paragraphs 1 through 16, above, as though set
16 forth fully herein.

17 18. The Defendants’ use of the term SECRET LOVE mark in connection
18 with their goods, as alleged above, is likely to cause confusion, mistake or deception
19 among members of the consuming public as to whether there is a connection or an
20 association between Plaintiff and Defendants or as to whether Defendants’ goods
21 originate with or are approved or sponsored by Plaintiff in violation of Section 32(1)
22 of the Lanham Act, 15 U.S.C. § 1114(1).

23 19. Plaintiff has never authorized the Defendants to use, or consented to
24 their use of, any words or names in connection with their products or services that
25 are similar to Plaintiff’s mark.

26 20. On information and belief, the Defendants’ acts have been undertaken
27 with full knowledge of Plaintiff’s rights in and to the LOVES mark and with the
28 willful and deliberate intent to cause confusion, mistake and deception among

1 members of the relevant public and to trade on the goodwill associated with
2 Plaintiff's mark.

3 21. By reason of Defendants' acts, as alleged herein, Plaintiff has suffered
4 damage to its business, reputation and goodwill and Defendants have realized profits
5 and sales they would not have made but for Defendants' conduct.

6 22. Defendants' acts have caused and will continue to cause irreparable and
7 immediate injury to Plaintiff for which Plaintiff has no adequate remedy at law.
8 Unless Defendants are restrained by this Court from continuing their unauthorized
9 use of words and symbols that are confusingly similar to Plaintiff's mark, these
10 injuries will continue to occur.

11
12 **SECOND CLAIM FOR RELIEF**

13 **(Against All Defendants for False Designation of Origin, 15 U.S.C. § 1125(a))**

14 23. Plaintiff incorporates paragraphs 1 through 16, above, as though set
15 forth fully herein.

16 24. The Defendants' actions, as alleged above, are likely to cause confusion,
17 mistake or deception among members of the consuming public as to whether there is
18 a connection or an association between Plaintiff and Defendants or as to whether
19 Defendants' goods originate with or are approved or sponsored by Plaintiff in
20 violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

21 25. Plaintiff has never authorized the Defendants to use, or consented to
22 their use of, any words or names in connection with their products or services that
23 are similar to Plaintiff's mark.

24 26. On information and belief, the Defendants' acts have been undertaken
25 with full knowledge of Plaintiff's rights in and to the LOVES mark and with the
26 willful and deliberate intent to cause confusion, mistake and deception among
27 members of the relevant public and to trade on the goodwill associated with
28 Plaintiff's mark.

1 possession, or under their control, bearing or intended to bear the term **SECRET**
2 **LOVE** or any permutation of that term, whether alone or in combination with other
3 words, characters or symbols;

4 3. For an order permanently enjoining Defendants and their officers,
5 agents, employees, and all those acting in concert or conspiracy with them from
6 making use of the term **SECRET LOVE** or any phonetic equivalent of that mark in
7 connection with the sale of adult sexual aids;

8 4. For a judicial declaration that Defendants are not entitled to a U.S.
9 trademark registration for the term **SECRET LOVE** for use in connection with the
10 goods that are the subject of the '907 Application;

11 5. For a monetary award in favor of Plaintiff in an amount equal to (i)
12 Plaintiff's actual damages and (ii) to the extent not included in actual damages, the
13 Defendants' profits flowing from the acts alleged above, such damages and profits to
14 be trebled under 15 U.S.C. § 1117(a);

15 6. For a finding that this is an exceptional case within the meaning of, and
16 for an award of attorneys' fees pursuant to, 15 U.S.C. § 1117(a);

17 7. For an award of pre-judgment interest and post-judgment interest in the
18 maximum amount permitted by law;

19 8. For a finding that the Defendants' acts were undertaken intentionally,
20 maliciously and/or with a reckless and wanton disregard of Plaintiff's rights and for
21 an award of exemplary damages pursuant to California Civil Code section 3295 in an
22 amount sufficient to punish, deter, and make an example of Defendants for the acts
23 complained of herein;

24 9. For an award of costs under 15 U.S.C. § 1117(a), or as otherwise
25 provided by law;

26 10. For such other and further relief as the Court deems just and proper.

27 Dated: December 9, 2014

LEECH TISHMAN FUSCALDO & LAMPL

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By: /s/ Douglas H. Morseburg
Douglas H. Morseburg

Attorneys for Plaintiff American Latex Corp.

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REQUEST FOR JURY TRIAL

Plaintiff requests trial by jury on all issues so triable.

Dated: December 9, 2014

LEECH TISHMAN FUSCALDO & LAMPL

By: /s/ Douglas H. Morseburg
Douglas H. Morseburg

Attorneys for Plaintiff American Latex Corp.

CERTIFICATE OF SERVICE

The undersigned certifies that on the 10th day of December 2014, a true copy of the foregoing **MOTION TO SUSPEND PROCEEDING IN VIEW OF PENDING CIVIL ACTION PURSUANT TO TRADEMARK RULE 2.117(A)** was served on the opposing party via email and via United States first class mail, postage prepaid, addressed as follows:

Mr. James Lin
THINKBUG LLC
4155 Lawrenceville Hwy, NW #8178
Lilburn, GA 30047-1500
Email: admin@thinkbug.net

