

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

mbm/gcp

Mailed: August 25, 2016

Opposition No. 91218280 (**Parent Case**)  
Cancellation No. 92060249

*Mya Saray, LLC*

v.

*Ibrahim Dabes dba Dabes Egyptian Imports*

George C. Pologeorgis,  
Administrative Trademark Judge:

These consolidated proceedings now come before the Board for consideration of Opposer's/Petitioner's motion (filed March 23, 2016) to suspend these consolidated proceedings pending final disposition of a civil action between the parties herein filed in the United District Court for the Eastern District of Virginia (the "Civil Action").<sup>1</sup> On August 9, 2016, Applicant/Respondent filed its response to the motion.<sup>2</sup>

---

<sup>1</sup> Civil Action No. 1:16-cv-00064, styled *Mya Saray, LLC v. Ibrahim Dabes d/b/a Dabes Egyptian Imports, et al.*, filed on or about January 20, 2016.

<sup>2</sup> After Applicant/Respondent did not file a brief in response to Opposer's/Petitioner's motion to suspend by the extended April 19, 2016 deadline, the Board granted Opposer's/Petitioner's motion as conceded. 24 TTABVUE. Applicant/Respondent then moved to vacate the Board's order suspending the proceedings and to reopen the time to respond to Opposer's/Petitioner's motion to suspend. 27 TTABVUE. The Board granted the combined motion and allowed Applicant/Respondent until August 9, 2016 to file a response to Opposer's/Petitioner's motion to suspend. 28 TTABVUE.

Opposer/Petitioner submitted a copy of the civil action complaint in the Civil Action concurrently with its motion to suspend.

In support of its motion, Opposer/Petitioner maintains that final disposition of the Civil Action would have a bearing on the issues in these consolidated proceedings. Specifically, Opposer/Petitioner contends that the Civil Action (1) involves the same parties to these consolidated proceedings, (2) concerns, in part, Applicant's/Respondent's marks at issue in these consolidated proceedings, and (3) involves common issues of law and fact. Accordingly, Opposer/Petitioner argues that suspension of these consolidated proceedings pending the final determination of the Civil Action is warranted since the registrability and maintenance of Applicant/Respondent's marks will be decided in the Civil Action and such a determination will have a bearing on the issues in these consolidated proceedings.

In response, Applicant/Respondent maintains that the issues in the Civil Action are not identical to those at issue in these consolidated proceedings. Specifically, Applicant/Respondent argues that Opposer/Petitioner has pleaded additional registrations in support of its asserted claims in these consolidated proceedings that are not subject to the Civil Action. In view thereof, Applicant/Respondent contends that any final determination made in the Civil Action will not be determinative of all of the issues before the Board in these consolidated proceedings.

Applicant/Respondent also maintains that the Civil Action involves more parties and other claims not at issue in these consolidated proceedings; consequently, Applicant/Respondent argues that the final disposition in the Civil Action will occur later than a final determination in these consolidated proceedings. Finally, Applicant/Respondent contends that suspension is not appropriate and will serve to delay resolution, because these consolidated proceedings are substantially more advanced than proceedings in the Civil Action (in which Applicant/Respondent maintains it has not yet been served with the complaint). In view of the foregoing, Applicant/Respondent requests that the Board deny the motion to suspend for civil action.

**Decision**

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); TBMP § 510.02(a) (2016).

Following a careful review of the complaint in the Civil Action, the Board finds that a decision by the district court could have a bearing on the issues in these consolidated proceedings. Specifically, the Board notes that Opposer/Petitioner seeks, *inter alia*, “cancellation” of Applicant’s/Respondent’s application Serial No. 86025182 and Registration No. 4536391, which are the same application and registration at issue in these consolidated proceedings. *See* Paragraph K of Prayer for Judgment in civil complaint. Clearly, if the district court grants the aforementioned relief and orders the USPTO to (1)

abandon Applicant's application Serial No. 86025182, and (2) cancel Respondent's Registration No. 4536391, such a ruling would have a direct bearing on the issues in these consolidated proceedings.<sup>3</sup> The Board further notes that, to the extent that a civil action in a Federal district court involves issues in common with those in a Board proceeding (which the Board has found in this instance), the district court decision would be binding on the Board. *See Wella Corp. v. Cal. Concept Corp.*, 194 USPQ 419, 423 (CCPA 1977); *Midland Cooperatives, Inc. v. Midland Int'l Corp.*, 164 USPQ 579, 583 (CCPA 1970).

Furthermore, Board decisions are appealable to the district court. *See* Section 21(b) of the Trademark Act, 15 U.S.C. § 1071(b). Finally, suspending this matter pending the final determination of the Civil Action will serve the interests of judicial economy.

Accordingly, Opposer's/Petitioner's motion to suspend these consolidated proceedings for civil action is **GRANTED** as well taken and these consolidated proceedings are therefore **suspended** pending the final disposition of the Civil Action, including all appeals.

---

<sup>3</sup> The Board finds unpersuasive Applicant's/Respondent's argument that suspension of the Board proceedings is unwarranted because the claims in the Civil Action and these consolidated proceedings are not entirely overlapping. Although there may be some issues unique to either the Civil Action or these consolidated proceedings, both involve claims concerning the registrability of Applicant's application Serial No. 86025182 and the maintenance of Respondent's Registration No. 4536391. Additionally, the fact that Applicant/Respondent may have not yet been served with the civil action complaint also does not justify not suspending this consolidated case at this juncture of the proceedings.

Within twenty (20) 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.<sup>4</sup> Such notification to the Board should include a copy of any final order or final judgment that issued in the Civil Action.

The Board will reset trial dates upon resumption of this proceeding, if necessary and appropriate. 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.

---

<sup>4</sup> 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 merit(s) has been rendered, and no appeal has been filed therefrom, or all appeals filed have been decided. *See* TBMP § 501.02(b).