

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

BUO

Mailed: May 8, 2015

Opposition No. 91219909

Select Comfort Corp.

v.

Dires LLC

Benjamin U. Okeke, Interlocutory Attorney:

Now before the Board is Opposer's motion, filed March 11, 2015, to suspend the current proceeding pending disposition of a civil action filed by Select Comfort Corporation ("Opposer") in the U.S. District Court for the District of Minnesota, against, inter alia, Dires, LLC d/b/a Personal Touch Beds and Personal Comfort Beds ("Applicant") (hereinafter "the civil action").¹ In support of its motion, Opposer attached a copy of the amended complaint filed in the civil action.

Opposer avers that the parties to this opposition proceeding are both parties to the civil action, and that the civil action is "ongoing." Opposer asserts that the complaint it has filed and served in the civil action contains allegations of trademark infringement and dilution, and thus suspension is appropriate to

¹ The civil action is styled as *Select Comfort Corporation; and Select Comfort SC Corporation v. John Baxter; Dires, LLC d/b/a Personal Touch Beds and Personal Comfort Beds; Digi Craft Agency, LLC; Direct Commerce, LLC d/b/a Personal Touch Beds; and Scott Stenzel; and Craig Miller*, Case No. 12-cv-2899-DWF-SER (D. Minn. 2013).

minimize the time, money and risk of contradictory findings by the Board and the District Court. Applicant specifically asserts that the “outcome of both [Opposer’s] claims and [Applicant’s] Counterclaims in [the civil action] directly bear on the issues in this proceeding.” 6 TTABVUE 6.

Applicant contests suspension of this proceeding, arguing that the civil action “will have a minimal and tangential effect on this Opposition;” 7 TTABVUE 6, and since Applicant’s entire mark is not at issue in the civil action “even if the District of Minnesota finds that the phrase ‘Number Bed,’ is likely to cause confusion and even if an injunction is granted prohibiting Dires from using the phrase ‘Number Bed,’” that would not preclude registration of the mark involved herein. *Id.* at 7. Finally, Applicant contends that the civil action involves many unrelated issues and parties.” *Id.* at 9.

Motion to Suspend

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). The Board may suspend proceedings whenever it comes to the attention of the Board that a party or parties to a case pending before it are involved in a civil action which ***may*** have a bearing on the Board case (emphasis added).² Trademark Rule 2.117(a). *See General Motors Corp.*

² The Board may suspend proceedings for the disposition of a civil action without any motion at all. A civil action need only be brought to the Board’s attention. The Board will normally require a copy of the operative pleadings from the civil action be submitted, so that the Board can ascertain whether the final determination of the civil action may have a bearing on the issues before the Board. *See New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011). However, the Board may suspend the proceeding even without the submission of the complaint and require the movant to promptly file such complaint.

v. Cadillac Club Fashions Inc., 22 USPQ2d 1933 (TTAB 1992). Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board. *See Opticians Ass'n of Am. v. Indep. Opticians of Am. Inc.*, 734 F. Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990).

Opposer's motion to suspend, which indicates that the parties to this proceeding are both parties to a civil action involving a question of trademark infringement is sufficient to bring the civil action to the Board's attention.

Applicant misses the mark in its contention of the motion. The standard is not that the determination of the civil action be dispositive of the Board proceeding, or that the issues in both forums are duplicated or will be precluded, but instead that the civil action "may have a bearing on the Board's proceeding. *See Trademark Rule 2.117(a); TBMP § 510.02(a) (2014)*. This, of course, is a lower standard.

This opposition involves a claim of likelihood of confusion, which implicates questions akin to those considered in a district court's determination of infringement, *e.g.* similarity of the marks, relatedness of the goods, priority, etc. Where grounds for a civil action involve a claim of infringement, a district court's findings regarding the similarity of the marks or relatedness of the goods or services, or any of the sub-issues involved therein, may have a bearing on a concurrent Board proceeding and would in any case inform our determination on those issues. Therefore, suspension of the Board's proceeding would be appropriate in view of a related civil action involving a claim of infringement. *See Other Tel. Co. v. Conn. Nat'l Tel. Co.*, 181 USPQ 125, 126-27 (TTAB 1974) (decision in civil action

for infringement and unfair competition would have bearing on outcome of Trademark Act § 2(d) claim before Board), *pet. denied*, 181 USPQ 779 (Comm'r 1974).

Accordingly, Opposer's motion to suspend is **GRANTED** and this proceeding is **SUSPENDED** pending final disposition of the civil action.³

Within **TWENTY DAYS** after the final determination of the civil action, the parties shall so notify the Board in writing, including a copy of the court's final order.

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.

³ In light of the suspension of the proceeding, the parties' stipulated motion, filed April 1, 2015, for an extension of time to serve their respective initial disclosures is made moot. Dates will be reset upon resumption of the proceeding.