UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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BUO

Mailed: October 1, 2015

Opposition No. 91220321

Primal Kitchen

v.

Primal Nutrition, Inc.

Benjamin U. Okeke, Interlocutory Attorney:

Now before the Board is Applicant's motion, filed August 26, 2015, to suspend the current proceeding pending disposition of a civil action filed by Primal Nutrition, Inc. ("Applicant") in the U.S. District Court for the Central District of California, for declaratory judgment of noninfringement against, Primal Kitchen ("Opposer") (hereinafter "the civil action").[1] In support of its motion, Applicant attached a copy of the complaint filed in the civil action.

Applicant avers that the parties to this opposition proceeding are both parties to the civil action, and that the civil action involves the "same mark at issue, which raises the same issues of fact and law." 5 TTABVUE 2.

[1] The civil action is styled as *Primal Nutrition, Inc. v. Primal Kitchen LLC,* Case No. 2:15-CV-06387-CAS-E (C.D. Cal. 2015).

Opposer contests suspension of this proceeding, arguing that the Board should not suspend the proceeding at this time "[i]n light of Applicant's apparent refusal to proceed in a manner which could possibly facilitate settlement in the pending matter, including its failure to reasonably participate in the discovery process," and instead allow Opposer time to determine whether a motion to compel should be filed. 7 TTABVUE 4.

The Board has considered the parties' submissions and presumes the parties' familiarity with the arguments made therein. The parties' arguments will not be further summarized herein except as necessary to explain the Board's decision.

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. v. Cadillac Club Fashions Inc.,* 22 USPQ2d 1933 (TTAB 1992). Suspension of a Board proceeding pending the final determination of another proceeding is solely

[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.

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).

Applicant'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.

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).

Opposer misses the mark in its contention of the motion. There is currently no motion to compel pending, and even had a motion to compel been filed, the Board simply could have suspended consideration of that motion until, or if, this proceeding was resumed.

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

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.