

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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MW/MC

Mailed: November 19, 2015

Opposition No. 91223192

*Barnlight Originals, Inc.*

*v.*

*Barn Light Electric Company, LLC*

**Marc A. Bergsman, Administrative Trademark Judge:**

On August 7, 2015, Barnlight Originals, Inc. (“Opposer”) filed a notice of opposition opposing registration of application Serial No. 86476717, filed by Barn Light Electric Company (“Applicant”) for the mark BARN LIGHT ELECTRIC COMPANY in standard characters. As grounds for opposition, Opposer claims that the wording “BARN LIGHT” is generic and should be disclaimed in the application for registration. On September 16, 2015, Applicant filed its answer denying the salient allegations in the notice of opposition.

This proceeding now comes before the Board for consideration of Applicant’s motion (filed September 8, 2015) to suspend this proceeding pending the final disposition of Civil Action No. 8:14-cv-01955-MSS-AEP filed in the United States District Court for the Middle District of Florida. Applicant included a copy of the civil action complaint with its motion. The motion is fully briefed.

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 has carefully reviewed the complaint in the civil action through which Applicant, as plaintiff in the civil action, alleges, *inter alia*, trademark infringement by Opposer and others.<sup>1</sup> In view thereof, the Board finds that a decision by the district court would have a bearing on the issue in this opposition proceeding. Specifically, if the district court finds that Respondent's mark is inherently distinctive or has acquired distinctiveness, such a finding would clearly have a bearing on Petitioner's asserted claim of genericness in this case. *See, e.g., New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (civil action need not be dispositive of Board proceeding, but only needs to have a bearing on issues before the Board). 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, e.g., Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988). Further, Board decisions are appealable to the district court. *See* Section 21(b) of the Trademark Act, 15 U.S.C. § 1071(b) and *Id.* at 1953. Finally, suspending this matter pending the final determination of the civil action will serve the interests of judicial economy.

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<sup>1</sup> Civil Action No. 8:14-cv-01955-MSS-AEP, styled *Barn Light Electric Company, LLC v. Barnlight Originals, Inc., Hi-Light Manufacturing Company, Inc., and Jeffrey L. Ohai*.

Accordingly, Applicant's motion to suspend the proceeding is **granted** as well taken and proceedings are, therefore, **suspended** pending final disposition of the civil action, including all appeals.

Within twenty 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>2</sup> Such notification to the Board should include a copy of any final order or final judgment which issued in the civil action.

In addition, it has come to the Board's attention that Opposition Nos. 91223192 and 91223193 involve the same application for registration and the same claim. Both proceedings have been suspended pending the same civil action. Therefore, upon resumption, the Board will consolidate the proceedings.

During the suspension period, the parties must notify the Board of any address changes for the parties or their attorneys. Additionally, 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. The Board may, at such time, consolidate any other related Board cases.

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<sup>2</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 merits) has been rendered, and no appeal has been filed therefrom, or all appeals filed have been decided. *See* TBMP § 510.02(b).