

ESTTA Tracking number: **ESTTA743423**

Filing date: **04/29/2016**

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

Proceeding.	91226424
Applicant	Plaintiff Engage Healthcare Communications, LLC
Other Party	Defendant Intellisphere, LLC
Have the parties held their discovery conference as required under Trademark Rules 2.120(a)(1) and (a)(2)?	No

Motion for Suspension in View of Civil Proceeding With Consent

The parties are engaged in a civil action which may have a bearing on this proceeding. Accordingly, Engage Healthcare Communications, LLC hereby requests suspension of this proceeding pending a final determination of the civil action. Trademark Rule 2.117.

Engage Healthcare Communications, LLC has secured the express consent of all other parties to this proceeding for the suspension and resetting of dates requested herein.

Engage Healthcare Communications, LLC has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Respectfully submitted,
/Janet W. Cho/
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04/29/2016

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

In the Matter of Application Serial No. 86/726,213
For the Mark: V-B ONC
Filing Date: August 15, 2015

Engage Healthcare Communications, LLC,)
)
Petitioner,)
)
v.)
)
Intellisphere, LLC,)
)
Applicant.)

Opposition No. 91226424

JOINT MOTION FOR SUSPENSION IN VIEW OF CIVIL PROCEEDING

Pursuant to 37 C.F.R. §2.117(c) and TBMP §§ 501, 510, Petitioner and Applicant, by counsel, hereby jointly request that the Trademark Trial and Appeal Board (“Board”) suspend the current opposition proceeding (“Proceeding”). The parties are simultaneously engaged in a civil action which the parties believe will have a bearing on this Proceeding, entitled *Engage Healthcare Communications, LLC, v. Intellisphere, LLC*, and is Civil Action 12-civ-787-FLW-LHG, pending in the United States District Court for the District of New Jersey.

The Trademark Rules of Practice expressly provide for the suspension of proceedings when the parties to a case pending before the Board are engaged in a civil action which may be dispositive of the case. 37 CFR § 2.117(a); *see also General Motors Corp. v. Cadillac Club Fashions, Inc.*, 22 U.S.P.Q.2d 1922 (TTAB 1992). The Board frequently suspends proceedings before it when an action filed in Federal District Court involves issues in common with those in a proceeding before the Board. *See* TBMP § 510.02(a) (and cases cited therein). It is well settled that “(t)o the extent that a civil action in a Federal District Court involves issues in

common with those in a proceeding before the Board, the decision of the Federal District Court is binding upon the Board." TBMP § 510.02(a); *see also Goya Foods, Inc. v. Tropicana Products, Inc.*, 846 F.2d 848, 6 U.S.P.Q. 2d 1950 (2d Cir. 1988); *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F.Supp. 563, 2 U.S.P.Q. 2d 1208 (D. Minn. 1986).

Moreover, the Parties respectfully submit that the interests of judicial economy require that this opposition proceeding be suspended pending the resolution of the Federal Court Action. Granting this Motion will relieve the parties from engaging in, and incurring the expense of further or duplicative discovery, motion practice and/or oral argument which would be unnecessary in light of the pending Federal Court Action. More significantly, however, granting this Motion would relieve the Board from expending its precious, limited judicial resources unnecessarily or prematurely. *See American Bakeries*, 2 U.S.P.Q.2d at 1211 (concluding stay is appropriate when adjudication might serve as a final disposition of the matter, making further proceedings unnecessary).

Accordingly, Petitioner Engage Healthcare Communications, LLC ("ENGAGE") and Intellisphere, LLC, hereby jointly request suspension of this Proceeding pending a final determination of the civil action. Trademark Rule 2.117.

ENGAGE has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Respectfully submitted,

LECLAIRRYAN

Dated: 4.29.14

By: 

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DAY PITNEY LLP

Dated: April 29, 2016

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Joint Motion for Suspension in View of Civil Proceeding has been served via first class mail, this 29th day of April, 2016, at the following address:

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Jennifer M. Carnes