

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

Mailed: July 18, 2006

Cancellation No. 92045849

PRIMEPAY, INC. PRIMEPAY,
INC.

v.

Primepoint, L.L.C.

David Mermelstein, Attorney:

Now before the Board is respondent's motion to suspend in view of a civil proceeding between the parties, now pending in the U.S. District Court for the District of New Jersey.

The civil proceeding involves claims of infringement and unfair competition under the Trademark Act, as well as claims of state unfair competition and equitable estoppel. Respondent herein seeks an injunction against petitioner's use of the mark at issue, as well as declaratory and other relief.

Petitioner filed an answer and counterclaim in the civil proceeding, also alleging infringement under state and federal trademark law, and fraud in the procurement of the registration at issue in the Board. Petitioner requests

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declaratory and injunctive relief, as well as an award of damages and profits.

The Board may suspend a proceeding before it when it appears that the parties are engaged in a civil matter which "may have a bearing" on the Board proceeding. Trademark Rule 2.117(a). As noted by petitioner, suspension of a proceeding is within the Board's discretion. However, the Board has almost uniformly exercised such discretion in favor of suspension. This policy recognizes the broader jurisdiction and remedial options available to the civil courts, reduces costs, promotes efficient use of the Board's and the parties' resources, and respects the authority of the federal courts.

Here, petitioner does not argue that the civil proceeding does not meet the "may have a bearing" standard. Rather, petitioner urges that the Board is "uniquely situated" to decide the issue of fraud, which it has raised in both proceedings. Petitioner does not explain why this is so. In any event, we have no doubt that the District Court will be able to competently decide this - and any other - issue before it.

It appears that the district court properly has before it all (or almost all) of the issues raised in this

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cancellation proceeding,¹ as well as other claims for infringement, injunctive relief, etc., which we have no authority to consider. The bifurcation of this proceeding would accomplish little more than a waste of time and effort on the part of both the Board and the parties.

Accordingly, proceedings herein are SUSPENDED pending a final resolution of the parties' civil suit. Within twenty days of such a final judgment, the parties shall file the disposition with the Board and seek any appropriate action from the Board.

During the course of the suspension, the parties shall notify the Board of any change in address for the parties or their counsel.

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¹ We note that, although petitioner's civil counterclaim includes a count alleging that respondent's registration "is invalid because it was procured through fraud," it does not appear that petitioner has specifically requested that the District Court issue an order canceling the registration. See Trademark Act § 37, 15 U.S.C. § 1119.