

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

Mailed: June 12, 2012

Cancellation No. 92055403

Barry Biondo dba Topsy Spa  
and Salon

v.

Thanh Nguyen

**George C. Pologeorgis,  
Interlocutory Attorney:**

This case now comes before the Board for consideration of petitioner's motion (filed April 14, 2012) for reconsideration of the Board's April 12, 2012, order granting respondent's motion (filed April 12, 2012) to suspend this proceeding pending the final disposition of a civil action between the parties herein. The motion has been fully briefed.

Subsequent to the filing of the aforementioned motion, the Board, pursuant to its inherent authority to manage its docket, suggested that the issues raised in petitioner's motion should be resolved by telephonic conference as permitted by TBMP § 502.06 (3d ed. 2011). The Board contacted the parties to discuss the date and time for holding the phone conference.

The parties agreed to hold a telephone conference at 10:00 a.m. EDT on Friday, June 8, 2012. The conference was held as scheduled among Wendy Peterson, as counsel for petitioner, Scott Konopka and Paige Gillman, as counsel for respondent, and George C. Pologeorgis, as a Board attorney responsible for resolving interlocutory disputes in this case.

The Board carefully considered the arguments raised by the parties, as well as the supporting correspondence and the record of this case, in coming to a determination regarding the above matters. During the telephone conference, the Board made the following findings and determinations:

**Petitioner's Motion for Reconsideration**

Petitioner's motion for reconsideration is **denied** for the reasons set forth below.

As background, petitioner filed a petition to cancel respondent's Registration No. 3529699 for the mark TIPSY used in association with "bar services" on March 29, 2012. As grounds for cancellation, petitioner alleges, among other things, that (1) registrant's mark was not in use at the time of the filing date of respondent's underlying application because it fails to function as a mark, (2) registrant's mark is merely a trade name and therefore was not in use as a service mark as of the filing date of

respondent's underlying application, and (3) the specimens submitted during the prosecution of respondent's underlying application do not support use of respondent's mark as a service mark.<sup>1</sup> As a basis for his standing, petitioner contends that his pending application Serial No. 85272051 for the mark TIPSY SPA SALON for "day spa services, namely, nail care, manicures, pedicures and nail enhancements; Hair salon services, namely, hair cutting, styling, coloring, and hair extension services" has been opposed by respondent in a related Board proceeding, i.e., Opposition No. 91202097.

In lieu of filing an answer, respondent, on April 12, 2012, filed a motion to suspend this proceeding pending a final determination of a civil action between the parties in the United States District Court for the Southern District of Florida. Respondent included copies of the civil action complaint and counterclaim with its motion papers.

In the civil action, respondent has asserted, *inter alia*, a claim of trademark infringement and a request for injunctive relief seeking to enjoin petitioner from using the mark TIPSY or any confusingly similar variation thereof.

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<sup>1</sup>During the telephone conference, the Board advised petitioner's counsel that while the failure to make service mark use as of the filing date of respondent's underlying use-based application may constitute a proper ground for cancellation, a claim based solely on the alleged failure of the specimens submitted in conjunction with respondent's underlying application to show such use is not a proper basis for cancellation. See *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989).

Petitioner, in the civil action, filed a counterclaim seeking to cancel respondent's involved registration on the ground of fraud. Following a careful review of the civil action pleadings, the Board issued an order on April 14, 2012 granting respondent's motion to suspend for civil action as well taken. By said order, the Board found that a decision by the district court could be dispositive of, or have a bearing on, the issues in this cancellation proceeding.

We now turn to petitioner's motion for reconsideration. In support thereof, petitioner essentially argues that the Board is uniquely qualified to review its own cases and determine the issues presented before it without the involvement of the district court. Moreover, petitioner contends that suspending this proceeding without allowing petitioner a chance to object prejudices petitioner and only favors registrant. Finally, petitioner maintains that suspending the Board proceeding pending the final disposition of the civil action eliminates the potential savings in time, effort and expense that can be gained if the Board were to decide the issues presented in this cancellation proceeding.

In response, respondent argues that petitioner has failed to demonstrate that the Board committed any error in granting respondent's motion to suspend. Respondent further

contends that the claims it has alleged in the civil action are likely to be dispositive of or have an impact on this cancellation proceeding, particularly since the identical parties and the same mark are at issue in the federal district court action. In view thereof, respondent requests that the Board deny petitioner's motion for reconsideration and maintain the stay of this proceeding pending the final disposition of the civil action.<sup>2</sup>

It has often been stated that the premise underlying a request for reconsideration under Trademark Rule 2.144 is that, based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it issued. See TBMP § 518 (3d ed. 2011) and authorities cited therein. The request may not be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in the requesting party's brief on the case. See *Amoco Oil Co. v. Amerco, Inc.*, 201 USPQ 126 (TTAB 1978). Rather, the request normally should be limited to a demonstration that, based on the evidence

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<sup>2</sup>During the telephone conference, the Board noted that respondent's opposition to petitioner's motion for reconsideration included a request that the Board grant respondent's motion to dismiss the petition to cancel based on the doctrine of *res judicata*. The Board further noted that respondent has not filed any such motion for the Board's consideration. In response, respondent's counsel withdrew this request for relief from respondent's opposition. Accordingly, the Board will give no further consideration to this particular request for relief.

properly of record and the applicable law, the Board's ruling is in error and requires appropriate changes. See *Steiger Tractor Inc. v. Steiner Corp.*, 221 USPQ 165 (TTAB 1984), *different results reached on reh'g*, 3 USPQ2d 1708 (TTAB 1984).

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). Although the Board has now been apprised, via respondent's opposition to petitioner's motion for reconsideration, that petitioner's counterclaim in the civil action was dismissed with prejudice, the Board nonetheless finds that the final disposition of the civil action may still have, at a minimum, a bearing on the issue of petitioner's standing in this case. Specifically, if the district court enjoins petitioner from using the mark TIPS Y or any variation thereof, such a decision may directly affect petitioner's standing in this proceeding.<sup>3</sup>

In view of the above, the Board remains of the opinion that its April 12, 2012, order granting respondent's motion to suspend for civil action is correct and, therefore, stands as

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<sup>3</sup>The fact that the Board has found that the final disposition of the civil action may have a bearing on petitioner's standing in this case should not be construed as a finding that this is the only issue regarding this proceeding that may be resolved or affected by the district's court's final determination.

issued. Accordingly, petitioner's motion for reconsideration is denied.

In view thereof, proceedings herein remain suspended pending the final disposition of the civil action between the parties.

Within twenty days after the final determination of the civil action, the parties shall so notify the Board and call this case up for any appropriate action. During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.

As a final matter, the Board notes that, subsequent to telephone conference held on June 8, 2012, petitioner filed a motion to amend his pleading on June 12, 2012 to add a claim of genericness.

While a party may amend its pleading, as a matter of course, 21 days after serving its initial pleading, see Fed. R. Civ. P. 15(a), inasmuch as these proceedings have been suspended since April 12, 2012 and will remain suspended per the Board's June 8, 2012 telephonic ruling, petitioner's motion to amend the pleadings filed during the suspension of this case is inappropriate and, therefore, will be given no further consideration.<sup>4</sup> Upon resumption of these proceedings, if necessary and appropriate, petitioner may

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<sup>4</sup>In any event, even if petitioner's motion to amend the pleadings were considered and granted, such a result would not alter the Board's decision herein.

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re-file and serve his motion to amend the pleadings for the Board's consideration and approval.