

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

Mailed: May 18, 2013

Cancellation No. 92056169

HarperCollins Publishers, LLC

v.

Jason P. Barnes
aka Jazan Wild

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of respondent's November 8, 2012 motion to suspend this cancellation pending disposition of a civil action. The motion has been fully briefed.¹

Motion to suspend

¹ Petitioner filed a brief in opposition to the motion after the deadline therefor, as prescribed in Trademark Rule 2.127(a). However, the untimeliness appears to have been due to the fact that respondent failed to serve its motion on counsel for petitioner as required by Trademark Rules 2.119(a) and (b). Indeed, petitioner states in its brief that it was never served, and respondent explains in its reply that it believed petitioner "would automatically receive a copy of" its motion, filed through the Board's ESTTA filing system (reply brief; p. 1).

Because the Board may consider the issue of suspension under Trademark Rule 2.117(a) even in the absence of a motion requesting suspension, the Board exercises its discretion to consider respondent's motion and attachments thereto, as well as petitioner's opposition brief and respondent's reply.

The Board expects that respondent will comply with the Board's Trademark Rule 2.119(a) and (b) service requirements in all future filings. See TBMP 110.09(d) ("In addition to the requirement for a certificate of service, ESTTA papers, like all other Board filings, must actually be served upon the other parties to the proceeding in the manner designated.")

It is the policy of the Board to suspend proceedings when a party or the parties are involved in a civil action, which may be dispositive of or may have a bearing on the Board proceeding. The applicable authority, Trademark Rule 2.117(a), reads:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

See also TBMP § 510.02(a); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1937 (TTAB 1992).

To 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 district court is often binding on the Board, while the decision of the Board is not binding on the district court. See, e.g., *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988); *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F Supp 563, 2 USPQ2d 1208 (D.Minn 1986).

Suspension of a Board proceeding, pending the final determination of another proceeding, is solely within the discretion of the Board. See TBMP § 510.02(a).

Respondent moves for suspension pending a civil action filed in the United States District Court for the Central District of California, Western Division, which action is captioned *Jazan Wild DBA Carnival Comics v. Harpercollins Publishers, LLC*, Case No. 8:12-CV-01191-JST-AN. Respondent appropriately submitted with its motion a copy of the complaint, first amended complaint, motion to dismiss first amended complaint, and answer and counterclaim filed in the civil action so as to aid the Board in determining whether the final decision in the civil action may have a bearing on the issues in this opposition. See TBMP § 510.02. The record reflects that the civil action remains pending at this time.

A review of the pleadings filed herein, as well as those filed in said civil action, indicates that these two matters involve the same parties, involve common questions of law and/or fact, and specifically involve adjudication of respective rights in the mark CARNIVAL OF SOULS, the registered mark which is the subject of this cancellation proceeding. Respondent (plaintiff therein) alleges, inter alia, federal trademark infringement, and in particular seeks relief which, inter alia, would directly bear on petitioner's right to use this mark or any colorable imitation thereof.²

² It is noted that the Board's jurisdiction is limited to determining the right to registration; it does not have jurisdiction over the right to use, infringement or unfair

In view of this record, the Board has determined that the outcome in the civil action may have a bearing on this cancellation proceeding. In view thereof, respondent's motion to suspend pursuant to Trademark Rule 2.117(a) is hereby granted.

Accordingly, this proceeding is suspended pending final disposition of the civil action. Within twenty (20) days after the final determination of the civil action, the interested party shall so notify the Board by filing notification(s) of this herein, so that the Board can call this case up for any appropriate action.³

During the suspension, the Board may issue periodic inquiries regarding the status of the pending civil action.

During the suspension, the parties must notify the Board of any address changes for the parties or their attorneys.

competition claims. Whether a party's use of a mark is appropriate under authorities governing infringement is beyond the Board's jurisdiction. See TBMP § 102.01, and cases cited therein.

³ 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 therefrom have been decided. See TBMP § 510.02(b).