

ESTTA Tracking number: **ESTTA537306**

Filing date: **05/11/2013**

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

Proceeding.	92057050
Applicant	Defendant CareEvolution, Inc.
Other Party	Plaintiff Bio-Reference Laboratories, Inc.

### **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, CareEvolution, Inc. hereby requests suspension of this proceeding pending a final determination of the civil action. Trademark Rule 2.117.

CareEvolution, Inc. has secured the express consent of all other parties to this proceeding for the suspension and resetting of dates requested herein.

CareEvolution, Inc. 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 Facsimile or email (by agreement only) on this date.

Respectfully submitted,  
/Timothy M. McCarthy/  
Timothy M. McCarthy  
tmccarthy@clarkhill.com, mkitz@clarkhill.com, sschmidt@clarkhill.com  
lessler@compuserve.com  
05/11/2013

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

BIO-REFERENCE LABORATORIES, INC.,	)	
	)	
Petitioner,	)	
	)	Cancellation No. 92057050
v.	)	
	)	Registration No. 4,304,005
CAREEVOLUTION, INC.,	)	
	)	
Respondent.	)	

**RESPONDENT’S MOTION TO SUSPEND**

Respondent, CAREEVOLUTION, INC., by its attorneys, requests pursuant to TTAB Rule 2.117(a) that the Board suspend this cancellation proceeding, and in support states:

1. On March 19, 2013, the Office issued the above-referenced trademark registration to Respondent.
2. On April 2, 2013, Petitioner, BIO-REFERENCES LABORATORIES, INC., filed this cancellation proceeding. Petitioner seeks cancellation on the basis that Respondent’s mark is allegedly confusingly similar to Petitioner’s mark in Registration No. 2,747,755, in violation of 15 U.S.C. §1052(d). Petitioner also alleges dilution in violation of 15 U.S.C. §1125(c).
3. On May 2, 2013, Respondent filed Civil Action No. 2:13-cv-11966-DML-DRG in the United States District Court for the Eastern District of Michigan. A true and correct copy of the Complaint for Declaratory Judgment is attached as Exhibit A to this Motion.
4. In the civil action, Respondent alleges that its use of its registered mark is not likely to cause confusion and does not dilute Petitioner’s mark. Respondent seeks a declaratory judgment of no likelihood of confusion, no dilution and no unfair competition.
5. Accordingly, both the civil action and the present Board proceeding involve

issues of likelihood of confusion and dilution. (The civil action additionally involves the issue of unfair competition, not an issue before the Board.) The civil action will therefore have a bearing on the present proceeding.

6. 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. *E.g., Brown v. Bishop*, 2010 TTAB LEXIS 313 (Cancellation No. 92050965, July 12, 2010) at \*9. As noted in that opinion, when a civil action in a federal district court involves issues in common with those in a Board proceeding, the district court's decision is binding on the Board, whereas the Board decision would only be advisory to the district court. *Id.* at n. 4.

7. The judges of the United States District Court for the Eastern District of Michigan will not stay the district court litigation pending a Board decision in a cancellation proceeding like the present one. *E.g., Goulas v. Goulas*, 2009 U.S. Dist. LEXIS 159, \*4-6 (E.D. Mich. January 5, 2009).

8. Accordingly, it is proper for the Board to suspend this matter under Rule 2.117(a) pending termination of the civil action.

WHEREFORE, Respondent, CAREEVOLUTION, INC., moves the Board to suspend proceedings pursuant to Rule 2.117(a) pending termination of Civil Action No. 2:13-cv-11966-DML-DRG in the United States District Court for the Eastern District of Michigan.

Respectfully submitted,  
CAREEVOLUTION, INC.  
s/Timothy M. McCarthy/  
One of its attorneys

Timothy M. McCarthy  
CLARK HILL PLC  
150 N. Michigan Avenue  
Suite 2700  
Chicago, Illinois 60601  
Tel: 312-985-5561  
Fax: 312-985-5961  
E-mail: [timmcCarthy@clarkhill.com](mailto:timmcCarthy@clarkhill.com)