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

Proceeding	92060157
Party	Defendant Just Push Pay, LLC
Correspondence Address	JUST PUSH PAY LLC 1727 FUNNY CIDE DRIVE WAXHAW, 28173 UNITED KINGDOM
Submission	Motion to Suspend for Civil Action
Filer's Name	Louis G. Spencer
Filer's e-mail	louis@alexanderricks.com
Signature	/Louis G. Spencer/
Date	11/21/2014
Attachments	JPP - Motion to Suspend Petition to Cancel Trademark - Mark 4444457.pdf(40491 bytes)

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

In the Matter of:

In re Registration No. 4,444,457

Mark: JUST PUSH PAY

Date of Registration: December 3, 2013

PUSHPAY IP LIMITED and PUSHPAY
HOLDINGS LIMITED,

Petitioners,

v.

JUST PUSH PAY, LLC

Respondent.

Cancellation No. 92060157

MOTION TO SUSPEND FOR CIVIL ACTION

Respondent, Just Push Pay, LLC, by and through undersigned counsel, hereby moves for suspension of these proceedings pursuant to Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a) because the parties are involved in a federal district court action involving the same mark and the same issues advanced by Petitioners, Pushpay IP Limited and Pushpay Holdings Limited, in this proceeding. In support of its motion, Respondent attaches a copy of the Amended Complaint filed by Petitioners in Pushpay IP Limited and Pushpay Holdings Limited v. Just Push Pay, LLC, Civil Action No. 3:14-cv-00412-RJC-DSC, which is currently pending in the U.S. District Court for the Western District of North Carolina.

Petitioners' federal district court Complaint against Respondent alleges trademark infringement, false designation of origin and seeks cancellation of Respondent's registered marks under the Lanham Act 15 U.S.C. § 1051 *et. seq.*, and declaratory relief judgment under 28 U.S.C. § 2201 (among other claims).

If the parties to an opposition are involved in a district court action involving the same mark or the opposed application, the Board will scrutinize the pleadings in the civil action to determine if the issues before the court may have a bearing on the Board's decision in the opposition. Forest Laboratories Inc. v. G.D. Searle & Co., 52 USPQ2d 1058, 1061 (TTAB 1999)(“The parties are allowed until thirty days from the mailing date of this order to submit a copy of the complaint in the civil action in order that the Board may determine whether suspension of proceedings herein is warranted.”). A decision by the district court may be binding on the Board whereas a determination by the Board as to a defendant's right to obtain or retain a registration would not be binding or res judicata in respect to the proceeding pending before the court. Whopper-Burger, Inc. v. Burger King Corp., 171 USPQ 805, 807 (TTAB 1971). Thus, the civil action does not have to be dispositive of the Board proceeding to warrant suspension, it need only have a bearing on the issues before the Board. Trademark Rule 2.117(a). *Accord* 6 McCarthy on Trademarks and Unfair Competition §32:47 (4th ed. updated June 2011)(“It is standard procedure for the Trademark Board to stay administrative proceedings pending the outcome of court litigation between the same parties involving related issues.”).

New Orleans Louisiana Saints LLC v. Who Dat? Inc., 99 USPQ2d 1550, 1552 (TTAB 2011). The pending federal district court civil action between the parties herein involves the same issues advanced by Petitioners in this proceeding. The determination of these issues by the federal district court will likely be dispositive of the issues involved in this proceeding. Respondent therefore respectfully requests suspension of these proceeding pending determination of the federal district court civil action pursuant to Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a).

Respondent has appointed Louis G. Spencer, Esq. of the law firm of Alexander Ricks PLLC, to transact all business in and before the United States Patent and Trademark Office in connection herewith.

Please address all correspondence to:

Louis G. Spencer, Esq.
Alexander Ricks PLLC
2901 Coltsgate Road, Suite 202
Charlotte, North Carolina 28211
Email: louis@alexanderricks.com

WHEREFORE, Respondent requests that this cancellation proceeding be suspended until termination of the above referenced civil action.

Dated: November 21, 2014.

ALEXANDER RICKS PLLC

/s/ Louis G. Spencer
Louis G. Spencer
N.C. State Bar No.: 36019
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Counsel for Just Push Pay, LLC

CERTIFICATE OF TRANSMITTAL

I certify that the attached Motion to Suspend is being filed electronically with the TTAB via ESTTA on November 21, 2014.

/s/ Louis G. Spencer
Louis G. Spencer

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **MOTION TO SUSPEND FOR CIVIL ACTION** with exhibits was served on November 21, 2014, via first-class mail, postage prepaid, on the following:

David L. May
Nixon Peabody LLP
401 9th Street, N.W., Suite 900
Washington, D.C. 20004

Counsel for Petitioners

Dated: November 21, 2014.

ALEXANDER RICKS PLLC

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