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

Proceeding	92060849
Party	Plaintiff FINAM
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Submission	Motion to Suspend for Civil Action
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Signature	/Kristen A. Mogavero/
Date	12/17/2015
Attachments	R224 Redacted.pdf(254969 bytes)

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

<p>FINAM,</p> <p style="text-align: center;">Petitioner,</p> <p>v.</p> <p>Sunkiss Thermoreactors, Inc.,</p> <p style="text-align: center;">Registrant.</p>	<p>Cancellation No.: 92060849</p> <p>Registration No.: 1,200,333</p> <p>Mark: SUNKISS</p>
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PETITIONER'S NOTICE OF CIVIL ACTION AND MOTION TO SUSPEND

Pursuant to the Board's Order of February 10, 2015, Petitioner hereby provides the Board with the required notice of a pending civil action, *FINAM v. Daniel Ayotte, et al* ("the Civil Action"), which involves the named parties in this cancellation proceeding and overlapping issues of law. See DE 2 at 6. Petitioner filed its "Motion to Institute Proceedings" (the "Complaint") with the Quebec Superior Court for the District of Montreal on December 11, 2015.¹ A copy of the Complaint is attached as Exhibit 1 (an English translation is provided as Exhibit 2).

Pursuant to 37 C.F.R. § 2.117(a) and TBMP § 510.02(a), Petitioner FINAM (hereafter, "Petitioner") respectfully requests that the Trademark Trial and Appeal Board suspend the above proceeding pending final resolution of the Civil Action. Petitioner is mindful of the Board's October 15, 2015 Order which states in relevant part that "[a]ny paper filed during the pendency

¹ In Quebec, a lawsuit is initiated through the filing of a "Motion to Institute Proceedings." This document has the effect of formally initiating a lawsuit. See Cristina Birks, *Litigation in Canada: 6 interesting facts*, AIPLA Newsstand (Dec. 17, 2010), <http://www.lexology.com/library/detail.aspx?g=cfa13306-73ac-49d1-9241-80c820275463> ("a statement of claim or a motion to institute proceedings is the document that formally begins any lawsuit in Canada").

of these motions which is not relevant thereto will be given no consideration.”² DE 16. However, Petitioner is required to provide the Board with notice of the Civil Action. See DE 2 at 6. Petitioner further includes the instant motion to suspend in the interest of avoiding cumulative litigation, which is consistent with the spirit of the Board’s October 15, 2015 order.

As set forth in detail in the Complaint, this dispute over the SUNKISS trademark arises from a long, albeit complicated relationship between the parties named therein as well as the rights and obligations of each under the [REDACTED]. See Exhibit 2 at ¶¶ 34, 35.

The Civil Action seeks to resolve issues that are, in whole or in part, identical to those presented to the Board in this proceeding. See *id.* A central issue of the Civil Action and this proceeding are the rights and ownership of the SUNKISS mark, and the effect of the [REDACTED] between the parties. See Exhibit 2 at ¶¶ 34, 35, 39, 88 and Requests for Relief; see also DE 10 (Amended Petition for Cancellation at ¶¶ 12-18).

The [REDACTED] constitute alternative grounds which support Petitioner’s original abandonment claim. See DE 1; DE 10 (Amended Petition for Cancellation at ¶¶ 13-14); DE 17 at 2-3; Exhibit 3 at ¶¶ 1.5, 2.1-2.3, 10.1-10.3 and Schedule B; Exhibit 6. In Petitioner’s pending Motion for Leave to Amend, Petitioner also relies on the [REDACTED] to show that Registrant is not the rightful owner of the SUNKISS mark.³ See DE 10 (Amended Petition for Cancellation at ¶¶ 12-18.)

² On December 8, 2015, Registrant filed an Opposition to Petitioner’s Motion to Strike (DE 25). It is Petitioner’s view that no reply is called for in view of the Board’s Order of October 15, 2015 (DE 16) and this Notice of Civil Action and Motion to Suspend, which Petitioner assumes will further stay this proceeding and, accordingly, Petitioner’s time to respond.

³ Registrant notes that the Board has not yet issued a decision regarding Registrant’s pending Motion for Leave to Amend. DE 10, 11. Regardless, the relevant [REDACTED] forms an

The relief sought by FINAM in the Civil Action includes the termination of the [REDACTED], a declaration that [REDACTED], and a declaration that [REDACTED]. See Exhibits 1, 2. The relief sought further requests an order that the Defendants named therein immediately cease using the SUNKISS mark. *Id.*

The [REDACTED] by the applicable laws of Quebec and Canada. See Exhibit 3 at ¶ 14.3; Exhibits 4 and 5 at ¶ 13.3. Accordingly, the Canadian Courts are the proper forum for resolving any disputes arising out of the parties' rights (including, but not limited to, rights in the SUNKISS mark) and obligations [REDACTED]. The applicability of [REDACTED] (see Exhibit 3 at ¶ 1.2 (see page labelled FINAM000095); Exhibits 4 and 5 (Preamble)). Moreover, the rights and obligations [REDACTED] pertain to the SUNKISS mark (Exhibit 3 at ¶¶ 1.5, 2.1-2.3, 10.1-10.3 and Schedule B; Ex. 4 ¶¶ 10.1 - 10.3).

Petitioner FINAM is a named Plaintiff in the Civil Action. See Exhibits 1, 2. The Registrant, Sunkiss Thermoreactors, Inc. (referred to as "Sunkiss Canada" in the Complaint) is named in the Civil Action as an "Impleaded Party." *Id.*⁴

Both parties in this Cancellation proceeding are named parties in the Civil Action. Both proceedings involve common issues which, if decided in the Civil Action, would have an impact

alternative factual basis for Petitioner's pending abandonment claim and are at the heart of the Civil Action. See Exhibit 2 at ¶ 34.

⁴ In addition, Registrant, Sunkiss Thermoreactors, Inc., is co-owned by Plaintiff FINAM's wholly-owned subsidiary and by Defendant 9140-3543 Quebec, Inc. (which, upon information and belief, is owned and/or controlled by co-Defendant Daniel Ayotte). See Exhibit 2 at ¶¶ 18, 25.

on this proceeding. Suspension is proper. 37 CFR § 2.117(a); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1936-37 (TTAB 1992). This Board “may suspend a proceeding pending final determination of a foreign action between the parties.” *Birlinn Ltd. v. Stewart*, 2014 TTAB LEXIS 346, at *13 (Trademark Trial & App. Bd. Sept. 3, 2014) (citing *Marie Claire Album S.A. v. Kruger GmbH & Co. KG*, 29 USPQ2d 1792, 1793-94 (TTAB 1993)).

The Board should properly suspend this Cancellation proceeding pending disposition of the Civil Action which seeks to resolve issues that are identical, in part, to those presented to the Board in this proceeding. Given that the [REDACTED], the Canadian Courts are the proper forum for interpreting the parties rights and obligations, including their rights to the SUNKISS trademark, pursuant to [REDACTED]. Therefore, this Cancellation proceeding should be suspended pending disposition of the Civil Action.

Respectfully Submitted,

Dated: December 17, 2015

By: 
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SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS
HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FILED ELECTRONICALLY
WITH THE UNITED STATES PATENT AND TRADEMARK OFFICE.

Date: December 17, 2015

By: 

CERTIFICATE OF SERVICE

I, Carina Scoria, hereby certify I caused a true copy of the foregoing Petitioner's Notice of Civil Action and Motion to Suspend to be served upon Registrant's Attorney of Record at the following address via first class mail, postage pre-paid, on this 17th day of December, 2015:

Levy & Grandinetti
PO Box 18385
Washington, DC 20036-8385
Attn.: Ms. Rebecca J. Stempien Coyle
mail@levygrandinetti.com

A handwritten signature in cursive script that reads "Carina Scoria". The signature is written in black ink and is positioned to the right of the typed address information.

Exhibit 1

Confidential

Exhibit 2

Confidential

Exhibit 3

Confidential

Exhibit 4

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Exhibit 5

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Exhibit 6

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