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

Proceeding	92061934
Party	Defendant Townsquare Commerce, LLC
Correspondence Address	TOWNSQUARE COMMERCE LLC 1851 NORTH GREENVILLE AVE , SUITE 100 RICHARDSON, TX 75081 UNITED STATES
Submission	Motion to Suspend for Civil Action
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of U.S. Trademark Reg. No. 3,895,241 (SEIZE THE DEAL)
Registered: December 21, 2010

GROUPON, INC.	§	
	§	
Petitioner,	§	
	§	
v.	§	Cancellation No. 92061934
	§	
TOWNSQUARE COMMERCE, LLC,	§	
	§	
Registrant.	§	
	§	

**REGISTRANT’S MOTION TO SUSPEND PROCEEDING
PENDING OUTCOME OF CIVIL ACTION**

Registrant Townsquare Commerce, LLC (“Registrant” or “Townsquare”), by and through its undersigned counsel, hereby moves for suspension of this proceeding pursuant to 37 C.F.R. § 2.117 and T.B.M.P. 510.02(a), pending the final determination of *Townsquare Commerce, LLC v. Groupon, Inc.*, Civil Action 3:15-cv-1870-P, pending in the United States District Court for the Northern District of Texas.

I. INTRODUCTION

On May 29, 2015, Townsquare filed a complaint against Petitioner Groupon, Inc. (“Petitioner” or “Groupon”) in the United States District Court for the Northern District of Texas, styled *Townsquare Commerce, LLC v. Groupon, Inc.*, Civil Action 3:15-cv-1870-P (the “Federal Action”).¹ The complaint asserts various counts of federal and state trademark infringement, unfair competition, trade dress infringement, and unjust enrichment against

¹ A true and correct copy of Townsquare’s Complaint in the Federal Action is attached hereto as Exhibit A.

Groupon. Groupon answered the Complaint on July 29, 2015 and asserted counterclaims for declaratory judgments of non-infringement, that Townsquare's marks are generic, that Townsquare's marks are merely descriptive, and requested cancellation of Registrant's marks pursuant to 15 U.S.C. § 1119.²

After the litigation commenced, Groupon filed this cancellation proceeding on July 27, 2015. The allegations made by Groupon in its petition for cancellation are that Townsquare's marks are generic or merely descriptive, and that Groupon will be irreparably damaged by the continued registration of Townsquare's marks.

II. ARGUMENT

Townsquare requests suspension of these cancellation proceedings because the currently pending Federal Action will address and resolve all of the issues raised by Groupon in this cancellation proceeding.

The Trademark and Trial Appeal Board (TTAB) has directly addressed this scenario in its rules and procedures. Trademark Rule 2.117(a), codified at 37 C.F.R. 2.117(a) provides that:

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 other Board proceeding.

Further, the Trademark Trial and Appeal Board Manual of Procedure explains that “[u]nless there are special circumstances, the Board will suspend proceedings in the case before it if the final determination of the other proceeding may have a bearing on the issues before the Board.”

See TBMP §510.02(a) (2015) (emphasis added).

² A true and correct copy of Groupon's Answer and Counterclaims in the Federal Action is attached hereto as Exhibit B.

The TTAB has applied this rule liberally and suspended proceedings until related district court actions are concluded. *See, e.g., Whopper-Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (T.T.A.B. 1971) (suspending cancellation proceeding in light of pending federal litigation because “the outcome of the civil action will have a direct bearing on the question of the rights of the parties herein and may in fact completely resolve all the issues.”); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1992 WL 141992, at *3-4 (T.T.A.B. 1992) (same). To the extent that a civil action in a Federal district court involves issues in common with the issues in a TTAB proceeding, the district court’s findings are binding on the TTAB. *See* TBMP §510.02(a) (2015).

Here, Townsquare requests suspension of the cancellation proceeding because the Federal Action involves the same parties, the same trademarks, the same request for cancellation of Townsquare’s marks, and the same alleged grounds for cancellation. Groupon has sought cancellation of Townsquare’s marks on the basis of genericness and descriptiveness. Findings by the district court on these issues will be binding on the TTAB, therefore the Federal Action has a bearing on this cancellation proceeding. *See General Motors*, 1992 WL 141992 at *3-4. In addition, Townsquare has asserted allegations of infringement against Groupon of its trademarks. In order to prevail on this claim, Townsquare has to establish its rights in these trademarks, and if the district court determines such rights exist, such determination should have a bearing on Groupon’s allegations of genericness in the cancellation proceeding.

Townsquare therefore respectfully requests that, in the interests of judicial economy and to avoid inconsistent results, this cancellation proceeding be suspended pending a final determination in the Federal Action.

DATE: September 1, 2015

Respectfully Submitted,

/s/ Stewart N. Mesher

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Registrant's Motion to Suspend Proceedings Pending Outcome of Civil Action has been served on counsel of record for Groupon by e-mail and first class mail, Certified Return Receipt Requested, on September 1, 2015.

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/s/ Darlene Ghavimi

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