

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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Baxley

Mailed: January 22, 2016

Cancellation No. 92061955

*DFASS Brands Holdings, LLC*

*v.*

*Reginald Williams*

**Andrew P. Baxley, Interlocutory Attorney:**

Pursuant to the Board's November 8, 2015 order, Petitioner filed an amended petition to cancel. The amended petition to cancel is the operative complaint herein.

While proceedings herein were suspended herein following issuance of that order, Respondent, on December 8, 2015, filed a motion to suspend this proceeding under Trademark Rule 2.117(a) pending final determination of a civil action between the parties styled *Williams v. DFASS Brand Holdings, LLC*, Case No. 4:15-cv-00837-O, filed in the United States District Court for the Northern District of Texas ("the civil action"). The motion has been fully briefed.

"Whenever it shall come to the attention of the ... Board that a party or parties to a pending case are engaged in a civil action ... 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." Trademark Rule 2.117(a). *See* TBMP § 510.02(a) (2015). 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

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the Board. *See New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011). Although the USPTO has expertise in determining trademark registrability, such determinations are not within the USPTO's exclusive jurisdiction. *See American Bakeries Co. v. Pan-O-Gold Baking Co.*, 2 USPQ2d 1208 (D. Minn. 1986). Moreover, the Board is empowered only to determine the right to register and has no injunctive authority. *See General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 (TTAB 2011) (no authority to determine the right to use, or the broader questions of infringement, unfair competition, damages or injunctive relief). 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 Federal district court is binding upon the Board. *See, e.g., Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir. 1988).

In the above-captioned proceeding, Petitioner alleges that Respondent's involved TIME TRAVEL ACADEMY mark, when considered in its entirety, is merely descriptive and has not become distinctive. In the civil action, Respondent, as plaintiff, alleges, among other things, that Petitioner's pleaded TIME TRAVEL mark infringes and dilutes his involved mark. Although the claims in the respective cases do not overlap at this time,<sup>1</sup> the Board notes that, in the civil action, Respondent asks in the prayer for relief that Petitioner be enjoined from "using 'Time Travel' or any mark confusingly similar to" Respondent's involved mark. At a

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<sup>1</sup> The Board notes, however, that Petitioner can seek cancellation of Respondent's registration in the civil action. *See* Trademark Act Section 37, 15 U.S.C. § 1119.

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minimum, any such injunction may have a bearing upon Petitioner's assertion in its pleaded application of a bona fide intent to use its pleaded TIME TRAVEL mark in commerce and therefore may have a bearing upon Petitioner's standing to maintain this proceeding. Accordingly, the Board finds that suspension of this proceeding pending final determination of the civil action under Rule 2.117(a) is appropriate.<sup>2</sup>

Based on the foregoing, Respondent's motion to suspend is granted. Proceedings herein are suspended pending final determination, including any appeals or remands, of the civil action. Upon final determination of the civil action, Respondent should notify the Board so that appropriate action may be taken herein. While this proceeding is suspended, the parties shall keep their correspondence addresses current.

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<sup>2</sup> If the district court suspends the civil action pending final determination of this proceeding, the Board will entertain a motion to resume this proceeding.