

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

Mailed: September 16, 2015

Cancellation No. 92062023

*Groupon, Inc.*

v.

*Townsquare Commerce, LLC*

**George C. Pologeorgis,  
Interlocutory Attorney:**

On July 27, 2015, Groupon, Inc. (“Petitioner”) filed a petition to cancel Registration No. 3895290 owned by Townsquare Commerce, LLC<sup>1</sup> (“Respondent”) for the mark “SEIZE THE DEAL,” in standard characters, for a “coupons; gift cards; printed certificates” in International Class 16.<sup>2</sup> Petitioner seeks to cancel the involved registration on the ground that the mark is generic for the identified goods under Trademark Act Section 23, 15 U.S.C. § 1091, as well as on the ground that the mark is merely descriptive of the identified goods under Section 2(e)(1) of the Trademark Act. On September 1, 2015, Respondent filed a consented motion to extend its time to answer the petition to cancel. On September 14, 2015, the Board

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<sup>1</sup> USPTO Assignment Branch records indicate that the owner of the registered mark subject to this proceeding changed names from Seize the Deal, LLC to Townsquare Commerce LLC on March 16, 2015, a date prior to the institution of this proceeding, and said name change was recorded with the Assignment Branch on August 25, 2015.

<sup>2</sup> Registered on December 21, 2010, claiming September 2009 as both the date of first use and the date of first use in commerce.

granted Respondent's consented motion to extend making Respondent's answer due by October 23, 2015.

This proceeding now comes before the Board for consideration of Respondent's motion (filed September 1, 2015) to suspend this proceeding pending the final disposition of a civil action between the parties herein filed in the U.S. District Court for the Northern District of Texas.<sup>3</sup> Respondent included a copy of the civil action complaint, as well as Petitioner's answer and counterclaim with its motion. Petitioner filed a timely response to Respondent's motion to suspend on September 14, 2015.

In support of its motion, Respondent maintains that suspension of this cancellation proceeding is warranted because the civil action involves the same parties, the same trademarks, the same request for cancellation of Respondent's mark, and the same grounds for cancellation. Additionally, Respondent argues that it has asserted a claim of trademark infringement against Petitioner in the civil action and that, in order to prevail on this claim, Respondent has to establish rights in its marks, and if the district court determines such rights exist, such a determination should have a bearing on the issues in this cancellation proceeding.

In response, Petitioner argues that Respondent's motion to suspend should be denied because the owner of the registered mark subject to this cancellation proceeding at the time this case was commenced, i.e., Seize the Deal, LLC, is not a party to the pending civil action.

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<sup>3</sup> Civil Action No. 3:15-cv-1870-P, styled *Townsquare Commerce LLC v. Groupon, Inc.*, filed on or about May 25, 2015.

**Decision**

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. *See* Trademark Rule 2.117(a).

Initially, the Board notes that the owner of the subject registration of this cancellation proceeding changed names from Seize the Deal, LLC to Townsquare Commerce, LLC via an executed certificate of amendment filed with the State of Delaware on March 16, 2015, a date prior to the institution of this proceeding, as well as prior to the commencement of the civil action. The fact that the name change was ***recorded*** with the USPTO subsequent to the commencement of this case, i.e., on August 14, 2015, does not alter the effective date of the name change itself. *See* TMEP § 503.01(c) (July 2015) (“[t]he act of recording a document is a ministerial act, and not a determination of the document’s validity or of its effect on title to an application or registration.”) Accordingly, Petitioner’s argument that the owner of the registered mark subject to this cancellation proceeding at the time this case was commenced is not a party to the pending civil action is without merit.

Notwithstanding the foregoing, the Board has carefully reviewed the Respondent’s complaint in the civil action, as well as Petitioner’s answer and counterclaim, and finds that a decision by the district court would have a direct bearing on the issues in this cancellation proceeding. Specifically, the Board notes that Petitioner also seeks to cancel Respondent’s mark in the civil action on the same grounds asserted in this proceeding, i.e., that Respondent’s registered mark is

generic and/or merely descriptive of the identified goods. Further, Board decisions are appealable to the district court. *See* Section 21(b) of the Trademark Act, 15 U.S.C. § 1071(b). Finally, suspending this matter pending the final determination of the civil action will serve the interests of judicial economy.

Accordingly, Respondent's motion to suspend this proceeding for civil action is **GRANTED** as well taken and this proceeding is, therefore, **suspended** pending the final disposition of the civil action between the parties, including all appeals.

Within twenty days after the final determination of the civil action, the parties shall so notify the Board so that this proceeding may be called up for appropriate action.<sup>4</sup> Such notification to the Board should include a copy of any final order or final judgment which issued in the civil action.

The Board will reset trial dates upon resumption of the proceeding, if necessary and appropriate. During the suspension period, the parties must notify the Board of any address changes for the parties or their attorneys. In addition, the parties are to promptly inform the Board of any other related cases, even if they become aware of such cases during the suspension period. Upon resumption, if appropriate, the Board may consolidate related Board cases.

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<sup>4</sup> A proceeding is considered to have been finally determined when a decision on the merits of the case (*i.e.*, a dispositive ruling that ends litigation on the merits) has been rendered, and no appeal has been filed therefrom, or all appeals filed have been decided. *See* TBMP § 510.02(b) (2015).