

ESTTA Tracking number: **ESTTA380584**

Filing date: **11/24/2010**

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

Proceeding	91193982
Party	Plaintiff Domino's IP Holder LLC
Correspondence Address	ELIZABETH F. JANDA BROOKS KUSHMAN PC 1000 TOWN CENTER, 22ND FLOOR SOUTHFIELD, MI 48075 UNITED STATES ejanda@brookskushman.com, ejbrooks@brookskushman.com
Submission	Other Motions/Papers
Filer's Name	Elizabeth F. Janda
Filer's e-mail	ejanda@brookskushman.com, ejbrooks@brookskushman.com
Signature	/elizabeth f janda/
Date	11/24/2010
Attachments	Resp_and.pdf (6 pages)(188925 bytes)

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

DOMINO'S IP HOLDER LLC)
)
 Opposer,)
)
v.)
)
DOCTOR'S ASSOCIATES, INC.)
)
 Applicant.)

Opposition No. 91193982

**RESPONSE TO APPLICANT'S MOTION TO COMPEL
AND
OPPOSER'S MOTION FOR SUSPENSION**

The Applicant, Domino's IP Holder LLC, files this Response to Doctor's Associates, Inc.'s Motion to Compel and moves for suspension of this proceeding in its entirety pending resolution of the related opposition proceedings filed by Sheetz of Delaware, Inc. against registration of Application SN 77/324,328.

Last month, and several times prior to the filing of Applicant's Motion to Compel, Opposer had requested the Applicant's consent to a suspension of the proceedings pending resolution of the Sheetz vs. Doctor's Associates, Inc., (Opposition No. 91192657), which would also resolve the key issues in the current matter relating to the registrability of the FOOTLONG for "sandwiches." The Applicant declined Opposer's request.

The Applicant notes that the parties herein have engaged in settlement discussions without reaching resolution, and Applicant retains the belief that this matter is still a candidate for settlement prior to imposing on significant resources of this Board. In addition, the Opposer recognizes that the issues before the Board in this matter are substantially identical to those raised in SEVERAL additional copending oppositions to this Applicant's Serial Number 77/324,328.

Including:

- *Sheetz of Delaware, Inc. v. Doctor's Associates Inc.*, Opposition No. 91192657
- *KFC Corporation v. Doctor's Associate, Inc.*, Opposition No. 91193157
- *A&W Restaurants Inc. v. Doctor's Associates Inc.*, Opposition No. 91193162
- *Pizza Hut Inc. v. Doctor's Associates Inc.*, Opposition No. 91193163
- *Taco Bell Corp. v. Doctor's Associates Inc.*, Opposition No. 91193164
- *Long John Silvers Inc. v. Doctor's Associates, Inc.*, Opposition No. 91193165
- *Firehouse Restaurant Group Inc. v. Doctor's Associates, Inc.*, Opposition No. 91193183.

In addition, the Board recently entered a Dismissal without prejudice of *KBI Holdings, LLC vs. Doctor's Associates, Inc.* (Opposition No. 91193183), based upon the consent of the parties.

In the matter between Sheetz and this Applicant, a summary judgment motion was filed in June of this year, and the parties await the Board's decision on that motion. In the interim, four of the other pending oppositions have been suspended, and a Motion for Suspension has been filed and is pending in the fifth. This Opposer seeks a suspension of the calendar in this proceeding pending resolution of the matter between Sheetz and Doctor's Associates, since it sees no reason to duplicate efforts and expend the resources of this Board or the parties on the issues which will likely be resolved by the Board's decision in the *Sheetz* matter.

This Opposer notes that in the copending *Firehouse Restaurant Group, Inc. vs. Doctor's Associates, Inc.* matter, the filed a Motion for Suspension for Cause. In that currently pending Motion, Firehouse Restaurant had based its motion on four grounds, which are equally applicable here. This Opposer requests suspension for the following reasons:

- (1) the opposer in the Sheetz Opposition has filed a motion for summary judgment and this Board's ruling on that motion is likely be dispositive of this case;
- (2) the Applicant filed a motion to amend its Application's identification of services in the Sheetz Opposition which, if granted, will affect this Opposition, the proper scope of discovery¹ and the discovery period;
- (3) the Trademark Office has intervened in the Sheetz Opposition and requested its suspension so the examining attorney can refuse the Application on the grounds that the applied-for mark is generic, and any such ruling would be dispositive here; and

¹ The pending discovery is tied to the current definition of goods.

(4) the Applicant will not be prejudiced because Opposer is willing to consent to extensions of discovery so that Applicant is not prejudiced, and because the Applicant has already consented to suspension of other co-pending oppositions.

The Board has the express authority to suspend any opposition or cancellation proceed for good cause or if the determination of another proceeding may have a bearing on the issues before the Board, under 37 C.F.R. Sections 2.117(a) and (c); TBMP 510. The rules specifically state:

(a) 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 the other Board proceeding.

37 C.F.R. Section 2.117 (a).

In this situation, suspension is particularly appropriate to avoid duplication of the Board's efforts and contradictory rulings. Here, the parties are working with a moving target, and the underlying facts and issues in this proceeding could be quite different, depending upon the outcome of the Sheetz proceeding. The focus and scope of discovery could change dramatically, as well as the parties' positions in settlement. In addition, if Doctor's Associates wins the Sheetz proceedings, that ruling will govern most of the issues before the Board here, and certainly streamline the path to settlement.

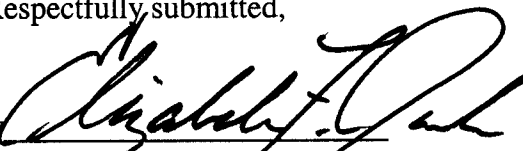
CONCLUSION

The Opposer respectfully requests that this Board suspend this proceeding No. 91193982, pending resolution of the prior pending Sheetz of Delaware, Inc. vs. Doctor's Associates Inc. Opposition No. 91192657, because it involves the same Applicant, the same mark, the same principal issues. The changes to the application and any rulings resulting from the related proceeding will affect this matter, the subject and scope of discovery, the settlement potential, and the ultimate resolution. The Opposer submits that the Applicant in this matter has consented to

settlement in other related proceedings, and has many pending motions in multiple matters before this Board that will be resolved upon resolution of the proceeding between Sheetz and Doctor's Associates.

This Opposer respectfully requests that the Board modify its current Order of Suspension and enter an order suspending this proceeding in its entirety pending resolution of Opposition No. 91192657.

Respectfully submitted,

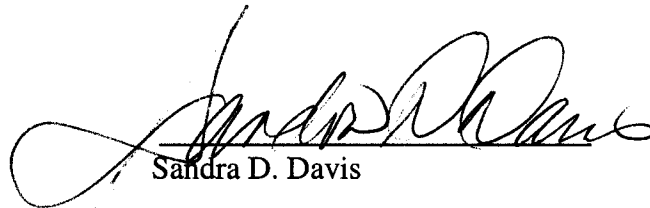
By 
Elizabeth F. Janda
Attorneys/Agents for Opposer

Date: November 24, 2010
BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
Phone: 248-358-4400
Fax: 248-358-3351
Our File: DOMP 0555 OC

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on July 8, 2010, a true and complete copy of the attached **RESPONSE TO APPLICANT'S MOTION TO COMPEL AND OPPOSER'S MOTION FOR SUSPENSION** has been served on counsel for the Applicant on the date listed below via First Class U.S. Mail, postage prepaid:

Richard R. Michaud
Alaine Doolan
Michaud-Kinney Group, LLP
306 Industrial Park Road, Suite 206
Middletown, Connecticut 06457


Sandra D. Davis