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EJW/Bukrinsky

April 23, 2020

Opposition No. 91218879

ESP Shibuya Enterprises, Inc., Cordoba Music Group, Inc., Collings Guitars, Inc., Roman Guitars, LLC, by substitution for Ed Roman Enterprises, Inc., Armadillo Distribution Enterprises, Inc., Schecter Guitar Research, Inc., Westheimer Corporation, and Peavey Electronics Corporation

v.

Gibson Brands, Inc.

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

This case comes up on Applicant's motion (filed December 3, 2019) to suspend this proceeding pending final determination of a civil action between itself and Opposer Armadillo Distribution Enterprises, Inc. ("Armadillo").[1] The motion is fully briefed.

The Board has considered the parties' briefs but addresses the record only to the extent necessary to set forth the Board's analysis and findings, and does not repeat or address all of the parties' arguments. *Guess? IP Holder LP v. Knowluxe LLC*, 116

[1] Applicant's consent motion (filed January 27, 2020) to extend the expert disclosure due date and subsequent trial dates is granted. *See* Trademark Rule 2.127(a). The parties' joint stipulation (filed March 24, 2020) to suspend this proceeding pending the Board's consideration of the subject motion is moot.

USPQ2d 2018, 2019 (TTAB 2015). For purposes of this order, the Board presumes the parties' familiarity with the pleadings, and the arguments submitted in connection with the subject motion.

I. Preliminary Matter

On January 22, 2020, Opposers filed a letter with the Board addressed to "Examining Attorney: Elizabeth J. Winter,"[2] arguing that Applicant's reply in support of its motion to suspend was untimely and should receive no consideration. 51 TTABVUE 2. Applicant responded to this letter with its own correspondence submitted to the Board on January 23, 2020. 52 TTABVUE.

The parties are reminded that written communications to the Board which seek relief or a particular result (or argue against the relief sought in a particular submission) must be submitted to the Board in the form of a motion (or response thereto) in accordance with Trademark Rule 2.126; *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 502.02(b) (2019). The parties are advised that any future submissions must comply with the Trademark Rules of Practice, failing which such submissions may not be considered.

Nonetheless, for judicial efficiency, the Board has considered the parties' submissions. To the extent Opposers argue that Applicant's reply brief should be stricken or not considered because it is untimely, Opposers' request is not well-taken. Opposers' response to Applicant's motion to suspend was filed on December 23, 2019. 49 TTABVUE. In view thereof, Applicant's reply brief, if any, was due no later than

[2] Opposers' counsel is reminded that submissions should be addressed to the Board, not to individual Interlocutory Attorneys.

January 12, 2020. *See* Trademark Rule 2.127(a). However, because January 12, 2020 was a Sunday, pursuant to Trademark Rule 2.196, Applicant was allowed until the next succeeding day that was not a Saturday, Sunday, or Federal holiday to file its reply brief. In this case, the next business day was Monday, January 13, 2020. Because Applicant's reply brief was filed on that date, the brief was timely. *See* Trademark Rule 2.196; *see also* TBMP § 112. In view thereof, Opposers' request that the Board not consider Applicant's reply brief is **denied**.

II. Applicant's Motion to Suspend for Civil Action

Applicant moves to suspend this opposition proceeding pending the final determination of a civil action between itself and Opposer Armadillo pending in the United States District Court for the Eastern District of Texas, Sherman Division, Case No. 4:19-cv-00358-ALM (the "Texas Civil Action").[3] 48 TTABVUE 3. In support of its motion, Applicant explains that, as plaintiff in the Texas Civil Action, it has alleged that Armadillo infringed Applicant's registered "ES Body Shape Design" mark[4] that is also at issue in this proceeding. Applicant also asserts that Opposer Armadillo, as defendant in the Texas Civil Action, has counterclaimed to cancel Applicant's registered design mark on the same grounds that Opposers allege in opposition to registration of the applied-for mark in this proceeding, namely, that the

[3] Applicant provided a copy of the first amended complaint and answer (and counterclaims) in the civil case, 48 TTABVUE 9, 53, as well as the declaration of its counsel, Andrea E. Bates, 48 TTABVUE 6, in support of its motion.

[4] Applicant also states that its "ES Body Shape Design" mark is registered on the Supplemental Register, U.S. Reg. No. 2007277. 48 TTABVUE 3.

guitar body shape design mark is generic or has not acquired secondary meaning. Based on these assertions, Applicant contends that the resolution of the civil action will resolve the issues before the Board and requests that this proceeding be suspended.

III. Analysis and Order

It is the policy of the Board to suspend proceedings when the parties are involved in a civil action that may be dispositive of or have a bearing on the Board case. *See New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (the Board will scrutinize the pleadings in the civil action to determine if the issues before the court may have a bearing on the Board's decision in the opposition); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992); Trademark Rules 2.127(a) and 2.117(a), 37 C.F.R. §§ 2.127(a) and 2.117(a); *see also* TBMP § 510.02. Additionally, the Board will suspend or maintain the suspension of a proceeding until the civil action at issue is considered to have been finally determined, that is, when a decision on the merits of the case has been rendered, and no appeal has been filed in regard thereto, or all appeals filed have been decided. *See* TBMP § 510.02(b).

In the Texas Civil Action, Applicant alleges, among other things, trademark infringement by Opposer Armadillo of its registered "ES Body Shape Design" mark, U.S. Reg. No. 2007277, which is identical to the involved mark in this proceeding. *Compare* civil complaint ¶¶ 27, 42-43, 48 TTABVUE 31-32, 37-38, to notice of opp. ¶ 41, 1 TTABVUE 12-13. Further, Opposer Armadillo, as defendant in the Texas Civil

Action, seeks to cancel Applicant's registration with prejudice on the basis that the registered "Semi-Hollow Body Shape" does not function as a source identifier, is incapable of functioning as a mark, and is generic for an electric guitar body. *Compare* Third Counterclaim and Prayer for Relief ¶ A, 48 TTABVUE 95, 99, to notice of opp. ¶ 46, 1 TTABVUE 13. In view of the factual allegations set forth in the civil complaint and counterclaim, it is clear that the factual findings ultimately made by the district court and its decision regarding Armadillo's counterclaim, specifically, whether or not the guitar shape in Applicant's involved mark is generic for the applied-for goods, may have a bearing on this case.

The Board has considered Opposers' contention that the eight opposers who are not involved in the Texas Civil Action will be prejudiced by the continued delay of this proceeding. 49 TTABVUE 11. But Opposers' only arguments regarding prejudice relate to the length of the delay and Applicant's on-going cease and desist letters sent to Opposers in the meantime. *Id.* at 11-13. Opposers do not argue that evidence or witnesses may be lost. *See New Orleans La. Saints*, 99 USPQ2d at 1551 n.4 (noting that prejudice in this context occurs where "evidence or witnesses may be lost if there is a protracted delay in the ability of [the parties] to bring their claims and defenses.").

While the Board is sympathetic to Opposers' concerns, to deny suspension would result in duplicative actions in the district court and before the Board. These considerations outweigh the fact that this is the second suspension occasioned by Applicant's filing of a civil action against one of the opposers. Accordingly, Applicant's

motion to suspend is **GRANTED**, and proceedings are **SUSPENDED** pending final disposition of the civil action.[5]

Within twenty days after the final determination of the civil action, the parties shall so notify the Board and call this case up for any appropriate action. During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.

[5] Suspensions remain in the Board's discretion. *See* TBMP § 510.02(a). Thus, the Board may, depending on the circumstances, reject Applicant's future attempts to suspend this proceeding.