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

Proceeding	91223633
Party	Plaintiff Torpack Limited
Correspondence Address	PAUL A BOST SHEPPARD MULLIN RICHTER & HAMPTON LLP 1901 AVE OF THE STARS, STE 1600 LOS ANGELES, CA 90067 UNITED STATES pbost@smrh.com, baanderson@smrh.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Paul A. Bost
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Signature	/Paul A. Bost/
Date	09/30/2016
Attachments	Torpack v. FJS -Motion to Suspend.pdf(373354 bytes)

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

<p><i>In re Matter of Application No. 85/917,263 for the mark: GUITAR MUSE in Class 9</i></p> <p>Torpack Limited, Opposer, vs. Francisco Sanchez-Jara, Applicant.</p>	<p>Opposition No. 91-223,633</p> <p>OPPOSER TORPACK LIMITED’S MOTION TO SUSPEND THE PROCEEDING PENDING THE ADJUDICATION OF THE CANADIAN PROCEEDING</p>
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Pursuant to 37 C.F.R. § 2.117 and TBMP § 510, Opposer Torpack Limited (“Opposer”) hereby moves the board to suspend these proceedings pending the outcome of an action filed in Canada by Opposer challenging the validity of the Canadian registration owned by Applicant Francisco Sanchez-Jara (“Applicant”) and upon which Applicant’s application at issue in these proceedings is based.

Relevant Factual Background

Applicant filed its application to register GUITAR MUSE, Ser. No. 85/917,263 (the “Application”) on April 19, 2013. Applicant asserted a filing basis of § 44(d) for the Application based on its then-pending application to register GUITAR MUSE in Canada. On November 18, 2014, Applicant’s Canadian registration of GUITAR MUSE issued. The Canadian Intellectual Property Office’s (“CIPO”) registration of Applicant’s GUITAR MUSE mark was materially based upon Applicant’s Declaration of Use, in which Applicant falsely stated that he had used the mark in Canada.

On March 9, 2015 and in support of his Application, Applicant submitted to the U.S. Patent & Trademark Office (“PTO”) a copy of his registration certificate for GUITAR MUSE in Canada and amended his Application to assert a filing basis of § 44(e). Based thereon, the PTO published the Application for opposition.

On September 2, 2015, Opposer instituted the instant opposition proceedings based upon its prior, registered rights in the MUSE mark, and opposed registration of the Application on grounds of likelihood of confusion, likelihood of dilution, and false suggestion of a connection. During discovery, Applicant admitted in verified interrogatory responses that it had never used the GUITAR MUSE mark. Based on this admission and other grounds asserted therein, Opposer, on September 30, 2016, applied for expungement of Applicant’s Canadian registration of GUITAR MUSE in Canadian Federal Court. A true and correct copy of Opposer’s Notice of Application is attached hereto as **Exhibit A**.

The Board Should Suspend the Proceedings

It is well established that a “valid foreign registration must exist for a U.S. application under Section 44 to register.” *Marie Claire Album S.A. v. Kruger GmbH & Co. KG*, 29 USPQ2d 1792, 1793 (TTAB 1993). “[I]f, at any time prior to the issuance of the U.S. registration, the foreign registration is shown not to be in full force and effect, the U.S. application loses its Section 44 basis.” *Id.*, citing *Fioravanti v. Fioravanti Corrado S.R.L.*, 230 USPQ 36 (TTAB 1986). “[U]ntil the U.S. registration issues, the foreign registration must be in effect.” *In re Societe D’Exploitation de la Marque Le Fouquet’s*, 67 USPQ2d 1784, 1788 (TTAB 2003).

Here, Opposer has challenged in Canadian Federal Court the foreign registration upon which Applicant bases its Application. In the event Opposer succeeds in invalidating said foreign registration, the Application, like that at issue in *Marie Claire*, would have no valid

basis, “in which case the opposition would be sustained.” *Id.* at 1794. Furthermore, Opposer only recently discovered certain of the grounds underlying its action in Canadian Federal Court, namely, Applicant’s submission of a fraudulent statement of use to CIPO.

In circumstances such as the present, the Board regularly suspends proceedings pending the final determination of the dispositive foreign action. *See* TBMP § 510.02 (a) (pursuant to 37 C.F.R. § 2.117(a), the Board may, in its discretion, “suspend a proceeding pending the final determination of . . . a foreign action between the parties, wherein one party challenges the validity of a foreign registration upon which the other party’s subject application is based”); *Marie Claire*, 29 USPQ2d at 1793 (granting motion to suspend opposition proceeding pending decision of German court on validity of foreign registration forming the basis for the applicant’s application.)

Accordingly, the Board should suspend these proceedings pending the adjudication of the Canadian action.

Respectfully submitted,

Dated: September 30, 2016

/Paul A. Bost/
Jill M. Pietrini
Paul A. Bost
SHEPPARD MULLIN RICHTER & HAMPTON LLP
Attorneys for Opposer Torpack Limited

CERTIFICATE OF SERVICE

I hereby certify that **OPPOSER TORPACK LIMITED'S MOTION TO SUSPEND THE PROCEEDING PENDING ADJUDICATION OF CANADIAN PROCEEDING** is, pursuant to an agreement of the parties, being emailed to Francisco Sanchez-Jara at fjsjeurope@hotmail.com and fjsjeurope@gmail.com on this 30th day of September, 2016.

/s/Paul A. Bost

Paul A. Bost

CERTIFICATE OF E-FILING

I hereby certify that **OPPOSER TORPACK LIMITED'S MOTION TO SUSPEND THE PROCEEDING PENDING ADJUDICATION OF CANADIAN PROCEEDING** is being transmitted electronically to Commissioner of Trademarks, Attn: Trademark Trial and Appeal Board through ESTTA pursuant to 37 C.F.R. §2.195(a), on this 30th day of September, 2016.

/s/Paul A. Bost

Paul A. Bost

SMRH:479343226.1

EXHIBIT A

Court No. T-1651-16

FEDERAL COURT

BETWEEN:

TORPACK LIMITED, A LEGAL ENTITY

Applicant

- and -

FRANCISCO SANCHEZ-JARA

Respondent

NOTICE OF APPLICATION

Pursuant to Sections 7, 53.2 and 57
of the *Trademarks Act*, R.S.C. 1985, c. T-13,
and for expungement of Registration No. TMA890,203
for the trademark GUITAR MUSE

TO THE RESPONDENT:

A PROCEEDING HAS BEEN COMMENCED by the applicant. The relief claimed by the applicant appears on the following page.


THIS APPLICATION will be heard by the Court at a time and place to be fixed by the Judicial Administrator. Unless the Court orders otherwise, the place of hearing will be as requested by the applicant. The applicant requests that this application be heard at Toronto, Ontario.

IF YOU WISH TO OPPOSE THIS APPLICATION, to receive notice of any step in the application or to be served with any documents in the application, you or a solicitor acting for you must prepare a notice of appearance in Form 305 prescribed by the *Federal Courts Rules* and serve it on the applicant's solicitor, or where the applicant is self-represented, on the applicant, WITHIN 10 DAYS after being served with this notice of application.

Copies of the *Federal Courts Rules* information concerning the local offices of the Court and other necessary information may be obtained on request to the Administrator of this Court at Ottawa (telephone 613-992-4238) or at any local office.

IF YOU FAIL TO OPPOSE THIS APPLICATION, JUDGMENT MAY BE GIVEN IN YOUR ABSENCE AND WITHOUT FURTHER NOTICE TO YOU.

Dated: September 30, 2016

Issued by: 
ABIGAIL GRIMES
REGISTRY OFFICER
AGENT DU GREFE
(Registry Officer)

Federal Court of Canada
180 Queen Street West
Toronto, Ontario
M5V 3L6

TO: Francisco Sanchez-Jara
79 Saint Vallier
Gatineau, QUEBEC
J8V 3V6

APPLICATION

1. The Applicant TORPACK LIMITED, A LEGAL ENTITY (“Applicant”) makes an application for an Order, for:

- (a) A Declaration that Canadian Trademark Registration No. TMA890,203 (“Respondent’s Registration”) for the trademark GUITAR MUSE (“Respondent’s Trademark”), registered November 18, 2014, owned by Francisco Sanchez-Jara (“Respondent”) is invalid;
- (b) An Order pursuant to Sections 53.2 and/or 57 of the *Trademarks Act*, striking out the Respondent’s Registration on the basis that it does not accurately express or define the existing rights of the Respondent and on the basis of material false or fraudulent statements;
- (c) An Order pursuant to Section 53.2 of the *Trademarks Act* that the Respondent be permanently prohibited from using, directly or via licence, the Respondent’s Trademark, and its common-law equivalent in Canada;
- (d) A Declaration that the Respondent by filing trademark application no. 1,624,515 (“Respondent’s Application”) that issued to the Respondent’s Trademark, has directed public attention to its goods, services and business in such a way as to cause or be likely to cause confusion in Canada between the Respondent’s goods, service and business and the goods, services and business of the Applicant, contrary to Section 7(b) of the *Trademarks Act*.
- (e) A Declaration that the Respondent, by filing the Respondent’s Application, has depreciated the value of the goodwill in the Applicant’s trademark MUSE (“Applicant’s Trademark”), which is the subject of Canadian Application No. 1,753,996 (“Applicant’s Application”);
- (f) An interlocutory, interim and permanent injunction restraining the Respondent and his servants, agents, contractors, employees and any other person or persons

under his power or control or otherwise in any person having knowledge of this Order, from directly or indirectly;

- (i) Using the words “guitar muse”, or any other words or combination of words or any design confusing with the Applicant’s Trademark, as a trademark or trade name, or for another purpose;
 - (ii) Advertising, displaying or using the Applicant’s Trademark or any trademark or design that is likely to cause confusion with the Applicant’s Trademark;
 - (iii) Directing public attention to his goods, services or business in such a way as to cause or be likely to cause confusion in Canada between the goods, services and business of the Applicant and the goods, services and business of the Respondent;
 - (iv) Passing-off the Respondent’s goods, services as and for the Applicant’s goods, services or business; and
 - (v) Ordering, directing, inducing, instructing, guiding or authorizing any of the above;
- (g) An Order for the Applicant’s costs and disbursements for this application; and
- (h) For such further and other relief as this Honourable Court may deem just.

THE GROUNDS FOR THE APPLICATION ARE:

Applicant

2. The Applicant is the owner of the Applicant’s Trademark that has been used in Canada since at least as early as May 31, 1993. The particulars of the Applicant’s dates of first use in association with goods and services is attached as **Appendix “1”** to this Notice of Application.

The Applicant's Trademark has become well known in Canada as distinguishing the Applicant's goods and services from those of others.

3. The Applicant is also the owner of trademark applications and registrations in the United States for the trademark MUSE, including Application No. 85/252,874 and Registration Nos. 2,322,679, 4,028,796, 4,028,797, 4,031,646, 4,031,647, 4,031,648, 4,037,950, 4,216,283, 4,224,018, 4,390,280 and 4,792,669.

4. The Applicant has filed the Applicant's Application for the Applicant's Trademark. The particulars of the Applicant's Application are attached as **Appendix "2"** to this Notice of Application.

5. The Respondent's Registration has been cited against the Applicant's Application and this is preventing the Applicant's Application from proceeding to registration.

Respondent

6. The Respondent is the owner of the Respondent's Registration for the Respondent's Trademark registered in association with the goods "educational software for guitarists containing topics of music theory" and the services of "operation of a website containing topics of music theory for guitarists".

7. The Respondent's Application was filed April 29, 2013, based on proposed use and a Declaration of Use was purportedly filed on November 18, 2014.

Grounds

8. The grounds for this Application, which is made pursuant to Sections 7, 53.2 and 57 of the *Trademarks Act* and Rules 300 and 301 of the *Federal Courts Rules*, are that the entry in the Trademarks Register relating to the Respondent's Registration for the Respondent's Trademark do not accurately express or define the existing rights of the Respondent, in that:

- (a) the Respondent's Trademark is invalid pursuant to Section 18(1)(a) of the *Trademarks Act* in that the Respondent's Trademark was not registerable at the date of registration;
- (b) the Respondent's Trademark is invalid pursuant to Section 18(1)(b) of the *Trademarks Act* in that the Respondent's Trademark is not, and has never been, distinctive of the Respondent. The Respondent's Trademark does not actually distinguish and is not adapted to distinguish the goods, services and business of the Respondent from the goods, services and business of the Applicant;
- (c) the Respondent's Trademark is invalid pursuant to Section 18(1)(c) of the *Trademarks Act* on the basis that the Respondent has abandoned the Respondent's Trademark. The Respondent is not using, has never used, and has no intention of using the Respondent's Trademark in Canada in association with the goods and services listed in the Respondent's Registration;
- (d) the Respondent's Trademark is invalid pursuant to Section 18 of the *Trademarks Act* on the basis that the Respondent was not the person entitled to secure the registration and, in particular, on the date of filing the Respondent's Application, the Respondent's Trademark was confusing with:
 - (i) a trademark that had been previously used in Canada and made known in Canada, by the Applicant, namely the Applicant's Trademark, which has been used by the Applicant since the dates indicated for the goods and services in Appendix "1" to this Notice of Application; and
 - (ii) a trade name that had been previously used in Canada by the Applicant, namely, MUSE;
- (e) The Respondent's Registration is invalid pursuant to Section 57 of the *Trademarks Act* on the basis that the registration was obtained on the basis of

material false or fraudulent statements. The Respondent did not intend to use the Respondent's Trademark when he filed the Respondent's Application, and did not use the Respondent's Trademark before it registered. The Respondent filed a Declaration of Use in order for the Respondent's Application to proceed to registration. The Respondent's Application could not have proceeded to registration without the material false or fraudulent statements in the Declaration of Use.

9. The Respondent's Registration is void and invalid and must be struck pursuant to Section 53.2 of the *Trademarks Act*, on the basis that the Respondent's Application could not have proceeded to registration had the material false or fraudulent statements in the Declaration of Use not been filed. The Respondent's Registration is void and invalid and must be expunged. An injunction is also appropriate restraining the Respondent from using the Respondent's Trademark, or any mark confusingly similar therewith.

10. The Respondent's Trademark so nearly resembles the Applicant's Trademark that it is likely to be mistaken for it. The Respondent's Registration is depreciating the value of the goodwill in the Applicant's Trademark and directs public attention to the Respondent's goods, services and business in such a way as to cause or be likely to cause confusion in Canada between the Respondent's goods, services and business and the goods, services and business of the Applicant.

11. The Applicant relies upon the *Federal Courts Rules*, including Rules 3, 63, 300 and 301, and the *Trademarks Act*, including Sections 2, 4, 6, 7, 16, 18, 30, 40, 53.2 and 57.

THIS APPLICATION WILL BE SUPPORTED BY THE FOLLOWING MATERIAL:

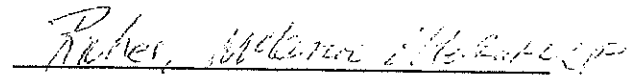
12. This Application will be supported by the following material:

(a) Affidavits on behalf of the Applicant;

- (b) A certified copy of the prosecution history of the Respondent's Registration; and
- (c) Such further and other material as this Honourable Court may allow.

13. The Applicant requests that this Application be heard at Toronto, Ontario.

Dated at Toronto, Ontario this 30th day of September, 2016



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Toronto, Ontario, Canada
M4W 3J5

Michael Adams

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Fax (416) 961-5081

Solicitors for the Applicant

APPENDIX “1”



APPENDIX 1

Applicant's Trademark MUSE

#	GOODS	DATE OF FIRST USE
1	pre-recorded compact discs and audio cassette tapes featuring music	May 31, 1995
2	cell phone cases; cell phone charms; downloadable music via the internet and wireless devices; downloadable video recordings featuring music; downloadable electronic publications in the nature of songbooks, tablature, and sheet music; musical sound recordings; musical video recordings; pre-recorded CDs, DVDs and audio/visual discs featuring music and music instruction; phonograph records featuring music	May 31, 1993
4, 5, 6, 7, 9, 10, 11, 12, 13	jewelry; and dog tags for wear by humans for decorative purposes guitar picks posters, calendars, stickers, tour programs, books in the field of music, songbooks, sheet music, and pen ink cartridges messenger bags, totes, gym bags, umbrellas, and wallets non-metal and non-leather key chains beverage ware; bottle openers; and coasters not made of paper and not being table linen clothing, namely, shirts, t-shirts, sweatshirts, tank tops, hooded shirts, shorts, underwear, rain ponchos, and jackets; belts; cloth wristbands; and headwear ornamental cloth patches; and ornamental novelty buttons and badges Christmas tree ornaments, puzzle cubes, and teddy bears	April 18, 2004
#	SERVICES	DATE OF FIRST USE
1	entertainment, namely, live performances by a musical band	April 18, 2004
2	non-downloadable music; providing a website featuring information in the field of music and entertainment; live performances by a musical group; music publishing services; fan club services; and on-line journals, namely, blogs featuring discussions about music, musicians and entertainment events	June 30, 1996

APPENDIX “2”





Canadian Intellectual
Property Office
An Agency of
Industry Canada

Office de la propriété
intellectuelle du Canada
Un organisme
d'Industrie Canada

Canada

Canadian Intellectual Property Office

Canadian trade-mark data

Third-Party Information Liability Disclaimer

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APPLICATION NUMBER:

1753996

REGISTRATION NUMBER:

not registered

STATUS:

SEARCHED

FILED:

2015-11-09

FORMALIZED:

2015-11-13

APPLICANT:

TORPACK LIMITED, a legal entity
55 Drury Lane, Covent Garden
London WC2B5RZ
UNITED KINGDOM

AGENT:

RICHES, MCKENZIE & HERBERT LLP
SUITE 1800
2 BLOOR STREET EAST
TORONTO
ONTARIO M4W 3J5

REPRESENTATIVE FOR SERVICE:

RICHES, MCKENZIE & HERBERT LLP
SUITE 1800
2 BLOOR STREET EAST
TORONTO
ONTARIO M4W 3J5

TRADE-MARK (Word):

MUSE

INDEX HEADINGS:

MUSE

GOODS AND SERVICES:

GOODS BY NICE CLASS:

Nice Class

Statement

9

(1) pre-recorded compact discs and audio cassette tapes featuring music

(2) cell phone cases; cell phone charms; downloadable music via the internet and wireless devices; downloadable video recordings featuring music; downloadable electronic publications in the nature of songbooks, tablature, and sheet music; musical sound recordings; musical video recordings; pre-recorded CDs, DVDs and audio/visual discs featuring music and music instruction; phonograph records featuring music

(3) cell phone cases; cell phone charms; downloadable music via the internet and wireless devices; downloadable video recordings featuring music; downloadable electronic publications in the nature of songbooks, tablature, and sheet music; musical sound recordings; musical video recordings; pre-recorded DVDs and audio/visual discs featuring music; phonograph records featuring music

- 14 (4) jewelry; and dog tags for wear by humans for decorative purposes
- 15 (5) guitar picks
- 16 (6) posters, calendars, stickers, tour programs, books in the field of music, songbooks, sheet music, and pen ink cartridges
- 18 (7) messenger bags, totes, gym bags, umbrellas, and wallets
- (8) messenger bags, tote bags, gym bags, umbrellas, and wallets
- 20 (9) non-metal and non-leather key chains
- 21 (10) beverage ware; bottle openers; and coasters not made of paper and not being table linen
- 25 (11) clothing, namely, shirts, t-shirts, sweatshirts, tank tops, hooded shirts, shorts, underwear, rain ponchos, and jackets; belts; cloth wristbands; and headwear
- 26 (12) ornamental cloth patches; and ornamental novelty buttons and badges
- 28 (13) Christmas tree ornaments, puzzle cubes, and teddy bears

SERVICES BY NICE CLASS:

Nice Class

Statement

- 41 (1) entertainment, namely, live performances by a musical band
- (2) non-downloadable music; providing a website featuring information in the field of music and entertainment; live performances by a musical group; music publishing services; fan club services; and on-line journals, namely, blogs featuring discussions about music, musicians and entertainment events

CLAIMS:

Used in CANADA since at least as early as May 31, 1995 on goods (1).
 Used in CANADA since at least as early as May 31, 1993 on goods (2).
 Used in CANADA since at least as early as April 18, 2004 on goods (4), (5), (6), (7), (9), (10), (11), (12), (13) and on services (1).
 Used in CANADA since at least as early as June 30, 1996 on services (2).
 Used in UNITED STATES OF AMERICA on goods (1), (3), (4), (5), (6), (8), (9), (10), (11), (12), (13) and on services.

Filed in UNITED STATES OF AMERICA on February 27, 2011 under No. 85/252,874 on goods (8).
 Registered in or for UNITED STATES OF AMERICA on February 29, 2000 under No. 2,322,679 on goods (1) and on services (1).
 Registered in or for UNITED STATES OF AMERICA on October 16, 2012 under No. 4,224,018 on goods (3).
 Registered in or for UNITED STATES OF AMERICA on August 27, 2013 under No. 4,390,280 on goods (4).
 Registered in or for UNITED STATES OF AMERICA on September 27, 2011 under No. 4,031,646 on goods (5).
 Registered in or for UNITED STATES OF AMERICA on September 27, 2011 under No. 4,031,647 on goods (6).
 Registered in or for UNITED STATES OF AMERICA on October 11, 2011 under No. 4,037,950 on goods (9).
 Registered in or for UNITED STATES OF AMERICA on September 20, 2011 under No. 4,028,796 on goods (10).
 Registered in or for UNITED STATES OF AMERICA on August 18, 2015 under No. 4,792,669 on goods (11).
 Registered in or for UNITED STATES OF AMERICA on September 27, 2011 under No. 4,031,648 on goods (12).
 Registered in or for UNITED STATES OF AMERICA on September 20, 2011 under No. 4,028,797 on goods (13).
 Registered in or for UNITED STATES OF AMERICA on October 02, 2012 under No. 4,216,283 on services (2).

Action Information

<u>ACTION</u>	<u>DATE</u>	<u>BF</u>	<u>COMMENTS</u>
Filed	2015-11-09		
Created	2015-11-10		
Formalized	2015-11-13		
Search Recorded	2016-04-14		
Examiner's First Report	2016-04-14	2016-10-14	
Correspondence Created	2016-09-07	2016-10-14	

Last updated: 2016-09-27