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

Proceeding	91237760
Party	Defendant Secret of the Islands, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matters of Applications Serial No.: 87/328,055,
87/328,045, 87/328,062, 87/250,354, 87/328,071

Holy City Skin Products, LLC,

Opposer,

-against-

Secret of The Islands, Inc.,

Applicant.

Opposition No.: 91237760, 91237759, 91237761,
91237762, 91237763

MOTION TO SUSPEND
ACTION UNDER 37 C.F.R.
2.117

MEMORANDUM OF LAW IN SUPPORT TO SUSPEND ACTION
UNDER 37 C.F.R.2.117

Applicant, Secret of The Islands, Inc., moves for this action to be suspended pending the disposition of a civil action pending in IN THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF SOUTH CAROLINA COLUMBIA DIVISION, C/A No.: 2:17-cv-00342-DCN, between the parties designated in that case as Plaintiff, Secret of the Islands, Inc. (“Plaintiff”), for Its complaint against defendants, Hymans Seafood Company, Inc. (“Hymans”), Eli Hyman (“Eli Hyman”), Aaron Hyman (“Aaron Hyman”), and Brad Gena (“Gena”) (Hymans, Eli Hyman, Aaron Hyman, and Brad Gena collectively “Hyman

Group”), Holy City Skin Products, Inc. (“HC”), (Hyman Group, and HC collectively “HYHC”), and U.S. Foods, Inc. (“USF”), USA Distributions, LLC, (“USA”), all defendants herein (collectively “Defendants”) for the reasons below.

STATEMENT OF THE FACTS

On or about November 13, 2017 Opposer filed an opposition proceeding to prevent Applicant from registering the mark.

Applicant, Secret of The Islands, Inc., moves for this action to be suspended pending the disposition of a civil action pending in IN THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF SOUTH CAROLINA COLUMBIA DIVISION, C/A No.: 2:17-cv-00342-DCN, filed on February 3, 2017.

An overview of that case is as follows:

“Plaintiff brings this action to enjoin all Defendants’ ongoing and willful efforts, and specifically HYHC’s willful and malicious efforts, to market and sell salts, scents, soaks, lotions, skin products, and other bathroom and personal care products, packaging, jars, bowls, spoons, and displays which are strikingly and confusingly similar to Plaintiff’s line of products, and copies thereof, made known by Plaintiff and viewed widely within the industry as coming from Plaintiff as the one and only original source of goods, and using a marketing method strikingly similar to Plaintiff’s, and marketing using Plaintiff’s slogans or confusingly similar slogans and underlying concepts as Plaintiff’s established slogan marks such as: “Turn your bathroom into a profit center™”, “Turn your bathroom into a display™”, “Turn your bathroom into a showroom™”, and “Turn your bathroom into a display and showroom™”, made known by Plaintiff and viewed widely within the industry established as coming from Plaintiff as the one and only original source of goods. Defendants have intentionally, willfully, and maliciously copied the features

that make Plaintiff's line of products, company, business, good will, instantly recognizable to customers. "

"In fact, upon information and belief, Defendants have been displaying and accepting orders through the practice of showing strikingly similar products, samples, and displays, in substantially similar display set-ups as the SOTI "Turn your bathroom into a display™" displays in a manner to make them appear as if they were Plaintiff's displays and products and in many cases they are using and/or have used Plaintiff's own displays and/or samples, to induce customers into believing they are Plaintiff's products, and then have sold Defendants' merchandise under this pretense that it is Plaintiff's and in some cases even filling Defendants' jars with Plaintiff's products."

The case is still pending in federal court as the parties' dispute about infringement of Plaintiff's intellectual property rights, and the dispute includes the ownership of the application in question in this proceeding.

ARGUMENT

The Board has the power to suspend proceedings in favor of a pending civil action pursuant to Trademark Rule 2.117(a), which states "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. 2.117(a). The Trademark Trial and Appeal Board Manual of Procedure also states "ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding may have a bearing on the issues before the Board."

T.B.M.P. 510.026) (3d ed. 2011).

The Board commonly suspends actions "in the interest of judicial economy and consistent with [its] inherent authority to regulate its own proceedings to avoid duplicating the effort of the court and the possibility of reaching an inconsistent conclusion." *Soc'y of Mex. Am. Eng'rs & Scientists, Inc. v. GVR Pub. Relations Agency, Inc.*, opp. No. 91121723, 2002 WL 31488947, at *4 (TTAB Nov. 6, 2002). A civil action only needs to have a bearing on the issues before the Board in order for the Board to suspend the action. See 6 McCarthy on Trademarks and Unfair Competition §32:47 (4th ed. updated June 2011) ("It is standard procedure for the Trademark Board to stay administrative proceedings pending the outcome of court litigation between the same parties involved in related issues.").

The federal case has a bearing on this proceeding, because the federal court is determining various rights in Applicant's intellectual property, which includes the applicant's rights to the trademark application for the mark and Applicant's application that is the subject of the present opposition. The present applicant's rights to the proposed mark in the disputed application are being challenged in the federal case. Therefore, it would be a waste of the Board's resources to continue prosecuting this opposition proceeding.

CONCLUSION

For the foregoing reasons, Applicant respectfully make this motion and ask the Board to grant this Motion to Suspend this Action under 37 C.F.R. 2.117 and for such other and further relief as may be deemed just and proper by the Board.

Dated: February 13, 2013

Secret of The Islands, Inc.

/Joanne Bolos/

By: Joanne Bolos

President

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Pro Se Applicant