

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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EJW

July 24, 2018

Opposition No. 91237763

*Holy City Skin Products, LLC*

*v.*

*Secret of the Islands, Inc.*

**ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:**

This case now comes up for consideration of Applicant's fully briefed motion (filed on March 2, 2018) to suspend this proceeding pending the final resolution of a civil action pending between the parties.

For purposes of this order, the Board presumes the parties' familiarity with the pleadings, the parties' arguments made in connection with the subject motion, and the supporting material submitted by Applicant.

**PRELIMINARY MATTER**

- **Applicant's "Counterclaims" Stricken**

The Board will give no consideration to Applicant's "Counterclaims" set forth in its answer. In the first instance, Opposer has not pleaded any trademark or service mark registration to cancel by means of a counterclaim.<sup>1</sup> Moreover, Applicant's

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<sup>1</sup> Even if Opposer had pleaded registrations, Applicant did not submit any fees in support of a counterclaim. See Trademark Rules 2.6(a)(16)(ii), 2.106(b)(3), and 2.111(a).

allegations essentially involve unfair trade practices and trademark infringement, neither of which may be addressed before the Trademark Trial and Appeal Board. The Board is empowered to determine only the right to register trademarks or service marks. *See* Sections 17, 18, 20 and 24 of the Trademark Act, 15 U.S.C. §§ 1067, 1068, 1070, and 1092; *see also Conolty v. Conolty O'Connor NYC LLC*, 111 USPQ2d 1302, 1309 (TTAB 2014); *Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1082-83 (TTAB 2014), *aff'd* 112 F.Supp.3d 439, 115 USPQ2d 1524, 1558 (E.D. Va. 2015), *vacated on other grounds, Pro-Football, Inc. v. Blackhorse*, 709 Fed.Appx. 182 (4<sup>th</sup> Cir. 2018) (mem.). In particular, the Board has no jurisdiction to determine claims of trademark infringement and unfair competition. *See Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1771 n.5 (TTAB 1994), *aff'd mem.*, 108 F.3d 1392 (Fed. Cir. 1997). Additionally, the Board will not hold any person in contempt, or award attorneys' fees or other expenses to any party. Trademark Rule 2.127(f). Accordingly, Applicant's "counterclaims" are hereby **stricken**, and will be given no further consideration. *See* Fed. R. Civ. P. 12(f); Trademark Rule 2.116(a).

## **APPLICANT'S MOTION TO SUSPEND**

- **Parties' Arguments**

Applicant requests that this proceeding be suspended pending the resolution of a civil action between the parties and other defendants therein, namely, *Secret of the Islands, Inc. v. Hymans Seafood Company, Inc., Eli Hyman, Aaron Hyman, Brad Gena, Holy City Skin Products, Inc., U.S. Foods, Inc., and USA Distributions, LLC*, C/A No.: 2:17-cv-00342-DCN, pending in the United States District Court for the

District of South Carolina, Columbia Division. As grounds for suspension, Applicant argues that the civil case has a bearing on these proceedings because the Court therein will determine Applicant's intellectual property rights in its applied-for marks. In opposition, Opposer asserts that suspending this proceeding is improper because the parties involved here are different from the parties in the civil action, the claims are different, and Applicant (as plaintiff in the civil case) may cite its pending applications as support for the existence of bona fide trademarks. Opposer also mentions that it filed a motion to dismiss in the civil case, which is still pending. In reply, Applicant submitted a copy of the complaint in the civil case.

- **Decision**

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 (June 2018). 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).

The Board finds that suspension of this proceeding is appropriate. The Board proceeding and the referenced civil action involve the same marks and the same parties (14 TTABVUE 2). Furthermore, to determine Applicant's trademark infringement claim (as plaintiff therein) (*see, e.g.*, complaint, ¶¶ 29, 45, 71 and 86, 13 TTABVUE 16, 18, 21-22, 24), the district court will most likely decide what Applicant's rights are, if any, in the applied-for marks. *See, e.g., JFJ Toys, Inc. v. Sears Holdings Corp.*, 237 F.Supp.311, 327 (D.Md. 2017) (citing *Putt–Putt LLC v. 416 Constant Friendship, LLC*, 936 F.Supp.2d 648, 653 (D.Md. 2013) and *Lone Star Steakhouse & Saloon, Inc. v. Alpha of Virginia, Inc.*, 43 F.3d 922, 930 (4th Cir. 1995)) (“To establish a claim of trademark infringement, a plaintiff must prove that it (1) owns a valid and protectable mark and (2) that the defendant’s use of that mark creates a likelihood of confusion”); *see also Ale House Mgmt., Inc. v. Raleigh Ale House, Inc.*, 205 F.3d 137, 140 (4th Cir. 2000) (a generic term “can never be protected”) (internal citation omitted). In view thereof, any factual findings made by the district court related to Applicant’s claim of trademark infringement (including whether the applied-for marks are inherently distinctive and function as source indicators) would likely impact the Board’s factual findings in connection with Opposer’s claims that the applied-for mark is generic and comprises functional matter (1 TTABVUE 1). Accordingly, the civil action would likely have a bearing on these Board proceedings.

In view of the foregoing, Applicant's motion to suspend this proceeding pending the resolution of the civil action between the parties is **GRANTED**, and this proceeding is hereby **SUSPENDED** pending final disposition of the civil action between the parties.

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.



**THE FOLLOWING INFORMATION ON BOARD PROCEEDINGS IS PROVIDED AS A COURTESY TO APPLICANT.**

- **Nature of an Opposition Proceeding**

An *inter partes* proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions; discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. **No paper, document, or exhibit will be considered as evidence in the case**

**unless it has been introduced in evidence in accordance with the applicable rules.**

- **Legal Representation Is Strongly Encouraged**

It should also be noted that while Patent and Trademark Rule 10.14 permits any person to represent him or herself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition or cancellation proceeding to secure the services of an attorney who is familiar with such matters. The U.S. Patent and Trademark Office cannot aid in the selection of an attorney.

It is recommended that Applicant obtain a copy of the latest edition of Title 37 of the Code of Federal Regulations, which includes the Trademark Rules of Practice. These rules may be viewed at the USPTO's Trademarks page: <https://www.uspto.gov/trademark/laws-regulations>. The Board's main webpage, <https://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board>, includes information on the Trademark Rules applicable to Board proceedings, on the Board's online systems, Alternative Dispute Resolution (ADR), Frequently Asked Questions about Board proceedings, and a web link to The Trademark Trial and Appeal Board Manual of Procedure (the TBMP). Further, all Board proceedings and other information regarding the Trademark Trial and Appeal Board may be accessed at the following URLs: <http://ttabvue.uspto.gov/ttabvue/> and <http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

- **Requirement for Service on Adverse Party of All Papers Filed**

Trademark Rules 2.119(a) and (b) require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board. Consequently, copies of all papers which Applicant may file in this proceeding must be accompanied by “proof of service” of a copy on the adverse party or the adverse party’s counsel if one is appointed.

"Proof of service" usually consists of a signed, dated statement attesting to the following matters: (1) the title or nature of the paper being served, (2) the method of service (*i.e.*, electronic mail), (3) the person being served and the email address used to effect service, and (4) the date of service. This written statement should take the form of a “certificate of service” which should read as follows:

The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was served upon Opposer by forwarding said copy, via email to: [insert email address].

The certificate of service must be signed and dated.

- **Electronic Submissions to the Board**

All submissions in Board proceedings must be made via ESTTA, the Electronic System for Trademark Trials and Appeals, and must be in compliance with Trademark Rules 2.126(a) and 2.126(b). *See* TBMP § 110.01. The ESTTA user

manual, ESTTA forms, and instructions for their use are located at <http://estta.uspto.gov/>.

- **Applicant's Correspondence Address**

Applicant is reminded that it is her responsibility to ensure that the Board<sup>2</sup> has her current correspondence address, including email address and telephone number. *See* TBMP § 117.07 (If a party fails to notify the Board of a change of address, with the result that the Board is unable to serve correspondence on the party, default judgment may be entered against the party).

- **General Information on Discovery Conferences**

Applicant is referred to the Board's institution order in this proceeding and to the following URL:

[http://www.uspto.gov/trademarks/process/appeal/RULES08\\_01\\_07.pdf](http://www.uspto.gov/trademarks/process/appeal/RULES08_01_07.pdf), see, e.g., pp. 42245, 42246, 42248 and 42252. During the conference, the following topics must be discussed:

- (1) the nature of and basis for their respective claims and defenses;
- (2) the possibility of settling the case or at least narrowing the scope of claims or defenses, and;
- (3) arrangements relating to disclosures, discovery and introduction of evidence at trial, should the parties not agree to settle the case.

Either party may request the participation of the Board in the discovery conference.

*See* Trademark Rule 2.120(a)(2), 37 C.F.R. § 2.120(a)(2).

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<sup>2</sup> When an *inter partes* proceeding is not pending before the Board, the registrant must maintain a current address with the Trademark Office.

- **Information on Initial Disclosures**

Applicant is referred to the following web addresses to obtain information regarding initial disclosures:

[http://www.uspto.gov/trademarks/process/appeal/RULES08\\_01\\_07.pdf](http://www.uspto.gov/trademarks/process/appeal/RULES08_01_07.pdf) and to

<http://edocket.access.gpo.gov/2006/pdf/06-197.pdf> or to

[http://www.uspto.gov/trademarks/process/appeal/RULES01\\_17\\_06.pdf](http://www.uspto.gov/trademarks/process/appeal/RULES01_17_06.pdf). See Notice

of Final Rulemaking (“Miscellaneous Changes to Trademark Trial and Appeal

Board Rules”) in the Federal Register, 72 Fed. Reg. 147 (August 1, 2007) and 71

Fed. Reg. 10, 2501 (January 17, 2006).

