

UNITED STATES PATENT AND TRADEMARK OFFICE  
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February 13, 2019

Opposition No. 91239962

*Hulu, LLC*

*v.*

*Humu, Inc.*

**J. Krisp, Interlocutory Attorney:**

This proceeding is before the Board for consideration of Applicant's January 18, 2019 motion to suspend this proceeding pending the determination of a civil action. The motion is fully briefed.<sup>1</sup>

Applicant moves for suspension of this opposition pursuant to Trademark Rule 2.117(a), based on *Humu, Inc. v Hulu, LLC*, Civil Action No. 3:19-cv-00327, which it filed on January 18, 2019, and is presently pending in the United States District Court for the Northern District of California ("civil action"). Applicant appropriately

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<sup>1</sup> The Board has considered the parties' briefs on the contested motion, but does not repeat or discuss all of the arguments and submissions, and does not address irrelevant arguments. *Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

The Board, in its discretion, and to avoid delay to this proceeding, considers the merits of Applicant's motion prior to the time for filing a reply brief thereon. TBMP § 502.02(b); *Cf.* TBMP § 502.06(a); *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1720 n.3 (TTAB 1989).

submitted a copy of the complaint for declaratory judgment which it filed in the civil action. 15 TTABVUE 6.

### **Analysis**

It is the policy of the Board to suspend proceedings when the parties are involved in a civil action, which may be dispositive of or have a bearing on the Board case. The applicable authority, Trademark Rule 2.117(a), provides:

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.

TBMP § 510.02(a) (June 2018); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1936-37 (TTAB 1992). The determination of the appropriateness of suspension of an *inter partes* proceeding pending the final determination of a civil action or another proceeding is solely within the discretion of the Board. TBMP § 510.02(a).

This opposition involves the registrability of Applicant's three applications to register the standard character mark HUMU for its identified products and services, in view of Opposer's claims alleging likelihood of confusion and dilution, and alleging rights in and registrations for the mark HULU. The Board has reviewed the complaint filed in the civil action. It involves the same parties, as well as the same or similar issues of law and fact. Specifically, Applicant (plaintiff therein) denies that its use of its HUMU mark is likely to cause confusion with Opposer's (defendant therein) pleaded marks, and seeks declaratory judgment that use of its HUMU mark

is not likely to cause confusion, that Opposer's mark is not famous, that Applicant's use is not likely to dilute the distinctiveness of Opposer's marks through blurring or tarnishment, and that its use is not in violation of any rights Opposer may have in its marks under federal or California state law. 15 TTABVUE 9-14.

The Board briefly addresses Opposer's arguments. Whether the District Court has jurisdiction is a matter for resolution in that forum, and Opposer's argument that there is no jurisdictional basis for a declaratory judgment action does not lead to a conclusion that the determination in the civil action will not have a bearing on this opposition proceeding. Moreover, Opposer argues but has not demonstrated that suspension would waste judicial resources. 16 TTABVUE 3.

On this record, the Board finds that the final determination in the civil action may have a bearing on or be determinative of one or more of the issues presented in this opposition proceeding. In view of this finding, suspension is appropriate pursuant to Trademark Rule 2.117(a). Applicant's motion is **granted**.

Accordingly, this proceeding is suspended pending final determination of the civil action.

Within twenty days after the final determination of the civil action, the parties shall so notify the Board so that this proceeding may be called up for appropriate action.<sup>2</sup> Such notification to the Board should include a copy of any final order or

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<sup>2</sup> A proceeding is considered to have been finally determined when an order or ruling that ends litigation has been rendered, and no appeal has been filed, or all appeals filed have been decided and the time for any further review has expired. TBMP § 510.02(b).

final judgment which issued in the civil action. This need not be a certified copy. The Board may periodically inquire as to the status of the civil action.

In view of the Board's suspension of proceedings under Trademark Rule 2.117(a), Applicant's February 12, 2019 consented motion to extend is moot and will be given no consideration.

During the suspension period, the parties must notify the Board of any address or email address changes for the parties or their attorneys. In addition, the parties are to promptly inform the Board of any other related cases, even if they become aware of such cases during the suspension period. Upon resumption, if appropriate, the Board may consolidate related Board cases.